

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2015571  
BY URBIS LIGHTING LIMITED TO REGISTER  
THE TRADE MARK AURORA IN CLASS 11**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 45300 BY AURA LIGHT AB**

## TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2015571**  
**by Urbis Lighting Limited to register**  
**the trade mark AURORA in Class 11**

**and**

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**IN THE MATTER OF Opposition thereto**  
**under No 45300 by Aura Light AB**

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### **BACKGROUND**

On 27 March 1995 Urbis Lighting Limited of Basingstoke, Hampshire applied to register the trade mark AURORA in Class 11 for “Installations and apparatus for street lighting”. The application is numbered 2015571.

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On 4 September 1996 Aura Light AB filed notice of opposition to this application. In summary, the grounds of opposition are:

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- I under Section 1 of the Act because the trade mark is not capable of distinguishing the goods of one undertaking from those of another, is not an indication of origin of goods and is not a guarantee of quality
  - ii under Section 5(2)(b) because the trade mark applied for is similar to earlier trade marks in their ownership (see Annex for full details of these registrations)
  - iii under Section 5(3) in that use of the trade mark applied for would take unfair advantage of and be detrimental to the distinctive character or the repute of various earlier trade marks belonging to the opponents where the respective goods are not similar
  - iv under Section 5(4)(a) and (b) of the Act in that its use in the United Kingdom is liable to be prevented by virtue of any rule or law protecting an unregistered trade mark or other sign in the course of trade and by virtue of the law of copyright, design right or registered designs
  - v under Section 3(1)(a) of the Act in that the mark is not capable of distinguishing the goods of the applicant from those of other undertakings
  - vi under Section 3(1)(b) in that the trade mark applied for is devoid of any distinctive character
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- vii under Section 3(3)(b) in that the trade mark is of such a nature as to deceive the public
- 5 viii under Section 3(4) in that its use is prohibited in the United Kingdom by any enactment of rule or law or by any provision of Community law.
- xi under Section 3(6) of the Act in that the application was made in bad faith
- 10 x under Section 6(1)(c) as of the date 27 March 1995 the trade mark AURA either as a word mark or in combination with a device or other matter was a trade mark entitled to protection under the Paris Convention.

The applicants filed a counterstatement denying the grounds. In particular the opponents were put to proof that they were the owners of Trade Mark Application Nos 1559152 and 1572207. The applicants for registration denied all the other grounds of opposition.

Both sides seek an award of costs.

The matter came to be heard on 16 February 1999 when the applicants were represented by Mr Edenborough of Counsel, instructed by R R Prentice & Co. The opponents were represented by Ms McFarland of Her Majesty's Counsel, instructed by Trade Mark Owners Association Limited.

#### The Opponents' Evidence

The opponents filed a Statutory Declaration dated 21 May 1997 by Mr Krister Issal who is President of Aura Light AB. Mr Issal has been employed by the opponents for more than 13 years. He states that he makes his declaration on the basis of information known personally to him and extracted from the records of the opponents.

Mr Issal states that the trade mark AURA either alone or in combination with a device was first adopted by the opponents' predecessor company Lumalampan AB during 1993 and that the trade mark AURA either alone or in combination with a device was first used in the United Kingdom by the opponents or its predecessors in the same year. Mr Issal states that the trade mark AURA is registered in the United Kingdom under Trade Mark Nos 1559151 and 1559152 in Classes 9 and 11 and the trade mark AURA and device is registered under No 1572207. Photocopies of the certificates of registration of the aforesaid trade marks are exhibited as A1. Exhibited as A2 are copies of certificates for registrations in various countries across Europe.

Mr Issal states that between 15 January 1993 and 10 March 1995 the opponents sold products under the trade mark AURA in the United Kingdom amounting to approximately £460,000, that being the sum of the price paid by the company's agents. He states that the retail amount would have been much higher.

Copies and originals of brochures used in the United Kingdom showing use of the trade mark AURA in relation to the products, including outdoor and street lighting, are exhibited as A3. Also included in this exhibit is a general AURA brochure showing use of AURA in various countries.

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Mr Issal notes that the applicants for the trade mark in suit deny that their trade mark resembles his company's trade mark AURA. He believes the respective trade marks are similar and confusion is likely. He makes particular reference to the fact that his company products are also used for outdoor and street lighting.

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Mr Issal believes that the trade mark AURA is very well known throughout the world and certainly the United Kingdom. He believes that if the applicant's trade mark were allowed to be registered it could tend to deceive or cause confusion in the minds of the purchasing public.

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Mr Issal concludes his declaration by stating that the image which the trade mark AURA projects, either alone or in combination with the device, is one of exclusivity and quality conferring status upon the purchaser of the opponent's products and attracting existing and potential purchasers to the opponents. He believes the registration of the trade mark in suit could seriously damage the opponents' trade mark AURA.

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The opponents also filed a Statutory Declaration dated 19 June 1997 by Mr Arthur Rowley who is the Managing Director of Dron & Dickson Group of Stirling, Scotland. He states that he makes his declaration on the basis of information known personally to him and extracts from the records of his company.

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Mr Rowley states that his company acts as an agent in the United Kingdom for Aura Light AB and since 1994 have been importing and selling long life fluorescent tubes under the trade mark AURA. He declares that the annual retail value of goods sold in the United Kingdom under the mark AURA has been £300,000 and the amount spent in advertising such fluorescent tubes has been £100,000 to date. He exhibits as AR1 copies of advertising material his company produced over the previous financial year, including labels, stickers and price lists.

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Mr Rowley finally declares that fluorescent tubes under the trade mark AURA either alone or in combination with a device have been sold throughout the whole of the United Kingdom.

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The opponents filed a further Statutory Declaration dated 11 July 1997 by Mr Krister Issal.

Mr Issal states that the company Auralight AB was originally established in 1930 under the name Lumalampan AB and has been represented in the United Kingdom market since 1980 when the worldwide well known trade mark Luma was being used. He further declares that during 1993 the company changed its name to Aura Light AB and the trade mark was accordingly changed to AURA and this trade mark has been in use in the United Kingdom since the autumn of 1993. He declares that since 1994 the company Dron & Dickson Group have represented the opponents in the United Kingdom as their agents.

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### The applicants evidence

5 The applicants filed three Statutory Declarations. The first Statutory Declaration is dated 7 October 1997 and was made by Stephen John Devitt who is a trainee Trade Mark Agent employed by R R Prentice & Co.

10 Mr Devitt states that he examined the official files for registered Trade Mark Nos 1559152 and 1572207 in the Patent Office in London on 22 August (presumably in 1997). He states that Trade Mark No 1559152 was filed by Auralight AB on 14 January 1994. Trade mark No 1572207 was filed on 17 May 1994 by Lumalampan AB.

15 Mr Devitt exhibits as SJD1 a copy of Trade Marks Form TM20 which relates to Application No 1559152. He states that this form indicates that on 31 March 1994 there was an application to change the name of the applicants from Lumalampan AB to Aura Light AB.

20 Mr Devitt exhibits as SJD2 a copy of a notice of opposition accompanying a Statement of Grounds filed in relation to Trade Mark Application No 1559152. He states that the opposition was filed by D W Windsor Ltd on the grounds that they had been using the trade mark AURA in the United Kingdom since August 1993, therefore prior to Application No 1572207 which was filed on 14 January 1994.

25 Mr Devitt exhibits as SJD3 a copy of a Trade Marks Form TM20 which relates to Application No 1572207, he states that the form indicates that on 24 August 1994 there was an application to change the name of the applicants from Auralight AB to Aura Light AB.

30 Mr Devitt exhibits as SJD4 a Notice of Opposition and accompanying Statement of Grounds filed in relation to the registration of Trade Mark Application No 1572207. The Opposition was filed by D W Windsor Ltd on the basis of their use of the trade mark AURA since August 1993.

35 Mr Devitt states that official files made available for his inspection contained no documents after the Notice of Opposition other than Form TM9 which was lodged by the agents acting for the opponents. A copy of this form is exhibited as SJD5.

A second Statutory Declaration dated 10 October 1997 is made by Mr Bengt Nihlmark of Stockholm. Mr Nihlmark states that he is a Trade Mark Agent in Sweden.

40 Mr Nihlmark states that he was requested to conduct searches in respect of the Swedish companies Aura Light Aktiebolag and Lumalampan Aktiebolag. He exhibits as BN1, three certificates of registration in relation to three Swedish companies and one certificate of merger.

45 Mr Nihlmark states that Registration No 556028-7525 shows that a company called Glödlamps-Aktiebolag Kullen was registered on 12 March 1930. He goes on to state that on 23 October 1942 this company changed its name to Lumalampan Aktiebolag, the company

changed its name again on 27 January 1994 to Aura Light Aktiebolag and again on 20 June 1994 to Auralight Aktiebolag. Mr Nihlmark states that Mr Tomas Krister Issal is named as the Deputy Managing Director of the company.

5 Mr Nihlmark states that Registration No 556398-8178 shows that the company called Luma Industrier Aktiebolag was registered on 14 January 1992. He goes on to state that the company changed its name to Aura Industrier Aktiebolag, then Auralight Aktiebolag and finally to Gordios Desmos Leasing Aktiebolag. He states that Mr. Issal is not named as an officer of the last company.

10 Mr Nihlmark states the certificate of merger shows that on 24 October 1994 the court gave permission for a fusion agreement to be executed which resulted in Auralight Aktiebolag being dissolved and merged with Aura Industrier Aktiebolag. He states that this certificate further shows the merged company changed its name to Auralight Aktiebolag on 19 January 1995 and on 15 May 1995 subsequently changed its name to Gordios Desmos Leasing Aktiebolag. He goes on to declare that on 14 August 1997 a Board of Directors of Gordios Desmos Leasing Aktiebolag decided upon voluntary liquidation. This was recorded on 29 August 1997. He exhibits as BN2 a copy of the certificate issued by the Companies Department of the Patent and Registrations Office in Sweden which he states gives details of liquidation.

20 Mr Nihlmark states that Registration No 556491-1088 indicates that a company named Aura Ljus Aktiebolag was registered on 2 August 1994. He goes on to state that the name of this company was changed on 15 May 1995 to Auralight Aktiebolag. He declares that Mr Tomas Krister Issal is named as the Managing Director of this company.

25 Mr Nihlmark goes on to declare that he believes that it is clear from this that all three companies have used the word Aura in their company name at some point in time. The earliest registration of a company using the word Aura in its name is 27 January 1994. He goes on to state that on 4 September 1996, the date on which the opposition was filed, the only Aura company in existence was Auralight Aktiebolag, the successor of Aura Ljus Aktiebolag.

30 The third Statutory Declaration dated 15 October 1997 is made by Robert David Bennett who is the Sales and Marketing Director of the applicants for the trade mark in suit. He states that he has been employed by the applicants since February 1998. Mr Bennett declares that he makes his declaration on the basis of information known personally to him and extracted from the records of the applicants.

35 Mr Bennett declares that Mr Issal states that he is President of Aura Light AB, however, according to the information obtained by Mr Nihlmark there was no such company in existence in 1997 when Mr Issal signed his declarations. Mr Bennett states that Mr Issal is named as the Managing Director of Auralight Aktiebolag. Mr Issal stated that the term AURA was first adopted by his company's predecessors Lumalampan AB during the year 1993, and the trade mark AURA was first used in the United Kingdom in the same year. However, according to the document exhibited as BN1 to Mr Nihlmark's declaration the change of name from Lumalampan Aktiebolag to Aura Light Aktiebolag was recorded on 27 January 1994.

Mr Bennett notes from Mr Issal's declaration that United Kingdom Trade Mark Nos 1559151 and 1559152 have been registered with effect from 14 January 1994. He also notes that United Kingdom Trade Mark No 1572207 has been registered with effect from 17 May 1994.

5 Mr Bennett goes on to state that Mr Issal claims that the value of the products sold under the trade mark AURA in the United Kingdom between 15 January 1993 and 10 March 1995 amounted to approximately £460,000, however, that there is no breakdown of these figures. He goes on to state that in Mr Issal's second declaration he states that the trade mark AURA has only been used in the United Kingdom since the autumn of 1993 and not January 1993.

10 Mr Bennett states that he considers it important to note that in documents exhibited as A3 to the first declaration of Mr Issal, the earliest invoices in the bundle are dated 21 February 1994. He also states that the brochure Aura Thermo-LL is not dated but the brochures Aura Reflector-LL, Luminette LL and Super EX-LL are dated 1996, which is after the date of filing of the application in suit. Mr Bennett notes that the brochure Aura is also not dated but it does refer on page 7 to the company being able to offer their customers the "lifelong recycling" systems by 1993 or later. So he states this indicates that the brochure must have been printed in 1993 or later". He declares that the remaining brochures are also undated. He declares that there is no evidence to support any prior established reputation on behalf of the opponents in their trade mark as they have asserted.

20 Mr Bennett states that Mr Issal has not produced any evidence to show that the respective trade marks are similar and that confusion is likely.

25 Mr Bennett states that Mr Issal has produced no evidence to show that the opponents trade mark AURA is very well known throughout the world or in the United Kingdom. He also notes Mr Issal has stated that if the application in suit is allowed to be registered it would seriously reduce the opponents rights which have been built up over the years. However, the evidence which has been produced shows that the opponents first used the trade mark AURA in the United Kingdom little more than one year before the application in suit was filed.

30 Mr Bennett declares that Mr Issal has stated that the opponents adopted the trade mark AURA during 1993 and that the trade mark AURA has been in use in the United Kingdom since the autumn of 1993. He does not believe that any company in the field of outdoor and strip lighting could build up a worldwide reputation in a trade mark in the period between autumn 1993 and the date of the filing of the application in suit.

35 Mr Bennett goes on to state that in the declaration of Mr Rowley he states that his company has been importing and selling long life fluorescent tubes under the trade mark AURA since 1994. Mr Bennett declares that Mr Rowley has produced evidence to support the statement that his company has sold goods to the retail value of £300,000 under the trade mark AURA in the United Kingdom. Mr Bennett goes on to declare this would appear at variance with figures quoted by Mr Issal in his first declaration. Mr Bennett states that neither Mr Issal nor Mr Rowley have produced any evidence to support their sales figures and that the first invoices to Dron & Dickson Group contained in Exhibit 3 to Mr Issal's first declaration are dated February 1994.

Mr Bennett states that Mr Rowley exhibits as AR1 to his declaration copies of advertisements which he declares his company ran over the past financial year. Mr Rowley made his declaration on 19 June 1997. Mr Bennet exhibits as RDB1 copies of the abbreviated balance sheets of Dron & Dickson Ltd for the years ending 31 May 1995 and 31 May 1996 as submitted to the Registrar of Companies. He declares that they indicate that the financial year of Mr Rowley's company ends on 31 May. He goes on to state that, therefore, documents which make up Exhibit AR1 must be dated between June 1996 and May 1997 and this is confirmed by the dates on some of the advertisements. He declares that this is after the date of filing of the application in suit and therefore not relevant.

Mr Bennett states Mr Rowley's declaration that fluorescent tubes under the trade mark AURA have been sold throughout the whole of the United Kingdom is not substantiated by any evidence. He goes on to declare that the applicants have been using the trade mark AURORA since December 1993. He states that the development of the name Aurora was chosen for one of the applicants' products without any reference to Auralight AB. He declares that he was looking in a book about the moons of Saturn, because the applicants were already using the name Saturn as a trade mark in respect of some of the applicants' products. He noted that Aurora was the name of one of the moons that orbit Saturn and since that was a name that appealed to him he discussed the matter with the Managing Director of the company and it was then decided to adopt this name for the new product. Mr Bennett declares therefore that the trade mark in suit was conceived before the opponents decided to register their trade mark in 1994.

Mr Bennett goes on to exhibit as RDB2 a copy of the applicants art work for the lighting product range selector. He declares the art work is dated 20 December 1993 and 20 January 1994. He states that the art work shows the range of products of the applicant available at the time, including Saturn and Aurora trade mark products. He also states that included in the exhibit are the job details dated 31 January 1994 from the printers commissioned to produce the lighting product range selector, together with the purchase order proof note and delivery note for the selector.

Mr Bennett goes on to exhibit as RDB3 a copy of selected pages for catalogues produced by a company called D W Windsor Ltd. He declares that the catalogue was produced in August 1993 and contains references on pages 6 and 25 to a lighting unit called AURA. He declares that this clearly shows that the Windsor company was using the trade mark AURA in the United Kingdom before the opponents changed their company name to Aura Light AB and he believes this therefore demonstrates that the opponents cannot argue that they have rights to the trade mark on the premise that it is well known for their products in the United Kingdom.

Mr Bennett declares that he believes that it is clear that the opponents chose the name AURA at about the same time that the applicants decided to adopt the name AURORA as a trade mark. He states that the opponents have failed to establish a provable date on which they first adopted the trade mark AURA. He goes on to declare that Dron & Dickson Group were not appointed by the opponents as agents until 1994 and at the time they were appointed the applicants had already adopted the trade mark AURORA in the United Kingdom. Further, he adds, at the time the application in suit was filed trade mark AURA had only been used in the United Kingdom by the opponents for a short period of time, if at all, and this was certainly

not enough time to build up a significant reputation. He declares that there is no evidence to suggest that trade mark of the opponents is well known throughout the world and the United Kingdom.

5 Opponents evidence in reply

There is a further declaration by Mr Krister Issal dated 11 March 1998.

10 Mr Issal states that he intends to clarify the history of Auralight AB, a Swedish company founded on 2 August 1994 (under Company Registration No 556491-1088) and Aura Light AB, Company Registration No 556028-7525.

15 In relation to Company Registration No 556028-7525 Mr Issal states that this company was founded on 12 March 1930 under the name Glödlamps-Aktiebolaget Kullen. This company then changed its name on 23 October 1942 to Lumalampan Aktiebolag AB, on 27 January 1994 it was further changed to Aura Light AB and finally on 20 June 1994 to Auralight AB. On 3 May 1994 Company Registration No 556028-7525 was merged with Company No 556398-8178, Gordios Desmos Leasing AB. He states that Gordios Desmos Leasing AB was previously known as Aura Industrier AB and changed its name to Gordios Desmos  
20 Leasing AB. Gordios Desmos Leasing AB is now in liquidation he states.

Mr Issal states that in relation to Company Registration No 556491-1088 that this company was founded on 2 August 1994 under the name of Aura Ljus AB and changed its name on  
25 15 May 1995 to Auralight AB. Mr Issal declares that he can confirm that Company Registration No 556491-1088 is the only remaining company with the name Auralight in Sweden and that there is no other company in Sweden with the name Aura Light. He exhibits as KI.1 extracts from the Swedish Companies Register in support of this claim.

Mr Issal declares that the companies United Kingdom Trade Mark Registration Nos 1559151,  
30 1559152 and 1572207 should have been filed in the name of Auralight AB (Company No. 556491 - 1088). Mr Issal declares that Company Registration No. 556491 - 1088 was founded on the 2 August 1994 under the name of Aura Ljus AB and that he can confirm the word Ljus is Swedish for light.

35 Mr Issal declares that all the companies mentioned above are part of the same company group, indeed internally that the companies Aura Light AB (later called Auralight AB) and Aura Ljus AB (later known as Auralight AB) have been treated as the same company.

Mr Issal declares that first use of the trade mark AURA by the opponents in the United  
40 Kingdom was in Autumn 1993. He states that up until 1994 such use was made directly by the opponents. He declares that it is correct that the trade mark AURA was used and sold in the United Kingdom before the opponents changed its name to Auralight and before they applied for trade mark registrations in the United Kingdom.

45 Mr Issal goes on to confirm the details of the opponents UK trade mark registrations Nos. 1559151, 1559152 and 1577207.

Mr Issal goes on to state that the opponents are also the registered proprietors of registration Nos. 1572833 for AURA in Class 11 covering; lamps, lighting units, luminaries(sic), lamps support columns; parts and fittings for all the aforesaid goods. He states that this trade mark was filed on 23 May 1994, originally in the name of D W Windsor Limited. He declares that the assignment of 1572833 to Aura Light AB was recorded at The Trade Marks Registry on 27 February 1997. A copy of the assignment documentation is exhibited as K12.

Mr Issal declares that the opponents predecessors in title to registration No. 1572833, D W Windsor Limited, first used the trade mark AURA in the United Kingdom in August 1993, he exhibits as KI3 copy catalogue dating from November 1993 (but showing the date August 1993 on the back cover) confirming use of AURA in such a printed catalogue. Use of AURA is illustrated on pages 6 and 25 of the catalogue, he states. Exhibit KI4 is an extract from a trade publication ABC & D which features new products, including mention of D W Windsor's AURA product. Mr Issal declares that by virtue of the assignment of registration No. 1572833 to the opponent that the opponents can claim use of the trade mark AURA in the United Kingdom from August 1993.

Mr Issal goes on to declare that in paragraph 6 of his previous declaration dated the 21 May 1997 he stated that sales in respect of the trade mark filed under the trade mark AURA in the United Kingdom between 15 January 1993 and 10 March 1995 amounted to approximately £460,000. He declares that the date 15 January 1993 should be replaced by the date 30 October 1993. He goes on to state that in respects to the copy of invoices submitted under exhibits A3 to his declaration of 21 May 1997 he can confirm that the earliest date of these invoices is 21 February 1994.

The opponents filed a second Statutory Declaration in evidence in reply dated 12 March 1998 by Mr Malcolm Richards. Mr Richards states that he is Technical Director of D W Windsor Limited. He declares that he has been with the company for eight years. Mr Richards states that he makes his declaration on the basis of information known personally to him or extracted from the records of his company.

Mr Richards states that his company opposed an application for registration of the trade mark AURA under No. 1559152 in the name of Aura Light AB on the basis of use of the trade mark AURA in the United Kingdom since August 1993 in connection with lamps, lighting units and luminaries(sic). He declares that the name AURA was first used as a one product style in his company's optima series of luminaries(sic) and that the trade mark has been used continuously since August 1993.

Mr Richards declares that the Annual Sales for the AURA lighting/luminaries(sic) since 1993 have been as follows:

## HOME MARKET

	<u>YEAR</u>	<u>AMOUNT</u>
5	1993	£400
	1994	£10,665
	1995	£37,315
10	1996	£14,045

## EXPORT MARKET

	<u>YEAR</u>	<u>AMOUNT</u>
15	1995	£4,980
	1996	£12,876

20 Mr Richards goes on to state that the total annual advertising and promotional expenditures incurred to establish and increase the reputation of the trade mark AURA by his Company has been as follows:

	<u>YEAR</u>	<u>AMOUNT</u>
25	1993	£26,072
	1994	£16,671

30 He states the advertising was made by affixing the trade mark to packaging, advertising in pamphlets and catalogues as well as in the following magazines and publications:

- 35 “What’s New in Building”
- “The Lighting Journal”
- “Light Magazine”
- 40 “Building Design”
- “London Architect”
- “Building Products”
- 45 “Riba Journal”
- “Lighting Equipment News”

He goes on to declare that his Company's products which included luminaries(sic) under the name AURA were exhibited at the following exhibitions:

5 Bristol Lightex 93 (Sept)

ILE Exhibition 93 (Renfrew)

Cities Exhibition 93 (Docklands)

10 Mr Richards exhibits as MR1 a selection of advertisements relating to the Company's OPTIMA series of which the name AURA forms a part. Included amongst these exhibits are two brochures dated June 1994 and September 1995; he declares that these are reprints to the original brochure dated August 1993 for which only a date cover is available.

15 Mr Richards states that his Company applied to register the trade mark AURA under No. 1572833 to cover lamps, luminaries(sic), lamps support columns; parts and fittings for all the aforesaid goods. However, following an agreement with Aura Light AB he declares that it was decided to assign the trade mark to them and the relevant assignment was made on 3  
20 September 1996, a copy of this assignment documentation is exhibited as MR2. Mr Richards finally declares that since that date rights in the trade mark AURA have been vested in the Swedish company, Aura Light AB.

This completes my review of the evidence filed in these proceedings.

## 25 **Decision**

Two preliminary points were dealt with at the hearing.

30 Firstly Mr. Edenborough submitted that the opposition should be dismissed as the opponent did not exist and did not exist at the time of the filing of the opposition. The evidence from both parties clearly shows that Aura Light AB did not exist at the time of the filing of the opposition and did not exist at the time of the Hearing. Indeed in the third statutory declaration of Mr. Issal, dated 11 March 1998, he states:

35 "I confirm that Company Registration No. 556491-1088 is the only remaining company with the name Auralight in Sweden and there is no company in Sweden with the name Aura Light."

He goes on to state:

40 "I can confirm that all the companies mentioned above are part of the same company group and indeed internally, the companies Aura Light AB (later called Auralight AB) and Aura Ljus AB (later known Auralight AB) have been treated as the same  
45 company."

Ms McFarland submitted that a proper existing legal entity was prosecuting the opposition; that the variant use of the company names had been fully explained by Mr. Issal and corroborated by the evidence of Mr. Nihlmark. Finally she submitted that if there was an error in the form of the title of the opponent, being the gap between Aura and Light, this could simply be attributed to a typographical error. The third point must be dismissed. It is clearly stated in the opponents evidence that Aura Light AB, before merging with Gordios Desmos Leasing AB, had the company registration number 556028-7525, whilst Auralight AB had the company number 556491-1088. It is clear that separate legal entities are involved. The nature of the fact militates against the cause, even if it had been a clerical error. The presumption behind Ms. McFarland's first submission is that the opponent can be changed, because in the instant case it is argued that all the companies are closely connected.

Although I have a certain sympathy for Ms. McFarland's point of view I cannot find for her in this respect. It is a sine qua non that in an opposition there must be an opponent. In the instant case Aura Light AB at the time of the filing of the opposition and afterwards no longer existed, this is stated in the evidence of the opponents. The absence of an opponent, whether an individual or corporate entity, must be a fatal deficiency in proceedings. At no time during the proceedings was there a request to amend or substitute the opponent. However, should there have been this would not have resolved the problem. The Trade Mark Rules 1994(as amended) do not make any provision for the substitution of one opponent for another. (This is consequential on the non-extendable three month opposition period, otherwise there would be de fact extensions of time for the filing of opposition and the possibility of the trading in oppositions.) The recent interlocutory decision in opposition proceedings in respect of trade mark application nos. 1355427, 1355423 and 1355433 clarifies the Registrar's position in relation to requests for the substitution of an opponent. In the circumstances I have to hold that the opponent did not exist at the date on which the opposition was filed and was therefore not a person who could so do.

Consequent upon the above I order that the opposition proceedings be dismissed.

However, in the event that I am wrong in the above I will deal with the substantive issues involved in this case and deal first with the second preliminary point raised at the Hearing.

The applicants requested that additional evidence should be admitted into the proceedings. I refused the request on the basis that there was no reason why the evidence could not have been put in at a much earlier stage in the proceedings. Also much of the evidence sought to be introduced related to what was on the Register. This would not have a bearing upon the proceedings unless evidence as to the usage of the trade marks was also adduced, which it has not been. (See BECK KOLLER 64 RPC 76).

I turn now to the main grounds of opposition. Prior to the Hearing the trade mark attorneys for the opponents wrote to the Registrar to state that in relation to Section 5(4) they would only be pursuing this in relation to unregistered trade marks and other signs and not relating to copyright, design right or registered designs. Ms. McFarland stated that the grounds to be pursued were slimmed down to those arising out of Sections 3(1)(b), 3(3)(b), 3(4), 5(2)(b), 5(3) and 5(4)(a).

In my view the opponents have filed no evidence bearing directly on the grounds under Section 3(1)(b), 3(3)(b) and 3(4) and Ms McFarland's submissions at the hearing concentrated on the relative ground issues. The side note to Section 3 of the Act indicates that that Section is concerned with "absolute grounds for refusal of registration", that is to say some inherent characteristic of the mark that disqualifies it from registration. I do not see any such issues arising in the context of this application. Ms McFarland indicated that Section 3(4) was being pursued upon the basis on passing off. I do not consider that this part of the Act can be used in pursuit of passing off. The Act makes specific provision for opposition based upon the common law tort of passing off under Section 5(4)(a), and the opponents have attacked the application under this provision. As an absolute ground this part of the Act, is in my view, limited to the prevention of registration of trade marks which would contravene the law, arising from the intrinsic feature or features of the trade mark rather than by taking into consideration other parties' rights; the consideration of another party's rights would bring the matter into the area of relative grounds. Therefore the opponents' opposition based upon Section 3(1)(b), 3(3)(b) and 3(4) are dismissed.

It was common ground between the parties that the trade mark in suit is in respect of similar goods as to those upon which the opponents use their trade mark. Section 5(3) of the Act reads:

“(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

As the application in suit is for similar goods the opposition under Section 5(3) must fail as that part of the Act only pertains to where non-similar goods or services are involved.

This leave two areas of opposition, under Section 5(2)(b) and Section 5(4)(a). I will deal with the objection under Section 5(2)(b) first, this reads as follows:

“5.-(1) .....

- (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,

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

The term “earlier trade mark” is itself defined in Section 6 as follows:

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“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,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

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In considering the issue of confusion I also take account of the guidance given by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* (1997 RPC 199). The relevant sections of the ECJ’s decision are set out below:-

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“..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘there exists a likelihood of confusion on the part of the public .....’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

45

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

I also take into account the decision of the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117. In particular I take note of the following:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

and

It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

Finally the court gave the following judgement on the interpretation of Article 4(1)(b):

“On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 89/104 even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.”

In the view of Mr. Geoffrey Hobbs QC, acting as the Appointed Person, in the Balmoral case (Application No. 2003949):

5           “The tenth recital to the Directive and these observations of the Court of Justice  
indicate that an objection to registration under Section 5(2) of the Act should be taken  
to raise a single composite question: are these similarities (in terms of marks and goods  
or services) which would combine to create a likelihood of confusion if the “*the*  
*earlier trade mark*” and the sign subsequently presented for registration were used  
concurrently in relation to the goods or services for which they are respectively  
10           registered and proposed to be registered?”

It could be said that this represents the “holistic” approach to the issue of confusability rather than the previous dualistic approach.

15           Both counsel spent some time making submissions in relation to both Section 5(2)(b) and  
5(4)(a) on the basis of the issue of prior or first use of the respective trade marks. In relation  
to Section 5(2)(b) such argument is not relevant and will not aid a party. There would appear  
to be a misconception in this case that Section 5(2) of the new act was like Section 12(3) of  
the Trade Marks Act 1938 (as amended). Under that Act the Registrar could refuse to  
20           register an application for registration until the respective rights of competing claimants had  
been determined. This is not the case now. Section 5(2) is inextricably linked to the definition  
of an earlier trade mark in Section 6. In the instant case the earlier trade marks in question are  
registrations nos. 1559151, 1559152 and 1572207. For the purposes of Section 5(2) it is not  
relevant if the applicant can claim an earlier date of use; it is a simple matter of who gained  
25           the earlier filing date; this part of the Act takes no cognisance of the issue of earlier use.  
Consequently registrations 1559151, 1559152 and 1572207 represent earlier rights. (It is not  
relevant whether they are or are not in the name of the opponents, there is no requirement for  
an opponent to be the owner of an earlier trade mark.)

30           Subject to the above the task before me is to decide whether registration of the trade mark in  
suit would be subject to objection under Section 5(2)(b) of the Act in relation to registrations  
Nos. 1559151 and 1559152 and 1572207. For the sake of convenience I will take registration  
no. 1599152 as the test for whether the application should fail under Section 5(2)(b). This is  
for the trade mark AURA in respect of “Apparatus and installations for lighting; all included in  
35           Class 11”. If the opposition fails in respect of this registration, which is the closest to the  
trade mark in suit, having no device element, and for goods which both parties have accepted  
are similar or identical it will fail in respect of Section 5(2)(b) in respect of the other  
registrations .

40           Mr. Edenborough submitted that there was no danger of confusion as the words AURA and  
AURORA had a different appearance, had different meanings and were pronounced  
significantly differently. Ms McFarland argued the exact opposite in relation to all three  
contentions. Some time was spent on assertions of how the public would perceive the trade  
marks in question, whether they would consider that the words had different meanings or  
45           would consider that they had similar connotations. As no evidence was adduced to show  
how the public would view the two words I can only consider the issue of the “idea” of the  
trade marks from the knowledge I bring to the matter. In doing so I consider that the trade

marks do summon up different “ideas” in that the words have different meanings in normal usage. (I did not find references by Mr. Edenborough to the Shorter Oxford English Dictionary of assistance, the nature of this work is such that it has both many words and many definitions of words that are unknown to even the highly educated and erudite. Ms McFarland commented that in the page from the dictionary submitted by Mr. Edenborough she did not know the majority of the words, I was in a similar position.) I would associate the word aurora solely with the aurora borealis and the word aura I would define as being a distinctive air or characteristic associated with a person or an invisible emanation. I certainly would not confuse the meanings of the two words.

However, it is not an automatic sequitur that because the respective trade marks have different meanings that there is not a likelihood of confusion. I need to consider the trade marks globally and such considerations must take into account oral use and imperfect recollection. I am assisted in such considerations by the opinion of Advocate General Jacobs in the Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V. (Case C-342/97 in the European Court of Justice):

“Moreover, while the Directive must be interpreted as laying down uniform criteria for assessing the likelihood of confusion, those criteria may fall to be applied differently in the Member States because, inter alia, of linguistic differences. For example, while ‘Lloyd’ and ‘Loint’s’ may seem to have little aural or visual similarity to an English-speaker, that may not be the case for a German-speaker given that the letter ‘t’ and a final ‘d’ are pronounced similarly in German. Consequently, it seems appropriate that the national courts of a Member State should assess the likelihood of confusion in the minds of the public of that State.”

and

“In the context of the present case it may be helpful to add the following. First, with reference to Question 1, it is clear from the ruling in SABEL that the likelihood of confusion must be assessed globally in the light of all relevant factors. Contrary to the view expressed by Lloyd, it may therefore be relevant, depending on the circumstances, to consider not only the degree of aural similarity of the mark and the sign but also the degree (or absence) of visual and conceptual similarity. In the absence of visual or conceptual similarity it would be necessary to consider whether, having regard to all the circumstances including the nature of the goods and the conditions in which they were marketed, the degree of any aural similarity would of itself be likely to give rise to confusion.”

I was struck during the hearing at the difficulty that I experienced in differentiating between the aural use of Aura and Aurora, even when Counsel for the applicants was speaking the word with the clearest of diction. I consider the words are visually similar, the only difference in appearance is the additional syllable “or”. On the issue of visual similarity I also take into account fair and likely use of the trade marks; as they are for lighting it is most likely that when the products are being viewed or serviced in situ that there will be some difficulty in clearly seeing the trade mark and I believe that this would increase the likelihood of visual confusion I take into account that the goods of the applicants are not the proverbial bag of

sweets but equally I note the closeness, indeed identity, of the goods. Taking a global perspective of the likelihood of confusion between the trade mark in suit AURORA and registration no 1559152 for the trade mark AURA I find that the respective trade marks are similar and are in respect of similar or identical goods and consequently there exists a likelihood of confusion. I find therefore that the opposition under Section 5(2)(b) of the Act succeeds.

I go on to continue to consider the grounds of opposition under Section 5(4)(a). Section 5(4)(a) reads:

Section 5(4)a reads:

“ (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, or

(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.”

No reference is made to any rule of law other than passing off. Mr Geoffrey Hobbs QC set out the basis an action for passing off in WILD CHILD Trade Mark (1998) RPC 455:

‘A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the

House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House"

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Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

10 "To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

15 (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation 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 feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

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In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

30 (a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

35 (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

40 (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 confusion or 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." '

45

Counsel made extensive submissions as to whether the assignment of trade mark registration no. 1572833 was with goodwill and if indeed the assignment was valid. I do not intend to

make a judgement in relation to that question. Even if I take into account the usage by D.W. Windsor Limited I do not consider that the use of the trade mark by the opponents by the relevant date in these proceedings, 27 March 1995, would be such that as to contribute to the establishment of the opponents' goodwill or reputation for which there is very scant and  
5 limited evidence. The turnover figures for the relevant period are limited as is the evidence in relation to publicity and advertising in respect of the trade mark AURA. There is no evidence of any reputation or goodwill in the opponents' predecessor business upon which a finding can be made. I note in any event that the exhibits relate to use of the trade mark AURA by the  
10 opponents in relation to fluorescent light tubes and not for the breadth of the specification of the goods of their registrations. These are also very different goods to those that were produced under the trade mark AURA by D.W. Windsor Limited, these were luminaires. So even if the opponents had taken the goodwill of the assignors this would not assist them as it would be a goodwill in respect of a different area of goods within the lighting field. In all of the circumstances I hold that the evidence filed does not begin to address the issue of whether  
15 or not the opponents have a business in which a reputation or goodwill exists sufficient to establish that they have acquired a right to prevent anyone using a sign similar to theirs under the common law tort of passing off.

The opposition under Section 5(4)(a) therefore fails.  
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In summary notwithstanding my decision on the relative grounds of opposition the application may proceed to registration.

As the applicants have been successful in these proceedings I order the payment of the sum of  
25 **£635** as a contribution towards their costs. Section 68 of the Act allows me to direct by what parties any costs are to be paid. In the current proceedings as Aura Light AB does not exist I consider it appropriate that Auralight AB pay the costs awarded to the applicants. From the declarations of Mr. Issal it is clear that this is the entity that has behind the prosecution of these opposition proceedings and it the entity that has been instructing Trade Mark Owners  
30 Association Limited in relation to these proceedings.

Dated this 19 day of March 1999

35

M.KNIGHT  
For the Registrar  
40 the Comptroller-General.

## ANNEX

	Number	Trade Mark	Specification
5	1559151	AURA	Electric accumulators, armatures, batteries, batteries for lighting; flash-bulbs, optical lamps and lanterns, luminous signs and signals, neon signs, parts and fittings for all the aforesaid goods; none being for use in apparatus for recording, transmission or reproduction of sound or images.
10			
	1559152	AURA	Apparatus and installations for lighting; all included in Class 11
15			
	1572207		Apparatus and installations, all for lighting; parts and fittings for all the aforesaid goods; all included in Class 11.
20			

