

O-448-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3373449

BY COMFY LIFE LTD

TO REGISTER:



AS A TRADE MARK IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416005

BY

ALTUNKAYA INSAAT NAKLIYAT GIDA TICARET ANONIM SIRKETI

BACKGROUND & PLEADINGS

1. On 7 February 2019, ComfyLife Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods in class 5 shown in paragraph 9 below. The application was published for opposition purposes on 15 February 2019.

2. On 15 April 2019, the application was opposed in full by Altunkaya Insaat Nakliyat Gida Ticaret Anonim Sirketi (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon all the goods (shown in paragraph 9 below) in the following International Registration designating the UK (“IRUK”):

No. 1232076 for the trade mark shown below, which designated the UK on 16 December 2015 and which was granted protection on 11 August 2016:



“Colours claimed - Blue, dark blue, black and white.”

3. The opponent states:

“The marks are similar visually and phonetically as the trade marks both contain similar words CONFY/COMFY. The later filed application contains the word COMFYLIFE in a bubble which extends at both ends. This brings to mind the bubble writing of the earlier CONFY mark, especially because the font is highly similar/identical. Further, the earlier mark claims the colour blue and the predominant colour of the later filed application is blue.

In addition, the later filed application covers both identical and similar goods, including, by way of example only, various terms relating to diapers, which is encompassed by, and is similar to, the wider term in the earlier registration, covering "sanitary preparations". The identical term "diapers for adults" is also covered..."

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. In these proceedings, the opponent is represented by Boulton Wade Tennant LLP; the applicant represents itself. Although neither party filed evidence, the applicant filed written submissions during the evidence rounds. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. Periods expiring on 7 May and 8 June 2020 respectively were allowed for these purposes. Both of these periods fell within the "interrupted days" period implemented by the Intellectual Property Office as a result of the disruption caused by the Covid outbreak. On 8 June 2020, the opponent filed written submissions in lieu of a hearing. In an official letter dated 25 June 2020, the applicant was allowed until 30 July 2020 in which to request a hearing and until 27 August 2020 to file written submissions. On 25 August 2020, the applicant filed written submissions. I have read all of these submissions and shall keep them all in mind in reaching a conclusion.

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 –

(a)...

(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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

7. The trade mark upon which the opponent is relying qualifies as an earlier trade mark under the provisions of section 6 of the Act. Given the interplay between the dates on which the opponent’s trade mark was granted protection and the application date of the trade mark being opposed, the earlier trade mark is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent can rely upon all the goods claimed without having to demonstrate it has made genuine use of them.

Case law

8. The following principles are gleaned from the decisions of the courts of the European Union 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.

Comparison of goods

9. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 3 - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; baby wipes; pre-moistened cosmetic wipes. Class 5 - Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes;	Class 5 - Adult diapers; Disposable adult diapers; Disposable diapers; Disposable diapers for incontinence; Disposable diapers of paper for incontinents; Disposable liners for incontinence diapers; Incontinence diapers; Diapers for incontinence; Diapers for incontinents; Incontinence diapers; Incontinence garments; Incontinence napkins; Incontinence pads; Diapers for incontinence;

<p>dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; diapers for babies; diapers for adults.</p> <p>Class 16 - Paper and cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; paper tissues.</p>	<p>Disposable diapers for incontinence; Disposable liners for incontinence diapers; Disposable pads for incontinence; Pants, absorbent, for incontinence.</p>
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10. In its counterstatement, the applicant states:

“Brand Usage: Up on analysing the opponent's product in this category, we could also understand that the opponent is not using their registered logo on their adult diaper product brand and packages. Instead, they are using a completely different logo which has no relation with either of these logos in question...”

And:

“...Neither they have a brand presence in UK, nor, they have this particular product sold in UK at present.”

11. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the Court of Justice of the European Union (“CJEU”) stated:

“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.”

12. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated:

“78....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

13. Although I understand the applicant’s comments, its approach is misconceived. As the above case law makes clear and as I explained, as the opponent’s earlier trade mark is not subject to the proof of use provisions, it is not necessary for it to

demonstrate that it has used its trade mark. In those circumstances, what I must do is compare the words as they appear in the competing specifications on a fair and notional basis, reminding myself that none of the specifications are limited in any way.

14. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

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

“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”.

16. The applicant’s specification contains a range of diapers, liners for diapers, incontinence garments, incontinence napkins, incontinence pads and absorbent pants for incontinence, whereas the opponent’s specification in class 5 includes, inter alia, “diapers for babies” and “diapers for adults.” Where not identical (either literally or on the *Merici* principle), given the similarity in the nature, intended purpose, method of use and trade channels, the competing goods are similar to a high degree.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. 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.”

18. In its written submissions, the opponent states:

“20. The contested goods in class 5 are available to the general public as they are sold without prescription in pharmacies, in supermarkets and online. Whilst it is likely to be a particular consumer seeking an incontinence product, the outlay is not particularly large and as such, the purchasing of these goods is likely to be predominately based on the effectiveness of the product. Accordingly, it is not considered a dramatically important choice for the consumer. In my view, the purchasing process for these goods would typically be visual in nature; the goods are likely to be purchased after the consumer has perused the shelves in brick and mortar retail establishments or viewed information in brochures or on the internet. The level of attention of the consumer will be average to low...”



19. I agree with the majority of the opponent's submissions, to which I would add that aural considerations in the form of word-of-mouth recommendations and oral requests to sales assistant must not be ignored. I do, however, disagree that the selection of the goods at issue "is not considered a dramatically important choice for the consumer". Rather, the "effectiveness of the product" is, in my view, a highly relevant consideration and is likely to result in an at least a medium degree of attention being paid during the selection process.

Comparison of trade marks

20. 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 them, 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."

21. 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
	

22. The opponent's trade mark consists of the word "CONFY" presented predominantly in dark blue in a slightly stylised but unremarkable script. There is what appears to be a stylised device of any eye (presented in white, pale blue and black) in the centre of what I am satisfied will be construed by the average consumer as a letter "O". Even if the device of an eye is noticed, given its size in the context of the trade mark as a whole, any contribution it may make to the overall impression conveyed and distinctiveness will, at best, be low. Rather, it is the word "CONFY" that will dominate the overall impression conveyed and it is in this word the overwhelming majority of the distinctiveness lies.

23. The applicant's trade mark consists of a number of components. The first is a device presented in turquoise and white and in which the white elements appear to show a weave like pattern. In my view, this component is likely to be construed by the average consumer as a stylised representation of some of the goods for which registration is being sought, for example, "incontinence pads". Although given its size this component will make a significant contribution to the overall impression conveyed, its distinctiveness is likely to be very limited. Within the turquoise device (at the top left and bottom right) there appears, in a darker shade of blue, stylised devices of hands. Although the devices of hands will contribute to both the overall impression conveyed and the trade mark's distinctiveness, given their size in the context of the trade mark as a whole, this contribution will, in my view, be modest.

24. The final component consists of the words “Comfy” and “Life” presented in title case in white in a slightly stylised and again unremarkable script. Although both words and their meanings will be very well known to the average consumer, for the avoidance of doubt, I note that Collinsdictionary.com defines “comfy” as: “A comfy item of clothing, piece of furniture, room, or position is a comfortable one.” I am satisfied that is a meaning with which the average consumer will be very familiar. The words “Comfy” and “Life” form a unit which I am further satisfied will be understood by the average consumer as meaning “comfortable life” (or similar). Given their size and positioning, these words will make an important contribution to the overall impression conveyed, although when considered in the context of the goods for which registration is being sought, their distinctiveness is likely to be low.

Visual comparison

25. Both parties’ trade marks consist of or contain words consisting of five letters in which the first and second and fourth and fifth letters i.e. “CO”/”Co” and “FY”/”fy” are the same and which appear as the only/first word in the competing trade marks. Although the third letters differ i.e. “N”/”m”, these letters are visually very similar to one another. In addition, both parties’ trade marks are presented in various shades of blue. There are, however, a number of differences i.e. the eye device in the opponent’s trade mark and the word “Life” and the various devices in the applicant’s trade mark. Weighing the relative importance of the various similarities and differences, results in what I regard as a fairly low degree of visual similarity between the competing trade marks.

Aural comparison

26. It is well established that when a trade mark consists of a combination of words and figurative components, it is by the word components that the trade mark is most likely to be referred to. Proceeding on that basis and as the words in the applicant’s trade mark will be very well known to the average consumer, how they will be verbalised is

predictable i.e. as the three syllable combination “Come-fee-Life”. In my view, the opponent’s trade mark is most likely to be articulated as the two syllable combinations “CON-FEE” or “CON-FI”. Even though its articulation as “CON-FEE” offers the opponent its best prospect of success, even then it only results in a fairly low degree of aural similarity.

Conceptual comparison

27. In its counterstatement, the applicant states:

“**Name:** Comfylife is an English name with a meaning for Comfort/Comfortable Life; whilst, 'CONFY' doesn't make any meaning in English to be mistaken for Comfylife.”

28. In its written submissions, the opponent states:

“28. In terms of conceptual meaning, whilst there may be some connotations with comfort associated with the Applicant’s mark and none associated with CONFY...”

29. I have described the devices in the competing trade marks above. They will send differing conceptual messages to the average consumer. Insofar as the word components are concerned, the applicant’s trade mark will send a concrete conceptual message to the average consumer whereas I agree with the opponent that its trade mark will send none.

Distinctive character of the earlier trade mark

30. 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.

31. As the opponent has filed no evidence, I have only the inherent characteristics of its trade mark to consider. As the opponent's trade mark has no meaning, it enjoys a high degree of inherent distinctive character.

Likelihood of confusion

32. 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 it 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.

33. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

34. Earlier in this decision, I concluded that:

- Where not identical, the competing goods are similar to a high degree;
- The average consumer is a member of the general public who, whilst not ignoring aural considerations, will select the goods at issue by predominantly visual means whilst paying at least a medium degree of attention during that process;
- The competing trade marks are visually and aurally similar to a fairly low degree;
- While the devices in the competing trade marks will send differing conceptual messages, the words in the applicant's trade mark will convey a concrete conceptual message whereas the opponent's trade mark will convey none;
- The opponent's earlier trade mark is possessed of a high degree of distinctive character.

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

“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.”

36. In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it

possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

37. The fact that the competing goods are identical/highly similar and the high degree of distinctive character the earlier trade mark enjoys are points in the opponent’s favour. However, despite both being presented in various shades of blue, the fairly low degree of, in particular, visual similarity together with the very clear conceptual message conveyed by the words in the applicant’s trade mark (which are likely to fix themselves in the mind of the average consumer and in so doing will act as a “hook” to prompt their recall), are, in my view, likely to counteract the visual and aural similarities between the competing trade mark and are most unlikely to result in direct confusion. Although I have reached that conclusion in relation to an average consumer paying at least a medium degree of attention during the selection process (thus making him/her less prone to the effects of imperfect recollection), I would have reached the same conclusion even if I had characterised the degree of attention paid as “average to low” as the opponent suggests.

38. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along

the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

39. Given the fairly low degree of visual and aural similarity and reminding myself again of the significantly different conceptual position, there is, in my view, nothing else about the competing trade marks that is likely to lead an average consumer who has noticed that the competing trade marks at issue are different, to conclude that the applicant’s trade mark is in any way connected with the opponent. There is no likelihood of indirect confusion. As there is no likelihood of either direct or indirect confusion, the opposition fails.

Overall conclusion

40. The opposition has failed, and, subject to any successful appeal, the application will proceed to registration.

Costs

41. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. The official letter of 7 April 2020 sent to the applicant contained the following:

“What to do if you intend to request costs

If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send

these by e-mail to tribunalhearings@ipo.gov.uk. If there is to be a “decision from the papers” this should be provided by **8 June 2020**.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs.

Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

42. The deadline for the filing of the pro-forma was also extended to 27 August 2020. The Cost Pro Forma requires those completing it to indicate the amount of time they have spent during the proceedings by reference to various categories of work, for example, “Notice of defence”, “Considering forms filed by the other party”, “Preparing evidence/written submissions/considering and commenting on the other sides’ evidence/written submissions”. However, the completed Cost Pro Forma provided simply indicates that in total 20 hours had been spent by the applicant during the proceedings in relation to “Submissions document preparation.” At an hourly rate of £50, this, states the applicant, amount to £1000.

43. As the law of trade marks is fairly complex, I have little doubt that it would have taken some time for the applicant to familiarise itself with the legal basis of the opposition and, having done so, to complete its counterstatement. Although the applicant filed written submissions during the evidence rounds and in lieu of a hearing, as these submissions drew heavily on comments contained in its counterstatement, these would, I think, have been less onerous to prepare.

44. Although the time spent in dealing with specific parts of the opposition have not been attributed in the manner requested, taking a “rough and ready” view of the matter in light of the basis of the opposition and my comments above regarding the written

submissions filed, a total of 20 hours dealing with the totality of the opposition does not appear to me to be unreasonable. Approached on that basis and applying the guidance provided in the official letter of 7 April 2020, 20 hrs @£19 per hour amounts to £380.

45. I therefore order Altunkaya Insaat Nakliyat Gida Ticaret Anonim Sirketi to pay to ComfyLife Ltd the sum of **£380**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of September 2020

C J BOWEN

For the Registrar