

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2168334
BY VISTEON CORPORATION
TO REGISTER THE MARK VERSALUX IN CLASS 19**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 49107
BY VKR HOLDING A/S**

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DECISION

1. On 3 June 1998 Ford Motor Company applied to register the mark VERSALUX for "glass for use in buildings and construction" in Class 19. The application is numbered 2168334. It seems that the application has since been assigned to Visteon Corporation.
2. On 22 October 1998 VKR Holding A/S (previously V Kann Rasmussen Industri A/S) filed notice of opposition to this application. They are the proprietors of the trade marks, brief details of which are set out in the Annex to this decision. They say they have made extensive use of these trade marks in relation to the goods in respect of which they are registered. Objection is taken under Section 5(2)(b), 5(3) and 5(4)(a) of the Act in terms which largely follow the wording of the Act.
3. The applicants filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour.
4. Both sides filed evidence. The matter came to be heard on 12 February 2002 when the applicants were represented by Mr T Moody-Stuart of Counsel instructed by Grant Spencer Caisley & Porteous and the opponents by Mr M Edenborough instructed by D Young & Co.

Opponents' evidence

5. The opponents filed two affidavits by Martin Sick Nielsen, their IP Counsel and Head of Intellectual Properties.
6. Mr Nielsen confirms details of his company's registrations (VI-3) and draws attention particularly to registrations in Class 19. He goes on to say that

"VELUX products are manufactured by VELUX A/S, Tobaksvejen 10, DK-2860 Søborg, Denmark (company reg. No. A/S45.215), either by itself or by its sub-suppliers and are distributed and marketed in the UK by THE VELUX COMPANY LTD, Woodside Way, Glenrothes East, FIFE KY7 4ND, Scotland (company reg. No. Glenrothes, 70286).

VELUX A/S and THE VELUX COMPANY LTD are directly or indirectly wholly owned subsidiaries of my Company, and either company holds valid License to use the VELUX trademark in the UK.

The trademark VELUX was first used in the UK immediately after 1945.

My Company has, through its subsidiaries, extensively used and is using the trademark VELUX in relation to roof windows and associated goods throughout the UK since the date of the registration of the trademark."

7. He exhibits (VI-1) copies of specimen brochures and price lists showing the manner in which the mark VELUX is used. The goods in respect of which it is used are primarily manufactured using glass, wood and aluminium. VELUX windows are offered with a wide range of panes of glass to suit the customer and VELUX panes of glass are offered for upgrade and replacement purposes as separate goods. Supplementary brochures and price lists are exhibited (VI-2) showing use of the mark in relation to glass.

8. Mr Nielsen also offers what amount to submissions on the issues of similarity of marks and goods and refers to the existence of a VISTEON web-site thought to be connected with the applicants which suggests that they are one of the largest, full-service glass design, development and manufacturing companies in North America. In his second affidavit Mr Nielsen exhibits (VI-4) material showing use of the mark VERSALUX in relation to glass by a company called Visteon which is said to be an enterprise of the Ford Motor Company.

Applicants' evidence

9. The applicants filed a statutory declaration by Danise van Vuuren-De Groote and an affidavit by Kathryn S Lamping.

10. The former is a trade mark agent acting on behalf of the applicants. She exhibits (DV VDG1) a copy of an English translation of a decision in the Korean Trade Mark Office in opposition proceedings between other parties. At the hearing Mr Moody-Stuart, quite correctly in my view, did not place any reliance on this part of the applicants' evidence.

11. Ms Lamping is an Assistant Secretary with the Ford Motor Company. Her evidence in part duplicates the information already supplied on proceedings before the Korean Office. She also offers her own submissions on the comparison of marks issue.

Opponents' evidence in reply

12. The opponents filed a statutory declaration by Dawn Moodie, their professional representative in this matter. Her declaration seeks to cast doubt on the value of a decision of the Korean Office as a precedent on these proceedings. I have already indicated that this evidence has not played a part in Mr Moody-Stuart's submissions (or my decision). She further suggests that Ms Lamping's comments in relation to the marks are uncorroborated and should be given no weight.

Further evidence

13. Both sides filed further evidence which largely goes to the issue of how the respective marks are pronounced. Ms van Vuuren exhibits material bearing on media advertising of the opponents' mark (DVV1 and DVV2). Included in this material is a video tape of an advertisement from which Ms van Vuuren concludes that "The advertisement makes it clear that the trade mark of the Opponent is pronounced as "VEE-LUX" with a long "ee" sound as in "feel". However, the trade mark of the applicant is VERSALUX, with a short "e" as in "verve"."

14. Mr Nielsen, for the opponent, responds to this as follows:

"I am advised that VKR Holding A/S have no internal guidelines on how to pronounce the trade mark VELUX , which is simply pronounced in accordance with the language usage of the many countries where the products are marketed. In order to respond to the evidence filed by the attorney for Visteon Corporation in these opposition proceedings, our clients have reviewed a substantial amount of material which indicates that the trade mark VELUX is pronounced with a short, as well as a long, "e", depending on the context. This review has not permitted them to draw any conclusions as to which pronunciation is the most common.

In support of our contention that the trade mark VELUX may equally be pronounced with a short "e", our clients will rely on the following representative examples of such usage:

- a) A UK television commercial for VELUX decoration and sun-screening products;
- b) A television profile of The VELUX Group produced by London International Television.

There are now produced and shown to me marked Exhibit "MSN1" video tapes which feature the TV commercial and television programmes referred to above, and it will be noted that in both of these, the word VELUX is pronounced with a short "e" by the participants."

15. That concludes my review of the evidence.

16. Submissions at the hearing concentrated on the objection based on Section 5(2)(b) of the Act. The opponents accept that if they do not succeed under this head they are unlikely to fare any better under Section 5(3) or 5(4)(a)

17. Section 5(2)(b) reads as follows:-

"5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or

services similar to those for which the earlier trade mark is protected, or

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

18. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a

likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;

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

19. I should record that both Counsel were realistic and helpful in narrowing down the issues in dispute and focussing on the points that were likely to have a bearing on my decision.

20. The opponents have a number of earlier trade marks. The two which were central to submissions before me along with the relevant part of their respective specifications are as follows:

No	Mark	Class	Specification (relevant part only)
69115	VELUX	19	Building materials, windows and window frames none being made of metal.
1320083		19 windows; glass; window glass; double glazing panels incorporating insulating glass; glass roofs



(This mark is said to be limited to the colours red and white)

21. Details of the applied for mark are set out at the start of this decision.

Distinctiveness of the Opponents' Earlier Trade Mark (VELUX)

22. I am required to consider the distinctive character of the opponents' earlier trade mark both in terms of its inherent characteristics and as a result of the use made of it. Mr Edenborough argued for an enhanced reputation though in doing so he recognised that the opponents' evidence provided an imperfect base from which to do so. Mr Moody-Stuart referred me to *General Motors Corporation v Yplon SA (Chevy)* [2000] RPC 572 and the considerations identified there by which reputation is to be assessed. The Chevy case concerned the Directive provisions equivalent to Section 5(3) of the UK Act rather than Section 5(2). Nevertheless the factors identified - market share, intensity, extent and duration of use etc - are also likely to be relevant in determining distinctive character acquired through use for present purposes. The plain fact is that the opponents' evidence is thin in terms of substantiating detail being largely confined to the date of first use and the fact that a UK

subsidiary and regional offices exist. There is no attempt to quantify the opponents' use or to place it in context in terms of the overall size of the trade. It is true that the applicants have not sought to cross-examine Mr Nielsen on his evidence but even accepting the limited statement made as being unchallenged there is simply not enough to further the opponents' claims to an enhanced reputation through use. Nor do I feel able to accede to Mr Edenborough's invitation to take judicial notice of the opponents' reputation.

23. However this does not in my view diminish the opponents' case to any appreciable extent. VELUX is an invented word. There is a suggestion in one of the pieces of video evidence that it derives from, or incorporates references to, ventilation and lighting (lux) the twin characteristics of the opponents' main product line. But the evidence does not suggest that the relevant public has either been educated to the fact or would make such a deduction from the mark itself. I, therefore, regard VELUX as being an invented word with a relatively high degree of distinctive character.

Similarity of goods

24. The opponents' registration No 1320083 covers glass. Their registration No 69115 covers building materials. Mr Moody-Stuart accepted that identical and/or similar goods are involved. As building materials is, in my view a sufficiently broad term to include glass I regard both the above registrations as encompassing goods identical to those of the subject application. The opponents' specifications also include other goods, notably windows, which must be considered to be closely similar to glass.

Similarity of marks

25. By common consent the matter turns critically on my view of the marks themselves. Both Counsel, therefore, concentrated their submissions on the similarities and differences between the marks, that is VELUX and VERSALUX. For this purpose nothing in my view turns on the presentational differences between the word only mark (No 69115) and that word set in a red rectangular box with the word in white lettering (No 1320083). The latter is still first and foremost a VELUX mark.

26. Visually the respective marks are of unequal length but self evidently they have letters or elements in common, that is to say the letters VE at the start and LUX at the end. That is of course based on the somewhat artificial process of conducting a textual analysis of the marks. In practice, of course, the eye does not dissect and analyse marks in this way. The marks are single words and it is the words as wholes that will create a visual impression. Even allowing for the points of visual similarity I find their overall appearances to be different.

27. It has helpfully been accepted by the applicants that the opponents' mark can be and is pronounced with either a short or long 'e' sound as the first (and stressed) syllable. The video evidence supports the claim that more than one pronunciation is employed.

28. VERSALUX is unmistakably a three syllable word (either VERS-A-LUX or VER-SA-LUX). The mark is likely to be pronounced and to sound quite different to VELUX, whichever way the latter is pronounced. Although it has been held (see TRIPCASTROID 42

RPC 264) that the beginnings of words are often accentuated with a resultant risk of the endings being slurred Mr Edenborough was right in my view to submit that the ending LUX is a relatively strong one. It is highly unlikely to be lost or slurred in speech. Nevertheless my overall impression is that these marks are not similar to the ear and would not suffer from imperfect articulation or mishearing to the point that they would become similar.

29. Counsel differed in their approach to conceptual similarities between the marks. Mr Moody-Stuart put his case as follows in his skeleton argument.

“The opponent’s mark VELUX is a fancy word, albeit one that contains connotations of “light” appropriate for a window mark by use of the syllable “LUX”. As a fancy word there is no “concept” of the opponent’s mark (other than the reference to “light” denoted by the last syllable). The mark applied for is similarly a fancy word, and similarly contains “LUX” as a reference to light in the last syllable. However, the first two syllables of the mark applied for “VERSA” constitute a reference to “turning” or being “against” that is not present [in] the opponent’s marks and gives a concept of “turning light” or “being against light” that is extremely appropriate for the applicant’s coated and treated glass products. The mark applied for is conceptually very different to the earlier marks.”

30. Mr Edenborough’s view was that both VELUX and VERSALUX were invented words and as such offered no convenient handle by which the relevant public could differentiate between them as might be the case with dictionary words. They were, as he put it, concept neutral.

31. I prefer Mr Edenborough’s view of the matter or at least would not go as far as Mr Moody-Stuart in anticipating how the applicants’ mark will be understood. It is true that the applicants’ trade literature (exhibited at VI-4) by Mr Nielsen) refers to the ‘solar control performance’ and reflective qualities etc of the product but it is going altogether too far to suggest that the average consumer would extract the meaning or allusion he suggests from the mark. Consumers are apt to take marks at face value. They do not necessarily look for a meaning where none is obvious. VERSALUX requires too much work to readily yield a meaning which in itself would serve as a point of differentiation from the opponents’ mark.

32. It is nevertheless possible that, in the context of the goods, some descriptive or allusive significance may be attached to the element LUX which is, to my knowledge, a dictionary term meaning a unit of illumination. The point would have more force perhaps in relation to lighting apparatus. But glass/windows etc can be said to have associations with light so the point is not wholly far fetched. Even so I hesitate to place any great reliance on the point without evidence as to consumer perception. In any case to do so involves the kind of analysis of a (not even separate) element in the marks contrary to the guidance in *Sabel v Puma*.

33. I therefore, approach the matter on the basis that, even if the parties chose their marks for a purpose and with allusive intentions in mind as it were, the marks do not strike me as conveying any obvious meaning to the relevant public. I treat them both as ‘fancy’ words.

Likelihood of Confusion

34. The test is one of global appreciation weighing all the above consideration in the balance and making due allowance in doing so for imperfect recollection. I bear in mind also that, although from the trade literature both parties appear to offer relatively sophisticated and high value products to, I infer, a discerning and knowledgeable customer base, there is no restriction in either specification. Notional and fair use would include applying the respective marks to products with a wide price spectrum and directed at a similarly broad range of customers. Millett L J stated in the case of *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at 288:-

“Similarity is a matter of degree; and except in the case where there is absolutely no similarity at all between sign and mark (which is not this case) the question is whether the similarity is such as to be likely to cause confusion in the mind of the public. A degree of similarity is tolerable, the question is whether there is a confusing similarity.”

35. I have come to the view that this is a case where there is a degree of similarity but that it is not of a kind that is likely to cause confusion in the mind of the public. The opposition fails under Section 5(2)(b).

36. I do not propose to comment in detail on the Section 5(3) and 5(4)(a) grounds. The opponents have simply failed to substantiate their claimed reputation in a manner that would satisfy the guiding principles in *Chevy* even allowing as Mr Moody-Stuart conceded, that it may not be necessary or possible to satisfy every aspect of the test in every case. Further even if a reputation had been established the opponents would be unlikely to succeed in relation to dissimilar goods when they have failed in relation to identical goods. The Section 5(4)(a) case is acknowledged to be no wider in scope than the failed attack under Section 5(2)(b). These supplementary grounds also fail.

37. The applicants have succeeded and are entitled to a contribution towards their costs. I order the opponents to pay them the sum of **£835**. This sum is to be paid within seven days of the expiry of the appeal or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of February 2002

**M REYNOLDS
for the Registrar
The Comptroller-General**

Opponents' trade marks:

No.	Mark	Class
691114	VELUX	6
1323173	VELUX	22
1186561	VELUX	24
1186560	VELUX	20
691115	VELUX	6 & 19
1323174	VELUX	37
1456083	VELUX	9
1320083	VELUX	19
1377522	VELUX GGL	6 & 19
1377524	VELUX GHL	6 & 19