

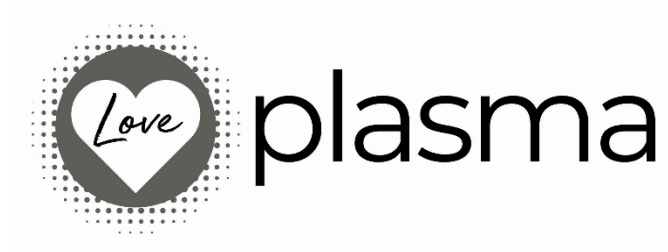
O/570/20

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**APPLICATION NO. 3336083**

**BY THERESA WILD TRAINING & EVENTS LIMITED  
TO REGISTER:**



**AS A TRADE MARK IN CLASSES 10 AND 44**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 414675**

**BY LW INTERNATIONAL LTD**

## Background and pleadings

1. On 04 September 2018, Theresa Wild Training & Events Limited (“the applicant”) applied to register the trade mark shown below:



2. It was accepted and published in the Trade Marks Journal on 14 September 2018 in respect of the following goods and services:

**Class 10:** *Electromedical instruments for firming treatments; Electromedical apparatus for dermatological purposes; Medical skin enhancement apparatus; Surgical and medical apparatus and instruments, for use in beauty, aesthetic and cosmetic treatments; Medical apparatus for dermatological and aesthetic treatment of the skin; Medical apparatus for firming the skin.*

**Class 44:** *Human hygiene and beauty care; Beauty treatment services; Dermatology services; Dermatological services for treating skin conditions; Laser skin rejuvenation services; Skin care salons; Cosmetic treatment; Cosmetician services; Cosmetic facial and body treatment services; Cosmetic laser treatment of skin; Services for the care of the skin; Information, advisory and consultancy relating to all aforesaid services.*

3. LW International Ltd (“the opponent”) filed a notice of opposition (Form TM7) on 13 December 2018 but it required amendments. An amended Form TM7 and statement of grounds was filed on 30 January 2019. The grounds of opposition are based on Sections 5(2)(b), 5(3), 5(4)(a), 3(6) and 3(1)(b) of the Trade Marks Act 1994 (“the Act”).

4. In the original Form TM7 and statement of grounds, the opponent, who was acting in person, included other two claims under Section 3(1)(a) and (d); however, the first was struck out on 10 January 2020 on the basis that it did not raise any reasonable

arguable points and the latter was struck out for want of evidence on 19 August 2019. In the notice of opposition filed on 13 December 2018 the opponent also ticked the Section 5(4)(b) box in Section E, which states '*Opposition based on any other ground*' [...] '*Section 5(4)(b): An earlier right by virtue of the law of copyright, design right or registered design*'. No details were given under this ground, other than "*Love Plasma has been used in many connotations by many people for a long time. They have not coined this generic term. It is a common hashtag*". As the pleadings were not clear as regards the opponent's stance on this ground, the Tribunal wrote to the opponent on 10 January 2020, advising that:

"Claims under this section of the Act relate to copyright, design right or registered designs.

The pleadings should set out:

- What the work relied on is, including a representation of it.
- Who created the work and when it was created.
- The nationality of the author (or if the author of the work is a corporate body where the corporate body is incorporated) at the time the work was created.
- If domicile/residence of the author is relied upon, where the author was domiciled/resident at the time the work was created.
- If the publication of the work is relied on, where the first publication of the work took place and when.
- Who the current owner of the work is and, if such a person is not the author, by what method was ownership transferred.

From the information provided it is not clear if you own this type of earlier right. If you do not it will not be possible to make claims under this section."

5. For whatever reasons, the opponent chose to abandon the ground under Section 5(4)(b) when it filed the amended Form TM7 and statement of grounds on 30 January 2019.

6. With regard to its claims under section 5(2)(b) and 5(3), the opponent relies on its UK trade mark number 3314082, which consists of the following:



7. The mark was filed on 29 May 2018 and was entered into the register on 7 September 2018 for the following goods and services, all of which are relied upon for the purposes of the opposition:

**Class 10:** *Electrotherapy instruments for firming treatments; Apparatus for non-invasive surgery.*

**Class 44:** *Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face.*

8. The opponent claims a reputation in respect of all the goods and services relied upon.

9. Given the respective filing dates, the opponent's mark is an earlier mark within the meaning of Section 6(1) of the Act. However, as it had not been registered for five years or more at the publication date of the application in issue, it is not subject to the proof of use requirements specified in Section 6A of the Act.

10. In respect of the grounds based upon Section 5(2)(b), the opponent claims that the applicant "*has a long track record of attempting to cause confusion*". According to the opponent:

- The applicant has previously been forced to withdraw a trade mark application for "iPlasma", a trade marked brand of the opponent;

- The applicant consistently uses the sign “Love Plasma” in the context of “Love Plasma Pen”, which is confusingly similar to the opponent’s mark;
- The opponent is well-known for using phrases like “LovePlasmaPen” and “we love Plasma”;
- The applicant’s mark is similar to the opponent’s mark, in particular, the figurative element of the applicant’s mark incorporates a circular icon placed to the left of the text and a reference to “spots” similarly to the opponent’s mark.

11. In respect of the grounds based upon Section 5(3), the opponent’s claims are as follows:

- The applicant’s mark looks like an extension of the opponent’s brand;
- The opponent surveyed 125 members of the relevant public and 100% agreed that *“unless told otherwise, they would assume Plasma Pen and Love Plasma Pen are one and the same entity”*;
- The opponent is an international brand with three decades of experience and a multi-million-pound turnover. The opponent is the direct manufacturer of the goods in relation to which the earlier mark is used. It has a huge and global reputation in this market and is recognised as the market leader;
- The opponent has invested millions over many years to design and manufacture an original product;
- The applicant is a tiny start-up training school with little or no reputation in the market and is simply a distributor/reseller of a third party’s device;
- Use of the applicant’s mark would, without due cause, take unfair advantage of the reputation of the earlier mark and/or be detrimental to its distinctiveness or reputation.

12. In respect of the grounds based upon Section 5(4)(a), the opponent asserts that use of the applicant’s mark will result in a misrepresentation leading to passing off. It relies upon the sign shown below that it claims was first used throughout the UK at least since November 2017 in respect of the same goods and services covered by the earlier mark:



13. The opponent claims that:

- Use of the applicant's mark in relation to the contested goods and services would constitute a misrepresentation to the public that the applicant is the opponent or is economically linked to the opponent. The applicant uses the applied for mark together with a TM symbol which increases the risk of misrepresentation;
- The get-up, appearance, look-and-feel of the applicant's brand and of the products and services the applicant sells for a third party are intentionally similar to the opponent's products and to the earlier mark;
- Use of the applicant's mark would constitute passing off.

14. The opponent's claim based on Section 3(1)(b) is that the applicant's mark is devoid of distinctiveness because the word 'PLASMA' is a generic word which is widely used, and the word 'LOVE' does not add any distinctiveness to the mark. References are made to the word 'PLASMA' having a meaning in different contexts, namely "tv", "blood", "space", "cosmetic device" and "gas".

15. The opponent's claim based on Section 3(6) is as follows:

*"Balancing [the applicant's] previous attempt to use and register one of the [opponent's] existing trade marks (iPlasma), other legal actions [the opponent] is pursuing against [the applicant] on copyright theft which [the opponent] reserves the right to file as evidence in response to any TM8 and counter-statement and this latest attempt to pass off as [the opponent] then we feel there is little doubt this application is eye-gouging and made in bad faith"*

16. The applicant filed a counterstatement denying the claims made. In particular, the applicant:

- denies that the marks are similar and that there is a likelihood of confusion;
- asserts that the only common feature between the competing marks is the word 'PLASMA', which is descriptive and in common use in other UK trade marks registered in classes 10 and 44;
- asserts that the term 'PLASMA PEN' is purely descriptive and refers to a device in the shape of a pen which conducts soft surgery plasma fibroblasting; as such the opponent cannot claim any monopoly in such a descriptive term;
- put the opponent to proof of reputation and goodwill;
- denies that the applicant's mark is devoid of distinctive character;
- denies that the application was made in bad faith and submits that even if the applicant knew of the existence of the opponent and its use of the earlier mark it would not constitute bad faith.

17. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.

18. The opponent has represented itself in these proceedings. The applicant was initially represented by Freeths LLP, but subsequently ceased to be represented by anybody in these proceedings. No hearing was requested and neither party filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

## **THE OPPONENT'S EVIDENCE**

19. The opponent's evidence consists of a witness statement (with eight exhibits DP01-DP08) by its managing director, Mr Dylan Pemberton. The original witness statement was dated 2 July 2019; this was subsequently amended with the amended witness statement being dated 2 September 2020.

20. I have read all the evidence. I note the following points from Mr Pemberton's evidence:

- The earlier mark has been used throughout the UK since no later than 23 November 2017. The applied for mark has been used in the UK since no later than 20 September 2018. Produced at Exhibits DP01 and DP02 are copies of Theresa Wild Permanent Makeup’s Facebook page showing use of the applied for mark on a silver pen which is described as a “*plasma device*” and “*an advanced medi - aesthetic treatment addressing a variety of skin concerns*”. Exhibits DP02 also contains extracts from the same Facebook page and from a google search for ‘love plasma pen’, all of which show use by Theresa Wild of the words ‘LOVE PLASMA™’, ‘plasma pen’ and ‘love plasma pen’ in relation to the same device;
- The opponent’s annual sales in relation to the registered goods and services in classes 10 and 44 are as follow:

|                          |          |
|--------------------------|----------|
| April 2016 to March 2017 | £719,753 |
| April 2017 to March 2018 | £812,404 |
| April 2018 to March 2019 | £863,512 |

According to Mr Pemberton, the above figures do not include “*the extensive turnover*” which was generated by other companies the opponent has control in within its “*overall international group structure*”;

- Annual amounts spent by the opponent on promoting the goods and services are as follows:

|                          |          |
|--------------------------|----------|
| April 2016 to March 2017 | £215,926 |
| April 2017 to March 2018 | £324,962 |
| April 2018 to March 2019 | £431,756 |

- The Plasma Pen mark has been used in relation to the goods and services across the UK and internationally. The opponent has academies, distribution, sales and operations spread across the UK;



- Mr Pemberton believes that there is a likelihood of confusion between the marks at issue and that the applicant has copied the earlier mark. Mr Pemberton also asserts that the opponent has sought expert advice on these issues, and he is content to include details of this in future submissions or at the hearing.
  
- According to Mr Pemberton, the fact that there is a history of previous attempts by the applicant to infringe the opponent's trade marks, copyright and intellectual property 1) makes it less likely that the similarity between the respective marks are a coincidence and 2) supports the opponent's claims that the applicant's mark was filed in bad faith and that the applicant is seeking to misrepresent and take unfair advantage of the opponent's brand and reputation. In this connection, Mr Pemberton refers to the fact that prior to the filing of the opposition at issue, the applicant had to withdraw an application for the registration of a mark that incorporates the word 'iplasma', namely application number UK 3330634 for the mark IPLASMA. According to our records, this application was filed by FLIGER WILD LIMITED on 9 August 2018 and following an opposition filed by the opponent, it was withdrawn on 25 October 2018 (Exhibit DP04). Mr Pemberton further explain that Theresa Wild is the CEO of FLIGER WILD LIMITED;
  
- At the time of the witness statement, the opponent was still pursuing actions for copyright infringement. Exhibits DP5 consists of a copy of a letter which was sent from the opponent's lawyers to Theresa Wild Aesthetic and Beauty dated 28 September 2018. The letter clarifies that the opponent's claims against the applicant were founded on the following allegations:
  - i. The copyright material was created for Plasma Pen by Louise Walsh in February 2018 in the course of her position as the opponent's director. It is used by the opponent in brochures, video and website and is protected by "copyright notices". The letter of 28 September 2018 refers to a copy of the copyright material but the attachments to that letter are not exhibited;

- ii. In March 2018 discussions took place between the opponent and Theresa Wild Aesthetic and Beauty concerning the possible appointment of the latter as an agent/distributor of the first. During those discussions the opponent made available to Theresa Wild Aesthetic and Beauty various confidential information about the opponent's business, including the copyrighted material which included the wording "copyright Louise Walsh International 2018";
  - iii. On 4 May 2018 Mr Pemberton emailed Theresa Wild Aesthetic and Beauty with a "Poland Agent Proposal" and further copyrighted documentation;
  - iv. It subsequently came to the opponent's attention that Theresa Wild Aesthetic and Beauty utilised the confidential and copyrighted documentation under the brand IPLASMA and subsequently under a new brand LOVE PLASMA, which is considered to be a derivative of the opponent's trade mark Plasma Pen;
  - v. The opponent considered that the application to register the trade mark LOVE PLASMA was made in bad faith;
  - vi. Theresa Wild Aesthetic and Beauty's marketing material and website uses images of the opponent's pen and copies the opponent's copyrighted material, including text from the opponent's website. The opponent is the manufacturer of the pen and the images are copyrighted. The device that Theresa Wild Aesthetic and Beauty supplies to customers is markedly different from the pen supplied by the opponent; this clearly misled customers and the opponent has referred the matter to the Advertising Standard Association;
  - vii. The opponent requested Theresa Wild Aesthetic and Beauty to sign undertakings requiring information about all the material supplied by the opponent or copied from the opponent's website, social media or other channel.
- Exhibit DP6 consists of a copy of a letter which was sent from the opponent's lawyers to FLIGER WILD LIMITED dated 24 August 2018. The letter states that it was sent in response to a letter received from FLIGER WILD LIMITED, but that for the purpose of the response the opponent's course of dealing had been

with Theresa Wild. The letter refers to the opponent's application to register the mark 33327717 for IPLASMA and refers to the applicant having submitted an application for a cloned mark. It says that the opponent's application was not made in bad faith but to protect the opponent's brand. It also says that use by the applicant of the mark IPLASMA has been licensed by the opponent and again contains accusation of copying and reference to the opponent's copyrighted material.

- Exhibit DP07 consists of examples of use of the words 'LOVE PLASMA PEN' by Theresa Wild on the website theresawild.com and on what appears to be videos posted on YouTube;
- Exhibit DP8 consists of screenshots from the opponent's Facebook page (undated). One of the posts features the earlier mark.

## **THE APPLICANT'S EVIDENCE**

21. The applicant's evidence consists of a witness statement by Theresa Wild, the applicant's managing director. The original witness statement was dated 18 December 2019; this was subsequently amended with the latest witness statement being dated 21 December 2019. I have read all the evidence. I note the following points from Ms Wild's evidence:

- The applicant's company was previously named Fliger Wild Ltd; this was changed in September 2019. Ms Wild has been a director of the applicant's company since 10 May 2017;
- Ms Wild points out that Mr Pemberton is not named as a director of the opponent in the records available from Companies House's website and there is no information about Mr Pemberton or his position within the company on the opponent's website;

- In May 2018, Ms Wild was in conversation via e-mail and WhatsApp with Louise Walsh with regards to buying her unbranded plasma pen and get her own logo put on the pen;
- Edirect were commissioned to design a logo for the plasma pen and, after substantial conversations, the logo was shared with Louise Walsh. During those conversations, Louise Walsh told Ms Wild to buy the trade mark iPlasma.co.uk;
- On 9 August 2018 Ms Wild's company submitted an application to register iPlasma as a trade mark (UK 3330634). The opponent opposed this application due to Ms Wild not purchasing pens from the opponent. The application was withdrawn after it came to light that the opponent had submitted an application (UK 3327717) for the trade mark iPlasma on 27 July 2018;
- The opponent has shown that their annual sales have grown, which according to Ms Wild means that her mark had no effect on the opponent's business, so she struggles to understand why her application is opposed. Ms Wild alleges that *"this is clearly a case of the larger company bullying the smaller company"* and she cannot afford to take further legal advice on this matter;
- Ms Wild's annual sales and advertising figures are about £41,000 (2018-2019) and £21,500 (2017-2018), respectively;
- Ms Wild has promoted the Love Plasma Pen internationally and extensively within the UK;
- Ms Wild disagree that the respective logos are similar and denies the accusation of copying. Ms Wild states the opponent's logo was not shown to her and was not taken as point of reference in designing the applicant's mark. Ms Wild points out that the opponent did not include any evidence to back up their claim that the opponent's logo was sent to Ms Wild prior to the applicant's mark being released;

- Ms Wild talked to other businesses in the industry and it became clear that there were some concerns about the opponent's pens and their origin, due to rumours of German pens being put through the CE certification and then copied out in China. Due to the amount of money that was to be spent on pens (about 100K), Ms Wild decided to pull back and go with what she describes as another more reputable supplier. The opponent's pens have no serial numbers, no WEE registration, no user manuals and no individual pen can be identified;
- Ms Wild confirms that she no longer uses the phrase LOVE PLASMA PEN;
- Ms Wild alleges that the opponent has recently changed their website to represent the applicant's colours and fonts as well as Ms Wild's images. Ms Wild says that she has never signed any consent to be associated with the opponent.

22. Ms Wild's witness statement includes:

- A printout from Companies House (Exhibit LP1). The printing date is 19 November 2019. There are 3 people listed as directors, two of which have not been involved in these proceedings. The first person was appointed on 1 December 2016, the second person was appointed on 21 October 2016 and resigned on the same day and, lastly, Louise Walsh appears to be listed as appointed on 2 November 2016 and having resigned on 1 December 2016. Mr Pemberton is not listed as a director;
- Printouts of WhatsApp messages between Louise Walsh and Ms Wild. The messages (undated) include the following (Exhibit LP2 and LP4):
  - A. Louise Walsh: *"Speak later Hun...is Iplasma. Com available ?? Xx"*
  - B. Ms Wild: *"Yes I want i plasma I'll call you in a min xx"*
  - A. Louise Walsh: *"Gis an hour . Buy iplasma Xx"* – Louise Walsh forwarded the image of what appears to be an electrical machine with a pen.

B. Ms Wild: *"I want these can that guy make these xx Okay so I got iplasma.co.uk .org and.us xx iplasma.com is £6k Shall I get someone to do logo and website? Xx"*

A. Louise Walsh: *"Yes defo. Great name xxx"*

And

A. Ms Wild: *"We've come up like 3 times to your place. Promised plasma factory which nothing has happened. I've heard from quite a few people that these pens are made in China and one of your distributors is being sued for poor quality pens. So rather than have a refund I'm trying to get this swapped with a silver one but if that's not going to happen I'll have a refund for the pens please. I don't want to take any further risk I am sure you understand and I certainly don't want things to become nasty"*

B. Louise Walsh: *"It's a Sunday and I'm on holiday in Spain. I have no silver pens at the moment in the new shape. I can sort tomorrow. Why is there an issue with every single thing we do .!!!! At this time on a Sunday morning I do not want to discuss Swoppong Plasma Pens. If u think I would have government certification if they were made in China ur dreaming!!!!!! Speak"* (Exhibit LP4);

- An invoice to Theresa Wild for the purchase of the domain name iplasma.co.uk, iplasma.org and iplasm.us dated 2018/06/04 (Exhibit LP6);
- A copy of a letter from the managing director of eDirect stating as follows *"This letter is to confirm that Theresa Wild commissioned eDirect to design a logo for Love Plasma from a blank canvas through our design process. We had instruction from Theresa Wild to change the logo name from iPlasma to Love Plasma as someone had registered the trade mark a week before Theresa"* (Exhibit LP8);
- A trade mark report including records relating to a number of UK and EU trade mark registrations in classes 10 and 44 incorporating the word PLASMA (Exhibit LP9).

## DECISION

### Section 5(2)(b)

23. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

24. Section 5A of the Act is as follows:

“5A. Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

25. The following principles are gleaned from the decisions of the courts of the European Union 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 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. The principles:

(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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**Comparison of goods and services**

26. The goods and services to be compared are as follows:

| <b>Applicant's goods and services</b>  | <b>Opponent's goods and services</b>  |
|--|---|
| <p><b>Class 10:</b> <i>Electromedical instruments for firming treatments; Electromedical apparatus for dermatological purposes; Medical skin enhancement apparatus; Surgical and medical apparatus and instruments, for use in beauty, aesthetic and cosmetic treatments; Medical apparatus for dermatological and aesthetic treatment of the skin; Medical apparatus for firming the skin.</i></p>  | <p><b>Class 10:</b> <i>Electrotherapy instruments for firming treatments; Apparatus for non-invasive surgery.</i></p> |
| <p><b>Class 44:</b> <i>Human hygiene and beauty care; Beauty treatment services; Dermatology services; Dermatological services for treating skin conditions; Laser skin rejuvenation services; Skin care salons; Cosmetic treatment; Cosmetician services; Cosmetic facial and body treatment services; Cosmetic laser treatment of skin; Services for the care of the skin; Information, advisory and consultancy relating to all aforesaid services.</i></p> | <p><b>Class 44:</b> <i>Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face.</i></p>  |

27. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated:

“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”.

## **Class 10**

*28. Electromedical instruments for firming treatments; Electromedical apparatus for dermatological purposes; Medical skin enhancement apparatus; Surgical and medical apparatus and instruments, for use in beauty, aesthetic and cosmetic treatments; Medical apparatus for dermatological and aesthetic treatment of the skin; Medical apparatus for firming the skin in the applicant's specification are all encompassed by Electrotherapy instruments for firming treatments; Apparatus for non-invasive surgery in the opponent's specification. These goods are identical on the principle outlined in Meric.*

## **Class 44**

*29. Human hygiene and beauty care; Beauty treatment services; Dermatology services; Dermatological services for treating skin conditions; Laser skin rejuvenation services; Skin care salons; Cosmetic treatment; Cosmetician services; Cosmetic facial and body treatment services; Cosmetic laser treatment of skin; Services for the care of the skin; Information, advisory and consultancy relating to all aforesaid services in the applicant's specification are either identical to or fall within the broad terms Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face in the opponent's specification. These goods are also identical on the principle outlined in Meric.*

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

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

31. The average consumer of the respective services is a member of the general public. The services will commonly be provided through salons and related establishments. The price and frequency of use of such services may all vary with the precise type of service. Generally, however, the purchasing process for cosmetic and beauty-related services will be, at least, a normal, reasonably considered one. The services will be found and selected through advertisements, directories, street signage, internet searches, etc. The process will be primarily visual, but word of mouth recommendations may also have some role to play.

32. In respect of the goods in class 10, they are likely to be directed to business users, such as, for example, beauty salons, although, taking into account the evidence produced by the parties, some of the terms in the specifications would also encompass skin-care devices which could be tried at home. Owing to the nature and likely cost of the products, the level of attention is likely to be higher than normal after taking into account the safety and effectivity of the product and (for business users) commercial considerations such as profit margins and sales potential. The purchase is likely to be

a primarily visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations.

**Comparison of the marks**

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. 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.”

34. 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. The respective trade marks are shown below:

| Applicant’s mark  | Opponent’s earlier mark  |
|---|--|
|  |  |

## **Overall impression**

### **The applicant's mark**

35. The applicant's mark consists of the word 'plasma' presented in a slightly stylised low case font. The word 'plasma' is preceded by a black circular device incorporating a white heart shape which includes the word 'Love', presented in black, in a handwritten, smaller font. Around the edge of the circular device there is a faded ring which is created by black and grey dots. The word 'Love' is placed at the beginning of the applicant's mark, however, the word 'plasma' is significantly larger. Further, the presence of the heart device merely emphasises the word 'Love'. Consequently, given the goods and services at issue, the mark will convey, as a whole, the idea of loving the effect of the 'plasma' goods and services. Whilst the device and the word 'Love' are not negligible elements of the applicant's mark, they have, in the light of their laudatory connotations, a lower degree of distinctive character than the word element 'plasma'. Therefore, the overall impression of the applicant's mark lies in the combination of these elements, with the word 'plasma' playing the greater role and the word 'Love' and the device playing a lesser role.

### **The earlier mark**

36. The earlier mark consists of the words 'Plasma' and 'Pen', written in white, in a title case font and the words 'By Louise Walsh International', written in grey in a smaller title case font, with the former being presented above the latter. The words are preceded by a white circular device incorporating a diamond shape and a dot. These components are presented against a black rectangular background.

37. In considering the relative weight which must be attached to the various components of the earlier mark, it is important to have in mind 1) that the evidence establishes that the term 'plasma pen' is used in relation to a device in the form of a pen that is used for cosmetic treatments and 2) that the goods and services for which the earlier mark is registered, i.e. *Electrotherapy instruments for firming treatments; Apparatus for non-invasive surgery* (in class 10) and *Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face* (in class 44), are broad enough

to include cosmetic devices in the form of a pen and cosmetic treatments provided using pen devices. This means that when applied in that context, the word 'Pen' in the earlier mark is likely to be perceived as a reference to the goods and services, although there is no evidence that the average consumers will be particularly alert to what 'plasma' means. The fainter words 'By Louise Walsh International' will be understood as the name of the trader who is responsible for providing the opponent's goods and services; this leads to the impression that 'Plasma Pen' is an individual brand and that the entity responsible for its creation is 'Louise Walsh International'. Taking all of this into account, I consider that the overall impression of the mark is dominated by the words 'Plasma Pen' and 'By Louise Walsh International' with the device playing a lesser role.

38. Indeed, I remind myself that here we are considering the earlier mark for the purpose of an opposition based on relative grounds and the earlier mark is not subject to any challenge based on absolute grounds. This means that a second scenario is in play, namely that of the earlier mark being used in relation to *Electrotherapy instruments for firming treatments; Apparatus for non-invasive surgery* (in class 10) and *Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face* which have nothing to do with pen devices, in which case the words 'Pen' would, together with the word 'Plasma', probably be considered more dominant than the words 'By Louise Walsh International' due to their size and positioning.

### **Visual similarity**

39. Both parties filed submissions on the similarities (and differences) between the marks, as part of their evidence. In particular, Mr Pemberton claims that the marks use a similar scale of proportions and similar fonts and spacing and that the presence in both marks of a circular device creates the impression of the same brand. Ms Wild argues that the logos are "completely different" and that the applicant's mark does not use a capital P in 'plasma' and the spacing between the device and the words is bigger in the opponent's mark than in the applicant's mark.

40. Although the marks at issue present a number of visual differences, the way there are presented pictorially, and their overall impression, are quite similar. In particular,

the marks have in common the word plasma/Plasma which is the most distinctive element in the applicant's mark and one of the most distinctive elements in the opponent's mark and renders the marks visually similar. The fact that the opponent's mark contains the device and the additional words 'Pen' and 'By Louise Walsh International' and the applicant's mark contains a different device and the other word 'Love', is not sufficient to reduce the (at least) medium degree of visual similarity between the marks, in particular taking into account the impact of the word plasma/Plasma and the way the marks are presented. **The marks are similar to a medium degree.**

### **Aural similarity**

41. The applicant's mark will be pronounced as 'LOVE PLASMA'. The opponent's mark will be pronounced as 'PLASMA PEN BY LOUISE WALSH INTERNATIONAL'. **Aurally the similarity between the mark is relatively low.**

### **Conceptual similarity**

42. Conceptually, I have already found that the words 'Love' and 'plasma' in the applicant's will be taken as conveying the idea of loving the effects of the 'plasma' goods and services. I also found that the term 'Plasma Pen' in the earlier mark will be perceived as a brand of Louise Walsh International and that the word 'Pen' will, in the context of goods and services consisting of (or provided through) pen devices, be seen as a reference to the pen devices themselves. Consequently, it is the word 'Plasma' which is conceptually more dominant within the phrase 'Plasma Pen', since the word 'Pen' is merely descriptive of the goods and services.

43. As regards the meaning of the word 'Plasma', definitions from the Oxford Dictionary include:

1. the colourless fluid part of blood, lymph, or milk, in which corpuscles or fat globules are suspended.
2. an ionized gas consisting of positive ions and free electrons in proportions resulting in more or less no overall electric charge, typically

at low pressures (as in the upper atmosphere and in fluorescent lamps) or at very high temperatures (as in stars and nuclear fusion reactors): the current passed through a column of plasma | [as modifier] : plasma physics.

- a substance analogous to ionized-gas plasma, consisting of mobile charged particles (such as a molten salt or the electrons within a metal).
3. a bright green, translucent variety of quartz used in mosaic and for other decorative purposes.
  4. another term for cytoplasm or protoplasm.

44. In my view, in the context of the goods and services at issue, which are identical, the word plasma/Plasma will convey in both marks the same concept. However, I doubt that consumers will know exactly which one of the specific dictionary definitions is relevant. **The marks are conceptually similar to a high degree.**

#### **Distinctive character of the earlier trade 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-2779, 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. Although the opponent has filed some turnover and advertising figures for the two years before the filing date of the applicant’s mark, i.e. 4 September 2018, this is not sufficient, on its own, to establish that the earlier mark had, at that date, an enhanced distinctiveness acquired through use in the UK.

47. In particular, the use is not longstanding, and the sales and advertising figures are not particularly significant and are completely uncorroborated. Further, Mr Pemberton has not sought to explain the inconsistency in its witness statement after Ms Wild filed evidence to show that he is not listed as a Director of the opponent’s company. There are also other points which identify a lack of consistency in Mr Pemberton’s evidence; in particular Mr Pemberton stated that the earlier mark has been used throughout the UK since no later than 23 November 2017 (“the date of first use”) but then, when he gave the sales figures, he included figures which are earlier than that date, or after the relevant date in these proceedings, i.e. 4 September 2018. In this connection, the figures given for April 2016 to March 2017 must be disregarded as they are earlier than the date of first use. Likewise, the figures for April 2017 to March 2018 include turnover generated before the date of first use and the figures for April 2018 to March 2019 include turnover generated after the relevant date, however, it is not clear what was the proportion of turnover generated under the earlier mark after the date of first use and before the relevant date. Accordingly, given the inconsistencies in Mr Pemberton’s evidence and the lack of sufficient details, I find that the opponent’s evidence falls short of establishing that the earlier mark has acquired an enhanced degree of distinctive character.

48. From an inherent perspective, I have already mentioned that the evidence shows that the term ‘plasma pen’ denotes a device used in the cosmetic field. However, the

applicant has not challenged the validity of the earlier mark. In *Formula One Licensing BV v OHIM*, Case C-196/11P, the Court of Justice of the European Union found that:

“41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

49. Further, the earlier mark contains other components, which, as a whole, make the mark distinctive to a medium degree. As regards the distinctiveness of the common element ‘PLASMA’, it is a word which can convey different meanings. Although there is, in material filed, some references to ‘plasma fibroplasting’ and to plasma pen devices using ‘fibroblasting’<sup>1</sup>, it is not clear what ‘plasma’ or ‘plasma fibroplasting’ means in that context. Most importantly, there is no information as to whether the word ‘plasma’ has any specific meaning in relation to the goods and services at issue.

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<sup>1</sup> Exhibit DP7, Witness statement of Theresa Wild paragraph 5

Consequently, I doubt that the relevant public would have the technical knowledge to attribute any descriptive meaning to the word 'Plasma' in the earlier mark; rather, it will understand it as no more than a relatively uninformative word with a medium degree of distinctive character.

50. As regards the results of the research submitted by the applicant, it is well established that "state of the register evidence" is not enough to establish that the distinctive character of an element of a mark has been weakened because of its frequent use in the field concerned<sup>2</sup>.

### **Likelihood of confusion**

51. In determining whether there is a likelihood of confusion, 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 marks may be offset by a greater degree of similarity between the respective goods and services vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

52. Confusion can be direct or indirect. This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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

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<sup>2</sup> *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01 and *Zero Industry Srl v OHIM*, Case T-400/06

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.

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).”

53. I have found the marks to be visually similar to a medium degree, aurally similar to a relatively low degree and conceptually similar to a high degree. I have found the opponent’s mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a business user, who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be at least medium for the services and higher than normal for the goods. I have found the parties’ goods and services to be identical.

54. The opponent's primary case is that the applicant's mark will be seen as a "derivative" of the earlier mark. I agree with the opponent. In my view, taking into account the identity of the goods and services involved, the similar overall impression created by the marks and their similarities, once it is remembered that the average consumer may not have the opportunity to compare the two marks side by side but may have to rely upon his or her imperfect memory of the earlier mark, then there is a real chance that the average consumer would, at least, think that the marks originate from the same (or an economically connected) undertaking. In my view, even if the words 'Plasma Pen' in the earlier mark will be perceived as unit, the average consumer is likely to understand the word 'Pen' as somehow descriptive of the goods and services and, if anything, he or she will see the word 'Plasma' as the striking element. This is all the more likely given that the word 'Plasma' maintains in both marks a somehow vague, indeterminate and ambiguous meaning, in the context of the goods and services concerned. Further, the absence of the words 'by Louise Walsh International' in the application, will not prevent the likelihood of confusion as the average consumer could readily make the assumption that the applicant's mark is an alternative mark used by the same undertaking, i.e. Louise Walsh International. For the sake of clarity, I should say that the fact that the opponent's cited survey evidence (which has not been produced) has had no effect on my decision. **There is a likelihood of indirect confusion.**

### **Section 5(2)(b) outcome**

55. The ground of opposition under Section 5(2)(b) succeeds.

### **Section 5(3)**

56. Section 5(3) states:

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international

trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

57. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and *the court's answer to question 1 in L'Oreal v Bellure*).

58. The relevant date for the assessment under Section 5(3) is the date of the application, namely, 04 September 2018.

## Reputation

59. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

60. I have already identified the main gaps in the opponent’s evidence. I also take into account that the opponent has given no indication of the market share held by the earlier mark. Further, there is a complete lack of corroborating evidence as regards the sales or advertising activities that may have taken place. Consequently, for similar reasons to those outlined at paragraph 47, I conclude that the opponent’s evidence falls short of establishing that it had a reputation at the relevant date. Without a reputation the claim cannot succeed.

### Section 5(3) outcome

61. The Section 5(3) ground fails.



## Section 5(4)

62. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) .....

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

63. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

64. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon case* (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

### **Relevant Date**

65. Although Ms Wild has provided annual sales figures for 2018-2019, there is no clear indication that the applicant's mark has been used prior to the application date and therefore the relevant date is the date of the application<sup>3</sup>, namely 4 September 2018.

### **Goodwill**

66. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

67. Whilst the evidence suggests that the opponent has generated some income from the sale of plasma pen devices, there is very little evidence of use of the earlier mark. The only evidence filed by the opponent in this regard consists of two Facebook posts which are undated and which show use of the earlier mark in a reverse version<sup>4</sup>.

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<sup>3</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O410-11

<sup>4</sup> Exhibit DP08

Further, although Mr Pemberton claimed that the mark was first used no later than 23 November 2018, it is impossible to quantify the proportion of revenue generated between that date and the filing date of the applicant's mark. Consequently, I find that the opponent has not established sufficient goodwill at the relevant date to sustain a passing-off action. The opposition failed accordingly.

### **Section 5(4)(a) outcome**

68. The Section 5(4)(a) ground fails.

### **Section 3(6)**

69. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

70. The opponent's pleading is reproduced at paragraph 15 above. It essentially amounts to the following allegations:

- the applicant previously attempted to register what is described as “*one of the opponent's trade mark*”. This part of the claim refers to application no. UK 3330634 for the mark IPLASMA, which was filed by Theresa Wild's previous company, i.e. LIGER WILD LIMITED, on 9 August 2018 and following an opposition filed by the opponent, it was withdrawn on 25 October 2018. In that opposition the opponent relied on registration no. 3327717 for the mark



which was filed on 27 July 2018 and registered on 16 November 2018;

- the opponent is pursuing other legal actions against the applicant on copyright theft which the opponent said reserves the right to file as evidence in response to any defence filed by the applicant;

- given the above, the applicant's application for the contested mark, which is described as the applicant's "*latest attempt to pass off as the opponent*", is made in bad faith.

71. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C-529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark, The Appointed Person*, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark, The Appointed Person*, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

72. The law appears to be as follows:

- (a) While in everyday language the concept of 'bad faith' involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky CJEU*.
- (b) Applying to register a trade mark without an intention to use it is not bad faith *per se*. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky CJEU*.
- (c) The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU*.

- (d) However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU*.
- (e) This may be the case where the exclusive right was sought as part of a strategy of using widely cast trade mark registrations as legal weapons for use against others in opposition proceedings and/or for the purposes of blocking applications by third parties: *Sky EWHC* and *Copernicus-Trademarks v EUIPO*.
- (f) A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky CJEU*.
- (g) This may be the case where the applicant has included a specific term in the specification, such as 'computer games', with no intention of using the mark in relation to any such goods, simply to obstruct third parties from using or registering the same mark, or similar marks. It may also be the case where the applicant has included a broad term, such as 'computer software', with the intention of using the mark in relation to a particular sub-category of such goods/services, but no intention of using the mark in relation to all the other (sometimes very different) sub-categories of goods/services covered by the broad term, with the objective of obstructing third parties from using or registering the mark in relation to such goods/services: *Sky EWHC*.
- (h) In deciding whether there was a rationale for registering the trade mark in relation to any particular term, it is necessary to bear in mind that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in future

(even if there were no plans to use the mark in relation to the goods/services at issue at the time of filing the application): *Sky EWHC*. It is therefore relevant to consider whether the goods/services in the contested application are related to those for which the mark has been used, or for which the applicant had plans to use the mark.

73. The following points are apparent from the pre-*Sky* case-law about registering trade marks in bad faith:

- (i) Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.
- (j) Similarly, the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.
- (k) However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.
- (l) An application may also have been filed in bad faith where the applicant acted in breach of a general duty of trust as regards the interests of another party, including his or her own (ex) company or (ex) partners, or a party with whom there is, or had recently been, a contractual or pre-contractual relationship, such as a licensor, prospective licensor or overseas principal: *Saxon, Mouldpro*; or where a legal agreement prohibits such a filing.

74. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark*, the key questions for determination in such a case are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

75. The applicant's intention (i.e. objective) is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

76. The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*.

77. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

78. A statement on the application form that the mark is in use, or there is a *bona fide* intention to use it may, if untrue, provide evidence supporting a bad faith case, but is not sufficient by itself to justify the refusal or cancellation of the registration: *Sky CJEU*.

79. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

## Assessment

80. The fact that the applicant might have applied for marks which are similar to marks registered by the opponent does not, in itself, constitute bad faith. Taking the opponent's case at its highest point, the claim includes allegations of copyright theft and refers to the opponent taking other legal actions against the applicant. Certainly, the pleadings advanced in the original notice of opposition could have been more detailed. Although the Tribunal had allowed, at the early stage, a certain amount of leeway to the opponent, who was acting in person, the onus was on the opponent to develop the grounds which it had adumbrated in its notice of opposition and establish the factual basis of its allegations.

81. So far as the issue of copyright is concerned, the only evidence filed by the opponent consists of two letters which were sent by the opponent's lawyers to the applicant's lawyers<sup>5</sup>. One of the letters relates to the opponent's application for the mark IPLASMA (UK3327717). Both letters accuse the applicant of having copied copyrighted material belonging to the opponent, including the content of its website. These letters explain that Louise Walsh and Theresa Wild met in March 2018, around 6 months before Theresa Wild's company, i.e. the applicant, filed an application to register the opposed mark. A possible appointment of Theresa Wild as an agent/distributor of Louise Walsh's company, i.e. the opponent, was discussed. The letters acknowledge that according to Theresa Wild the relationship between the two women ended as a consequence of issues surrounding the quality of the products being provided, but, according to Louise Walsh, Theresa Wild used "*her relation with Louise Walsh in order to obtain exposure to her business, its operations, its supply chain, its intellectual property, its business strategies and the like with a view to obtaining an unfair competitive advantage*". The letters also contain allegations that Theresa Wild used the opponent's confidential and copyrighted material which was made available to her whilst she was authorised by the opponent as its representative.

82. There are several issues with the opponent's claim under Section 3(6). First, it is apparent from the letters referred above that the underlying theme of the opponent's

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<sup>5</sup> Exhibits DP05-06



complaints is that the applicant had previous dealing with the opponent and used the knowledge acquired in the course of her dealing with the opponent to attempt to compete unfairly with it. This involves allegations of use by the applicant of signs incorporating the brand PLASMA, which it is claimed, belongs to the opponent, and allegations of copying copyrighted material. However, whilst the allegation that Theresa Wild has used copyrighted material which was made available to her as part of the discussion about becoming a distributor of the opponent's goods implies (I think) that she has acted in breach of a general duty of trust, this is not part of the opponent's case under Section 3(6). These facts were not pleaded in the notice of opposition and not arguments were made in relation to the relevance of these facts for the purpose of establishing bad faith in evidence or submissions. Consequently, I would, on that base alone, find that the opponent has failed to plead and establish the primary facts on which its claim is based.

83. I would add that on any view, even if the opponent could get over the hurdle of whether the Section 3(6) claim was appropriately pleaded, the evidence filed is certainly not sufficient to establish that the applicant has acted in bad faith. This is because: 1) the letters are hearsay evidence and as such, do not have the same evidential weight as direct evidence; 2) there are issues concerning Mr Pemberton's position within the company, to which the opponent has not responded; 3) the reference to copyright seem to relate to the marketing material used by the opponent which has nothing to do with the application to register the applicant's mark and there is no evidence that the earlier trade mark is based on copyright protected work; 4) bad faith subsists when the subject applying for a trade mark has no intention to use a trade mark or engage fairly in competition. As regards the last point in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2009] RPC 9 (approved by the COA in [2010] RPC 16), Arnold J. (as he then was) stated that:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the

mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

84. It is sufficiently clear that the applicant uses the contested mark in relation to products comparable to those offered by the opponent under the earlier registered mark. There is no evidence that the applicant applied to register the contested mark in order to prevent the opponent or other competitors from using similar signs in relation to similar products. What little evidence has been filed in these proceedings supports, in my view, the conclusion that the application was filed with the aim of using the mark and engaging fairly in competition. The claim under Section 3(6) fails accordingly.

### **Section 3(6) outcome**

85. The claim under Section 3(6) fails.

### **Section 3(1)(b)**

“3(1) The following shall not be registered –

(a).....

(b) trade marks which are devoid of any distinctive character,

(c)...

(d)

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.”

86. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the 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)."

87. The opponent's pleadings under this ground are as follows:

**Plasma in its own right has no distinctive character as it so so widely used & generic i.e. plasma (tv), plasma (blood), plasma (physics/space), plasma (cosmetic device), plasma (gas) etc. In turn, just saying you love a generic word is devoid of any distinctive character. One may love cheese but it is surely unlikely a mark would ever be granted for that! If they called it "Love Plasma Treatments" for example then that may be upscaled to something that is indeed distinctive although something like Love Plasma Pen - which they use - clearly conflicts with our existing mark.**

88. The opponent has filed no evidence to support the claim that the applicant's mark is devoid of distinctive character. In his evidence, Mr Pemberton claimed that 'plasma' as an isolated word *"is incredibly generic and far from unique"*. He states: *"plasma is such an all-encompassing general term (a broad term that is used to essentially describe one of the four states of matter i.e. hot ionized gas) and which is contained/used in everything from the sun to lighting to television to blood to, in our arena, cosmetic treatments. It has no ability to function as a viable trade mark in its own right"*. The basis for claiming that the applicant's mark is devoid of distinctive character seems therefore to be the objection that the word PLASMA is descriptive of the goods and services and is generic.

89. The little evidence that has been provided relates to use of the word 'PLASMA' in the parties' trade marks. As mentioned earlier, the dictionary meaning of the word 'PLASMA' is the fluid part of blood, an ionized gas, a variety of quartz, another term for cytoplasm. There is no evidence that, at the date when the applicant's mark was filed, the word 'PLASMA' was descriptive in relation to goods and services at issue or that it was used in the cosmetic field to such an extent that the average consumer would immediately have perceived it, without thought or explanation, as a word that was generic or descriptive or devoid of distinctive character in the context of the goods and services at issue. The claim under Section 3(1)(b) fails accordingly.

### **Section 3(1)(b) outcome**

90. The claim under Section 3(1)(b) fails.

### **OUTCOME**

91. The opposition has failed in respect of the Sections 5(3), 5(4)(a), 3(6) and 3(1)(b) grounds but succeeds in respect of the grounds based upon Section 5(2)(b) of the Act. The application is refused in its entirety.

### **COSTS**

92. At the end of the proceedings, the parties were sent a letter indicating that if they wanted to claim costs they should complete a costs pro-forma, setting out the hours expended in dealing with the proceedings, otherwise no costs (other than official fees) would be awarded. The opponent, who otherwise would have been entitled to a costs award, did not respond.

93. Given that the opponent has been successful but has not responded, I make no costs award other than in respect of the opponent's official opposition fee. However, I reduce the fees to the only ground which has been successful, i.e. £100.

94. I order Theresa Wild Training & Events Limited to pay LW International Ltd the sum of £100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16<sup>th</sup> day of November 2020

T Perks

For the Registrar,

the Comptroller-General