

O/607/17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3166494

BY

SHAMEER KOMMOTH

TO REGISTER THE TRADE MARK



**aura lustre**

**GREEN BEYOND BRIGHTNESS**

IN CLASS 11

AND

THE OPPOSITION THERETO

UNDER NO 407401 BY

AURA LIGHT INTERNATIONAL AB

## BACKGROUND


1. Trade mark No. 3166494 shown on the cover page of this decision is applied for in the name of Mr Shameer Kommoth (the applicant). It was applied for on 25 May 2016 and the specification is as follows:<sup>1</sup>

### Class 11

Apparatus for lighting; LED lighting apparatus and installations; LED light bulbs; lighting fixtures and fittings.

2. The application was published on 17 June 2016, following which Aura Light International AB (the opponent) filed notice of opposition against all of the goods in the application.

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act) and relies upon the following trade marks:

Mark details:	Goods relied upon in these proceedings:
<p><b>EUTM:</b> 11634219</p>  <p><b>Colours claimed:</b> green, black</p> <p><b>Filed:</b> 7 March 2013</p> <p><b>Registered:</b> 31 July 2013</p>	<p><b>Class 9</b> Electric accumulators, electric luminaires, batteries for pocket lamps, electric batteries, battery chargers, flash-bulbs (photography), optical lamps and lanterns, luminous signs, neon signs, light emitting diodes [LED], sensors [for lighting], apparatus for lighting management, ballast for electrical lighting components, energy saving solutions included in class 9, parts and components of the aforementioned goods included in class 9.</p> <p><b>Class 11</b> Apparatus for lighting, installations for lighting and lighting solutions, pocket torches, electric lamps and lanterns, safety lamps, halogen lamps, light bulbs, LED-lamps, fluorescent tube lamps, tube lamps [LED], low energy lamps, discharge lamps, electric discharge tubes for lighting, street lighting, luminaires for electric lighting, gas lamps, fairy lights for festive decoration, lamp hanging supports, protective apparatus for lighting, parts and components of the aforesaid goods, included in class 11.</p> <p><b>Class 35</b></p>

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	Marketing, including on-line marketing, of apparatus and installations for lighting as well as parts and accessories therefor, none of the aforementioned goods being apparatus for safety or emergency purposes.
<b>UKTM:</b> 1559152 <b>AURA</b> <b>Filed:</b> 14 January 1994 <b>Registered:</b> 14 March 1997	<b>Class 9</b> Luminous signs.  <b>Class 11</b> Apparatus and installations for lighting; all included in Class 11.
<b>EUTM:</b> 1115047 <b>AURALIGHT</b> <b>Filed:</b> 23 March 1999 <b>Registered:</b> 29 May 2000	<b>Class 9</b> Luminous signs.  <b>Class 11</b> Apparatus for lighting and installations for lighting, electric lamps and lanterns, safety lamps, light bulbs, fluorescent tube lamps, lamp hanging supports, electric discharge tubes for lighting, protective apparatus for lighting, parts and components of the aforesaid goods.

4. The opponent submits that the application is similar to all of its earlier marks and covers goods which are identical with or similar to the goods and services protected by the earlier marks.

5. The applicant filed a counterstatement in which it denies the ground on which the opposition is based. I reproduce the content in full, as follows:

*“The similarity of the Applicant’s mark when compared with the Opponent’s marks is denied.*

*The Applicant’s mark is AURA LUSTRE GREEN BEYOND BRIGHTNESS combined with a distinctive Tree logo. Visually, aurally and conceptually the Applicant’s mark is not confusingly similar.*

*The dominant element of the Applicant’s mark is not AURA. Given the relative size and prominence of each of the elements in the Applicant’s mark, it must be considered as a whole with each element contributing to the overall distinctive character of the combined mark.*

*The validity of UK 1559152 (AURA) is not admitted and the Opponent is put to proof.*

*The validity of EUTM 1115047 (AURA LIGHT) is not admitted and the Opponent is put to proof.*

*The Applicant's mark is dissimilar when compared with the Opponent's marks on which the Opposition is based. Therefore, no further consideration of the respective goods and services is warranted.*

*The Applicant requests that the opposition is dismissed in its entirety.*

*The Applicant requests that an award of costs be made in its favour.”*

6. The opponent filed evidence and submissions during the time allowed for filing evidence and filed further submissions in lieu of attendance at a hearing. I will refer to the submissions where necessary in this decision. The applicant did not file evidence or submissions nor did he seek to be heard. Both sides seek an award of costs.

### **The earlier marks**

7. The applicant has stated that the validity of the opponent's earlier marks UKTM 1559152 and EUTM1115047 is not admitted and puts the opponent to proof of their validity. However, since both marks are registered trade marks, they are presumed to be valid in accordance with section 72 of the Act. If the applicant wished to challenge the earlier marks on validity grounds it should have made an application to do so, in the absence of which there is no requirement on the opponent to prove that they are valid. It may be the case that the reference to validity was a misunderstood reference to the proof of use provisions. Such provisions are relevant to two of the earlier marks and the applicant did put the opponent to proof of their use; as such, I come on to the requirement to show genuine use shortly. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or 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. The marks relied upon by the opponent are earlier marks, two of which (as detailed above) are subject to proof of use as per Section 6A of the Act which reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2)(application on relative grounds where no consent to registration).”

9. EUTM 11634219 is not subject to proof of use, as per section 6A of the Act, having not been registered for five years at the date of publication of the application. The relevant period for which the opponent must show use of UKTM 1559152 and EUTM 1115047 is the five year period ending on the date of publication of the application, namely 18 June 2011 to 17 June 2016. The onus is on the opponent, under section 100 of the Act, to show genuine use of its mark during this period in respect of those goods relied on. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

## Approach and evidence

10. In the first instance I intend to consider the opponent's earlier UK trade mark no 1559152 and provide the following evidence summary on that basis:

### Witness statement of Gunilla Danström and exhibits GD2 and GD4 - GD21

11. Ms Danström has been employed by the opponent for nine years. She is currently the Vice President and Marketing Director, a position she has held since 2011. She describes the opponent's business in the following terms:

*"2. My Company is a global company which designs, manufactures and supplies lighting products, including light sources, luminaires and lighting control products..."*

*3. My Company provides lighting products which are used in many different environments, including in industrial premises, warehouses, offices, public areas, roads and tunnels, parking areas, and transportation areas. It also provides lighting products to the education market and healthcare market."*

12. Ms Danström states that the opponent has subsidiary offices in eleven countries, its parent company being based in Sweden. The UK office is shown to have had 4 employees in 2014 and 2015. She adds that in addition to the subsidiaries the opponent has distributors in a further thirty countries. She confirms that these distributors all offer the opponent's 'products and solutions'.

13. With regard to the nature of the opponent's business and its products, Ms Danström states:

*"7. My Company specialises in designing and supplying sustainable lighting solutions for professional customers, enabling them to reduce costs, energy consumption and environmental impact. My Company's products enable customers to lower energy consumption by up to 80%..."*

*8. My Company's products are divided into light sources, luminaires and lighting*

*control. Many of my Company's product names incorporate the word AURA — and a large number of these also incorporate the AURA LIGHT device mark.”*

14. Ms Danström provides the following definition of a light source:

*“9. A ‘light source’ is an umbrella term for a lamp, or bulb. My Company offers the following types of light sources: LED (light emitting diode), fluorescent, high intensity discharge, high pressure sodium and halogen lamps. Light sources bearing the marks AURA and AURALIGHT are listed below, along with when the products were first marketed.”*

15. She states that the following light source products are offered specifically on the opponent's UK website [www.aura-light.co.uk](http://www.aura-light.co.uk), the dates of first marketing that Ms Danström provided are shown in the right hand column.

Aura NoctiLED Long Life	Nov 2014
Aura Apus Pro LED	Sept 2013
Aura Easy T8 90 CR1 Long Life	Sept 2014
Aura EasyT8 HO Long Life	Sept 2014
Aura Easy TB Long Life	April2014
Aura Lunaria Pro	April 2014
Aura Lunaria Family	Sept 2013
Aura T5 Premium Long Life	2008
Aura T5 Miniature Long Life	2002
Aura T5 Protector Long Life	2008
Aura T5 Reflector Long Life	2004
Aura T5 Thermo Long Life	2004
Aura TB Eco Saver Long Life	2008
Aura Ultimate Long Life	2004
Aura Ultimate AN Long Life	2011
Aura Signette Long Life	2005
Aura Universal Long Life	2004
Aura Super Ex long Life	2001
Aura Sodinette AN Long Life	2012



16. Exhibit GD4 comprises prints of light source products taken from the opponent's UK website and printed on 3 March 2017. The following mark is shown at the top of each page:



17. Each product is titled with the first word 'AURA'. For example:

## Aura Premium Long Life

Fluorescent lamps for economical cost calculation



### Product information

Aura Premium Long Life is a tri-phosphor T5 fluorescent lamp with very good color rendering, ideally suited for areas where a replacement is not too difficult to achieve but the cost of operation still gives a good opportunity to optimize costs.



The service life of the lamp is 36,000 hours operated with electronic ballast (warm start).

18. Ms Danström defines a 'luminaire' as:

*"...an alternative term for a light fitting, or light fixture which consists of the "unit" itself, containing a socket for a bulb or lamp, which enables the bulb or lamp to be replaced."*

19. She provides the following list of luminaire products which bear the AURA mark and are available from the opponent's UK website. The dates of first marketing are provided as before:

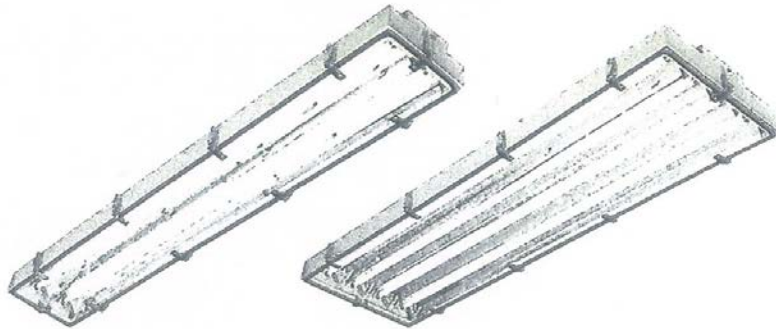
Aura Conspecto Ceiling & Wall	Oct 2014
Aura Notum Ceiling	Oct 2014

Aura Notum Pendulum	Oct 2014
Aura Lunaria Pro pendulum	April 2014
Aura Conspecto	Sept 2013
Aura Alpinia	April 2014
Aura Apus Pro LED	Sept 2013
Aura Concelo	Sept 2013
Aura Aperius	Sept 2013
Aura Emanio	Sept 2013
Aura Certos	June 2015
Aura Multimo	April 2015
Aura Vinza	June 2014
Aura Duro	Sept 2013
Aura Unity	Sept 2013
Aura Robinia	Sept 2014
Aura A-line	April 2014
Aura Persea	April 2014
Aura NoctiLED Long Life	April 2014

20. Exhibit GD5 comprises prints from the opponent's UK website of luminaire products. The pages were printed on 3 March 2017 and in each case the same AURA LIGHT mark is shown at the top of each page as in the previous examples. Each product description has the first word, 'AURA'. For example:

# Aura Multimo

Luminaire for industry and logistics



## Product information

Aura Multimo is a moisture- and dust-proof IP65 luminaire for Aura Light Long Life light sources. It offers exceptional energy efficiency, reliability and safety.



High-gloss mirror reflectors made from Miro4 aluminium provide a high reflection ratio and optimal light distribution.

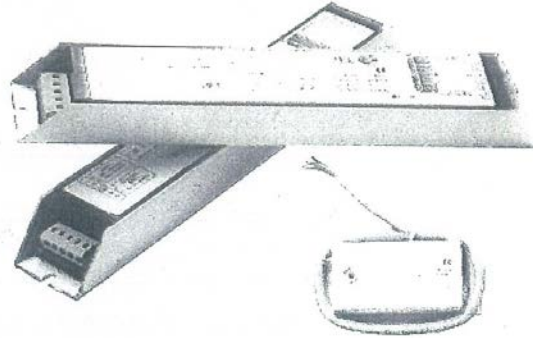
21. Ms Danström describes lighting control products as devices:

*“...which will detect movement, by high frequency waves, heat, infrared emissions or light levels in order to be able to switch a light on or off.”*

22. She provides an example of lighting control products sold on the opponent’s UK website and first marketed in 2009. The AURA LIGHT mark (shown above at paragraph) 16 is shown at the top of the page. The product is shown as follows:

# Aura Elmetec Constant Light Long Life

Maintenance free light



23. Ms Danström provides sample invoices dated between 2011 and 2016.<sup>2</sup>

24. Goods listed on the invoice are all identified as AURA, followed by the relevant description. They relate to a number of countries, including the UK. For example, page 10 of the exhibit is an invoice dated 29 May 2015 to an address in Scotland. Three AURA product types are listed with 250 units being purchased which totalled £1955.40. Page 12 is an invoice to an address in Lincoln dated 15 February 2016. 880 units of three different AURA products were purchased, totalling £8,538.48.

25. Ms Danström provides the following sales figures for the UK:

<b>Year</b>	<b>Net sales (£)</b>
2010	849,000
2011	1,681,000
2012	1,696,000
2013	2,395,000
2014	1,662,000
2015	1,390,000

26. The sales figures are supported by a number of invoices, fourteen of which relate to the UK and are dated between 10 June 2016 and 4 March 2016.<sup>3</sup> Thirteen of them originate

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<sup>2</sup> Exhibit GD10

<sup>3</sup> See exhibit GD10.

from Aura Light UK while one has the trading entity listed as Aura Long Life Lamps Ltd.<sup>4</sup> In every case the products listed on the invoices are identified as 'AURA' goods. Sales totals range from £349 to £104,053.80 to delivery addresses throughout the UK, including Stirling, Aberdeen, Glasgow, Stockport, Derby, Birmingham, Shropshire, Surrey and Southampton.

27. Exhibit GD7 comprises two brochures and two articles headed 'PRESS INFORMATION'. The first brochure is not dated and the second is dated 2016/2017, which means that it was available for, at most, the last six months of the relevant period. The first of the press articles is also dated after the relevant date. The second article is dated 9 June 2016 and is titled 'Inspiration New Architectural Luminaire from Aura Light'. It was issued on behalf of Aura Light UK. Attached to the exhibit are the opponent's distribution lists for its advertising brochures and press releases.<sup>5</sup> The list includes publications aimed at lighting professionals, such as, 'Professional Lighting Design UK'; freelance lighting businesses; energy and environment specialist organisations and publications, such as, UK Power and Innovation UK; Information for builders, such as, INSITE (National Federation of Builders), as well as local authorities, housing associations, and so on.

28. Ms Danström states that as a result of 'substantial sales and advertising', the opponent's products have been used in 'a number of high profile environments'. These include, inter alia, the EU Parliament, Scandic Hotels, Stockholm Metro in Sweden, Milan Metro in Italy and the Cadbury Plant in Bournville (UK).<sup>6</sup>

29. She provides details of third party websites and publications where the opponent's products are advertised. These are, the website for 'Process Engineering Control and Manufacturing Magazine', 'Lighting Journal Magazine', 'Intralogistics Magazine' and 'Energy Manager Magazine'. Examples provided at GD9 in support of this statement include articles and advertising for AURA LIGHT. The first is not dated but the remaining three were published within the relevant period. All of the publications appear to refer to and originate from the UK and relate to the energy saving nature of the opponent's business and its products.

30. Ms Danström also provides details of a number of editorials featured on the website 'Lighting Insight' at [www.lightinginsight.com](http://www.lightinginsight.com), which she describes as an independent

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<sup>4</sup> The relationship between this trader and the opponent is not clear from the evidence.

<sup>5</sup> The example provided here refers specifically to article dated 9 June 2016.

<sup>6</sup> Articles about each of these installations is provided at exhibit GD8.

magazine dedicated to commentary and research in respect of the lighting industry. She states as follows:

*“31. This website has described [the opponent’s] AURA PERSEALED and AURA DURO products as ‘luminaires designed to significantly improve lighting and reduce energy costs of industrial applications’...*

*32. This website page also described [the opponent’s] PROPEL LED Luminaire as ‘an exciting and colourful addition to offices and public spaces’ and a product which was a ‘low energy replacement for a wide range of light sources as it can significantly reduce the overall running costs of the lighting scene.’”*

31. Ms Danström identifies a number of awards won by the opponent:

November 2016	The European Business Awards Environmental and Corporate Sustainability
2016	Frost & Sullivan Award Global Lighting Growth Excellence Leadership
2015	Frost & Sullivan Award Entrepreneurial Company of the Year
2013	Frost & Sullivan Award European Growth Leadership
2015	12 <sup>th</sup> Annual International Business Awards Company of the Year – Electronics

32. The judges’ comments in respect of the last award listed are provided as follows:

*“A leader in the Industry adapting for new markets and creating a sustainable business model.”*

33. At paragraph 28 of her statement Ms Danström states:

*“In 2015, [the opponent] won the SEAD (Super-efficient Equipment and Appliance Deployment) International competition for the design of the world’s most efficient office lighting in the category of ‘Planar luminaires’. [The*

opponent's] LED panel product 'AURA LUNARIA' was winner of this award. SEAD is an initiative set up by seventeen governments to accelerate and strengthen the design and use of energy-efficient appliances and policies.”

## Proof of use

34. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*,<sup>7</sup> Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at

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<sup>7</sup> [2016] EWHC 52

[14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”



35. With regard to sales made to the trade, I bear in mind *Laboratoire de la Mer Trade Mark*<sup>8</sup>, in which the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Neuberger L.J. stated that:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul* , it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

36. The opponent’s evidence shows a number of products available via its website and provides details of when these goods were first made available in the UK. The goods shown include outdoor lighting,<sup>9</sup> LED panels,<sup>10</sup> high powered industrial lighting,<sup>11</sup> bulbs for street lighting and car parks,<sup>12</sup> pendulum lights and panels,<sup>13</sup> wall and ceiling mounted light fixtures<sup>14</sup> as well as bulbs, tubes and lamps. In each case the products are identified as AURA, followed by the relevant description. Sales figures have been provided relating to

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<sup>8</sup> [2006] FSR 5

<sup>9</sup> See, for example, exhibit GD4, page 2.

<sup>10</sup> See, for example, exhibit GD4, page 29 and GD5 pages 4 and 5.

<sup>11</sup> See, for example, exhibit GD5, page 17.

<sup>12</sup> See, for example, exhibit GD4, page 41.

<sup>13</sup> See, for example, exhibit GD5, pages 9 and 10.

<sup>14</sup> See, for example, exhibit GD5, page 7.

goods sold under the marks during the relevant five year period, which are by no means insignificant and these are further supported by invoices which show sales of the same and similar goods to addresses throughout the UK.

37. Press releases, editorials and articles show that the opponent's business model is to provide energy saving goods and this is supported by a number of industry awards, though I cannot be sure how many of the awards relate to the UK.

38. The evidence has not been challenged by the applicant and in its totality is clearly sufficient to show that the opponent has made use of its trade mark AURA throughout the relevant period in the UK.

39. With regard to its specification, the opponent has not shown use of its mark in respect of luminous signs in class 9. The opponent has shown use on a range of lighting goods which are covered by the term 'apparatus and installations for lighting' in class 11 and this term is a fair reflection of the use shown in evidence. I will proceed on that basis.

## **DECISION**

40. 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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

### **5(2)(b) case law**

41. 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.

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods**

42. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>15</sup> the General Court 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”.

43. The applicant’s specification is: ‘Apparatus for lighting; LED lighting apparatus and installations; LED light bulbs; lighting fixtures and fittings’. All of these terms are included within the opponent’s specification for ‘apparatus and installations for lighting’ and in accordance with the decision in *Meric*, these are identical goods.

## **The average consumer and the nature of the purchasing act**

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<sup>15</sup> Case T- 133/05

44. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

45. 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*<sup>16</sup>, 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

46. In this case the average consumer is a member of the general public or a business. The nature of the purchase is likely to be primarily visual, the average consumer encountering the goods and trade marks on the internet, in a catalogue, in literature, through advertising or at the point of purchase such as in store. However, there may also be aural considerations as it is likely that enquiries may be made or advice sought, prior to or during the purchase of some of these products. The level of attention paid to the purchase will vary according to the nature of the goods. A new lighting system aimed at reducing a businesses’ energy consumption will demand a higher level of attention to be paid than the purchase of a replacement bulb, but, taking into account the nature of the goods, the level of attention paid will be at least reasonable.

### **Comparison of marks**

47. The marks to be compared are as follows:

<b>The opponent’s mark</b>	<b>The applicant’s mark</b>
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<sup>16</sup> [2014] EWHC 439 (Ch)



48. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>17</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

49. The opponent attached a number of dictionary definitions to its submissions provided with its evidence in chief.<sup>18</sup> These are taken from [www.dictionary.com](http://www.dictionary.com). From these the opponent submits:

*“...the word ‘LUSTRE’, forming part of [the application], is derived from the Latin word “LUX”, meaning ‘LIGHT’...the current meaning of the word ‘LUSTRE’ is ‘shine’, or ‘brightness’. Accordingly, the element ‘LUSTRE’ in the mark of the present Application is of low distinctive character in respect of the goods covered by the present Application (being ‘Apparatus for lighting; LED Lighting apparatus and installations; LED light bulbs; lighting fixtures and fittings’) and less reliance should be placed on that element. Additionally, the element ‘LUSTRE’ appears after the element ‘AURA’ in the mark of the present Application. It is a well established principal of Trade Mark law that the first word in a mark will be seen, by the relevant consumer, as the dominant and distinctive element of that mark.*

*Further, the element ‘GREEN BEYOND BRIGHTNESS’ covered by the mark of the present Application will be seen as having a low level of distinctive character in the present Mark. This element appears in small script and below the element*

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<sup>17</sup> *Sabel v Puma AG, para.23.*

<sup>18</sup> *See submissions dated 8 March 2017.*

*'AURA LUSTRE' and thus will be seen as of secondary importance when compared with the element AURA LUSTRE.*

*The word AURA is therefore the most distinctive element in the mark of the present Application, and accordingly this dominant element must be compared with the marks of the earlier Registrations...*

*The comparison to be made is therefore between the dominant element AURA in the complex mark of the present Application, and the dominant element AURA in the marks of the earlier Registrations."*

50. The opponent's mark is the word AURA in capital letters. There is no additional stylisation, The overall impression rests purely on the word AURA.

51. The applicant's mark comprises the words 'aura lustre' in lower case, presented in an old English style typeface. Directly below these words is a black rectangle, with rounded corners, in which the words 'GREEN BEYOND BRIGHTNESS' are shown in white, block capital letters. Above the words 'aura lustre' is what the applicant describes as a 'tree logo'. Given the arrangement and presentation of the lines and rounded protrusion underneath it, it could also be seen as a stylised Edison screw-in light bulb with the filament being formed by a black tree silhouette.

52. 'GREEN BEYOND BRIGHTNESS' has a subservient position within the mark and is a suggestive promotional message of the type with which the average consumer is familiar, meaning that its relative weight is fairly low. The words 'aura lustre' are presented in the same typeface with neither elevated above the other in terms of their size within the mark. The words remain independent of each other and do not combine to form a unit. The opponent makes no comment regarding the device in the application, which is at the top of the mark and is not insubstantial in size. I find that the device element and the words 'aura lustre' play a roughly equal role in the overall impression of the mark.

53. Visual similarity rests in the fact that the entirety of the earlier mark is the first word 'aura' in the mark applied for. The additional word 'lustre', the device element and the words 'green beyond brightness' provide obvious points of difference. Overall, I find these marks to have a low degree of visual similarity.

54. The applicant's mark will be spoken as 'aura lustre'. The words 'green beyond brightness' are unlikely to be articulated, given what I have said about the contribution this makes to the mark's overall impression. The device will not be articulated. Consequently, the opponent's earlier right sounds the same as the first word of two words which will be articulated in the application, with the second word 'lustre' being an obvious point of difference. I find these marks to be aurally similar to a medium degree.

55. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>19</sup> The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.<sup>20</sup>

56. The word 'aura', which is the entirety of the opponent's mark and the first word of the application, is a common English word with which the average consumer will be familiar and is likely to be considered to mean an atmosphere or feeling surrounding something or someone.

57. The opponent submits that 'lustre' comes from the latin word 'lux' and means light. Whilst I know this to be the case, I am not prepared, absent evidence, to conclude that the average UK consumer of the goods in class 11 would know that as a matter of fact. It is more likely that the average consumer will see 'lustre' as referring to something with a sheen, shine or gloss, which is a little less distinctive for the goods than the word AURA.

58. Both marks give the consumer the conceptual message of an aura. In the case of the application there are the additional conceptual impressions of 'shine' or 'gloss' from the word 'lustre' (which is further supported by the lightbulb device if that is how it is seen by the average consumer) and the impression of 'green' given by the tree device. Both of these are reinforced by the words 'GREEN BEYOND BRIGHTNESS'. In the context of the goods at issue neither 'green' nor 'light/shine' are particularly distinctive and it is the AURA element which plays the greater role in the conceptual impression. Taking these factors into account, I find these marks to be conceptually similar to a fairly high degree.

### **Distinctive character of the earlier mark**

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<sup>19</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>20</sup> See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O/048/08, paragraphs 36 and 37.



59. 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 used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.<sup>21</sup>

60. The opponent has filed evidence of use which includes turnover figures which are not insubstantial. However, I have no indication of the size of the lighting market, which I suppose is considerable, nor do I have any indication of the opponent's share of that market in the UK. There is some evidence of advertising but not to the extent that it would enable me to identify the opponent's extent of reach in the UK nor the average consumer's knowledge of the opponent's business. Consequently, I am unable to conclude that the opponent's mark benefits from an enhanced distinctiveness as a result of the use which has been made of its mark in relation to the goods on which it relies.

61. In terms of its inherent distinctiveness, the word 'AURA' is likely to be considered to mean an atmosphere or feeling surrounding something or someone. It makes no descriptive nor allusive reference to the goods and will be given its plain ordinary meaning. Consequently, it is a normal trade mark possessed of a medium degree of inherent distinctive character.

### **Likelihood of confusion**

62. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>22</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

63. I have made the following findings:

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<sup>21</sup> *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

<sup>22</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27*

- The average consumer is a member of the general public or business.
- The level of attention paid to the purchase will vary. That said, the goods will require at least a reasonable degree of attention to be paid.
- The purchase will be primarily a visual one, though there may also be an aural element where advice is sought prior to purchase.
- The parties' marks possess low visual similarity, medium aural similarity and fairly high conceptual similarity.
- The earlier mark AURA has an average level of inherent distinctive character.

64. The opponent draws my attention to the general rule that the average consumer pays more attention to the beginnings of marks submitting that AURA in the application is the dominant element as a result. This principle has been established in a number of cases, including, *El Corte Inglés, SA v OHIM*<sup>23</sup> and is a general rule which does not replace the principle that each case must be decided on its merits.

65. In this case, taking into account the nature of the average consumer, the nature of the purchase, the level of attention to be paid to the purchase of these goods and the differences between them which I have highlighted, lead me to find that the marks would not be directly confused with one another. However, I do find that the average consumer would confuse the marks indirectly. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person defined indirect confusion in the following terms:

“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

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<sup>23</sup> Cases T-183/02 and T-184/02. See also: GC cases: *Castellani SpA v OHIM, Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*,<sup>23</sup> (similar beginnings important or decisive), *CureVac GmbH v OHIM*,<sup>23</sup>(similar beginnings not necessarily important or decisive) and *Enercon GmbH v OHIM*,<sup>23</sup> (the latter for the application of the principle to a two word mark).

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.”

66. In this case the goods are identical. Taking into account the degree of similarity between the marks, the medium degree of distinctive character of the earlier mark and the nature of the purchase being made, I find that an average consumer, familiar with one of the parties' marks, subsequently encountering the other mark would believe that the goods originated from the same or linked undertakings. In reaching such a conclusion, I have borne in mind the low level of visual similarity between the marks in circumstances where the purchase is primarily visual (though may include an aural element) but conclude that having made the global comparison required by the relevant authorities there is a likelihood of indirect confusion. The additional elements in the application would not lead the average consumer to the conclusion that the goods were offered by a different originator. The tree logo reinforces the green message in the mark which is present in 'green beyond brightness'. If the tree logo is seen as a light bulb with the tree representing a filament, it simply reinforces that the goods are lighting goods. The essential message of both marks is that they are aura marks. For example, an average consumer familiar with AURA low energy light bulbs and lamps would simply think that light bulbs and lamps provided under the applicant's marks were goods from a range provided by the same manufacturer e.g. AURA's lustre range.

## **Conclusion**

67. The opposition succeeds under section 5(2)(b) of the Act. Having reached such a conclusion the opponent can be in no better position with regard to its other earlier marks and I need not go on to consider them.

## **Costs**

68. The opposition having been successful, the opponent is entitled to a contribution towards its costs, which I award on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£300

Filing evidence:	£400
Submission in lieu of attending a hearing:	£100
Total:	£900

69. I order Shameer Kommoth to pay Aura Light International AB the sum of £900. 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 30<sup>th</sup> day of November 2017**

**Ms AI Skilton**

**For the Registrar,**

**the Comptroller General**