

O-145-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2401252
BY CITY ELECTRICAL FACTORS LIMITED TO REGISTER
A SERIES OF TRADE MARKS IN CLASS 11**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 96871 BY COOPER INDUSTRIES, LLC**

BACKGROUND

1. On 10 September 2005, City Electrical Factors Limited (“City”) applied to register the following as a series of two trade marks:



The application was accepted and published for opposition purposes on 25 January 2008 in Trade Marks Journal No.6720 for the following goods in class 11:

“Apparatus for lighting; lamps; light bulbs; strip lights; halogen, fluorescent, halide, sodium and mercury lamps and tubes; parts and fittings therefor.”

2. On 16 April 2008, Cooper Industries, LLC (“Cooper”) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). Cooper indicates that the opposition is directed against all of the goods in the application for registration. Cooper relies upon one earlier Community trade mark registration:

Trade Mark	No.	Application date	Registration date	Goods
EDISON	2345	1.4.1996	13.10.2010	11 - Electric light fixtures.

3. On 23 April 2008, City filed a Form TM21 to restrict the specification of goods which following amendment now reads:

“Lamps; light bulbs; strip lights; halogen, fluorescent, halide, sodium and mercury lamps and tubes; parts therefor.”

4. On 22 July 2008, City filed a counterstatement which consisted, in essence, of a denial of the ground of opposition. Having noted that at that time Cooper’s Community trade mark was under opposition and that the opposition proceedings had been suspended, City said:

“The mark which is the subject [of the application for registration] has been used in the United Kingdom by and with the consent of the applicant for a significant period of time. The applicant first introduced EDISON and EDISON LAMPS in

1994 and has consistently used the mark developing its brand and associated reputation in the United Kingdom. The mark in its current form has been used for at least thirteen years and by reason of this long and unhindered use of EDISON in the UK, the Applicant has established its own rights at common law.

The mark applied for is a stylised mark which leaves a strong visual impression with the user and registration is sought in relation only to lamps and bulbs of various types. The earlier application is made in relation to electric light fixtures which are not identical goods and which appear to have co-existed in the marketplace with the applicant's goods for a considerable period of time. It is the applicant's position that due to the visual impact of its mark and the differences between the respective goods, there is no likelihood of confusion on the part of the public in the United Kingdom and consequently the application should not be refused under section 5(2)(b) of the Trade Marks Act as the opponent requests.

It is also the applicant's contention that by reason of its use of the subject mark in the United Kingdom it has an earlier right which pre-dates that of the opponent.

In view of the longstanding uncertainty surrounding the opponent's interest before the Community Office, the applicant is purely seeking to protect the interests it has developed unhindered in the United Kingdom and requests that it is looked upon favourably as regards an award of costs."

5. Neither party filed evidence or written submissions during the course of the proceedings nor did they ask to be heard. Cooper filed written submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

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, or

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

7. An earlier trade mark is defined in section 6 of the Act, 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. Cooper’s registration is an earlier trade mark and is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, as it had not achieved registration at the time of the publication of City’s trade mark application. It subsequently achieved registration as shown in paragraph 2 above.

Section 5(2)(b) – case law

9. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing process

10. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In their written submissions Cooper state (by reference to the goods contained in City's application which they refer to as the contested goods):

“Furthermore, all of the contested goods are everyday consumer items and therefore, they have identical end users, in particular the average consumer.”

11. I agree that both parties' goods are everyday consumer items which will be bought by members of the general public; they then are the average consumer for such goods.

12. As to how the goods at issue will be selected by the average consumer, my own experience as a member of the general public tells me that visual considerations having encountered the trade marks in, for example, retail premises, in magazines or on line are likely to dominate the selection process. However, as orders may also be placed by telephone, aural considerations cannot be ignored. The cost of the goods falling within the competing specifications will vary from very small amounts for, for example, a standard light bulb, to hundreds or even thousands of pounds for more elaborate or sophisticated lighting units. When selecting a lighting unit for, for example, use in or around the home, the average consumer is likely, in my view, to have one or more of the following factors in mind; where the product will be deployed i.e. indoors in the hallway, kitchen, living room, bedroom, bathroom etc. or outdoors in the driveway, pathway, garden, patio etc. wattage considerations, the aesthetics of the product (its design and colour) and, of course, the cost. Taking into account the widely differing cost of the goods at issue, leads to the inevitable conclusion that the average consumer's level of attention will vary depending on the cost and nature of the item being selected i.e. it will range from relatively low (when selecting, for example, an inexpensive light bulb) to reasonably high (when selecting, for example, a single sophisticated lighting unit or a range of lighting units for use in different parts of the home).

Comparison of goods

13. For the sake of convenience the goods to be compared are as follows:

Cooper's goods	City's goods
Electric light fixtures	Lamps; light bulbs; strip lights; halogen, fluorescent, halide, sodium and mercury lamps and tubes; parts therefor."

14. In their written submissions Cooper argue that the goods covered by their earlier trade mark are identical to the goods contained in City's application; City disagree. In their written submissions Cooper state:

"The terms "lamps" and "strip lights" are commonly used, and it is submitted, understood by the relevant public to mean light fixtures alone or in combination with light sources in an all-in one luminary unit, for example, a table lamp base is referred to simply as a lamp, as is the base in combination with the bulb. Similarly, stage lights for example are often referred to as strip lights even though they technically include a strip light fixture and a bulb.

Consequently, electric light fixtures are included in [the goods contained in City's application] or vice versa and the respective goods are therefore identical."

15. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05, at paragraph 29 the General Court said:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42.”

16. In my view all of the goods contained in City’s application fall within the broad term electric light fixtures in Cooper’s registration. As such, they should, given the guidance in *Meric*, be considered identical. However, even if I am wrong in that conclusion and not all of the competing goods should be considered identical, they must, in my view, and for, inter alia, the reasons outlined in Cooper’s written submissions, be considered highly similar. In their written submissions Cooper state:

“[Cooper’s goods] are similar in nature to [City’s goods]. [The terms in City’s specification] are commonly used to define items containing both an electric light fixture and a light bulb and therefore the electric light fixture portion is identical in nature to the earlier goods.

Furthermore, all of [City’s goods] are everyday consumer items and therefore, they have identical end users, in particular the average consumer.

All of [City’s goods] have an identical or similar method of use to [Cooper’s goods] because they are essentially connected to a power source to create illumination.

[City’s goods] are complimentary with [Cooper’s goods]...In order to create illumination a light fixture must be connected to a power source and a light source, such as a light bulb.


It is clear...that the goods have identical ultimate purposes, for example to illuminate an area.

The goods are also often made by the same or economically linked companies and are supplied through identical distribution channels and sales outlets, e.g. supermarkets, department stores, hardware shops and lighting specialists, and are sold in the same areas on the same shelves.”

In summary, in my view, the competing goods are either identical or highly similar.

Comparison of trade marks

17. The trade marks to be compared are as follows:

Cooper's trade mark	City's trade marks
EDISON	

18. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

19. In their written submissions Cooper say of the figurative element appearing in City's trade marks:

"It is self evident that this device represents the letter O when reviewed in the context of the overall mark. In addition, it is submitted that the stylisation in [City's trade marks] would be classified under the following Vienna classifications and indeed is so classified in the corresponding Community trade mark application filed by the applicant: "stars grouped in circles, ovals or other geometric figures", "letters or numerals representing a figurative element" and "luminous sources, rays, shafts of light." The opponent asserts that these classifications would have been allocated because the device is clearly a circle made up of individual elements which are meant to look like rays of light, which overall represents the letter O in the word EDISON. The opponent contends that this stylisation is non distinctive or at least weak when one considers the goods."

They add:

"The opponent notes that the word element EDISON of the applicant's mark is presented on a blue or grey rectangular background. However, standard geometric backgrounds are often used to present trade marks and are entirely banal and non distinctive...The opponent contends that the rectangular background does not act to differentiate the respective marks."

And:

“It is clear from the above that the overall impression given by the mark is that of the word EDISON and that it is this word which would be used by consumers in conversation or when making a written order. As a result, the Opponent contends that EDISON is the dominant and distinctive element of each of the marks.”

20. Cooper’s trade mark consists exclusively of the word EDISON presented in upper case. There are no distinctive and dominant components, the distinctiveness lies in the totality. City’s application consists of a series of two trade marks. The letters EDIS and N appearing in the first trade mark in the series are presented in white and the figurative element appearing between the letters S and N is presented in yellow; these components are presented on a blue rectangular background. The second trade mark in the series contains all the same components but the letters and figurative element are presented in white against a black rectangular background.

21. In my view the rectangular backgrounds whether presented in blue or black are commonplace and are neither distinctive nor dominant components of City’s trade marks. Having considered the figurative element appearing in each trade mark (whether presented in yellow or white), I remain unconvinced that when considered either in isolation or as part of a unified whole (as in City’s trade marks) that this figurative element would be perceived by the average consumer as indicating rays of light which in turn would render this element as non-distinctive or weak (given the goods for which registration is sought). However, while it may be a distinctive component, its positioning as the fifth character accompanied by a string of five other characters means it is not, in my view, a dominant element of the trade marks. Rather, I agree with Cooper that the average consumer will perceive the figurative element to be performing the function of a letter O completing the word EDISON which is, in my view, the distinctive and dominant component of City’s trade marks. I shall approach the comparison of the respective trade marks with that conclusion in mind.

Visual similarity

22. The distinctive and dominant components of the competing trade marks consist of six characters; the first four characters and sixth character of the competing trade marks i.e. the letters EDIS and the letter N are identical. While Cooper’s trade mark has a letter O as its fifth character and City’s trade marks the figurative element mentioned above, the appearance of this figurative element is clearly intended to mimic the letter O. While the figurative element creates a point of difference, overall I consider there to be a fairly high degree of visual similarity between the competing trade marks.

Aural similarity

23. In their written submissions Cooper states:

“The opponent also contends that the marks are phonetically identical because, for the same reasons given above, the only aural and pronounceable element of each of the marks is EDISON. As a result, customers would refer to the marks identically as EDISON.”

24. As the figurative element appearing in City’s trade mark will be perceived by the average consumer as a letter O, I agree that the distinctive and dominant components of the competing trade marks are aurally identical.

Conceptual similarity

25. In their written submissions Cooper states:

“The marks are also conceptually identical because the only element with any meaning is the word EDISON, which the public would immediately and unambiguously understand to be a surname. The opponent appreciates that a name would not usually depict a clear concept; however, in the current case, the opponent contends that EDISON would immediately and unambiguously conjure images of Thomas Edison, the inventor of the electric light bulb. As a result, the opponent contends that the marks are conceptually identical.”

26. No evidence has been provided confirming the average consumer’s perception of the word EDISON. In her decision in *Chorkee Ltd v Cherokee Inc* (BL O-048-08) Ms Anna Carboni acting as the Appointed Person commented on this issue in the following terms:

“36. The next three criticisms all relate to the Hearing Officer’s assessment of conceptual similarity between the mark applied for and the earlier trade marks. While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of

this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.

38. I therefore agree with the Opponent that the Hearing Officer was wrong to find that the earlier trade marks would give rise to the concept of the native American tribe by the same name in the mind of the average consumer and that he should not have relied on his own knowledge and experience to do so.”

27. While I am familiar with the word EDISON (as both a surname and more specifically as the surname of Thomas Edison the American electrical engineer and inventor), and have no doubt that some people will also be familiar with these meanings, as Ms Carboni points out, in the absence of evidence that is not sufficient for me to impute such knowledge to the average consumer of the goods at issue in these proceedings. Of course, if, as I suspect, the average consumer is familiar with the word EDISON as a surname in either general or specific terms, the competing trade marks are likely to convey similar conceptual messages i.e. either as a surname or as the surname of the electrical engineer and inventor. However, I accept that for those average consumers unfamiliar with the word EDISON, the competing trade marks will be neither conceptually similar nor conceptually dissonant.

Distinctive character of Cooper’s earlier trade mark

28. I must now assess the distinctive character of Cooper’s EDISON trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, 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. The word EDISON will either be accorded no meaning at all, or, more likely in my view, will be seen as a surname. Even if it is seen as a surname, surnames are one of the most common forms of trade mark and are readily accepted by the average consumer as indicators of trade origin. If treated as an invented word Cooper’s trade mark would possess a high degree of inherent distinctive character. Treated more realistically as a surname (and

notwithstanding the link between Thomas Edison and lighting), it is still, in my view, a trade mark possessed of a reasonable degree of inherent distinctive character.

Likelihood of confusion

29. In determining whether there is a likelihood of confusion, I need to bear a number of factors 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. It is also necessary for me to consider the distinctive character of Cooper's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has retained in his/her mind.

30. Earlier in this decision I concluded that the competing goods were either identical or highly similar, that the distinctive and dominant component of the competing trade marks was the word EDISON and that this component of the competing trade marks shared a fairly high degree of visual similarity, were aurally identical, and if (as I suspect), are perceived (at the very least) as surnames, are likely to send similar conceptual messages. I did however accept that if the word EDISON conveyed no meaning to the average consumer the conceptual position would be neutral. Applying those conclusions to the matter at hand, I have no hesitation concluding that there is a likelihood of either direct or indirect confusion i.e. the average consumer will either mistake City's trade marks for the trade mark of Cooper, or, more likely in my view, will assume that the goods of City come from an undertaking economically linked to Cooper. In reaching that conclusion I have not overlooked the fact that the first of City's trade marks is presented in a number of colours. However, the impact created by these colours falls a long way short of offsetting the degree of similarity between the distinctive and dominant elements of the competing trade marks and Cooper's opposition based upon section 5(2)(b) of the Act succeeds accordingly.

31. However, that is not an end of the matter, as I must also deal with City's argument that they have "prior use" of their EDISON trade mark and, in effect, an earlier right. In this regard, I note that paragraph 5 of Tribunal Practice Notice 4 of 2009 reads as follows:

"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark." (my emphasis)

32. A review of the Community Trade Marks register at the time of writing this decision confirms that no action has been taken by City (or anyone else for that matter) to cancel the registration upon which Cooper relies in these proceedings. As such, City's claim to prior use is irrelevant.

Costs

33. I note that in their counterstatement City said:

"In view of the longstanding uncertainty surrounding the opponent's interest before the Community Office, the applicant is purely seeking to protect the interests it has developed unhindered in the United Kingdom and requests that it is looked upon favourably as regards an award of costs."

34. While I admit to not being entirely certain what City meant by this statement, it appears to me to mean that City's application was filed in the full knowledge of Cooper's earlier trade mark. As far as I am aware (see paragraph 32) City have taken no action to challenge Cooper's earlier right and in those circumstances I see no reason to depart from the quantum of costs I would otherwise have awarded. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide I award costs to Cooper on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Written submissions	£300
Total:	£700

35. I order City Electrical Factors Limited to pay to Cooper Industries, LLC the sum of **£700**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28 day of April 2011

**C J BOWEN
For the Registrar
The Comptroller-General**