

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2113511
BY ADVANCED LIGHTING TECHNOLOGIES INC.
TO REGISTER A TRADE MARK
WHITE-LUX
IN CLASS 11

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 46914
by FLOWIL INTERNATIONAL LIGHTING (HOLDING) B.V.

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BACKGROUND

On 22 October 1996, Advanced Lighting Technologies, Inc., of 2307 East Aurora Road, Suite One, Twinsburg, Ohio 44087, United States of America applied under the Trade Marks Act 1994 for registration of the trade mark **WHITE-LUX** in respect of the following goods in Class 11:

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“Metal halide electric lamps”

On the 27 May 1997 Flowil International Lighting (Holding) B.V. filed notice of opposition to the application. The grounds of opposition are in summary:

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i) The opponents, Flowil International Lighting (Holding) B.V., a Dutch company are part of a large group of companies that are collectively known as the Sylvania Lighting Group. This group is a well-known group of companies that make and sells a wide range of lighting apparatus and instruments in the UK, Europe and many other countries of the world.

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ii) The opponents are the proprietors of the mark BRITELUX (registration number B1585070) for goods in Class 11.

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iii) There exists a likelihood of confusion on the part of the public between the marks of the applicants and the mark of the opponents, which includes the likelihood of association. The opponents therefore claim that the application offends against the provisions of Section 5(2) of the Trade Mark Act 1994.

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The applicants subsequently filed a counterstatement denying all of the grounds of opposition, other than agreeing that the opponents are the registered proprietors of the trade marks as claimed. Both sides ask for an award of costs.

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Both sides filed evidence in these proceedings and the matter came to be heard on 8 July 1999 when the applicants were represented by Ms Michaels of Counsel, instructed by the trade mark agents Fry Heath & Spence, and the opponents by Mr Birss of Counsel, instructed by the trade mark agents Frank B. Dehn & Co.

OPPONENTS' EVIDENCE

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This takes the form of a statutory declaration, dated 26 November 1997, by Mr Edward Philip Bartlett a Director of Flowil International Lighting (Holding) B.V. a position he has held since 29 January 1993. He confirms that his declaration is based on his knowledge and also from the records and documents

of the company.

Mr Bartlett states that the opponents are part of a large group of companies, known as the Sylvania Lighting Group. He claims that this group of companies is well known and that they make and sell a wide range of lighting apparatus and instruments throughout Europe and also in “many other countries of the world”. He states that

“SYLVANIA is the House Mark of the Group in all countries of the world other than North America. The Group owns registrations of the mark SYLVANIA in at least 100 countries / territories of the world. Lighting products (such as fluorescent, incandescent and metal halide lamps) of the Group are widely advertised and are exhibited at numerous lighting exhibitions throughout the world. There is now produced by me marked EPB1 as an exhibit to this my declaration a copy of the current SYLVANIA lamp catalogue showing the wide range of lamps that is sold by the Group.”

The catalogue at exhibit EPB1 shows the Group name (Sylvania) on the front cover. There are 152 pages in the catalogue with details of the BRITELUX bulbs being given on page 109. From the picture of the light bulb shown it is clear that the name of the Group (Sylvania) appears above, and in larger lettering than, the mark BRITELUX.

Mr Bartlett states that the opponents are the registered proprietors of the mark BRITELUX registered for a “broad range of lighting apparatus, instruments and installations”. He claims that products bearing the BRITELUX mark have been sold by the group in the UK since 1995.

Mr Bartlett gives his opinion that the two marks are similar as “the hyphen is a trivial difference and all the letters except the first two are the same. Furthermore, the words ‘brite’ and ‘white’ in my view sound very similar”. Mr Bartlett claims that if the application were allowed there would be confusion between the two marks particularly when orders are made over the telephone. He also claims that “when customers try to remember a product for re-order they may well be confused into ordering the wrong product”.

APPLICANTS’ EVIDENCE

This consists of two statutory declarations. The first is by Mr Robert S Roller, dated 2 March 1998, the Vice President for Marketing of Venture Lighting International, Inc. a wholly owned subsidiary of Advanced Lighting Technologies Inc. Mr Roller has held his position as vice president since 1983, and is, since December 1995, also an officer of Advanced Lighting Technologies Inc.

Mr Roller states that the applicants are a well-known company which manufactures and sells lighting products “in the UK and throughout the world”. He claims that the applicants adopted and began using the mark WHITE-LUX for metal halide lamps in the USA “at least as early as January 1989”, and further claims that the mark has been “in substantially exclusive and continuous use in the USA and throughout the world by the applicants since that time.”

With regard to the UK, Mr Roller states that:

“The applicants began using the mark for metal halide lamps in the United Kingdom at least as

early as 1990, and has been in substantially exclusive and continuous use by the applicants in the United Kingdom since that time. The mark is used by selling lamps bearing the mark and by advertising and promotion of the lamps which bear the mark”.

5 At exhibit 1 is a copy of a brochure which Mr Roller claims shows use of the mark for metal halide lamps in the UK. The brochure features the mark WHITE-LUX prominently, and the brochure also notes the brand as being a registered trade mark in the US. All of the addresses on the brochure are in the USA.

10 Mr Roller states that the applicants have, since 1994, been manufacturing and supplying its metal halide lamps to the opponents bearing Sylvania’s mark BRITELUX. Mr Roller claims that it was the success of the applicants in marketing WHITE-LUX lamps in the UK that was the motivation for Sylvania to enter the market for such lamps with its mark BRITELUX. He claims that the two parties considered the issue of confusion before entering into their present relationship, and that both parties believed that
15 no likelihood of confusion would result from the concurrent use of the two marks.

Mr Roller points out that the opponents claim that their first sale under the BRITELUX brand was in 1995, five years after the applicants began using their mark in the UK. Mr Roller states that he is unaware of any confusion which has occurred in the marketplace.

20 The second statutory declaration is by Anne Spence, dated 2 March 1998. Ms Spence is a registered Trade Mark Agent and a partner of Fry Heath & Spence.

25 Ms Spence states that she was asked by the applicants to search the UK Trade Marks Register for marks in Class 11 relating to lighting apparatus which included the word LUX. She lists 74 such marks. She claims that:

30 “It appears that LUX is a common, non-distinctive element of marks relating to lighting apparatus. LUX is an English word defined in the concise Oxford Dictionary as: ‘a unit of illumination, one lumen per square metre.’ As such LUX is a non-distinctive element of marks relating to lighting apparatus”.

35 OPPONENTS’ EVIDENCE IN REPLY

This consists of a statutory declaration, dated 28 May 1998, by Mr Bartlett. He states “... the applicants manufacture for us some of our BRITELUX range of metal halide lamp products in the USA, not in the United Kingdom”.

40 Mr Bartlett states that contrary to the applicants’ claims the name BRITELUX was chosen as the words BRITE and LUX were used on other products sold by the opponents and “there was a natural progression in putting the two words together”. He denies that the name was chosen due to the alleged success of the WHITE-LUX mark. Mr Bartlett also denies that the parties ever had discussions on the possibility of confusion between the marks, and states that there “was no agreement that there was no
45 likelihood of confusion”.

That concludes my review of the evidence. I now turn to the decision.

DECISION

The only ground of opposition in this case is under Section 5 (2) (b) which states:

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

I have to determine whether the marks are so similar that there exists a likelihood of confusion on the
part of the relevant public. In deciding whether the two marks are similar I rely on the decision of the
Court of Justice of the European Communities (ECJ) in the Sabel v Puma case C251/ 95 - ETMR
15 [1998] 1-84. In that case the court stated that:

 “Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on
 the part of the public. In that respect, it is clear from the tenth recital in the preamble to the
20 Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements
 and, in particular, on the recognition of the trade mark on the market, of the association
 which can be made with the used or registered sign, of the degree of similarity between the
 trade mark and the sign and between the goods or services identified’. The likelihood of
 confusion must therefore be appreciated globally, taking into account all factors relevant to
 the circumstances of the case.”

25 Global appreciation of the visual, aural or conceptual similarity of the marks in question ,
 must be based on the overall impression given by the marks, bearing in mind, in particular,
 their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive -
30 “there exists a likelihood of confusion on the part of the public” - shows that the perception
 of the marks in the mind of the average consumer of the type of goods or services in question
 plays a decisive role in the global appreciation of the likelihood of confusion. The average
 consumer normally perceives a mark as a whole and does not proceed to analyse its various
 details.

35 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of
 confusion. It is therefore not impossible that the conceptual similarity resulting from the fact
 that two marks use images with analogous semantic content may give rise to a likelihood of
 confusion where the earlier mark has a particularly distinctive character, either per se or
40 because of the reputation it enjoys with the public.”

The opponents’ mark BRITELUX is registered for:

45 “Apparatus and installations for lighting; fluorescent light tubes; light bulbs; lamps; filaments
 for lamps; arc lamps; electric discharge tubes for lighting; lamp casings, lamp glasses, lamp
 hanging supports, lamp reflectors, lampshades; luminous tubes for lighting; sockets for electric
 lights; torches; searchlights; lights for automobiles; lights for attracting and killing insects; light
 sources for use in electrical devices for attracting and killing insects; devices for heating insect
 repelling substances; parts and fittings for all of the aforesaid goods; all included in Class 11.”

As the opponents' specification would encompass the applicants' goods, the marks must be considered on the assumption that the goods of the two parties are identical.

5 The applicants have filed evidence regarding the number of marks on the register with the suffix LUX. However it is well established, (see Beck Koller and Co.'s application 1947 64 RPC 76) that the presence of other similar marks on the register can be of no assistance to either party in an opposition unless there is evidence that some of those marks are in use.

10 Visually the marks are similar in that they have the same number of letters, the last six letters of each mark are identical. They differ in that the applicants' mark begins with the letter's WH whereas the opponents' mark begins with the letters BR, the applicants' mark also has a hyphen between the first word WHITE and the second word LUX. At the hearing Counsel for the opponents claimed that the hyphen was insignificant and drew attention to the deliberate misspelling of his clients' mark as BRITE instead of the correct English version, BRIGHT. Whilst I note the similarities I am not inclined to overlook the hyphen in the applicants' mark, and it is accepted that the beginnings of marks are more important than endings for the purposes of this type of comparison. Overall I consider that the marks convey a significantly different visual impression.

20 Phonetically the first two syllables of each mark differ in their beginnings but end the same and the second syllables are identical. Counsel for the opponents asserted that in most parts of the UK there would be little difference between the pronunciation of the two marks as in a number of dialects the "R" sound disappears. This it was contended would make it easy for one mark to be misheard for the other if ordering by telephone. It is well established (and no less true under the 1994 Act) that the beginnings of words are of particular importance - see for instance the following passage from London Lubricants (1920) Ltd's application (Tripcastrid) (1925) 42 RPC 264 at page 279 lines 36-40:-

30 "But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgement, the first syllable of a word is, as a rule, far the most important for the purpose of distinction."

35 Mr Birss also claimed that the goods of both parties were primarily aimed at architects and lighting installers and so orders by telephone would be commonplace. He claimed that the first impression of the marks, as referred to by the Appointed Person in ENERCAP [1999] RPC would lead to confusion. Ms Michaels, for the applicants claimed that the first impression would have entirely the opposite effect of emphasising the differences. She also asserted that the clientele of both parties, being professional would be more discriminating in ordering products and would be less likely to be confused than the average person. I agree with Ms Michaels in her view that such professionals would be less likely to

40 confuse the products of the two parties.

I am not persuaded that the average consumer of these products will so mispronounce the marks as to cause aural confusion.

45 Considering the conceptual nature of the marks, the opponents state that their mark is suggestive of the nature of their products (light bulbs). Their counsel suggested that the mark conveyed the image of brightness, or bright lights. The applicants' mark he asserted conveyed the same idea. He drew a parallel with advertising used for toothpaste and washing powders which use the word "bright" to

convey the image of whiteness. Mr Birss asserted that “things which are white are usually bright”. It is my view that there is some conceptual similarity between the marks, but in my opinion the opponents’ mark signifies an idea of brightness whereas the applicants’ mark conveys the image of purity.

5 Despite the dictionary meaning for the word LUX provided by the applicants as part of their evidence, Counsel for the opponents claimed that his clients’ mark was distinctive. He quoted the ECJ in the Lloyd v Lointns case (C-342 / 97) beginning at paragraph 20:

10 “Furthermore, the more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character, either per se or because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character.”

15 “It follows that, for the purposes of Article 5(1)(b) of the Directive, there may be a likelihood of confusion, notwithstanding a lesser degree of similarity between the trade marks, where the goods or services covered by them are very similar and the earlier mark is highly distinctive”.

20 There is no evidence of any actual confusion, and neither side has provided independent evidence of reputation. I am not persuaded that the opponents mark is highly distinctive. On the contrary, it appears to me that both marks are low in distinctive character because they allude to the nature of the goods at issue. They may not be directly descriptive, as Counsel for the opponents pointed out it in natural English a light bulb would be described as “One thousand-lux” not “BRITELUX”. If the marks were directly descriptive neither would be registrable at all. It is a matter of degree.

25 I therefore conclude that taking account of all the relevant circumstances and the identical nature of the goods, the similarity of the marks is not sufficient to have created a likelihood of confusion at 1 August 1995 (the material date). The opposition under Section 5(2) therefore fails.

30 The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £1135.

Dated this 3 day of August 1999

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George W Salthouse
For the Registrar
The Comptroller General

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