

O-386-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3143924
BY LUMILUX LIGHTING LTD
FOR THE TRADE MARK:**

The logo for LUMILUX features the word "LUMILUX" in a bold, grey, sans-serif font. The letter "X" is stylized with two red diagonal strokes crossing at the center, positioned to the right of the word.

**IN CLASS 11
AND
OPPOSITION THERETO (UNDER NO. 406783)
BY
LEDVANCE GMBH**

BACKGROUND

1) On 24 February 2016, All Lamps Int'l Ltd applied to register the trade mark shown on the cover page of this decision in respect of LED Lamps in class 11. The company later changed its name to Lumilux Lighting Ltd ('the applicant').

2) The application was published in the Trade Marks Journal for opposition purposes on 06 May 2016.

3) Ledvance GmbH ('the opponent') claims that the trade mark application offends under sections 5(1) and/or 5(2)(b) of the Trade Marks Act 1994 ('the Act'). In support of both grounds, the following trade mark registration is relied upon:

EUTM No: 7211121

LUMILUX

Class 11: Apparatus for lighting, in particular electric lamps and lights; parts for the aforesaid goods, included in class 11.

Filing date: 05 September 2008

Date of entry in the register: 30 May 2009

4) The opponent's registered trade mark is an earlier mark in accordance with section 6 of the Act and, as it had been registered for more than five years before the publication date of the applicant's mark, it is subject to the proof of use requirements, as per section 6A of the Act. The opponent made a statement of use in respect of the goods relied upon.

5) The applicant subsequently filed a counterstatement which was not adequately particularised. A number of opportunities were given to the applicant to amend its counterstatement. The applicant states that the opponent does not have sole rights

to the name 'LUMILUX'. Insofar as the matter of proof of use is concerned, it is noted that the official letter of 9 March 2017 sent to the applicant stated:

"I refer to the form TM8 and counterstatement filed 30 January 2017.

The first form TM8 filed in these proceedings dated 18 August 2016 was rejected by the registry on the basis that no proper defence had been filed. In addition, although you indicated that you wished the opponent to provide proof of use you did not further specify on which goods or services you required proof. As you failed to respond to the registry's letter of 28 September 2016 the registry issued a preliminary view that your defence to the opposition should be struck out.

On 18 November 2016 you submitted a second form TM8 which was acceptable to the registry. The second TM8 removed the request for the opponent to provide proof of use evidence, however, the registry asked for clarification of this on 12 December 2016 and 19 December 2016 as you were required to state either 'Yes' or 'No' to question 7 of the form.

As you did not respond to the official letter of 19 December 2016 the registry issued a letter to both parties on 26 January 2017 setting the evidential timetable on the basis that you had removed your request for the opponent to provide proof of use evidence and you failed to respond by the deadline to indicate that you wished to request proof of use.

Following the registry's letter setting the evidence timetable you submitted a third TM8, again requesting proof of use at question 7 but failing to state which goods or services you require proof of use.

In light of the registry providing you with sufficient opportunity to correct your request for proof of use, the preliminary view is that the third form TM8 filed by you on 30 January 2017 is rejected. The registry's view is that the proceedings have been unduly delayed in trying to resolve this issue and the

proceedings should continue on the basis as set out in the official letter of 26 January 2017.

If you disagree with this view you may request a hearing on the matter. Any request to be heard must be made on, or before, **23 March 2017**. If you do not request a hearing by this date the decision will automatically be confirmed.

The proceedings will continue on the basis set out in the registry's letter of 26 January 2017, the opponent's evidence/submissions being due on 27 March 2017."

6) The relevant part of the official letter dated 26 January 2017 (referred to above) stated:

"I refer to my letters dated 12 and 19 December 2016 requiring you to provide an answer to question 7 of the Form TM8 in relation to proof of use.

As you have not provided an amended page to the Form TM8 to make a request for proof of use, it is taken that you do not require the opponent to file proof of use evidence. The proceedings will now continue on that basis.

..."

7) The applicant did not respond to the official letter of 09 March 2017. It follows that the opponent is not required to furnish proof of use of its earlier mark and is therefore entitled to rely upon all of the goods for which it made a statement of use (those listed at paragraph 3 above).

8) Only the opponent filed evidence. The applicant filed nothing beyond the counterstatement. Neither party requested to be heard. Only the opponent filed written submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

Opponent's evidence

9) This comes from Corinna Hiscox, a Chartered Trade Mark Attorney, at Haseltine Lake LLP, the opponent's legal representative.

10) Ms Hiscox provides definitions of the terms 'LED' and 'LED Lamp', an extract from www.which.co.uk explaining the nature of such goods and pictures of LED lamps on the opponent's website. There are also extracts from a brochure entitled "Lighting Program 2014/2015" issued in the EU by the predecessor in title to the earlier mark showing various lighting products listed under the mark LUMILUX. Ms Hiscox also provides prints from the applicant's website showing how it uses its mark on a range of LED lamps.

DECISION

Section 5(1)

11) Section 5(1) of the Act provides:

"5. – (1) a trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trademark is applied for are identical with the goods or services for which the earlier trade mark is protected."

12) In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ('CJEU') held that:

"54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

Whilst both marks clearly consist of the same word, LUMILUX, the stylisation of the 'X' in the applicant's mark, in particular, creates a difference between the marks which, in my view, is not likely to go unnoticed by the average consumer. As such,

the marks are not identical. It follows that the claim under section 5(1) of the Act must fail.

Section 5(2)(b)

13) Section 5(2)(b) of the Act states:

“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.”

14) The leading authorities which guide me are from the CJEU: *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 great 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

15) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (*'Meric'*), the 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”.

The applicant's 'LED lamps' fall within the opponent's 'apparatus for lighting, in particular electric lamps and lights'. The respective goods are identical.

Average consumer and the purchasing process

16) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

17) The average consumer of the goods at issue is the general public. They may vary in price but are generally not very costly items. The consumer is likely to take into account the functionality of the product and may wish to ensure that it is suitable for purpose taking into account factors such as light intensity, colour and the size of the lamp etc. I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act is likely to be mainly visual given that these are goods which will likely be selected off the shelf in a retail establishment or after perusal of images of the product from a website. However, I do not discount aural considerations which may also play a part.

Comparison of marks

18) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in 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.”

It would therefore be wrong to artificially dissect the 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 created by the marks.

19) The marks to be compared are:

LUMILUX

v

LUMILUX

20) The overall impression conveyed by the applicant's mark is strongly dominated by the word LUMILUX. The stylisation of the letter 'X' contributes to the overall impression but to a lesser extent than the word LUMILUX. The stylisation of the letters 'LUMILU' carries very little weight. The opponent's mark consists of LUMILUX in plain block capitals without any stylisation; its overall impression rests solely on that word.

21) Visually, both marks clearly consist of the word LUMILUX. The stylisation of the applicant's mark does not disguise that word in any way. There is a high degree of visual similarity notwithstanding the stylised 'X' of the applicant's mark and the stylisation of the other letters. The marks will be pronounced in the same manner and so are aurally identical. In my view, neither mark evokes any clear and immediately graspable concept; the conceptual position is effectively neutral.

Distinctive character of the earlier mark

22) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

23) The evidence of use before me contains a brochure which is said to have been distributed in the EU some time in 2014/2015. There is nothing to indicate that it was sent to UK consumers. The only part of the evidence which shows any use in the UK is the print from the UK website of the opponent’s predecessor in title showing various lights advertised under the mark LUMILUX. This single piece of evidence clearly comes nowhere near establishing that the earlier mark enjoys an enhanced degree of distinctiveness in the UK. Consequently, I can only take into account the inherent distinctiveness of the earlier mark.

24) The word LUMILUX appears to me to be an invented one. Although it may possibly suggest something do with light/luminescence, any such message is not, to my mind, a clear one. Bearing this in mind together with the invented nature of the mark as a whole, I consider it to have a good degree of distinctiveness.

Likelihood of confusion

25) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare

marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

26) The respective goods are identical and the marks are visually highly similar, aurally identical and (effectively) conceptually neutral. The earlier mark has a good degree of distinctiveness and the average consumer is likely to pay a normal level of attention during a mainly visual purchase (although aural considerations are borne in mind). Having weighed all of these factors, I have no hesitation in finding that there is a likelihood of confusion. **The opposition under section 5(2)(b) of the Act succeeds.**

COSTS

27) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, which was in force at the time of commencement of these proceedings, I award the opponent costs on the following basis, taking into account that the opponent's submissions were very brief and the evidence that was filed was of very little assistance to me:

Official fee (TM7)	£100
Preparing the notice of opposition and considering the counterstatement	£200
Written Submissions and evidence	£300
Total:	£600

28) I order Lumilux Lighting Ltd to pay Ledvance GmbH the sum of **£600**. 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 16th day of August 2017

**Beverley Hedley
For the Registrar,
the Comptroller-General**