

O-478-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3048590
BY IQ GROUP HOLDINGS BERHAD
TO REGISTER THE TRADE MARK:**

Lumiqs

**IN CLASS 11
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 402957 BY
SITECO BELEUCHTUNGSTECHNIK GMBH**

BACKGROUND

1) On 26 March 2014, IQ Group Holdings Berhad (hereinafter the applicant) applied to register the trade mark shown on the above page in respect of the following goods:

In Class 11: Lighting fixtures for commercial use; LED lamps; LED lighting apparatus; apparatus for lighting; electric lighting apparatus; bulbs for lighting; casings for lights; ceiling light fittings; ceiling lights; Christmas lights (other than candles); decorative electric lighting apparatus; desk lights; electric lights; emergency lights; filters for lighting apparatus; gas lights; light bars; light reflectors; light shades; lighting panels; outdoor lighting; outdoor lighting fittings; spot lights; lighting tubes.

2) The application was examined and accepted, and subsequently published for opposition purposes on 4 July 2014 in Trade Marks Journal No.2014/028.

3) On 30 September 2014 Siteco Beleuchtungstechnik GmbH (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Designation date and date of protection in UK/EU	Class	Specification
LUNIS	M710804	02 March 1999 UK: 12 November 1999 Priority date 03 September 1998 Priority country Germany	11	Lighting apparatus, lamps, luminaires, parts of the aforesaid goods (included in this class).
LUNIS 2	M1063504	17 November 2010 EU: 19 December 2011 Priority date 25 May 2010 Priority country Germany	9	Apparatus and instruments for conducting, switching, transforming, storing, controlling of electricity, apparatus and instruments for measuring, signalling and controlling; electronic apparatus and instruments for operating, controlling and supervising lighting apparatus and instruments, especially exterior and tunnel lighting systems; regulating equipment for lighting, cooling, heating, air conditioning and ventilating apparatus and instruments; apparatus and instruments for supervision and controlling of brightness of lighting systems; electric and electronic apparatus and instruments for operating lighting apparatus; electric fastening and contact elements, connectors, clamps, ferrules, switches as well as interruptors,

				<p>included in this class, electric transformers; chokes, electric control gears and electric starters for lamps, especially electric discharge lamps; electronic control gears for lighting systems; electronic starters for lamps and luminaires, light sensors, motion detectors, infrared remote controls; light emitting diodes, also organic; laser diodes, especially power laser diodes; light guides, optocouplers, optical sensors, light emitting diodes lamp modules (such as modules of light emitting diodes, also organic, with lamp function) included in this class, especially for signalling functions; electric (included in this class) and electronic appliances for the operation of light emitting diodes and electroluminescence foils; computer programs, stored and downloadable.</p>
			11	<p>Lighting apparatus, including luminaires and lamps, as well as their parts (included in this class), especially prismatic panels and prismatic foils; reflectors; light guides; light distribution apparatus and their parts; all aforesaid goods included in this class; mirror projector lighting systems, mainly consisting of lighting apparatus and/or instruments as well as reflectors; cut glass (prisms), prismatic foils made of plastic, prismatic bars made of plastic, prismatic bars made of glass, prismatic panels made of plastic, prismatic panels made of glass, reflectors and louvers for sun-shielding and passing on daylight, all the aforesaid goods for constructing of use in daylight distribution systems and as parts of lighting apparatus; light emitting diode lamp modules included in this class, especially for lighting purposes; ventilating and air conditioning apparatus; lighters for lighting apparatus.</p>
LUNIS R	M746232	<p>22 August 2000 UK: 29 May 2001</p> <p>Priority date 01 March 2000 Priority country Germany</p>	11	<p>Lighting apparatus, including luminaires and lamps, as well as their parts, especially prismatic panels and prismatic foils; reflectors; light guides; light distribution apparatus and their parts; all the aforesaid goods as far as included in this class.</p>

b) The opponent contends that the mark in suit is confusingly similar to its registered trade marks shown above. It states that the services applied for in the mark in suit are similar or identical to

those for which its marks are registered. The mark in suit therefore offends against section 5(2)(b) of the Act.

4) On 8 December 2014, the applicant filed a counterstatement. Basically, it denied all the grounds. It puts the opponents to strict proof of use in respect of its marks 746232 and 710804.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 5 October 2015 when the opponent was represented by Mr Krause of Messrs Haseltine Lake LLP; the applicant was represented by Mr Rundle of Messrs Wilson Gunn.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 20 March 2015, by Peter Prodell the IP Manager of the opponent company in Germany, which is a subsidiary of Osram GmbH. He states that he is authorised to make the statement and that he has access to the records of the opponent. He states that the opponent is a manufacturer and provider of technical indoor and outdoor lighting with products that are engineered for a wide range of applications such as for use on roads and in plazas, airports and stadiums. They also provide a range of indoor lighting products for offices, industrial buildings, public buildings and shopping centres. The LUNIS trade mark has been used in relation to lighting products in the UK in the five year period before 4 July 2014, by Siteco Ltd, which has merged with Osram Company. He provides the following exhibits:

- PP2: A copy of a page from Siteco UK’s website dated 7 May 2013. This refers to the provision of lighting for public or industrial buildings. It does not mention any of the trade marks relied upon.
- PP3: A page from the UK website which shows use of LUNIS dated 16 October 2011. None of the images are shown on the page but the description states “downlights for circular lamps”, “downlights for point sources”, “downlights for compact fluorescent lamps or point sources” and “downlights for compact fluorescent lamps”. There are also mentions of other LUNIS marks such as LUNIS R, LUNIS SL, LUNIS EH and LUNIS M on a variety of goods such as downlights, spotlights as well as terms which I do not recognise such as wallwasher and distribution system.
- PP4: A webpage showing use of the mark LUNIS R dated 19 May 2011. The page does not show any images of the items but the description states “Lunis R downlight for circular lamp (with various central modules)”.
- PP5: Lists of products sold by Siteco in the UK under the name LUNIS during the period 1 October 2012 to 30 June 2014. This is in German but he states that the first column gives the product code, the second column the fiscal year for sales, the third the number of products sold and the fourth the net sales price in Euros. Also provided are page numbers which show where these products are located in the catalogue dated 2014/2015 filed at exhibit PP6. In particular he lists the following:

Code	Year	Number sold	Net sales price €	Item shown at: [numbers in () are the paginated numbers for the exhibit]
5DN11BD7VL336C	2013	121	21.38	Exhibit PP6 page 5.20 (28) shows a downlight under the mark LUMIS 2.
5DN11BD7VL356C	2013	42	8.346	Exhibit PP6 page 5.20 (28) shows a

				downlight under the mark LUMIS 2.
5DN11BD7VL356E	2013	81	16.72	Exhibit PP6 page 5.20 (28) shows a downlight under the mark LUMIS 2.
5LR94685EE	2013	144	3.40	Exhibit PP6 page 6.21 (69) shows a diffuser plate under the mark LUNIS R.
5DS32B77VL3R8E	2014	8	1.74	Exhibit PP6 page 5.12 (20) shows a spotlight under the mark LUNIS SL-T
5DN11K78VL3W3C	2013	2	375	Exhibit PP6 page 5.18 (26) shows a downlight under the mark LUNIS 2.
5LR61071TA11AE	2013	32	6.22	Exhibit PP6 page 6.26 (74) shows a ceiling recessing central module with TC downlight under the mark LUNIS R.
5LR134D1VA61	2013	28	5.37	Exhibit PP7 is dated 15 October 1999 and shows use of the mark LUNIS on a recessed downlight.
5LR610DEOA11AF	2013	55	11.67	Exhibit PP8 is dated 9 March 2015 and shows use of the mark LUNIS R on a recessed downlight.

Unfortunately none of the codes were readable other than six which had been highlighted. Of these only three related to the codes which Mr Prodell mentions. Also although exhibit 6 had been paginated the references were in relation to the numbering on the original catalogue. It also did not help that the pagination was done over the top of the original numbering. Following the hearing the opponent's agent provided a readable copy of the document so that the details for the above table could be input.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The only ground of opposition is based on section 5(2)(b) which reads:

“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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

10) The opponent is relying upon its three trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the dates of both parties' marks, only M710804 and M746232 of the opponent's marks are subject to proof of use. Section 6A of the Act states:

"6A Raising of relative grounds in opposition proceedings in cases 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).”

11) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its marks has been made. In the instant case the publication date of application 3048590 was 4 July 2014, therefore the relevant period for the proof of use is 5 July 2009 – 4 July 2014. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

12) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

13) Also in *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

“31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer* , to the rather slender facts found by Dr Trott.”

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users.”

14) Whilst Neuberger L.J. (as he then was) stated:

“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.”

15) The applicant contends that the opponent has not shown any use of the marks M710804 or M746232. In its submission these contentions were stated thus:

“10) For the purposes of Section 6A of the Act the Opponent’s evidence does not prove that the relevant earlier Marks have been put to genuine use in the United Kingdom in relation to those goods upon which this Opposition is founded. As such, the Opposition should be decided solely on the basis of the Opponent’s **LUNIS 2** mark. Alternatively, if the Hearing Officer does not agree with the Applicant’s position on this, the Applicant submits that the Opposition should proceed only on the basis of *spotlights for mounting* in respect of the **LUNIS** mark, and for *ceiling recessing, consisting of circular downlight and central module* in respect of the **LUNIS R** mark.”

16) The opponent for its part simply asserts that the evidence, taken as a whole, demonstrates that the LUNIS / LUNIS R marks have been put to genuine commercial use in the UK over the relevant period in relation to the goods for which the marks are protected.

17) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

18) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

19) From the table shown in paragraph 6 it can be seen that a number of the products which were brought to the fore by the opponent actually relate to use of the mark LUNIS 2 which is not the subject of proof of use. The only example of use of the trade mark LUNIS, *solus*, is outside the period, being dated 15 October 1999. I must therefore consider whether the use of LUNIS 2, LUNIS R and LUNIS SL-T can be taken to equate to use of mark M710804.

20) In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act (which is the same as that for section 6) as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

21) Similar comments have also been made in *Remus Trade Mark* – BL O/061/08 (Appointed Person) & *OAD Alfa-Bank v Alpha Bank A.E.* - 2011 EWHC 2021 (Ch) and *Orient Express Trade Mark* - BL O/299/08 (Appointed Person). Although these cases were decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, they remain sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

22) In the instant case I am willing to accept that the use of the marks LUNIS 2, LUNIS R and LUNIS SL-T equate to use of LUNIS as they do not differ from the registered trade mark in elements which do not alter the latter's distinctive character. The distinctive character of the opponent's mark M710804 is clearly the single word LUNIS. The addition of number such as "2" or letters such as "R" or "SL-T" after the word LUNIS will be seen to refer to a subset of LUNIS goods.

23) I now turn to consider what goods the marks has been used upon and the specification they are entitled to rely on for the purposes of the comparison. Mr Justice Arnold (as he now is) in his judgments as The Appointed Person in *Nirvana Trade Mark BL O-262-06* and *Extreme Trade Mark BL O-161-07* comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

"(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or

services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].”

24) The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Aladdin”)* held that:

“43. Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44. With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

25) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

26) The opponent’s mark M710804 is registered for “Lighting apparatus, lamps, luminaires, parts of the aforesaid goods (included in this class)”. However, even reading the evidence in the most generous manner, the totality of use shown in respect of all of the opponent’s marks has been upon “downlights, diffuser plates, spotlights, and ceiling recessing central modules with TC downlight”. To my mind it is appropriate to reduce the specification of trade mark M 710804 given the breadth of the use. Therefore, the specification of this mark which will be taken into account in the subsequent comparison will be “downlights, spotlights as well as their parts and accessories”. At the hearing Mr Krause offered to take me through the evidence explaining where each of the codes on PP5 could be found in the catalogue. However, I declined to allow this as had the opponent wished to show precisely what goods had been sold they could, and should have provided such links on their evidence to allow the other side to respond. It is not acceptable to file an eighty five page document full of code numbers and expect the other party to, as it were, “pick the bones out of it”. In any event it does not unduly affect the outcome as even with limited use the goods are, for the most part, regarded as identical, a point I made at the hearing.

27) Turning to the opponent’s trade mark M746232 registered for the mark LUNIS R. I do not accept that use of the opponent’s other marks LUNIS, LUNIS 2 or LUNIS SL-T equate to use as they differ from the registered trade mark in elements which alter the latter’s distinctive character. Clearly, there is a difference between LUNIS 2 and LUNIS R. They might be seen as part of the same family but their distinctive characters are not the same.

28) Trade mark M746232 is registered for the following: “Lighting apparatus, including luminaires and lamps, as well as their parts, especially prismatic panels and prismatic foils; reflectors; light guides; light distribution apparatus and their parts; all the aforesaid goods as far as included in this class”. However, the evidence filed by the opponent shows use only upon “downlights as well as their parts and accessories”.

29) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

30) 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 *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.”

31) The applicant contended:

“12) For the Applicant’s goods he/she is a professional person such as an architect, lighting consultant or interior designer who will have a very high level of attention when selecting goods for a building/construction or refurbishment/interior design project. It is clear from the Opponent’s evidence that the average consumer of its goods is the same – see, for example, paragraphs 6 and 7 of Peter Prodell’s Witness Statement.”

32) Both parties’ goods are for lights in general. The applicant’s specification does include the term “lighting fixtures for commercial use” but it includes a large number of other types of light fittings which are not covered by the restriction of “commercial use”. Even if they were so covered the term “commercial use” does not restrict the actual consumer for these articles. These products are sold by outlets which whilst catering mainly for the professional builder also serve the general public. I do not regard the average builder or electrician to be someone who will have a very high level of attention when selecting such items. Having said this, I believe that the general public, which includes businesses /professionals, will pay a reasonable to high level of attention to ensure that the lighting goods they purchase or specify are suitable for the use envisaged and will also be safe to use in the intended manner. Most people are instinctively wary of the ability of electricity to kill be it directly or indirectly by catching fire and so such goods are not chosen in a cavalier manner. Such items are usually sold from catalogues, on line or in retail outlets. As neither party’s specifications are limited I must keep all of these trade channels in mind. The initial selection will therefore be by visual means. I accept that more expensive or technical items of lighting may, for example, be researched or discussed with a member of staff, the latter bringing aural considerations into play.

Comparison of goods

33) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

34) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

35) For ease of reference the services of the two parties are as follows:

Applicant's goods	Opponent's goods
In Class 11: Lighting fixtures for commercial use; LED lamps; LED lighting apparatus; apparatus for lighting; electric lighting apparatus; bulbs for lighting; casings for lights; ceiling light fittings; ceiling lights; Christmas lights (other than candles); decorative electric lighting apparatus; desk lights; electric lights; emergency lights; filters for lighting apparatus; gas lights; light bars; light reflectors; light shades; lighting panels; outdoor lighting; outdoor lighting fittings; spot lights; lighting tubes.	M710804: downlights, spotlights as well as their parts and accessories".
	M1063504: Lighting apparatus, including luminaires and lamps, as well as their parts (included in this class), especially prismatic panels and prismatic foils; reflectors; light guides; light distribution apparatus and their parts; all aforesaid goods included in this class; mirror projector lighting systems, mainly consisting of lighting apparatus and/or instruments as well as reflectors; cut glass (prisms), prismatic foils made of plastic, prismatic bars made of plastic, prismatic bars made of glass, prismatic panels made of plastic, prismatic panels made of glass, reflectors and louvers for sun-shielding and passing on daylight, all the aforesaid goods for constructing of use in daylight distribution systems and as parts of lighting apparatus; light emitting diode lamp modules included in this class, especially for lighting purposes; ventilating and air conditioning apparatus; lighters for lighting apparatus.
	M746232: "downlights as well as their parts and accessories".

36) The applicant states that: "17) For all intents and purposes the respective goods in Class 11 are identical or similar". In respect of the opponent's specification under its mark M1063504 I fully agree that the goods are identical as the term "Lighting apparatus" in the opponent's specification encompasses the whole of the applicant's goods. However, in respect of the specifications under the opponent's marks M710804 and M746232 these are identical to aspects of the applicant's mark but only similar to a medium degree to others. To my mind, in respect of the specifications for M710804 and M746232, they are identical to the following goods of the applicant:

Lighting fixtures for commercial use; LED lamps; LED lighting apparatus; apparatus for lighting; electric lighting apparatus; bulbs for lighting; casings for lights; ceiling light fittings; ceiling lights; decorative electric lighting apparatus; electric lights; outdoor lighting; outdoor lighting fittings; spot lights; light reflectors; light shades; filters for lighting apparatus;

37) But only similar to a medium degree to the following goods of the applicant:

Christmas lights (other than candles); desk lights; emergency lights; gas lights; light bars; lighting panels; lighting tubes.

Distinctive character of the earlier trade mark

38) 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).”

39) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

40) However the independent and distinctive element does not need to be identical. In *Bimbo SA v OHIM*, Case T-569/10, the General Court held that:

“96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and

which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60).”

41) All three of the opponent’s marks have the word “LUNIS”, two of the marks then have a number “2” or a letter “R” in addition. The word LUNIS is not an English word, and would appear to be invented. Neither of the additions (the letter “R” and the number “2”) affect the meaning of the word although they cannot be ignored in the overall comparison. Overall all the opponent’s marks have a high level of inherent distinctiveness. Whilst the opponent has filed evidence of use of its marks in the UK it was paltry and did not address aspects such as overall turnover, evidence of market share or even promotional activity, and the evidence is not enough for the opponent to benefit from enhanced distinctiveness

Comparison of trade marks

42) 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

43) It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponents’ trade marks	Applicant’s trade mark
M710804 LUNIS	Lumiqs
M1063504 LUNIS 2	
M746232 LUNIS R	

44) The applicant contended in its submissions that:

“14) Visually, Lumiqs is readily distinguishable from LUNIS 2, LUNIS R and LUNIS even though there are letters in common. This is largely due to the presence of the highly distinctive letter “q” in the Applicant’s mark. The letter “q” is an extremely unusual letter and does not often appear in the middle of a word. It is also rarely followed by a consonant. Whenever the letter “q” is used, it is almost always followed by the letter “u”. Since the letter “q” is such a strong element and its presence would appear unusual, particularly when followed by the letter “s”, it serves to visually distinguish the marks. Further, the additional elements present at the end of the Opponent’s marks IR No. 1063504 and IR No. 746232, namely, the numeral “2” and letter “R” respectively, will not go unnoticed by the relevant consumer. The respective marks are therefore visually dissimilar.

15) Phonetically, Lumiqs is also readily distinguishable from LUNIS. Whilst the prefix ‘loo’ is identical the respective suffixes ‘mix’ and ‘nis’ are very different. Further, the additional elements present at the end of the Opponent’s marks IR No. 1063504 and IR No. 746232, namely, the numeral “2” and letter “R” respectively, will also be pronounced by the relevant consumer which will serve to further distinguish the respective marks. The respective marks should therefore be considered phonetically dissimilar.

16) The Applicant’s mark is an invented word and the same could be said of LUNIS, although it is in fact the dative case of the Latin word ‘luna’ meaning moon. but the average consumer is unlikely to know this. Nevertheless, for the average consumer who is familiar with the word ‘lunar’, LUNIS is likely to evoke the moon. On the other hand, for the average consumer who is familiar with the word ‘lumen’, referring to a unit of light and derived from the same Latin word meaning light, or the word ‘luminous’ meaning radiating or reflecting light, Lumiqs is very likely to evoke light. Thus, conceptually the respective marks are not similar.”

45) The opponent contended:

“10. The dominant and distinctive element of the earlier trade mark is the word LUNIS, which is very similar to the opposed mark; both consist of two syllables, commence with the letters LU- and end with the letter –S. There is therefore a significant degree of visual similarity and a very high degree of phonetic similarity.

11. Further, neither LUNIS nor LUMIQS has a strong conceptual significance that would allow consumers to differentiate easily between the marks.”

46) The opponent’s strongest case is under its mark M710804. I do not regard the fonts of either parties’ mark to be particularly distinctive. Visually the marks share their first two letters “LU” and their last letter “S”. The middle parts of each mark are very different, with the presence of the letter “Q” being unusual. There is a low degree of similarity. Aurally the opponent’s mark would, in my opinion, be pronounced “LOON- IS” as in “Lunar” and the present tense “is”, or “LOO” and “NIS”. The applicant’s mark would probably be pronounced “LOOM- ICKS” although the presence of the letter “Q” may make the average consumer somewhat uncertain as to how it should be pronounced, or alternatively “LOO” and “MIX”. To my mind there are significant differences between the marks aurally. As both are invented neither has any conceptual meaning.

Likelihood of confusion

47) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' trade marks 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 has retained in his mind. Earlier in this decision, I concluded that:

- The average consumer is a member of the general public (including businesses), who will select the services by predominantly visual means (but not discounting aural selection) and who will pay a reasonable to high level of attention when doing so;
- The class 11 specifications of both parties are identical or similar to a medium degree.
- In comparing the mark in suit to all of the opponents' marks the competing trade marks have a low degree of visual similarity whilst aurally they have significant differences. Conceptually both marks are neutral in having no meaning.
- The opponent's earlier trade marks have a high level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness.

48) In view of the above and allowing for the concept of imperfect recollection, and only taking into account the identical goods, there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails in relation to M710804. As this mark gave the opponent its strongest case it must also fail under its marks M1063504 and M746232.**

CONCLUSION

49) The opposition under Sections 5(2)(b) has failed under all three of the opponent's marks.

COSTS

50) As the applicant has been successful it is entitled to a contribution towards its costs. Whilst a CMC was held in this case I decline to award any costs in relation to this event.

Preparing a statement and considering the other side's statement	£300
Considering the opponent's evidence	£700
Attendance at the hearing	£900
TOTAL	£1900

50) I order Siteco Beleuchtungstechnik GmbH to pay Group Holdings Berhad the sum of £1900. 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 12th day of October 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**