

O/1146/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003822504  
AND UK00003822487 BY AURORA LABS LTD.  
TO REGISTER:

**AURORA**

AND



AS TRADE MARKS IN CLASSES 9 AND 42

AND

IN THE MATTER OF OPPOSITIONS THERETO  
UNDER NOS. 438783 AND 438782 BY  
AURORA LIGHTING UK LIMITED

## BACKGROUND AND PLEADINGS

1. On 22 August 2022,<sup>1</sup> Aurora Labs Ltd (“the applicant”) applied to register the word mark and the figurative mark shown on the cover page of this decision in the UK. The applications were published for opposition purposes on 21 October 2022. The applicant seeks registration for the following goods and services for both marks:

Class 9: Downloadable software for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned goods relating to autonomous vehicles.




Class 42: Computer services and Software as a Service for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned services relating to autonomous vehicles.

2. The applications were both fully opposed by Aurora Lighting UK Limited (“the opponent”) on 23 January 2023. The oppositions are based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”) with the opponent relying upon the following marks:

UKTM no	Mark	Filing and registration dates	Grounds relied upon	Goods/services relied upon
3219473	<b>AURORA</b> “The first earlier mark”	17/03/2017 03/11/2017	5(1) 5(2)(a)- against the word mark  5(1) 5(2)- against the figurative mark	See Annex A

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<sup>1</sup> Both applications claim a priority date of 28 February 2022 based on US filing number 97287852.

3702504	<b>AURORA</b> "The second earlier mark"	28/09/2021 10/02/2023	5(1) 5(2)(a)- against the word mark  5(1) 5(2)- against the figurative mark	See Annex B
3219477	 "The third earlier mark"	17/03/2017 21/12/2018	5(1) 5(2)- against both marks	See Annex A
3702543	 "The fourth earlier mark"	28/09/2021 10/02/2023	5(1) 5(2)- against both marks	See Annex B
3322692	 "The fifth earlier mark"	05/07/2018 20/12/2019	5(2)(b)- against both marks	See Annex C

3. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the filing date of the applications in issue, they are not subject to the use provisions in section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services identified.
4. The opponent claims that the marks at issue are either identical or highly similar and that the goods and services for which application is sought are identical and/or similar to the relied upon goods/services. As a result, the opponent argues that there exists a likelihood of confusion between the marks.
5. The applicant filed counterstatements wherein it provided a series of denials to the grounds raised. I will discuss these points throughout the course of my decision. I note that the applicant sought to put the opponent to proof of use for its marks in respect of the opposition against the figurative mark only, however as above, the opponent's marks are not subject to the proof of use provisions, so this request has no effect.
6. The Tribunal, utilising the power granted to it by Rule 62 of the Trade Marks Rules 2008, consolidated these proceedings. This was communicated to the parties via written correspondence on 6 June 2023.

7. The opponent is represented by Swindell & Pearson Ltd, and the applicant is represented by Cosmovici Intellectual Property. Only the applicant filed evidence in chief and the opponent filed evidence in reply. No hearing was requested however both parties elected to file written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **EVIDENCE**

9. The applicant's evidence came in the form of the witness statement of Paul Cosmovici dated 17 October 2023. Mr Cosmovici is the Director of the applicant's representative. Mr Cosmovici's evidence is accompanied by 40 exhibits, being PC1 to PC40. The evidence was adduced to demonstrate various other companies in the marketplace using the term "AURORA" in relation to class 9 goods and class 42 services.
10. The opponent's evidence in reply came in the form of the witness statement of Kieron Peter Mark Taylor dated 29 January 2024. Mr Taylor is the Director of the opponent's representative. Mr Taylor's evidence is accompanied by one exhibit, being KPMT01. The evidence was adduced in response to the claims of the applicant.
11. I do not intend to summarise the evidence filed by the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **My approach**

12. The opponent has relied upon five earlier marks in respect of both oppositions. In its submissions in lieu, the opponent identifies its first and second earlier marks as its strongest case. I am of the view that the goods and services within the specification of the first earlier mark represents the opponent's strongest case. In the event that I find a likelihood of confusion in respect of the first earlier mark, any finding of confusion in respect of the remaining marks does not further the opponent's case. On the contrary, if I find no likelihood of confusion for the first earlier mark, it follows that the same finding will apply to the remaining marks. I will, therefore, focus my assessment on the opponent's first earlier mark only for both oppositions. If required, I will address this point further when considering any final remarks at the conclusion of this decision. For the avoidance of doubt, I shall refer to the opponent's first earlier mark as "the earlier mark" throughout the remainder of this decision.

## **DECISION**

### **Opposition 438783- The word mark**

#### **Section 5(1)**

13. Section 5(1) of the Act reads as follows:

"(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

#### **Identity of the marks**

14. In order for claims under Section 5(1) of the Act to succeed, the competing trade marks are required to be identical. The question of when a mark may be considered identical to another was addressed in *S.A. Société LTJ Diffusion v.*

*Sadas Vertbaudet SA*, Case C-291/00, where the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

15. The applicant’s word mark and the earlier mark each comprise the same word “AURORA”, presented in capital letters. The respective marks are self-evidently identical. The opposition against the word mark can therefore proceed in respect of the Section 5(1).

### **Comparison of goods and services**

16. In order for the opponent to succeed under Section 5(1) of the Act, the goods and services covered by the earlier mark and the applicant’s word mark must be considered identical. I am therefore only concerned with whether the goods and services are identical at this stage. If any of the goods and/or services prove not to be identical at this stage, I will consider the similarity of those goods and/or services later in relation to the opponent’s Section 5(2)(a) ground.

17. Where services are worded identically in both specifications, it is clear they should be considered identical. Additionally, where the wording of a term differs to the wording of another term, but both terms share an identical meaning, again those services are self-evidently identical and should be considered as such. Finally, the General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (though it equally applied to services) are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. The applicant’s goods and services are outlined in paragraph 1 of this decision. The opponent’s goods and services for its earlier mark are contained within Annex A of this decision.

19. The applicant’s term *Downloadable software for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned goods relating to autonomous vehicles* falls within the opponent’s broader term *computer programs being downloadable software*. These terms are therefore identical in line with *Meric*.

20. For reasons I will come to explain, I do not consider the applicant’s services in class 42 to be identical to any of the opponent’s relied upon goods or services. As mentioned, in order to succeed under section 5(1), the contested goods and services must be identical to the goods and services relied upon under the earlier mark.

**21. Opposition 438783 against the applicant’s word mark therefore succeeds under section 5(1) in respect of the following:**

Class 9: Downloadable software for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned goods relating to autonomous vehicles.

22. For the services that I did not find identical, the section 5(1) ground fails. That being said, they remain relevant for the section 5(2)(a) ground, and I will proceed to assess their level of similarity under that ground below.

## Section 5(2)(a)

23. Section 5(2)(a) of the Act is 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, [...] there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

24. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of the trade marks**

25. I have found the respective trade marks to be identical as outlined in paragraph 15 of this decision.

## **Comparison of goods and services**

26. The applicant's goods are set out in paragraph 1 of this decision. The opponent's goods and services are set out in Annex 1.

27. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

28. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

29. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

30. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(4) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

31. Within its counterstatement and submissions, the applicant has submitted that the parties operate in entirely different sectors (the applicant's being blockchain and fintech and the opponent's being lighting device solutions), which dispels any possibility of confusion. For reasons which I will now explain, the applicant's points about the actual goods and services offered by the parties or the sectors they operate in will, as a matter of law, have no bearing on the outcome of this opposition.

32. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar services if there is a likelihood of confusion. Once a trade mark has been registered for five years, s.6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods and services for which they are registered.

33. As outlined above, the earlier mark had not been registered for five years at the date on which the word and figurative marks were filed. Consequently, the opponent is not required to prove use for any of the goods or services for which its mark is registered. The earlier mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use for all the goods and services listed in the register. The concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

“22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

34. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated (at paragraph 66 of its judgment) that, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though the applicant has suggested the ways in which its marks and the earlier marks are used, my assessment in this decision must take into account only the applied for marks – and their specifications – and any potential conflict with the earlier mark. Any differences between the actual goods or services provided by the parties, or differences in their target sectors, are not relevant unless those differences are apparent from the applied for and registered marks.

Software as a Service for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned services relating to autonomous vehicles.

35. The opponent’s services include *Software as a service (SAAS) services featuring computer software for use with environmental monitoring, control, and automation*

*systems*. Within its submissions the opponent claims that the term “featuring” is an exemplar rather than a limitation and as such, the term should be regarded as software as a service at large and therefore identical to the applicant’s services. I disagree with these submissions. Considering the points made in *Youview* and *Skykick*, this would be too broad of an interpretation. To my mind, the use of the word ‘featuring’ in the opponent’s specification means that *computer software for use with environmental monitoring, control, and automation systems* should be regarded as an important attribute to the *software as a service*. This is consistent with the definitions of the word ‘feature’ provided in Collins English Dictionary which states, “When something such as a film or exhibition features a particular person or thing, they are an important part of it.”<sup>2</sup> And the Cambridge International Dictionary of English which uses the definition “to include someone or something as an important part.”<sup>3</sup> I note that the opponent has also claimed that its goods in class 9 are similar to the applicant’s class 42 services. With this in mind, I will make my comparison based on the opponent’s term *Computer programs being downloadable software*.

36. The applicant’s services above and the opponent’s *Computer programs being downloadable software* clearly differ in nature and method of use. This is because the competing goods and services both involve software however, the opponent provides goods whereas the applicant provides services. As for the method of use, the applicant’s software will be accessed by consumers online via a portal or cloud, but the opponent’s software will be purchased and downloaded to a device. The opponent’s software could be used to provide an interface between applications and a decentralized computer environment so there is potentially an overlap in purpose. Given the overlap in purpose, there may be a degree of competition. There may also be an overlap in trade channels as the same businesses that offer physical software may also offer online/non-downloadable versions of the same goods. I do not find that the competing goods and services enjoy a complementary relationship. On balance, I consider the goods and services to be similar to a medium degree.

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<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/feature>

<sup>3</sup> <https://dictionary.cambridge.org/dictionary/english/feature?q=featuring>

Computer services for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned services relating to autonomous vehicles.

37. The above term may include software as a service meaning that my comparison above would also apply, in which case the respective goods and services are similar to a medium degree.

38. If I am wrong on that point, I find these goods and services to be similar to a low to medium degree. In circumstances where the opponent's software could be used to provide an interface between applications and a decentralized computer environment, I find there would be an overlap in end users. I also find that there may be an overlap in trade channels. The goods and services would also be complementary on the basis that they are important to one another, and the consumer will believe them to be the responsibility of the same undertaking. There is, however, a difference in nature and method of use and I do not consider there to be any competitive relationship.

Downloadable software for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned goods relating to autonomous vehicles.

39. I first remind myself that I have found these goods to be identical to the opponent's earlier goods under section 5(1), so they are to be refused under that ground. If I am wrong on that point and for the sake of completeness, I shall consider the above terms under section 5(2)(a).

40. The above terms overlap in terms of nature and purpose compared to the opponent's *Computer programs being downloadable software*. I also consider

there to be an overlap in method of use, users and trade channels. I consider these goods to be highly similar.

### **The average consumer and the purchasing act**

41. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

42. The average consumer for the parties goods and services will consist of two separate groups, being members of the general public at large and professional users purchasing on behalf of a business undertaking. The cost of the goods and services will vary.

43. Both consumer groups will likely consider various factors during the purchasing process such as compatibility with existing systems, functionality and customer support. Where the consumer of the goods and services comprises the general public, I consider that a medium degree of attention will be paid during the purchasing process. Where the goods and services are purchased by professional consumers, the level of attention paid is likely to be slightly higher at an above medium level. This is on the basis that the selection of the goods or services is likely to be important to the running/success of their business.

44. For those goods and services selected by members of the public, I find that they will be available via physical retail stores or their online equivalents. For business users, the goods and services will be selected at specialist retailers, be that physical stores or online. For both consumer groups, the purchase/selection process will involve primarily visual considerations. However, I do not discount the aural element playing a role in the form of advice from sales representatives or word of mouth recommendations. I further acknowledge that the aural element may also be particularly heightened for business users who may speak to sales representatives more frequently.

### **Distinctive character of the earlier mark**

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

46. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Although the opponent has pleaded that its mark has obtained an enhanced level of distinctiveness, it has not filed any evidence to that effect. Therefore, I have only the inherent position to consider.

47. A point relied upon by the applicant is that the earlier mark has a reduced level of distinctiveness due to the presence of other companies in the marketplace that include the mark ‘Aurora’. In support of this, the applicant has provided printouts of various websites displaying companies that include the mark ‘Aurora’ for their goods and services.

48. In *Lifestyle Equities CV & Ors v Royal County of Berkshire Polo Club Ltd & Ors* [2024] EWCA Civ 814, the judge at first instance had held that, if the existence of a number of other polo-themed clothing brands featuring horse-and-rider logos in the relevant markets was established on the facts, a trade mark may have a lesser degree of distinctive character than would otherwise have been the case. In the Court of Appeal, Arnold LJ considered whether the judge’s approach was correct. He referred to, among other cases, *Enterprise Holdings Inc v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), pointing out that it was implicit in his reasoning in that case that the trade mark in issue would have had a lesser degree of distinctive character if lower case ‘e’ logos had been common in the relevant sector. He added:

“42. Counsel for the Claimants nevertheless submitted that the existence of a ‘crowded market’ was legally irrelevant to the assessment of the trade mark’s distinctive character. He relied in support of this submission on Case C-145/05 *Levi Strauss & Co v Casucci SpA* [2006] ECR I-3703.

In that case the CJEU ruled that Article 5(1) of Directive 89/104 must be interpreted as meaning that, in order to determine the scope of protection of a trade mark which has been lawfully acquired on the basis of its distinctive character, the national court must take into account the perception of the public concerned at the time when the sign, the use of which infringes that trade mark, began to be used.

[...]

48. Counsel for the Claimants argued that, just as use by the defendant of its sign could not be relied upon to diminish the distinctive character of the trade mark, so by parity of reasoning neither could use by other third parties of other signs.

49. I do not accept this argument. The CJEU's reasoning is clear and makes perfect sense: the question whether the defendant's use of its sign infringes must normally be judged as at the date when that use commences, because otherwise there would be a risk of the defendant being permitted to take advantage of its own wrong. As the CJEU has recognised elsewhere, that principle is not without exception. [...] But in any event, the issue here is not the impact of the defendant's use of its sign on the distinctive character of the trade mark, but the impact of third party use of other signs. There is no good reason to discount this. On the contrary, experience shows that third party use of similar signs does tend to diminish the distinctiveness of a trade mark. In a crowded market it is harder for one mark to stand out.”

49. Consequently, evidence which establishes that a number of traders in the same market use the same or similar signs may result in the distinctive character of a trade mark being assessed as weaker than would otherwise have been the case.

50. I have given consideration to the applicant's evidence and the case law above however, the evidence is undated, so I am unable to ascertain if the examples

provided show other companies using the mark 'Aurora' in the UK at the relevant date. Further, much of the evidence shows companies using the mark 'Aurora' for goods and services unrelated to the opponent's and applicant's goods and services. As a result, even if the evidence was from prior to the relevant date, I do not consider that this evidence supports the applicant's assertions. Therefore, I will assess the earlier mark's distinctiveness in the usual way.

51. A further point submitted by the applicant in its counterstatements is the claim that 'Aurora' represents a rather popular female name and has therefore lost its distinctiveness. I accept that the term 'Aurora' can be used to denote a female name however, there is nothing to suggest that this would result in the earlier mark losing its distinctiveness. Further, the applicant has not substantiated this claim with any evidence to demonstrate the popularity of the name 'Aurora' in the UK. In the absence of any evidence regarding this claim, I reject this line of argument from the applicant.

52. I find that consumers will perceive the earlier mark either as a female forename or as an atmospheric phenomenon consisting of bands, curtains, or streamers of light, usually green, red, or yellow, that move across the sky in polar regions.<sup>4</sup> Neither meaning is descriptive or allusive of the goods and services at issue. Bearing that in mind, I consider the earlier mark has a medium degree of inherent distinctive character.

### **Likelihood of confusion**

53. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must

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<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/aurora>

instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

54. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

55. I have found the respective marks to be identical. I have found the respective goods and services to be similar in varying degrees from low-medium to high. I have found the average consumer will comprise of both members of the general public and professional users purchasing on behalf of a business. For both user groups, visual considerations will dominate during the purchasing process however, I do not discount an aural component. The general public will pay a medium degree of attention during the purchasing process whereas professional users will pay an above medium degree of attention. Lastly, I have found the earlier mark enjoys a medium degree of inherent distinctive character.

56. Taking all of the above factors into account, particularly given the identity of the respective marks, I find that the average consumer would likely mistake the parties' marks for one another, even for goods/services that are similar to a low to medium degree due to the interdependency principle. I consider that this will also be the case in circumstances where the consumer pays a higher than medium degree of attention. I therefore consider there to be a likelihood of direct confusion.

57. The opposition against the word mark succeeds in its entirety.

58. I will now go on to consider the second opposition under Section 5(2)(b).

### **Opposition 438782- The figurative mark**

#### **Section 5(2)(b): legislation and case law**

59. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) [...]

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

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

60. For the purposes of this opposition, I rely upon the established case law and principles as set out in paragraph 24 of this decision.

### **Comparison of goods and services**

Downloadable software for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned goods relating to autonomous vehicles.

61. For the same reasoning as outlined in in paragraph 19 of this decision, I find the above goods to be identical to the opponent’s term *computer programs being downloadable software*. If I am wrong in my findings, I find the goods to be similar to a high degree for the same reasons as set out in paragraph 40 of this decision.

Software as a Service for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned services relating to autonomous vehicles.

62. As previously outlined in paragraph 36 of this decision, I find that these services hold a medium degree of similarity to the opponent's *computer programs being downloadable software*.

Computer services for providing and interface between applications and a decentralized computing environment; none of the aforesaid goods/services being relational database management systems and none of the aforementioned services relating to autonomous vehicles.

63. As previously discussed in paragraphs 37 and 38 of this decision, I find these services to be similar to the opponent's *computer programs being downloadable software* to either a medium degree or a low to medium degree.

### **Comparison of the marks**

64. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.


65. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

66. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

67. The respective trade marks are shown below:

The earlier mark	The applicant's figurative mark
<p><b>AURORA</b></p>	

68. The earlier mark is a word only mark that consists of the word 'AURORA'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. The applicant's mark contains both figurative and word elements. This consists of a stylised word element presented in white on a black background intended to read as "AURORA". I note that several sections of the letters are omitted namely, the horizontal lines of the letters "A" and part of the vertical element of the letters "R". The average consumer will naturally fill in these missing components to read the complete word "AURORA". To the left of the wording is a figurative green triangular device with rounded edges. The wording and figurative elements are displayed on a black background. Due in part to its size, in addition to it being the verbal element of the mark, I find that the overall impression is dominated by the word element "AURORA". The figurative element is decorative and plays a secondary role in the overall impression, this is also the case for the stylisation which will play a secondary role. The black background will play an even lesser role.

69. Visually, both marks overlap through their use of the wording "AURORA". A point of difference is created by the stylisation of the applicant's mark and the use of a figurative element; this has no counterpart in the earlier mark. Balancing the points of similarity and difference, together with my assessment of the overall impression of the marks, my view is that there is between a medium and high level of visual similarity between the marks.

70. The earlier mark is a dictionary defined word and will be pronounced in the usual way. The applicant's mark will also be pronounced this way and the figurative elements will not be articulated. As such, the marks are aurally identical.

71. As previously discussed, the earlier mark will be perceived by consumers either as a female forename or as atmospheric phenomenon consisting of bands, curtains, or streamers of light, usually green, red, or yellow, that move across the sky in polar regions. I also find this to be the case for the applicant's mark. The figurative element in the applicant's mark is merely decorative and will not convey any meaning to consumers. Consequently, the marks are conceptually identical.

### **Average consumer and the purchasing act**

72. My findings regarding the average consumer and the level of attention paid during the purchasing/selection process are outlined in paragraphs 41-44 of this decision.

### **Distinctive character of the earlier mark**

73. My findings in relation to the level of distinctive character of the earlier mark are outlined in paragraphs 45-52 of this decision.

### **Likelihood of confusion**

74. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between

the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he or she has retained in their mind.

75. I have found the goods and services to range from being identical to a low to medium degree of similarity. I have found the average consumer will comprise of both members of the general public and professional users purchasing on behalf of a business. For both user groups, visual considerations will dominate during the purchasing process however, I do not discount an aural component. The general public will pay a medium degree of attention during the purchasing process whereas professional users will pay an above medium degree of attention. I have found the marks to be visually similar to a medium to high degree, aurally and conceptually identical. I found that the earlier mark has a medium degree of inherent distinctiveness and that distinctiveness has not been enhanced through use.

76. I first note that the respective marks share a dominant and distinctive element ("AURORA") with the only difference being the stylisation of the wording in the applicant's mark. During the purchasing process, visual elements are likely to dominate though I acknowledge that aural considerations also apply, and the marks are aurally identical. There is a figurative element in the applicant's mark which does have any counterpart in the earlier mark however, I did not find this element to play a dominant role in the overall impression. Taking this into consideration along with all of the relevant factors, notwithstanding the average consumers medium level of attentiveness, the marks may be misremembered by way of imperfect recollection, and it is my view that the figurative element and the stylisation in the applicant's mark may be forgotten or go unnoticed. I therefore find that it is likely that the consumer may mistake one mark for the

other and as such I find there is a likelihood of direct confusion. For the avoidance of doubt, this finding also applies regardless the level of attention paid and for lowly similar goods/services.

77. For the same of completeness, I will proceed to consider a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand

extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

78. If consumers notice the differences between the marks, it is my view that they will recognise that the most dominant and distinctive "AURORA" element is of the applicant's mark is completely reproduced within the earlier mark. Even if average consumer recognises the differences in the stylisation of the marks, in those instances, it is my view that the differences between the word only mark and figurative mark would likely be attributed to a brand revamp rather than denoting goods from different undertakings. I consider that it is not uncommon for undertakings to undergo a brand 're-fresh' or 'brand-revamp' from time to time to accommodate changes in marketing considerations. Due to the aural and conceptual identity, I find that if the average consumer notices these stylistic differences they will not, in this case, be put down to coincidence, but they will therefore regard the applicant's mark as an alternative stylisation of the earlier mark. Consequently, I find there is a likelihood of indirect confusion. For the avoidance of doubt, this finding also applies regardless the level of attention paid and for lowly similar goods/services.

## **CONCLUSION**

79. The oppositions under sections 5(1), 5(2)(a) and 5(2)(b) have succeeded. Subject to any appeal, the applications will be refused for all applied goods and services.

80. Given that I have found a likelihood of confusion for both applications based on the opponent's first earlier mark, I do not consider it necessary to consider the remaining marks on the basis that doing so will not improve the opponent's position.

## **COSTS**

81. In these consolidated proceedings, the opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. I note that during the proceedings, the opponent initially requested off-scale costs however, these were not pursued in the final submissions. In any case, I do not find that there is anything to support that the applicant was unreasonable in defending its claim. Accordingly, I find it appropriate to make an award within the usual scale, using the TPN as a guide. I therefore award costs to the opponent on the following basis:

Official fee x 2:	£200
Preparing statements and considering the other side's statements x 2:	£800
Considering the applicant's evidence and filing evidence in reply:	£800
Filing submissions in lieu of a hearing:	£300
<b>Total:</b>	<b>£2100</b>

82. I therefore order Aurora Labs Ltd to pay the sum of £2100 to Aurora Lighting UK Limited. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 29<sup>th</sup> day of November 2024**

**Catrin Williams**  
**For the Registrar**

## **Annex A**

### Goods and services relied upon by the first and third earlier marks:

#### Class 9

Computer programs being downloadable software; computer software applications being downloadable; Sensory software; Process controlling software; Software to control and improve audio equipment sound quality; Software to control building environmental, access and security systems; Communication software; Data communications software; Computer hardware and software systems for remotely controlling lighting devices within a building; Computer hardware and software systems for sensing the ambient environment in a building namely the temperature, humidity, level of illumination, movement within the building and controlling the heating, air conditioning and lighting in response to data; computer hardware and software for sensing the ambient environment in a building namely the temperature, humidity, level of illumination, movement within the building and communicating this data wirelessly or using wired connections to central data hubs; downloadable computer software to analysis of data from sensors in a building that measure the temperature, humidity, level of illumination, movement within the building; Computer software and computer hardware for the remote control of electric lighting apparatus; Home and office electrical power automation systems comprising wireless and wired controllers, controlled devices, and software for appliances, lighting, HVAC, security and other home and office electrical power monitoring and control applications; Lighting control software for use in commercial and industrial facilities; Computer software and computer hardware for the storage and analysis of data collected from sensors in buildings of light, heat, movement, temperature, humidity and sensors to detect the potential failure of lighting arrays or parts of lighting arrays including light bulbs or LED light bulbs; computer software for systems monitoring, control, and automation of the environment of home and offices, namely, temperature, lighting, security; electronic devices, namely, interfaces for computers, mobile telephones, tablet computers, notebook computers, and computer software that allow users to remotely interact with environmental monitoring, control, and automation systems. electronic devices, namely, interfaces for computers, mobile telephones, tablet computers, notebook computers and computer software that allow the sharing and transmission of data and information between devices for the purposes of facilitating environmental monitoring, control, and automation.

#### Class 42

Technical data analysis but not of drilling data or data from drilling projects, including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment, data from equipment for locating underground objects as part of

drilling operations; Computer services for the analysis of data but not of drilling data or data from drilling projects including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment, data from equipment for locating underground objects as part of drilling operations; computer technology consultancy but not such consultancy in relation to drilling data or data from drilling projects, including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment data from equipment for locating underground objects as part of drilling operations; computer software consultancy computer software consultancy but not such consultancy in relation to drilling data or data from drilling projects, including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment, data from equipment for locating underground objects as part of drilling operations; installation of computer software but not software for drilling rigs, underground drilling projects pipelines, guiding drilling equipment, drilling equipment, equipment for locating underground objects as part of drilling operations; maintenance of computer software but not software for drilling rigs, underground drilling projects pipelines, guiding drilling equipment, drilling equipment, equipment for locating underground objects as part of drilling operations; Computer services, namely, providing an internet site featuring technology for use in environmental monitoring, control, and automation systems; computer services, namely, providing an internet site featuring technology that allows users to remotely interact with environmental monitoring, control, and automation systems; platform as a service (PAAS) featuring computer software platforms for use with environmental monitoring, control, and automation systems.

## Annex B

### Goods and services relied upon by the second and fourth earlier marks:

#### Class 9

Sensory software but not such software for drilling rigs, drilling equipment, underground drilling projects; Process controlling software but not such software for drilling rigs, drilling equipment, underground drilling projects; Software to control building environmental, access and security systems; Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, and mechanical devices or systems; Communication software but not such software for drilling rigs, drilling equipment, underground drilling projects; data communications software but not such software for drilling rigs, drilling equipment, underground drilling projects; Data communications apparatus; computer programs being downloadable software but not such software for drilling rigs, drilling equipment, underground drilling projects; computer software applications being downloadable but not such software for drilling rigs, drilling equipment, underground drilling projects; Computer hardware and software systems for remotely controlling lighting devices within a building; Computer hardware and software systems for sensing the ambient environment in a building namely the temperature, humidity, level of illumination, movement within the building and controlling the heating, air conditioning and lighting in response to data; computer hardware and software for sensing the ambient environment in a building namely the temperature, humidity, level of illumination, movement within the building and communicating this data wirelessly or using wired connections to central data hubs; downloadable computer software to analysis of data from sensors in a building that measure the temperature, humidity, level of illumination, movement within the building; Computer software and computer hardware for the remote control of electric lighting apparatus; Home and office electrical power automation systems comprising wireless and wired controllers, controlled devices, and software for appliances, lighting, HVAC, security and other home and office electrical power monitoring and control applications; Lighting control software for use in commercial and industrial facilities; Computer software and computer hardware for the storage and analysis of data collected from sensors in buildings of light, heat, movement, temperature, humidity and sensors to detect the potential failure of lighting arrays or parts of lighting arrays including light bulbs or LED light bulbs; computer software for systems monitoring, control, and automation of the environment of home and offices, namely, temperature, lighting, security; electronic devices, namely, interfaces for computers, mobile telephones, tablet computers, notebook computers, and computer software that allow users to remotely interact with environmental monitoring, control, and automation systems; electronic devices, namely, interfaces for computers, mobile telephones, tablet computers, notebook computers and computer software that allow the sharing and transmission of data and information between devices for the purposes of facilitating environmental monitoring, control, and automation; computer software for use in environmental monitoring, control, and

automation systems; electronic devices and computer software that allow users to remotely interact with environmental monitoring, control, and automation systems; electronic devices and computer software that allow the sharing and transmission of data and information between devices for the purposes of facilitating environmental monitoring, control, and automation. all of the aforementioned goods with the exclusion of including magnetically encoded debit cards.

## Class 42

Technical data analysis but not of drilling data or data from drilling projects, including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment, data from equipment for locating underground objects as part of drilling operations; Computer services for the analysis of data but not of drilling data or data from drilling projects including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment, data from equipment for locating underground objects as part of drilling operations; computer technology consultancy but not such consultancy in relation to drilling data or data from drilling projects, including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment data from equipment for locating underground objects as part of drilling operations; computer software consultancy computer software consultancy but not such consultancy in relation to drilling data or data from drilling projects, including underground drilling projects, pipelines, data from guiding drilling equipment data from drilling equipment, data from equipment for locating underground objects as part of drilling operations; installation of computer software but not software for drilling rigs, underground drilling projects pipelines, guiding drilling equipment, drilling equipment, equipment for locating underground objects as part of drilling operations; maintenance of computer software but not software for drilling rigs, underground drilling projects pipelines, guiding drilling equipment, drilling equipment, equipment for locating underground objects as part of drilling operations; Computer services, namely, providing an internet site featuring technology for use in environmental monitoring, control, and automation systems; computer services, namely, providing an internet site featuring technology that allows users to remotely interact with environmental monitoring, control, and automation systems; platform as a service (PAAS) featuring computer software platforms for use with environmental monitoring, control, and automation systems; software as a service (SAAS) services featuring computer software for use with environmental monitoring, control, and automation systems.

## **Annex C**

Goods and services relied upon by the fifth earlier mark:

### **Class 9**

Distributed Ledger Technology software; Business to Business transaction and verification software; smart contract software; solar power trading software.

### **Class 42**

Computer services facilitating Business to Business transaction management and verification; Blockchain as a service.