

TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 1581553  
BY ILLUMA LIGHTING LIMITED  
TO REGISTER A SERIES OF TWO TRADE MARKS  
**TWINLUX / TWIN LUX**  
IN CLASS 11

AND IN THE MATTER OF OPPOSITION THERETO UNDER  
OPPOSITION NO 43188  
BY TRILUX-LENZE GMBH & CO KG

TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994

5 IN THE MATTER OF APPLICATION No 1581553  
BY ILLUMA LIGHTING LIMITED  
TO REGISTER A SERIES OF TWO TRADE MARKS  
**TWINLUX / TWIN LUX**  
IN CLASS 11

10 AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 43188 BY TRILUX-LENZE GMBH & CO KG

BACKGROUND

15 On 11 August 1994, Illuma Lighting Ltd of 24-32 Riverside Way, Uxbridge, Middlesex, UB8  
2YF applied under the Trade Marks Act 1938 for registration of a series of two trade marks  
TWINLUX / TWIN LUX in respect of:

20 "Lighting apparatus and instruments; parts and fittings for all the aforesaid goods; all included  
in Class 11"

On 2 October 1995, Trilux-Lenze GmbH & Co. KG. Of Heidestrasse 2, 59759 Arnsberg,  
Germany, filed notice of opposition to the application. The grounds of opposition are:

25 1) The opponents are the registered proprietors of trade mark registration Nos. 981595  
and 1436687.

30 2) The opponents have made substantial use of the trade mark in relation to goods  
covered by the registrations and have acquired a considerable reputation in the goods sold  
under the trade mark.

35 3) The trade mark the subject of application No. B1581553 is confusingly similar to the  
opponents' trade mark Nos. 981595 and 1436687 and its use in relation to the same or  
similar goods is calculated to deceive and cause confusion. Accordingly, the application  
should be rejected in accordance with the provisions of Section 12(1) of the Trade marks  
Act 1938 (as amended).

40 4) In view of the substantial goodwill and reputation acquired by the opponents in their  
trade mark, use of the same or a similar mark by the applicants will lead to deception and  
confusion and the mark applied for should accordingly be rejected in accordance with the  
provisions of Section 11 of the Trade Marks Act 1938 (as amended).

45 5) The Registrar should also refuse application No. B1581553 in the exercise of his  
discretion.

The applicants filed a counterstatement accepting that the opponents were the registered  
proprietors, but denying all other points. The applicants also ask the Registrar to exercise his

discretion in their favour and both sides seek an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 17 June 1999, when the applicants were represented by Mr Moody-Stuart of Counsel instructed by Saunders & Dollymore, Trade Mark Attorneys. The opponents were represented by Mr Birss of Counsel instructed by Potts Kerr & Co., Trade Mark Attorneys.

By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the Trade Marks Act 1938 ( as amended) unless otherwise indicated.

#### OPPONENTS' EVIDENCE

The opponents filed two statutory declarations. The first, dated 13 December 1996, is by Mr Fritz Schulte, an employee of Trilux-Lenze GmbH & Co. KG, the opponents. Mr Schulte states that the opponents have used their trade mark TRILUX (registration number 1436687 dated 1.8.90) in the UK since 1961. He claims that the mark is pronounced "trillux". He also states that the opponents' mark TRILUX & device (registration number 981595 dated 8.10.71) has been used in the UK since 1980. Both marks, he claims, continue to be used in the UK in relation to the products claimed in their registrations.

The opponents second statutory declaration, dated 4 February 1997, is by Mr Paul Anthony Thompson, a partner of Potts, Kerr & Co. the trade mark attorneys for the opponents. Mr Thompson provides copies of catalogues at exhibit PAT1 about which he says, "which I am advised are circulated freely in the United Kingdom on behalf of my clients under the TRILUX trade mark".

These show the range of products offered for sale by the opponents, with the mark TRILUX being prominent throughout each of the four catalogues. Only one of the four items is dated, and this shows a date of 1996, which is after the relevant date.

Mr Thompson also provides, at PAT2, copies of invoices and delivery notes. These show:

DATE	SALES £	
Sept 1986	2,762	four invoices to Mediplan Eng. Ltd
June 1987	23,991	three invoices to Schofield, Goodman & Sons
Aug. 1987	1,269	one invoice to Mediplan Eng. Ltd
Oct. 1989	135	one purchase order to Geneva Electrical Services Ltd
Nov. 1989	275	one invoice to P.D.S

The invoices were all in German Marks and have been converted into sterling by the Registry.

APPLICANTS' EVIDENCE

5 The applicants filed two statutory declarations. The first, dated 26 June 1997, by Mr Paul N Sillett who is the Managing Director of Illuma Lighting Ltd a position he has held since July 1996. Mr Sillett confirms that his declaration is based upon his own knowledge and the company records.

10 Mr Sillett states that the trade mark TWINLUX has been used continuously in the UK on lighting apparatus and instruments; parts and fittings, and particularly downlights since 1994. A brochure devoted to downlights sold under the mark is provided at exhibit ILL1. Mr Sillett claims that 20,00 such brochures were distributed per annum in 1994 and 1995. The brochure features the trademark (TWINLUX), but also has the company name (Illuma) prominently shown. Copies of pages from another company catalogue are provided at exhibit ILL2 and again show the mark being used in relation to downlights. Other "subsidiary" marks are used for other types of lighting products, with the company name on the front page and at the foot of each internal page. Mr Sillett states that 70,000 copies of the two catalogues were distributed in 1995.

20 A page from the publication Lighting Equipment News for November 1994 is also provided at ILL3 and shows the front page of the applicants' brochure, which shows the twinlux mark and the name of the company.

Mr Sillett provides sales and promotion figures:

Year	Sales (wholesale prices) £	Promotion £
1994	35,000	10,000
1995	170,000	8,000
1996	290,000	5,000

30 Mr Sillett claims that his company sells goods under the TWINLUX mark in "all the major towns and cities of the United Kingdom, in all some 260 distributors nationwide". He also states that goods bearing the TWINLUX mark have been exhibited at the Earls Court Lightshow in 1994,95 & 96, and at Electrotech at the NEC in 1994 and 1996.

35 Finally Mr Sillett states that:

40 "The above evidence shows that my company has established a reputation in the mark TWINLUX for downlights through the extensive publication and advertising of the product sold under the mark TWINLUX. To my knowledge there has been no instances of confusion between my company's TWINLUX product and any TRILUX product".

45 The applicants' second statutory declaration is by Keven Verdun, dated 13 August 1997. Mr Verdun is the Chief Executive Officer of the Lighting Association, a position he has held since 1991, having been involved in the lighting industry for 26 years.

Mr Verdun states that he is aware of the TWINLUX trade mark belonging to the applicants, and the downlights sold under this mark. He states that he considers the mark to be distinctive for the downlights sold by the applicants.

5 Lastly, he states that:

10 “Prior to the present request by Illuma Lighting Ltd for my involvement in this matter, I was not aware of the trade mark TRILUX or that company Trilux Lenze GmbH & Co. KG was trading in the UK in respect of lighting apparatus. I am not aware of any confusion between the trade marks TWINLUX and TRILUX and do not believe that there is any likelihood of such confusion arising in the course of trade”.

#### 15 OPPONENTS’ EVIDENCE IN REPLY

This consists of a statutory declaration by Mr Helmut Knappstein, dated 5 February 1998. Mr Knappstein states that he is “a German national, authorised signatory of Trilux Lenze GmbH & Co. KG”. Attached to his declaration as exhibits are three letters. The first is from Marwood Electrical Co. Ltd, Tonbridge, Kent, and states that:

20 “We can confirm that our earliest contact dates from about 15 years ago, when Trilux products were promoted by Roy Peet Ltd, who acted as an agent. This arrangement was in the later 80s taken over by Mediplan Ltd, and following the formation of Trilux Lighting Ltd about seven years ago, we entered into our current distribution agreement. Since then, we have promoted the Trilux name, via our lighting engineers, throughout the UK”.

The next by Yates associates, Bromley, Kent, states:

30 “We are pleased to be able to confirm to whomever it may concern that Yates Associates has been fully aware of both Trilux and its product range of commercial and industrial fluorescent luminaries as well as bedhead trunking systems for more than twelve years in this country. During that time we have specified Trilux products on several occasions and, indeed, have attended lighting seminars both in the UK and at the parent company’s premises in Arnsberg, Germany”.

Lastly, the hospital manager of The Rivers Hospital, Sawbridgeworth, Hertfordshire, writes:

40 “I am writing to confirm that our company has been aware of the existence of Trilux for approximately nine years and has been trading with them for over seven years”.

That completes my review of the evidence.

#### 45 DECISION

The grounds of opposition are under Sections 11 and 12 of the 1938 Act. These read as follows:

“11. - It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design”.

5

12. - (1) “Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of

10

(a) the same goods,

(b) the same description of goods, or

(c) services or a description of services which are associated with those goods or goods of that description.”

15

The reference in Section 12 to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

20

The established tests for objections under these provisions are set down in Smith Hayden & Co. Ltd’s application [Volume 1946 63 RPC 101] later adapted in the case of Section 11 by Lord Upjohn in the BALI trade mark case [1969 RPC 496]. Adapted to the matter in hand these tests may be expressed as follows:

25

1. (Under Section 11) Having regard to the user of the opponents’ marks, TRILUX and TRILUX and Device, is the tribunal satisfied that the series of two marks applied for, TWINLUX and TWIN LUX, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

30

2. (Under Section 12) Assuming user by the opponents of their trade marks TRILUX and TRILUX and Device, in a normal and fair manner for any of the goods covered by the registrations of those trade marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their series of two trade marks TWINLUX and TWIN LUX normally and fairly in respect of any goods covered by the proposed registration?

35

I shall first consider the ground of opposition under Section 12(1). The opponents have two marks registered:

40

Trade Mark	Number & Date Registered	Specification
	981595 8 <sup>th</sup> Oct 1971	Lighting installations; lighting apparatus and appliances all included in Class 11; lighting fittings for use in hospitals; and parts and fittings included in Class 11 for all the aforesaid goods.

TRILUX	1436687 1 <sup>st</sup> Aug 1990	Electrical lighting installations and apparatus; parts and fittings of metal and plastics for all the aforesaid goods; sanitary apparatus and installations and parts and fittings therefor; all included in Class 11.
--------	-------------------------------------	--

5 The goods of both parties are clearly similar if not identical. This was not contested by either side.  
 10 It was also agreed by both parties that the device in the opponents' trade mark number 981595 was irrelevant to the decision in this case as it neither added nor subtracted from the dominant feature of the mark. Similarly the applicants' mark will be considered as a single entity and splitting it into two words did not affect the overall impression of the mark. Therefore, I shall henceforth refer to the opponents' mark in the singular form of TRILUX and the applicants' marks in the form of TWINLUX.

I next compare the two trade marks. For this purpose I take into account the guidance set down by Parker J in Pianotist Co.'s application (1906 23 RPC 774 at page 777):

15 *“You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances: and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the*  
 20 *goods of the respective owners of the marks. If, considering, all those circumstances, you come to the conclusion that there will be a confusion - that is to say- not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”*

25 Mr Birss contended that in the UK the mark would be pronounced TRY-LUX, notwithstanding the evidence of his clients which stated that the mark should be pronounced TRIL-LUX. This assertion was not contested. He also contended that I should consider the “sound, sight and idea” of the mark in suit. He pointed out that both marks consist of two syllables with the second syllable in each mark (LUX) being identical. Both marks also begin with the letter T.  
 30

In my view the opponents' mark could be pronounced as TRY - LUX, TRE- LUX or TRIL - LUX, as compared to the applicants' TWIN - LUX. . It is accepted that the first syllable of a word is important for the purpose of distinction (see TRIPCASTROID [1925]RPC 264), and even  
 35 allowing for the notion of imperfect recollection I do not consider there is a real likelihood of aural confusion.

40 Visually the two marks share similarities. Both begin with a T and end in LUX. They are of similar length, one being a six letter mark, the other is seven letters.

As to the “idea” conveyed by the marks, Mr Birss contended that the suffix LUX is commonly identified as meaning light and is non-distinctive for the these goods . Further, he claimed that, whilst the applicants' prefix TWIN means two or double, the opponents' prefix TRI meant three

5 which is also a “low number”. I was therefore invited, by Mr Birss, to accept that the opponents mark meant three lights whilst the applicants mark meant two lights. This submission involves the public in a detailed analysis of the marks. A more careful analysis than is likely to really occur. Even if I were to accept this premise, I do not believe that such “meanings” would necessarily indicate common or related trade origin.

10 Taking into account all of the factors and comparing the marks as wholes, I consider that the degree of similarity between the mark TRILUX and the mark TWINLUX is insufficient to cause deception and confusion amongst a substantial number of persons. The ground of opposition under Section 12 is dismissed.

15 I now turn to the grounds of opposition under Section 11. Under this heading I must consider the actual user of the opponents’ mark. It is stated that the opponents had used their mark for approx. 14 years at the relevant date, 11 August 1994. The invoices filed relate to use between September 1986 and November 1989, the catalogues filed show a date of 1996, and there are letters from three customers confirming dealings for an average of eleven years. Clearly the opponents have used their trade mark TRILUX in the UK. The sales figures shown on the invoices are very modest. However, given my finding under Section 12 that there would be no deception or confusion amongst a substantial number of persons, assuming normal and fair use  
20 of the opponents’ mark, the opposition under Section 11 is bound to fail.

I do not intend to invoke the Registrar’s discretion in favour of the opponents.

25 As the opposition has failed, the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635.

30 Dated this 19 Day of July 1999

35 George W Salthouse  
For the Registrar  
The Comptroller General