

O/0323/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00915250707

IN THE NAME OF KEVIN LEE

FOR THE FOLLOWING TRADE MARK:



IN CLASS 11

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 504105

BY ONE-LUX LIMITED

BACKGROUND AND PLEADINGS

1. Kevin Lee (“the proprietor”) is the owner of the trade mark registration shown on the cover page of this decision (“the contested mark”). The contested mark was filed on 21 March 2016 and entered into the register on 02 August 2018. It stands registered for the following goods:

Class 11: *LED light bulbs; LED lighting installations; Light-emitting diodes [LED] lighting apparatus; Lighting; Lighting lamps; Lighting units; Electric lighting; Lighting fittings; Lighting installations; Lighting fixtures; Electrical lighting fixtures; Bulbs for lighting; LED lighting installations; Electrical lamps for indoor lighting; Lighting fixtures for household use.*

2. The contested mark is a comparable mark deriving from a EUTM registration. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the contested mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

3. On 02 September 2021, One-Lux Limited (“the applicant”) applied to have the contested mark declared invalid under Section 47 of the Trade Marks Act 1994 (“the Act”). The application is brought under Section 5(4)(a) of the Act and is targeted at the entirety of the proprietor’s specification. The applicant relies on the earlier unregistered right in the signs ‘SOLO’ and ‘ONE-LED SOLO’ (“the applicant’s signs”) that the applicant claims to have used throughout the UK and Ireland since 2014. The applicant claims to have used its sign for the *Light-emitting diode (LED) lamps and driver kits for emergency lighting*.

4. In support of its application, the applicant claims that it owns goodwill in its signs and that by seeking to register the contested mark, the proprietor made a misrepresentation to the public which is likely to lead the public to believe that the

goods offered by the proprietor are those of, or related to, the applicant. From this, the applicant claims that it has suffered and/or is likely to suffer damage.

5. The proprietor filed a counterstatement denying the claims made. It also put the applicant to proof of all of the necessary elements required to sustain its claim for passing off.

6. In tandem with his defence, the proprietor made an application for summary judgement and security for costs, on the basis that the applicant had already failed twice (in first instance and on appeal) in parallel proceedings instigated against the EUTM registration from which the contested mark is cloned, based on the same evidence and substantially the same cause of action (alleged common law rights under the equivalent provisions of the European Union Trade Mark Regulation) and failed to pay the cost order arising from those proceedings. A copy of the decisions of the EUIPO Cancellation Division and Board of Appeal was also provided, against which, the proprietor stated, there has been no further appeal to the General Court of the European Union. In a preliminary view issued on 8 November 2021, the Tribunal refused the proprietor's request for summary judgement, which was subsequently re-examined, together with the request for security for costs, at a Case Management Conference ("CMC") by a Hearing Officer who, on 16 December 2021, dismissed both requests, noting, *inter alia*, that the pending EU cost award had been paid a week before the CMC took place.

7. The applicant is represented by Swindell & Pearson Ltd and the proprietor is represented by Harrison IP Limited. Only the applicant filed evidence, but both parties filed written submissions. No hearing was requested and only the proprietor filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision

continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

9. As above, only the applicant filed evidence. This came in the form of two witness statements of Glynnis Murray dated 25 March 2022 and 29 June 2022, with accompanying exhibits (being those labelled exhibits GM01-09 and GM10-23, respectively). The second of Ms Murray's witness statements was filed in reply to the proprietor's submissions dated 28 April 2022. Ms Murray is the managing director of the applicant's company. I do not intend to reproduce the applicant's evidence or the proprietor's submissions in full here, however, I will refer to them below where necessary.

DECISION

Section 5(4)(a)

10. Section 5(4)(a) of the Act has application in invalidation proceedings because of the provisions of Section 47 of the Act, which states as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

11. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

12. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

13. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

14. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

RELEVANT DATE

15. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

16. The contested mark does not have a priority date, and neither is there any evidence of earlier use by the proprietor that is capable of being considered the start of the behaviour complained about. As a result, the relevant date for assessment of the applicant’s claim under Section 5(4)(a) of the Act is the date on which the contested mark was applied for, being **21 March 2016**.

GOODWILL

17. The first hurdle for the applicant is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the signs ‘SOLO’ and ‘ONE-LED SOLO’ were distinctive and/or associated with that goodwill.

18. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

19. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

20. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

21. Goodwill arises as a result of trading activities. I note that the proprietor's submissions include significant criticisms of the evidence filed. Whilst I have read the submissions in full and have taken them into account in reaching my decision, I do not intend to reproduce or even refer to the specific submissions in any great detail, save to note that, in short, the proprietor's position is that the applicant has fallen well short of establishing that there exists a goodwill at the relevant date.

22. I now turn to consider the evidence.

23. Ms Murray states that the applicant first used the signs 'SOLO' and 'ONE-LED SOLO' at the beginning of 2014. The signs are used in relation to light emitting diode (LED) lamps and driver kits, used primarily for emergency lighting.

24. Ms Murray says that the applicant's products are certified and meet regulatory requirements and exhibits two certificates which attest that the applicant operates a Quality Management System (2019) and an Environmental Quality System (2020) compliant with ISO requirements¹ (ISO being the International Organization for Standardization which sets standards for products and services in business). However, as the proprietor correctly noticed in his submissions, the certificates contain no reference to the signs 'SOLO' and 'ONE-LED SOLO'.

25. Ms Murray says that the applicant is a member of the Lighting Industry Association and ICEL (Industry Committee for Emergency Lighting), which is described as a trading division within the Lighting Industry Association (LIA) and an internationally recognised authority on emergency lighting. Copies of documents certifying the applicant's ICEL and LIA membership are exhibited,² however, they are dated after the relevant date (1 January 2022), and contain no mention of the signs 'SOLO' and 'ONE-LED SOLO'.

¹ GM1

² GM2

26. Ms Murray provides extracts from a 'ONE-LUX' product guide printed in 2014³ showing details of the product sold under the mark 'SOLO' which appears on only one page in the following form:

ONE-LED
SOLO | NON MAINTAINED
LED LAMP AND DRIVER KIT

27. According to Ms Murray, the applicant printed about 3,000 copies of the aforementioned product guide, most of which were distributed at the Light + Building exhibition in Frankfurt between 13 March and 4 April 2014, whilst 1,000 copies were returned and distributed to electrical wholesalers, distributors and lighting manufacturers in the UK, although no further details are provided.

28. Ms Murray also refers to the product guide being re-printed in 2016 and 2018 and distributed at another Light + Building exhibition in Frankfurt held between 13 and 17 March 2016.

29. Ms Murray provides copies of webpages from the applicant's website at www.one-lux.com dated from December 2014, February 2015 and July 2015, taken using the Way Back Machine.⁴ These webpages mention several products including 'ONE-LED SOLO - Non maintained LED lamp and driver kit' and 'SOLO – NON-MAINTAINED LED LAMP AND DRIVER KIT' as shown below:

³ GM3

⁴ GM6

Emergency

One-LED - Emergency Gear for LED

The One-LED range of LED emergency control gear provides peace of mind and the required illumination to aid safe evacuation. They are also available with self-test and DALI options. The constantly expanding range of emergency control gear products deliver maximum performance at a competitive price.

Our exciting new product, Unity-LED is the world's first dimmable mains/emergency multi-current LED driver. Featuring a constant power emergency output capable of driving multiple LED arrays, Unity-LED will help reduce the number of in-stock component variants needed for a range of finished products.

Incorporating the One-LUX Motion-PHASE system, to dim lighting to a pre-set level when no movement is detected, Unity-LED is designed for cost-effective installation in corridors, car parks and other areas where permanent lighting is desirable for security and safety.

Unity-LED delivers ultimate flexibility with maximum functionality in a cost effective package.

Product

UNITY-LED

Mains/Emergency LED Driver

OMNI-LED

LED Emergency Conversion Module

OMNI-LED DALI

LED Dali Emergency Conversion Module with Self-Test

UNITY LED LP

Low Power LED Mains/Emergency Driver

ONE-LED SOLO

Non Maintained LED Lamp and Driver Kit



Product description

- Self-contained LED emergency luminaire
- Low profile SELV hinged design driver and battery enclosure to fit through 42mm mounting hole
- Symmetrical output lamp design gives 5m spacing whilst retaining sufficient light output on call points in corridors

Common Technical Data

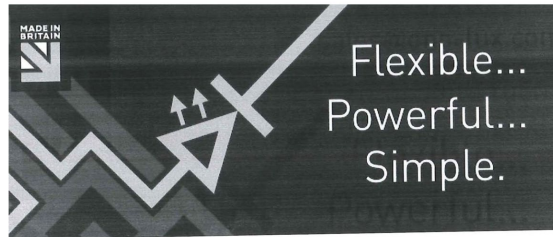
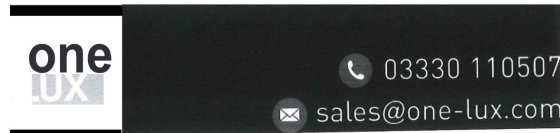
Input Supply Voltage

supply voltage: 230V AC

Maximum output: 9 W

30. Ms Murray says that goods sold under the mark 'SOLO' were promoted to her company's customers in February 2015, via an email marketing campaign. She attaches a document that is supposed to be a copy of the email she mentions,⁵ however, it only shows the following image and is undated save for what appears to be a printing date 8 March 2019:

⁵ GM7



One-LED SOLO

Non Maintained 3-hr Emergency LED solution

31. A list of recipients identified only by their first names is annexed together with a number which, according to Ms Murray’s explanation, is the number of times they opened the document.⁶

32. As regards turnover figures, Ms Murray produces the following table which, she says, “lists the number of invoices issued and the quantity of goods sold under the ‘SOLO’ and ‘LED SOLO’ marks by the applicant in the UK during the period 2014-2022” and provides sample invoices which, she states, have been issued to companies in the UK, Ireland, Luxembourg and the Netherlands:

Year	No. Invoices	Qty. Sold	Products Sales
2014	144	4007	£87,733.66
2015	80	1720	£44,661.48
2016	168	6386	£130,009.02
2017	114	3617	£106,736.05
2018	90	3114	£73,230.34
2019	106	3008	£69,512.49
2020	112	1912	£59,382.99
2021	120	3111	£104,519.48
2022	16	378	£12,497.71

33. It is not clear what relevance the evidence relating to goods sold to non-UK customers (or sold after the relevant date) might have in demonstrating goodwill in the UK at the relevant date of 21 March 2016, and Ms Murray did not provide any explanation as to the significance of this evidence.

⁶ GM6

34. In the invoices the applicant has supplied,⁷ the heading on the invoices is the sign 'ONE-LUX' presented in the form shown below:



35. In most of the invoices the sign 'SOLO' appears in the description of the goods as part of the phrase 'One-LED SOLO N/M Emergency 3W LED' and identifies only one product. The invoices also contain the product code OLS followed by the serial number which, Ms Murray explains, is an abbreviation of the brand ONE-LED SOLO/One-LED, as shown below:

Qty	Product Code	Description	Unit Price	Net Amt	VAT%	VAT
1	OLS/NM3	One-LED SOLO N/M Emergency 3W	32.00000	32.00	20.00	6.40

36. The evidence also includes examples of purchase orders in most of which the product code 'OLS' appears without the name 'One-LED SOLO' as shown below:

Stock Code	Description	Vendor Item No.	Qty	UOM	Unit Price	Net
4416	EMERGENCY PACK 1.5W	OLS/2/M3	18	EACH	35.50	639.00

37. There are also a few examples of purchase orders in which the word 'SOLO' appears on its own as shown below:

Quantity	Unit	Description	Price	Par	Goods	Code	V.A.T.
35	EACH	SOLO/NM3 3W NM DOWNLIGHT	23.95	1	838.25	A	

⁷ GM18 and GM8

38. Ms Murray states that the size of the UK market for all emergency lighting products is in the region of £80 - £100 million each year. She states:

“ [...] 50% of this market is satisfied by centralised systems and the remaining market is between £40 - £50 million. We estimate that the size of category for SOLO style products is estimated at between 3-5% or £1.2/£2 million - £1.5/2.5million per annum. As a result, I estimate our market share in this specialised lighting sector under our SOLO mark between 2014 to the present to be as follows:

Year	No. Invoices	Qty. Sold	Products Sales	£1.2M	£1.5M	£2M	£2.5M
2014	144	4007	£87,733.66	7.31%	5.85%	4.39%	3.51%
2015	80	1720	£44,661.48	3.72%	2.98%	2.23%	1.79%
2016	168	6386	£130,009.02	10.83%	8.67%	6.50%	5.20%
2017	114	3617	£106,736.05	8.89%	7.12%	5.34%	4.27%
2018	90	3114	£73,230.34	6.10%	4.88%	3.66%	2.93%
2019	106	3008	£69,512.49	5.79%	4.63%	3.48%	2.78%
2020	112	1912	£59,382.99	4.95%	3.96%	2.97%	2.38%
2021	120	3111	£104,519.48	8.71%	6.97%	5.23%	4.18%
2022	16	378	£12,497.71	1.04%	0.83%	0.62%	0.50%

39. However, Ms Murray’s statement about the size of the UK market for emergency lighting products and/or for the ‘SOLO’ style product is wholly unsupported by any evidence and Ms Murray does not explain where she got his estimates from.

40. Ms Murray also provides a list of the applicant’s consumers and their turnover.

41. The following annual marketing spend, which are said to relate to goods sold under the ‘SOLO’ and ‘LED SOLO’ marks in the UK, are produced:

Year	Advertising spend (£s)
2014	£5,124.00
2015	£200.00
2016	£4,032.00
2017	£1,974.00
2018	£3,488.00
2019	£1,110.00
2020	£560.00 (Advertising spend reduced owing to Covid related sales slowdown)
2021	£3,125.00
2022	No spend to date this year

42. In her second witness statement, Ms Murray gives further evidence about the applicant's certificates and the importance of its membership. She explains that the certificates introduced by her first witness statement and similar certificates exhibited to her second witness statement extend to goods sold under the signs 'SOLO' and 'ONE-LED SOLO/One-LED SOLO'. In this connection, Ms Murray states that the absence of any trade marks appearing on the face of the certificates produced in evidence should not be taken as an indication that there is no link to the applicant's goods sold under the signs 'SOLO' and 'ONE LED SOLO/One-LED SOLO' since the certification relates solely to the technical aspects of the applicant's goods rather than itemising the marks under which the products are commercialised. On the premise that the applicant accepts that the certificates do not show use of the signs upon which it relies, it is difficult to see how they can assist the applicant in establishing goodwill in relation to the same signs.

43. Ms Murray also states that the applicant has been a member of the 'Made in Britain' (MiB) organisation since January 2015, which, she explains, is a not-for-profit organisation that supports British manufacturers under a single, registered collective mark. A copy of the applicants' company page as included in the MiB website at <https://www.madeinbritain.org/members/one-lux-ltd> is shown below:⁸

The screenshot shows the 'MADE IN BRITAIN' website header with navigation links: APPLY NOW, MEMBERS, PRODUCTS, ABOUT, NEWS, and MEMBERS AREA. Below the header, the page title is 'One-LUX Ltd'. The main content area features a large image of a green 3D figure running through a crowd of grey 3D figures, with a spotlight effect. To the right of the image is the One-LUX logo, which consists of the word 'one' in black and 'LUX' in white on a green square background. Below the logo, the text reads 'One-LUX Ltd' and 'Technology / Components'. At the bottom of the page, there is contact information: a phone icon with '+44 (0)1922 452 423', an email icon with 'sales@one-lux.com', and a globe icon with 'http://one-lux.com/'.

⁸ GM14

44. As it can be seen, the page (undated) only refers to the company name 'ONE-LUX LTD' and the trade mark 'ONE LUX' whilst the next page contains a reference to the following signs, including 'ONE-LED SOLO':

Tags: [Omni-LED](#), [Omni-LED COMPACT IP65](#), [Omni-LED FLEXI](#), [One-CONNECT](#), [One-LED SOLO](#), [One-SENSE](#), [Unity-LED](#)

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45. In response to the proprietor's statement that the 2014 product guide contains only one instance of usage of the sign 'SOLO' accompanied by the words "NON-MAINTAINED LED LAMP AND DRIVER KIT", Ms Murray produces images of lighting products sold under the brands 'SOLO' and 'ONE-LED SOLO' from the website, as well as images of leaflets, packaging, labels and product information:⁹



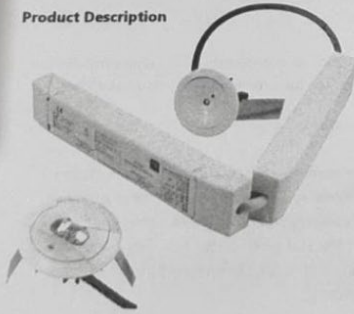
⁹ GM10-11

Installation Instructions

One-LED SOLO DST

one
LUX

Product Description



One-LED Solo™ is a non-maintained, self-contained LED emergency luminaire comprising an Omni-LED emergency LED driver, hinged rechargeable battery and a SELV isolated LED lamp head. Its compact, low-profile hinged design means it can be installed through the 42mm diameter lamp mounting hole, so making it ideal for use fixed ceiling applications. The pre-wired LED lamp will provide constant power output of approximately 1.5W, so maintaining the required illumination level throughout the three hour emergency duration. The symmetrical light distribution of the open area lamp head can give up to 8m spacing from a ceiling height of 2.5m, or 19m for the corridor lens version.

Disclaimers

This is a dedicated, non-maintained emergency luminaire, so by design the main LED light will only operate upon mains supply failure; it cannot be operated as a standard light source.

Common Technical Data

Input Supply Voltage	230V +/- 10%
Supply Frequency	50/60 Hz
Maximum Spacing (2.5m ceiling)	8m Open Area/ 19m Corridor
Battery Type	2.4V 4Ah 18700 NiMH

One-LED Solo Product Labels

one
LUX

OLM/NM3

For more information visit: www.One-LUX.com

one LUX One-LED Solo Mini
OLM/NM3 LED EMERGENCY LUMINAIRE

MAINS INPUT: 230V ±10% 50/60Hz	Watt Max: 1.2V DC
INPUT CURRENT: 50mA MAX	Inal Max: 400mA
BATTERY: NiMH 2.4V 4Ah	Charge: 340-260mA

OUTPUT / LED LAMP: RED +, BLACK -

TEST SWITCH: WHITE, YELLOW

IND. LED: BLACK, GREEN

BATTERY: BLACK, RED

BATT: +, -

1904(NM3)2 DO NOT INSULATION TEST

OLS/NM3

For more information visit: www.One-LUX.com

one LUX One-LED Solo
OLS/NM3 LED EMERGENCY LUMINAIRE

MAINS INPUT: 230V 50/60Hz	Watt: 3 - 1.2V
INPUT CURRENT: 50mA MAX	Inal Max: 600mA
3 HR DURATION NiMH 2.4V 4Ah	Power Max: 2W
Charge: 140-240mA	Max Open Circuit: 5.0V
Temp: 10°C - +35°C	X 0 A+++ 100

TEST SWITCH: BATT. (), ()

IND. LED: (), ()

OUTPUT LED LAMP: +, -

IP20 SELV DO NOT INSULATION TEST 15344/5

OLS/3/NM3

For more information visit: www.One-LUX.com

one LUX One-LED Solo
OLS/3/NM3 LED EMERGENCY LUMINAIRE

MAINS INPUT: 230V 50/60Hz	Watt: 3V
INPUT CURRENT: 50mA MAX	Inal Max: 450mA
3 HR DURATION NiCd 3.6V 1.8Ah	Power Max: 1.35W
Charge: 80 - 90mA	Max Open Circuit: 5.0V
MIN/MAX TEMP RANGE 5°C - 50°C	X 0 A+++ 100

INDICATOR LED: (), ()

TEST SWITCH: (), ()

OUTPUT LED LAMP: +, -

BATT: +, -

IP20 SELV DO NOT INSULATION TEST 37033/2

OLS/3/NM3/CL

For more information visit: www.One-LUX.com

one LUX One-LED Solo
OLS/3/NM3/CL LED EMERGENCY LUMINAIRE

MAINS INPUT: 230V 50/60Hz	Watt: 3V
INPUT CURRENT: 50mA MAX	Inal Max: 450mA
3 HR DURATION NiCd 3.6V 1.8Ah	Power Max: 1.35W
Charge: 80 - 90mA	Max Open Circuit: 5.0V
MIN/MAX TEMP RANGE 5°C - 50°C	X 0 A+++ 100

IND. LED: (), ()


TEST SWITCH: (), ()

OUTPUT LED LAMP: +, -

BATT: +, -

IP20 SELV DO NOT INSULATION TEST 15713/1

EMERGENCY | ONE-LED™
SOLO™ | NON MAINTAINED LED LAMP AND DRIVER KIT




Product description
One-LED Solo™ is a non-maintained, self-contained LED emergency luminaire comprising an Omni-LED emergency LED driver, hinged rechargeable battery and a flush-mount SELV lamp head. Its compact, low-profile hinged design means it can be installed through a 42mm lamp mounting hole, so making it ideal for use fixed ceiling applications.
The LED lamp incorporates a hidden 'push to test' switch and provides constant power output of 1.5W, so maintaining spacing throughout rated duration. The symmetrical distribution of light gives 9.3m spacing from a typical 2.5m height, when using an open area lamp head. For the most efficient spread of light along corridors, an optional corridor lens version is available to provide spacing of 19m from the same height.

Technical Data

Input Supply Voltage	230V +/- 10% - 50/60 Hz
Minimum Emergency Output	188lm Open Area/ 155lm Corridor
Maximum Spacing (2.5m ceiling)	9.3m Open Area/ 19m Corridor
Battery Types	3.6V 1.8Ah NiCd or 2.4V 4Ah 18700 NiMH
Ambient Temperature Range	10-35°C NiMH/ 5-50°C NiCd
Earth Leakage Current	<0.5mA
IP Rating	IP20
Recommended Cut-out Size	42mm
Weight	<90g

Properties



46. Ms Murray states that the labels as they appear on the products, informational inserts and on the packaging have been consistently used by the applicant since 2014 and that the technical information regarding the applicant's 'LED Lamp and Driver Kit' sold under the marks 'SOLO' and 'ONE-LED SOLO' has appeared on their website since 2014. However, none of the material produced is dated, save for an issue date of 10 January 2021 which appears at the bottom of the webpage.

47. In an attempt to fill the gaps in the evidence relating to the 2014 product guide, Ms Murray states that (a) the 2014 print of the guide was made up of 24 pages and the sign 'SOLO' featured only on one page, and (b) in the 2016 re-print of the guide there were 32 pages in total, 3 of which featured the sign 'SOLO', and the other pages were dedicated to different products.

48. Further, in answer to the proprietor's criticisms about the relevance of the evidence about the applicant's attendance at trade fairs in Germany, Ms Murray provides a list of customers that the applicant captured as a direct consequence of attending the Light + Building Exhibition held in Frankfurt in 2014 and 2016.¹⁰

ASSESSMENT

49. The evidence shows that in 2014 and 2015 the applicant sold 5,727 units of what Ms Murray describes as "SOLO/ONE-LED SOLO" branded goods in the UK

¹⁰ GM16

generating a turnover of £132,395.14. However, it is impossible to know what proportion of the sales achieved in 2016 – which amounts to £130,009.02 - took place before the relevant date and there is only one purchase order from January 2016 which shows the sale of 50 units of a product described as “SOLO/NM3 3WNM Downlight” to a company in Essex, for a total of £1,437. Whilst not all of the sales are documented, Ms Murray stated that the invoices produced in evidence are only examples, and it is not a requirement that all the sales must be supported by corresponding invoices.

50. Although I accept that there is some evidence of sale, that is, in my view, very tiny, amounting to less than 6,000 units sold before the relevant date. The applicant attempted to argue that the sales achieved must be contextualized insofar as the market for the products sold under the sign ‘SOLO’ is a niche market which is significantly smaller than the UK market for all emergency lighting products. I reject the submission. Although Ms Murray gave some estimates about market share, there is no explanation as to how the figures supplied were generated and one cannot simply pluck a figure out of thin air as it seems Ms Murray has done in this case. There is no independent evidence to indicate (1) what is the size of the UK market for light emitting diode (LED) lamp and driver kits, (2) what is the size of the UK market for lighting equipment/products and (3) that the market for light emitting diode (LED) lamp and driver kits used for emergency lighting is a niche market within the overall UK lighting industry. In any event, as the proprietor states, even if Ms Murray’s estimation of the UK lighting market being worth £100 million was correct (bearing in mind that the relevant date is in 2016), the sales achieved by the applicant at the relevant date would amount to a tiny percentage (according to my calculation of 0.13%).

51. In terms of marketing and promotion, the advertising figures for 2014-2015 amounts to just over £5,000 which may go to explain the scarcity of the evidence of advertising. Ms Murray says that since 2014, the sign ‘SOLO’ has featured in a variety of media, including (a) the applicant’s website in the 'Emergency' section and 'Product Guide,' (b) the promotional brochure printed in 2014, 2016 and 2018, (c) a company presentation on the applicant’s website, (d) the MiB website and (e) other promotional material such as the specific email marketing campaigns exhibited in evidence. However, this evidence is not particularly strong as it does not show much outward

use of the sign or is undated/dated after the relevant date. In this connection, I note that:

- with regard to points (a) and (b), the sign 'SOLO' featured only on one page (page 7) in the catalogue from 2014 and 2/3 of the copies which were printed were distributed at the 2014 Light + Building Show in Frankfurt. Although Ms Murray says that in the guide that was reprinted in 2016 and distributed at the 2016 Light + Building Show in Frankfurt between 13 and 17 of March 2016, the sign 'SOLO' featured on 2 pages rather than one, she did not provide a copy of the 2016 reprint, nor did she say that the 2016 guide was also distributed in the UK. In any event, as the proprietor correctly states, the evidence about the applicant's participation to the Light + Building Show in Frankfurt is unlikely to assist, because it only shows that the applicant attended two exhibitions in Germany prior to the relevant date (with the 2016 exhibition being only a few days before the relevant date) and there are no details which would allow me to draw any conclusion as to whether any outward use of the signs at the exhibitions gauged any interest and committal response from UK customers;
- with regard to points (c) although Ms Murray refers to the mark 'SOLO' featuring in a company presentation on the applicant's website since 2014, there is no evidence of that presentation and there are no details as what the presentation was about, when was it published, whom was it aimed at, and to what extent and in which form the signs 'SOLO'/'ONE-LED SOLO' were used;
- with regard to point (d), although Ms Murray states that the sign 'ONE-LED SOLO' was used on the MiB website, the webpage exhibited is undated, and the sign appears in very small writing along with other brands, so I doubt it would even be noticed, but in any event, it does not appear to be used in relation to any product;
- with regard to point (e), again the page exhibited is not an email and it is undated but, in any event, if this the best evidence of marketing that the applicant can provide, it is less than persuasive.

52. Overall, whilst the evidence establishes that the sign 'ONE-LED SOLO' was used on the applicant's website and on a product catalogue since 2014, neither the website

nor the catalogue draws much attention to the name 'SOLO' or 'ONE-LED SOLO'. This is consistent with the rest of the evidence which indicates that 'ONE-LED SOLO' is the name of a specific product sold by the applicant under the unifying umbrella of the company name 'ONE-LUX' from which the applicant derived a number of sub-brands (or products names) incorporating the word 'ONE' plus a descriptive word, including (a) **'ONE-LED' (for LED emergency lighting)** such as 'ONE-LED UNITY LED', 'ONE-LED OMNI LED', 'ONE-LED OMNI LED DALI', 'ONE-LED UNITY LED LP' and 'ONE-LED SOLO', (b) **'ONE-FL' (for fluorescent lighting)** such as 'ONE-FL UNITY', 'ONE-FL ESSENTIAL' and 'ONE-FL ULTIMO', (c) **'ONE-SENSE (for sensors)** such as 'ONE-SENSE ECO', 'ONE-SENSE EXO', 'ONE-SENSE PRO', 'ONE-SENSE FLY', 'ONE-SENSE AIR' and 'ONE SENSE LED' and (d) **'ONE-DRIVE' (for drivers)** such as 'ONE-DRIVE OMNI'. Further, the sign 'ONE-LED SOLO' is always used in conjunction with the main brand 'ONE-LUX' and with the abbreviation 'OLS' which stands for 'ONE-LED SOLO' and is referred to as model number or a product code; this is shown on the invoices, on the product labels, on the product guide, on the product itself and on the website. Finally, the one image of packaging that has been exhibited only shows the abbreviation 'OLS' without the sign 'ONE-LED SOLO'.

53. Taking into account all the above in relation to the sales achieved, the advertising carried out and way the signs have been used, the two main issue I need to resolve are (1) whether the applicant's evidence demonstrated that a small but not trivial goodwill was established at the relevant date and (b) if the answer to the first question is positive, whether the signs being relied upon are distinctive of the applicant's goodwill.

Did the applicant have a more than trivial goodwill at the relevant date?

54. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an

unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

55. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

56. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi's witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled,

reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

57. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, "*very limited*", the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.

58. In this case the applicant's sales are comparably higher in comparison to the sales in the *Lumos* case; nevertheless, they are still very low (but more than trivial) by reference to the market in which the applicant is operating, which I consider to be the lighting market at large. Further, the length of use is far from being long-standing, sales having commenced approximately two years before the relevant date, the marketing spend is very small and there is little information about the applicant's advertising reach in the UK but given the minimal advertising efforts shown in the evidence I doubt that it was significant. Overall, my conclusion is that the evidence demonstrates a small but probably more than trivial goodwill at the relevant date. This is sufficient to satisfy the first required element of passing off.

Are the signs being relied upon distinctive of the applicant's goodwill?

59. The applicant relies on two signs, namely 'SOLO' and 'ONE-LED SOLO'. The first conclusion I draw on the basis of the evidence filed is that the applicant did not have any goodwill in the sign 'SOLO' alone at the relevant date. This is because the name used by the applicant is 'ONE-LED SOLO', which is used as a product name and is abbreviated in 'OLS' as the product code – the fact that an acronym is created from the name also confirming the unitary character of the name itself. Although there are one of two instances of the sign 'SOLO' being highlighted or presented separately on the invoices and on the product guide, such use is inconspicuous to say the least.

60. The fact that the sign 'ONE-LED SOLO', is used as a product name is an important fact because it serves the purpose of indicating what the goods are rather than denoting their trade source. However, to the extent that the sign 'ONE-LED SOLO' is part of a family of marks which incorporates the applicant's brand 'ONE' and the descriptive element 'LED' – and recreated a distinctive pattern used by the applicant's marks - it is likely to be also appreciated as an indication of origin.

MISREPRESENTATION

61. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

62. I have already concluded that the applicant had a small but sufficient goodwill to sustain a claim for passing off at the relevant date of which the sign 'ONE-LED SOLO' was distinctive.

63. In considering the question of misrepresentation, I also take into account the following factors:

The closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business.

64. The applicant's goodwill attaches to the one type of goods it has supplied, namely *LED emergency luminaire* which comprises an emergency LED driver, a hinged rechargeable battery and a flush-mount lamp head. These goods are essentially emergency lighting systems. The proprietor's goods are *LED light bulbs; LED lighting installations; Light-emitting diodes [LED] lighting apparatus; Lighting; Lighting lamps; Lighting units; Electric lighting; Lighting fittings; Lighting installations; Lighting fixtures; Electrical lighting fixtures; Bulbs for lighting; LED lighting installations; Electrical lamps for indoor lighting; Lighting fixtures for household use*. Although some of the contested goods are closer than others to the applicant's goods - for example *LED lighting installations; Light-emitting diodes [LED] lighting apparatus; Lighting; Lighting units; Electric lighting; Lighting fittings; Lighting installations; Lighting fixtures; Electrical lighting fixtures; LED lighting installations; Lighting fixtures for household use* are broad enough to cover identical goods – they are all very close, being in the same fields of activity in which the applicant carry on its business.

The similarity of the mark, name etc used by the defendant to that of the claimant.

65. The sign used by the applicant is 'ONE-LED SOLO'. The proprietor's mark is a figurative mark consisting of the word 'SOLO' placed below a semi-oval shape:



66. The signs coincide in the word 'SOLO' but differ in the presence of the words 'ONE-LED' in the applicant's sign and the figurative elements in the proprietor's mark. Taking into account the similarities and the differences, the signs are in my view visually similar to a low degree and aurally similar to a low to medium degree. Conceptually, the Collins Online dictionary defines the word 'SOLO' as follows:

"SOLO

ADJECTIVE

You use solo to indicate that someone does something alone rather than with other people.

He had just completed his final solo album.

...his spectacular solo goal.

She had long since quit the band for a solo career.

Solo is also an adverb.

Charles Lindbergh became the very first person to fly solo across the Atlantic.

COUNTABLE NOUN

A solo is a piece of music or a dance performed by one person.

The original version featured a guitar solo."

67. Given the nature of the applicant's goods, which are self-contained emergency lighting systems that include their own batteries and operate independently, the word 'SOLO' is descriptive or at least allusive of the goods sold by the applicant insofar as it describes (or alludes to) a characteristic of

the goods, namely that of being powered by their own batteries (in the event of mains failure) and operating independently.

68. Conceptually, the signs coincide in the concept conveyed by the word 'SOLO' (which is present in both signs) and differ in the concepts conveyed by the words 'ONE' and 'LED' (which have no counterpart in the proprietor's mark), so there is a medium degree of conceptual similarity.

The manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

69. In taking into account the above factors, I also bear in mind my findings about (a) the fact that the applicant uses the main brand 'ONE-LUX' as well as sub-brands incorporating the element 'ONE' and/or 'ONE-LED' which, as I explained above, are highly distinctive of the applicant's business and will be perceived as the main indicator of origin, and (b) the descriptive/allusiveness of the word 'SOLO' in the context of the applicant's goods and (c) the fact that the name 'ONE-LED SOLO' has a unitary character and is used as a product name.

70. In my view, when all of the above factors are weighted together, use of the proprietor's mark will not be passing-off. The main factor which, in my view, is effective to distinguish the applicant's goods is that they are always sold under the applicant's own brand name, namely as a sub-brand of 'ONE LUX' called 'ONE-LED'. It is my view, therefore, that the applicant's actual or potential customers are unlikely to be misled into purchasing the proprietor's goods in the belief that they are the applicant's goods because they will consider that the absence of the distinctive brand 'ONE-LED' in the proprietor's marks means that the goods do not come from the applicant. The applicant does not have an exclusive reputation in relation to the sign 'SOLO' and whilst there is some goodwill associated with the sign 'ONE-LED SOLO', it is small, and the sign in itself has been effectively used as the name of a product within which the element that is more likely to be appreciated as an indication of origin is the element 'ONE-LED'. Further, the element 'SOLO' denotes a characteristic of the goods concerned, namely that they operate independently and is more likely to be appreciated for its own sake (rather than as an indication of origin).

71. For all of the above reasons, my conclusion is therefore that there is no misrepresentation.

72. The applicant's claim under Section 5(4)(a) fails.

CONCLUSIONS

73. The application for invalidation filed against registration no. UK00915250707 has failed in its entirety, and subject to any successful appeal, the registration will remain on the register.

COSTS

74. As the proprietor has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the proprietor the sum of £1,050 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's statement:	£250
Reviewing evidence And commenting on it:	£500
Preparing submissions in lieu	£300
Total	£1,050

75. I therefore order One-Lux Limited to pay Kevin Lee the sum of £1,050. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 31st day of March 2023

Teresa Perks
For the Registrar