

O-121-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 3029714
IN THE NAME OF LONG LIFE LAMP COMPANY LTD
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASS 11:**

LONG LIFE LAMP COMPANY

AND

**AN APPLICATION FOR INVALIDITY (NO. 500480) BY
OPUS LONG LIFE LAMP COMPANY LTD**

Background and pleadings

1. The trade mark **LONG LIFE LAMP COMPANY** was filed by Long Life Lamp Company Ltd (the proprietor) on 7 November 2013. The application was not opposed, so it was subsequently registered on 23 May 2014. It is registered for the following goods in class 11:

Apparatus for lighting; commercial lighting apparatus; light bulbs; energy saving light bulbs; light-emitting diodes [LED] lighting apparatus; LED light bulbs; LED light fittings; LED light machines; compact fluorescent lights and lamps; halogen lamps; halogen light bulbs; fluorescent lamps; fluorescent lights; electric discharge lamps; luminous discharge lamps; light discharge tubes; lamp holders; parts and fittings for all the aforesaid goods.

2. Opus Long Life Lamp Company Ltd (the applicant) claims that the registration is invalid under sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (the Act). It claims that the mark lacks distinctiveness, is a descriptor, and/or constitutes generic words, respectively.

3. The proprietor filed a counterstatement denying the claims. In the alternative, it claims that its mark has acquired a distinctive character through use. Both sides have been professionally represented throughout the proceedings, the applicant by Dehns, the proprietor by Trade Mark Direct Ltd. Both sides filed evidence. A hearing took place before me on 16 December 2015 at which the proprietor was represented by Ms Katherine McCormick of Trade Mark Direct, and the applicant by Mr Michael Edenborough QC, of counsel, instructed by Dehns.

The evidence

4. I will detail the evidence when it is necessary and relevant to the matters that need to be determined. For the record, though, those who have given evidence, and what, in brief, they have given evidence about, are:

For the applicant

- i) Ms Elaine Deyes, a trade mark attorney at Dehns. She gives evidence about the meanings of the words LONG LIFE and LAMP. Her exhibits are suffixed EPD.
- ii) Mr Graham White, general manager of The Light Bulb Company, a person from the relevant trade. He gives evidence about the terms LONG LIFE and LAMP, the descriptive use of these terms, and he gives his view on the capacity of the subject mark to denote one company. His exhibits are suffixed GW.
- iii) Mr Paul Kirwan, national sales manager of Philips Electronics UK Limited, another person from the relevant field. He also gives evidence about the use of the terms LONG LIFE and LAMP and the descriptive use of these terms. His exhibits are suffixed PK.

- iv) Mr Elliot Jenkins, Key Accounts Manager at GE Lighting Limited, a person from the relevant trade. He gives similar evidence to Mr White and Mr Kirwan. His exhibits are suffixed EJ.
- v) Mr Stephen Stark, a sales director at OSRAM Ltd. He gives similar evidence to the previous three witnesses. His exhibits are suffixed SS.
- vi) Mr Spencer Vold-Burgess, Managing Director of Eccora Limited, a firm of investigators. He investigated the use of the terms LONG LIFE/LONG LIFE LAMPS in the relevant field, and provides information as to his findings. His exhibits are suffixed SVB.

For the proprietor

- vii) Mr Bilwinder Mann, a director of the proprietor. There is not a great deal of commentary in his witness statement, he merely provides a number of exhibits, mainly dealing with the proprietor's use, but also of Google searches for various terms including LONG LIFE LAMP and LIGHT BULB. His exhibits are suffixed BM.

For the applicant, in reply

- viii) Further evidence from Ms Deyes which includes evidence relating to the word LAMP and evidence relating to the use of grammar to assist in understanding how the mark will be perceived.
- ix) Further evidence from Mr White in which he confirms his relationship with the applicant company. In summary, the company he works for is an exclusive distributor of the applicant. He gives further evidence about the words LONG LIFE.
- x) Mr Peter Hunt, Chief Operating Officer of the Lighting Industry Association He gives evidence about the terms LONG LIFE and LAMP and his view on how he sees the subject mark as a whole.

My approach

5. I will begin my assessment by considering whether, *prima facie*, any of the pleaded grounds under section 3(1) are made out. If at least one of them is, I will then go on to consider whether the mark has acquired a distinctive character through use.

6. I will begin my assessment with section 3(1)(b). This is for two reasons. First, I have reservations as to the appropriateness of the claims under sections 3(1)(c) and (d). In relation to the former, even if the applicant is correct as to the likely perception of the words of which the subject mark is composed, it is questionable whether the mark is describing a characteristic of the actual goods, or, instead, is describing a characteristic of the company providing the goods. In relation to the latter, it is clear from the evidence (which I will set out later) that the mark as a whole has not been generically used which, in my view, limits the applicableness of the ground. Second, although all the grounds of opposition have independent scope, all roads nevertheless

lead to section 3(1)(b). To illustrate the point, I note the decision of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Flying Scotsman*, where he stated:

“19. Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registrability of a sign under Section 3(1)(b), see Case C-104/00 P Deutsche Krankenversicherung AG v. OHIM (COMPANYLINE)[2002] ECR I-7561 at paragraph [20], it is not necessary to dwell on the question of how far Section 3(1)(b) may go in preventing registration beyond the scope of Section 3(1)(c). It is sufficient to observe that a sign may be:

(1) distinctive for the purposes of Section 3(1)(b), with the result that it cannot be regarded as descriptive for the purposes of Section 3(1)(c) and must be unobjectionable on both bases; or

(2) neither distinctive for the purposes of Section 3(1)(b), nor descriptive for the purposes of Section 3(1)(c), with the result that it must be objectionable on the former but not the latter basis; or

(3) descriptive for the purposes of Section 3(1)(c), with the result that it cannot be regarded as distinctive for the purposes of Section 3(1)(b) and must be objectionable on both bases.

These considerations point to the overall importance of establishing that a sign is free of objection under Section 3(1)(b).”

Section 3(1)(b) of the Act

7. Claims under section 3(1)(b) are relevant in invalidation proceedings in view of the provisions of section 47(1) of the Act:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

8. Section 3(1)(b) prevents registration of trade marks which are “...devoid of any distinctive character”. It is equivalent to article 7(1)(b) of the CTM Regulation, the principles of which were conveniently summarised by the Court of Justice of the European Union (CJEU) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

9. Whilst it is necessary to keep in mind that the test under section 3(1)(b) is to be based upon the mark as a whole, it is nevertheless important to consider what the composition of the mark is, and, also, what perception will be taken from the words of which it is composed.

10. Much of the discussion at the hearing focused on the meanings of certain words, or combinations of words. The primary discussion was about how the words LONG LIFE and LAMP will be perceived. There was little dispute as to how the word COMPANY would be perceived.

The meaning of LONG LIFE

11. Mr Edenborough submitted that the meaning of the words LONG LIFE was clear, unambiguous and entirely descriptive. Ms McCormick submitted that the words were vague and lacked a precise meaning/definition in relation to the goods at issue.

12. Even without examining the evidence, my inclination would have been to agree with Mr Edenborough. Put simply, the words LONG LIFE, viewed on the basis of their normal and understandable meanings, would indicate to the relevant public a product that has a longer life or lifespan than a standard version. In any event, the evidence

supports Mr Edenborough's submission. I will not touch on everything in the evidence, but highlight, for example, some pertinent exhibits:

- i) Exhibit EPD3 showing the words "long life" being used descriptively in respect of a variety of different products.
- ii) Exhibit EPD4 showing examples of the proprietor using the words LONG LIFE descriptively eg "...extended reliability for long life."
- iii) Exhibit EPD5, GW2 & GW3 showing examples of other manufacturers in the lighting field using LONG LIFE descriptively.

13. The above exhibits just skim the surface. The evidence in totality is compelling. Indeed, I struggle to see how it is capable of being argued against. One submission was the lack of any pre-defined meaning or standard ie how long the product has to last for for it to be classed as long-life. Whilst there is a table in the evidence showing what could be a pre-defined standard to qualify as long-life for the relevant goods, it is not clear whether this is an industry standard. However, even without a pre-defined industry standard, this does not matter. What matters is the perception of the relevant public. The perception they will take from the words LONG LIFE in relation to the relevant goods is exactly as I have described. The words are entirely descriptive. Indeed, it is a particularly useful description to be able to make in this field as longevity of product is clearly a desirable characteristic, something which is also borne out in the evidence.

The meaning of LAMP

14. The proprietor's main argument here was that members of the relevant public would perceive the word LAMP as a reference to a self-contained lighting unit, in the sense of a table lamp. The goods for which the mark is registered are, in the main, what Ms McCormick described as light bulbs and that this term is so well-known that the relevant public will not see the word LAMP as indicating a light bulb. This is a somewhat difficult submission to accept given that the proprietor, as Mr Edenborough pointed out, has elected to use terms in its specification such as: halogen lamps, florescent lamps, electric discharge lamps, lamp holders. Furthermore, and as I will come on to, there are numerous examples in the evidence of Mr Mann (for the proprietor) using the term LAMP in a wholly descriptive manner on its product packaging. This includes use on items which may traditionally be seen as light bulbs. The applicant has also provided significant evidence from members of the trade about the term LAMP which suggests that the lighting emitting part of any device is the lamp. For example, Mr Hunt (of the Lighting Industry Association) states:

"The term "lamp" is used throughout the lighting industry to refer to a light-emitting device that has a recognised cap or interface with a luminaire (light fitting)"

15. However, I note that he goes on to say that

"Although a consumer might refer to such an item as a "light bulb", this is not the correct term, and its use is extremely rare within the industry itself"

Some of the other witnesses, Mr Kirwan and Mr Jenkins, for example, also make the point that sometimes lamps are incorrectly referred to as light bulbs by consumers.

16. I have little hesitation in finding that members of the trade will clearly know what a lamp is (in the sense described by Mr Hunt). Members of the trade will include not just manufacturers, but also wholesalers and other intermediaries in the lighting sector. The impact of the mark on such people should not, in my view, be removed from the analysis as to whether the mark is devoid of distinctive character. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice held (my emphasis):

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say **in trade and or amongst average consumers of the said goods or services**, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

17. In any event, whilst end-consumers might refer to lamps as light bulbs, it does not necessarily follow that they will not also know of the meaning of the word lamp, even if they do not use the term themselves. As I have said, the proprietor uses the word descriptively on some of its product packaging. For example, packaging in BM3 includes the text:

Energy saving 25w bulb described as a replacement for a halogen lamp.

Switch power off before changing the lamp

Equivalent to 40 watt incandescent lamp

Halogen lamp with aluminium reflector

G4 Halogen Lamp

LED lamp

Metal halide lamp

Globe lamp G95

18. Mr Edenborough also highlighted the proprietor's own website which states “Long Life Lamp Company a major manufacturer in LEDs, CFL low energy lamps and halogen lamps”. It is highly unlikely that the proprietor will be the only company using such terminology. Therefore, whilst many of the goods may traditionally be referred to as light bulbs, I come to the view that the end consumer will know that a lamp is not just a complete lighting unit such as a table lamp, but they will also know that it is a

term which signifies the lighting device. Thus, when both the trade and the end-consumer is taken into account, the evidence establishes that the word LAMP per se a descriptive and understandable word as claimed, in relation to the subject goods.

The mark as a whole – perception and distinctiveness

19. The mark as a whole consists of the words LONG LIFE LAMP COMPANY. The goods sought to be registered are:

Apparatus for lighting; commercial lighting apparatus; light bulbs; energy saving light bulbs; light-emitting diodes [LED] lighting apparatus; LED light bulbs; LED light fittings; LED light machines; compact fluorescent lights and lamps; halogen lamps; halogen light bulbs; fluorescent lamps; fluorescent lights; electric discharge lamps; luminous discharge lamps; light discharge tubes; lamp holders; parts and fittings for all the aforesaid goods.

20. With one of two exceptions (which I will come on to) all of the goods either consist of, or will contain, a lamp. When taken in this context, and bearing in mind my previous findings, it is abundantly clear that the words LONG LIFE LAMP will indicate to the relevant public that the lamps in question are long life lamps. If the mark had been just for those words, I would have no hesitation in finding that those words lack any inherent distinctive character. However, the mark as a whole must be considered. There was a discussion at the hearing as to what impact the addition of the word COMPANY has on the mark. Ms McCormick drew an analogy with the IPO's published Manual of Trade Mark Practice. She provided an extract in her skeleton argument as follows:

“There may be situations where the addition of company name descriptors can be material....Conversely, the addition of a company name descriptor to words describing characteristics of the goods or services other than the name of the goods/services will sometimes bestow distinctive character. For example, “Soft and Gentle Ltd” would be seen as fanciful and therefore acceptable. Each case must be considered on its own facts”

21. There are two problems with this extract provided. First, the word COMPANY, as Mr Edenborough points out, is not a company name descriptor (such as LTD or PLC) as being discussed in the above extract, but is the word COMPANY per se. Secondly, Ms McCormick only provided a partial extract from the Manual. This is what is actually stated:

“A company name may be accepted for registration provided that it meets with the normal requirements of section 3 of the Act. The addition of 'Ltd' or 'PLC' to descriptive words is unlikely to confer distinctive character by suggesting that the sign is used by a single undertaking. For example 'SOAP LTD' (for soap) would not be acceptable *prima facie*. This is not, however, an inviolable rule. There may be situations where the addition of company name descriptors can be material. For example, 'The Blackheath Locksmiths Co Ltd' is likely to be acceptable for locksmiths' services, whereas 'Blackheath Locksmiths' would not. It is not the addition of 'The' which confers distinctive character. Rather it is the fact that there are likely to be a limited number of blacksmiths in Blackheath

and so the **combination** is thought to convey a single trade source. However, 'The Organic Food Company' would **not** be acceptable for organic foodstuffs as there would be a large number of organic food producers, 'organic food' describing the name of a **category** of goods.

Conversely, the addition of a company name descriptor to words describing characteristics of the goods or services other than the name of the goods/services will sometimes bestow distinctive character. For example, 'Soft and Gentle' would not be acceptable for soap, whereas 'Soft and Gentle Ltd' would be seen as fanciful and therefore acceptable. Each case must be considered on its own facts.

A company name may be accepted for registration provided that it meets with the normal requirements of section 3 of the Act. Unless the company name is **wholly descriptive** there will rarely be a basis of objection under section 3(1) because the addition of 'Limited' or 'Plc' will often provide moderately descriptive words with some capacity to indicate origin. The addition of Limited or Plc will avoid any objection under section 3(1)(c) or (d)."

22. The extract provided by Ms McCormick, therefore, did not include the only example where the word COMPANY was being used on the basis of its inherent meaning as opposed to a company designator. The example (The Organic Food Company) is indicated as a mark which ought to face objection. That being said, the Manual is just a guide and I place no real weight upon it. As the Manual itself concedes, each case must be considered on its own merits.

23. In my view, the mark as a whole, when the context of the goods is borne in mind, will send a very clear message. It is a message that the company providing the goods is one that specialises or has a particular focus on long life lamps. A long life lamp company. In terms of whether the mark is devoid of distinctive character, I consider that it is. The relevant public would see the sign purely as a description of the nature of the company. It is not the type of sign which performs the essential distinguishing function of a trade mark. Therefore, *prima facie*, the mark is objectionable under section 3(1)(b) of the Act.

24. I stated earlier that there were one or two goods in the specification which may not be, or may not contain, a lamp eg lamp holders and parts and fitting for the goods mentioned in the specification. However, such goods are so closely allied to lamps that the ground for refusal still exists. Mr Geoffrey Hobbs QC, sitting as the Appointed Person, made a similar finding in *The Range Cooker Co Plc v The Fourneaux De France Limited*, BL O/240/02. The mark in that case was FOURNEAUX DE FRANCE which translates into 'cookers from France'. The mark was objectionable under section 3(1)(c) as describing cookers (from France) . The issue was whether closely allied goods, which comprised cooker hoods and extractor fans, "should be treated as goods so closely related to cookers as to be an integral part of the commercial context in which the meaning and significance of the words FOURNEAUX DE FRANCE is to be regarded as essentially descriptive." Mr Hobbs concluded that cooker hoods and extractor fans were items of commerce which were closely connected with cookers and that it would be unrealistic to treat FOURNEAUX DE FRANCE as descriptive of

cookers and not of such closely connected goods. Although dealing with descriptiveness, the same applies to (non) distinctiveness.

25. The ground of invalidity under section 3(1)(b) succeeds, *prima facie*, in relation to all of the registered goods. I do not consider it necessary to consider whether the other grounds also apply.

Acquired distinctiveness

26. That the mark is objectionable under section 3(1)(b) is not the end of the matter. This is because, even if it is objectionable on a *prima facie* basis, the mark may have acquired a distinctive character through use. This is provided for in the proviso to section 3 which reads:

“Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

27. Furthermore, the proviso to section 47 is also relevant in invalidation proceedings, which reads:

“Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

28. The impact of the above is that if, at the date of filing, the mark had already acquired a distinctive character through use then the proviso to section 3 is applicable. However, even if this were not the case, and the subject mark has acquired a distinctive character since it was registered, the proviso to section 47 is applicable.

29. At the hearing Mr Edenborough submitted that if the proviso to section 47 was to be relied upon then, strictly speaking, any use made between application and registration should be ignored because the proviso refers to the acquisition of distinctive character since registration. I reject this submission. The reference to since registration is simply a reflection of the point in time at which the proposition is to be tested. There is nothing to say that the use between application and registration cannot be taken into account in assessing whether, since registration, the acquired distinctiveness criteria is met.

30. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a

particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37)."

31. As will be seen later, the subject mark is often used alongside a particular device element, which could be seen as creating a single composite mark. However, I bear in mind that the use of a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark. In *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, the CJEU held that:

"The distinctive character of a mark referred to in Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark."

32. Although dealing with non-conventional trade marks, the following guidance is also helpful in understanding the relevant test. In Case C-215/14, *Société des Produits Nestlé SA v Cadbury Uk Ltd*, the CJEU considered a preliminary reference from the High Court which sought guidance about the legal test for showing that a trade mark had acquired a distinctive character. The CJEU understood the question as follows:

"By its first question the referring court asks, in essence, whether an applicant to register a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95 must prove that the relevant class of persons perceive the goods or services designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular company, or whether it is sufficient for that applicant to prove that a significant proportion of the relevant class of persons recognise that mark and associate it with the applicant's goods."

The CJEU answered the question in these terms:

"In order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of

Article 3(3) of Directive 2008/95, regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company.”

In the High Court, Arnold J. stated that he understood this to mean that:

“...in order to demonstrate that a sign has acquired distinctive character, the applicant or trade mark proprietor must prove that, at the relevant date, a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking *because of* the sign in question (as opposed to any other trade mark which may also be present).”

Additionally,

“...it is legitimate for the competent authority, when assessing whether the applicant has proved that a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking because of the sign in question, to consider whether such persons would rely upon the sign as denoting the origin of the goods if it were used on its own.”

33. The final point I note before coming to the evidence filed is that it may be more difficult to prove distinctiveness of a non-distinctive sign if used with other distinctive marks. In *Audi AG, Volkswagen AG v OHIM*, Case T-318/09, the General Court stated that:

“73. in the advertising material submitted by the applicants and included in the administrative file, the sign TDI always appears with another mark belonging to the applicants, such as the trade marks Audi, VW or Volkswagen. The Court has, however, held on numerous occasions that advertising material on which a sign which is devoid of any distinctive character always appears with other marks which, by contrast, do have such distinctive character does not constitute proof that the public perceives the sign applied for as a mark which indicates the commercial origin of the goods (*Shape of a beer bottle*, cited in paragraph 41 above, paragraph 51, and *Shape of a lighter*, cited in paragraph 27 above, paragraph 77). In any event, by quoting an internet site indicating that the Spanish public perceives the sign TDI as an abbreviation which refers to the type of direct fuel-injection diesel engine, irrespective of the car manufacturer, the Board of Appeal established that, despite all the applicants’ advertising efforts in Spain, the relevant public did not perceive that sign as identifying the commercial origin of the goods in question, but as a descriptive and generic term.”

Each case must, though, be considered on its own merits.

34. The proprietor's evidence comes from Mr Mann. As stated already, he gives little by way of commentary other than explaining the content of his exhibits. The exhibits relating to the proprietor's use are as follows:

Exhibit BM3 contains product packaging for the proprietor's goods. I have touched on some of this already. They are said to date from 2008 to August 2014. The following represents the most common form of presentation, although it is also used in a domain name:

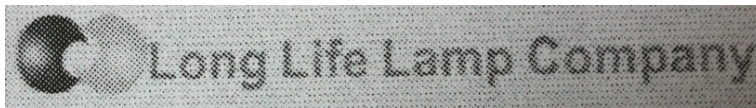


Exhibit BM4 contains Google Analytics information between June 2009 and July 2014. There was a dispute between the representatives as to how some of the data in this report was to be interpreted. Without a better understanding of the meanings of various terms and expressions used in the report it would be wrong, in my view, to side with either party. I consider this evidence to have little weight.

Exhibit BM5 contains invoices from the proprietor to a distributor called Watts Electrical and, also, an invoice from Watts Electrical to its customers. The invoices from the proprietor have the words LONG LIFE LAMP COMPANY LTD at the top. The products invoiced are just listed by code/type of product. The invoices from Watts Electrical to its customers make no mention of LONG LIFE LAMP COMPANY. There is also a "to whom it may concern" letter from Watts Electrical stating that they have been a distributor since 2007.

Exhibit BM6 contains an Internet search for the term LONG LIFE LAMP. The first page of the Google results are provided, with the proprietor, or its goods (on websites such as amazon and eBay), being found on 6 out of the 9 hits on the page. The applicant's website is also found. The underlying web prints for the hits are provided. For the Amazon and eBay prints, the mark is used in the product description without the device element, although the eBay print refers to LONG LIFE LAMP CO (not COMPANY).

Exhibit BM8 contains two sales invoices, the first dated 7 June 2014 is addressed to Energy Light Bulb Ltd. The company name Long Life Lamp Company Ltd is used on the invoice at the head of its address. The second is from November 2007 and is addressed to Management Matrix Ltd/Watts Electrical [the distributor] and is for 540x60LEDGU10 amounting to £3626. The name LONG LIFE LAMP COMPANY LTD is used at the top of the invoice and it is also used as part of the address and bank account details.

Exhibit BM9 is an invoice from Amazon to Energy Light Bulbs Limited [who I assume must be a distributor or otherwise related company] for what is described by Mr Mann as advertising and marketing services. It is from July 2014 for the amount of £10,000.

Exhibit BM12 contains trading figures and history. It is stated in the exhibited document that Mr Mann originally traded as a sole trader, albeit trading as Strictly Lamps¹ with sales being made mainly via a website, eBay and Amazon. Sales grew from £7k in 2007 to £291k in 2010. PayPal invoices for sales made via eBay are provided in BM24. The document goes on to discuss the proprietor company which was incorporated in 2007 to arrange, source, design and manufacture its products which were “then marketed in the name of “Long Life Lamp Company” and the goods sold through Strictly Lamps and a parallel company Energy Light Bulbs Limited. The proprietor also sold branded products to wholesalers. The sales made by the proprietor grew from £104k in 2009 to £1.4million in 2013. Finally, reference is made to Energy Light Bulbs Limited, which appears to focus on LED bulbs/lamps and its turnover has grown from £757k in 2011 to £3.7 million in 2014; advertising costs have risen from £37k to £103k in the same period. The sales appear to be made on Amazon and it is stated that it is the biggest seller on this platform. It is stated that the Sunday Times approached the company to have it listed in a list of fast track companies. It is stated that the goods sold are all in the name of LONG LIFE LAMP COMPANY. Further company information is provided in this exhibit (and, also, Exhibits BM13, 14, 15 and 17) but it is not necessary to summarise this further.

Exhibit BM16 contains information from the Sunday Times about the Fast Track 100 list, but the proprietor (or its related companies) are not mentioned.

Exhibit BM18 contains invoices for search optimization services between 2009 and 2014, Exhibit BM19 contains invoices for Google AdWord marketing, Exhibit BM20 for Google Marketing provided to Energy Light Bulbs Ltd for a particular campaign in 2010, BM21 contains invoices from Amazon for marketing on this platform and invoices between the proprietor and Energy Light Bulbs Limited for its wholesale supply, Exhibit BM23 contains payment summaries between Amazon and Strictly Lamps relating to the sales of “Long Life Lamp Company branded products to customers” and Exhibit BM26 contains various reports on the use of Internet keywords.

Exhibit BM25 contains screenshots from the website longlifelamps.co.uk and energylightbulbs.co.uk. On the former the use shown earlier (on the preceding page) is the primary sign used. On the latter, the words LONG LIFE LAMP COMPANY are used as part of the product description.

35. Ms McCormick took me through some of the above. Her submission was that the evidence showed that not only was the use longstanding, but that significant sales and profit had been made with reference to goods sold under the mark, as well as significant sums being spent on marketing. In relation to the nature of use, she felt that the use alongside the logo was not of concern as more weight, in such scenarios, would be placed on the word element. She also stressed that the goods in question were low costs items which gave even greater significance to the sales figures that had been provided.

¹ The use of the word LAMPS in this trading name was something else relied upon by Mr Edenborough to show that the word LAMPS lacks distinctiveness.

36. One of Mr Edenborough's criticisms was that other marks may have been used by the proprietor. This stems from a written submission made by Ms McCormick in February 2015 (paragraph 25) that "some of the owners evidence relates to use of the Contested Mark in a stylised format". However, this is clearly not a reference to another type of mark, instead, it is a reference to the composite type of use I have set out above, which represents the main form shown in the evidence. Other criticisms include that there is no market share evidence for a market which is no doubt quite large. Further, the impact of any marketing is not known. In his skeleton argument, criticism was also made of the probity of Mr Mann's evidence given that the proprietor's website refers to it having traded for 18 years when, in fact, this was not true, the business having started in 2007.

37. I do not intend to disregard or lessen the weight of Mr Mann's evidence due to a potentially erroneous indication as to length of trade on the proprietor's website. Mr Mann has provided numerous examples of documentary evidence setting certain things out. The question, though, still arises as to what can be taken from those things. The test is of a significant proposition of the relevant public. Whilst Mr Edenborough correctly identified that no evidence of market share has been provided, the provision of such evidence, even though I agree that it would have been helpful, cannot be regarded as a prerequisite. The evidence must be considered as a whole. In terms of the marketing, there is no evidence of the type of campaigns (if any) that were run. However, it may be the case, indeed is likely to be the case, that much of this was spent on Internet marketing, as evidenced by the AdWord expenditure etc. Whilst this may not be traditional advertising, it is something which helps the business to gain sales. The proof of the pudding, though, is in the eating. It seems to me that the level of sales set out in the evidence would represent sales to a significant enough proportion of the relevant public to have the potential for the acquired distinctiveness test to be met. I have guarded against adding the sales figures for all the related companies together. This is because some sales are made to each other (for example, sales by the proprietor to Energy Light Bulbs Limited) which would result in double counting. Nevertheless, I am still satisfied that the sales have potential for the test to be met.

38. The reason I use the word "potential" is due to the nature of the use. As already stated, the primary use appears to be of the composite sign as detailed earlier, although, I accept that there are some uses of the mark alone. Having considered the case-law quoted earlier, and having regard to the submissions made to me at the hearing (and earlier in writing), my view is that the use made will be taken as trade mark use. The word element will be seen, effectively, as the name of the manufacturer responsible for the goods. Regardless of the form of use, the words perform the essential distinguishing function. In relation to the goods, it is clear that not everything for which the mark is registered has been used. There are no examples of lamp holders, parts and fittings and light fitting/apparatus more generally. Accordingly, the mark has acquired distinctiveness only in relation to the following:

~~Apparatus for lighting; commercial lighting apparatus; light bulbs; energy saving light bulbs; light-emitting diodes [LED] lighting apparatus; LED light bulbs; LED light fittings; LED light machines; compact fluorescent lights and lamps; halogen lamps; halogen light bulbs; fluorescent lamps; fluorescent lights; electric~~

discharge lamps; luminous discharge lamps; light discharge tubes; ~~lamp holders; parts and fittings for all the aforesaid goods.~~

39. It does not really matter whether the mark had acquired a distinctive character at the filing date or since registration. For the record, though, my finding is that the test was met at the date of application (for the subject mark).

Outcome

40. For the goods struck through above, the registration is deemed invalid and never to have been made. The mark may remain registered for all the other goods.

41. For sake of completeness, I should also observe that there was discussion at the hearing, and evidence filed, regarding an *ex parte* hearing that led to the initial acceptance of the subject mark. I do not need to discuss this. The circumstances that led the hearing officer to accept the mark have no bearing whatsoever on the decision required of me.

Costs

42. The proprietor has largely succeeded (at least in relation to the goods that were the real focus of the case) and is entitled to a contribution towards its costs. I have, though, made a small reduction to reflect that the success was not complete. My assessment is set out below:

Considering the application and preparing a counterstatement - £200

Considering and filing evidence and submissions - £700

Attending the hearing - £300

Total - £1200

43. I therefore order Opus Long Life Lamp Company Ltd to pay Long Life Lamp Company Limited the sum of £1200. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of March 2016

**Oliver Morris
For the Registrar,
The Comptroller-General**