

O/0336/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003907269

BY DERMO VENTURES LTD

FOR THE TRADE MARK:


SERAFINE
SCOTLAND

IN CLASSES 3 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 442563

BY BEAUTY EVERICH LTD

Background and pleadings

1. On 2 May 2023, DERMO VENTURES LTD (“the applicant”) applied to register the trade mark as shown on the front page of this decision in the UK. The application was published on 19 May 2023. The applied for goods and services are shown in Annex 1 of this decision.

2. On 17 August 2023, Beauty Everich Ltd (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies upon the following mark:

SERAPHINE BOTANICALS

UKTM No. UK00915337173

Filing date: 14 April 2016

Registration date: 7 December 2016

“The earlier registration”

3. The opponent relies upon the following goods:²

Class 3: Cosmetics; Beauty care cosmetics; Body creams [cosmetics]; Skin masks [cosmetics]; Moisturisers [cosmetics]; Night creams [cosmetics]; Non-medicated cosmetics.

Class 21: Brushes [except paintbrushes]; cosmetic utensils; make-up brushes.

4. The opponent claims that the marks are highly similar and that the respective goods are identical or highly similar, with the result that there is a likelihood of confusion.

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

² The opponent had originally relied upon all of its goods as registered but later confirmed in their submissions in lieu dated 27 August 2024 that they were relying on the goods outlined above.

5. The applicant filed a counterstatement denying opponent's claims. Further, the applicant has requested that the opponent provides proof of use of its earlier mark.

6. The opponent is represented by Abel & Imray LLP and the applicant is unrepresented.

7. Both parties filed evidence and submissions in these proceedings. This will be summarised to the extent that it is considered necessary. No hearing was requested, however both parties filed submissions in lieu. This decision is taken following careful consideration of the papers.

Evidence and further submissions

8. The opponent's evidence was filed in the form of a witness statement dated 1 February 2024 from Lim Yang Hua, the Director of the opponent's company. The witness statement included 12 exhibits labelled LYH1-LYH14. The purpose of the evidence is to demonstrate that the earlier mark has been put to genuine use for the goods on which the opponent relies.

9. The applicant's evidence was filed in the form of a witness statement dated 12 May 2024 from Tomas Serafinavicius, the Director and Owner of the applicant's company. The witness statement included 14 exhibits labelled TS1-TS14.

10. The opponent's evidence in reply was filed in the form of a witness statement dated 28 June 2024 from Caroline Patricia Brooks, a Partner and Chartered Trade Mark Attorney at the opponent's representative firm. The witness statement included 1 exhibit labelled CPB1.

11. Throughout the proceedings, the applicant challenged the validity of the opposition. This is because the opponent assigned their earlier right from *So Susan Ltd* to *Beauty Everich Ltd* between the filing of the Form TM7A and Form TM7. Both the TM7A and TM7 were filed under the name *So Susan Ltd*. The applicant submits

that *So Susan Ltd* did not have the legal standing to file the opposition because they were not the proprietor of the earlier trade mark at the time of the filing of the TM7.

12. On 9 July 2025, an official letter was issued to both parties regarding this issue with the relevant parts reading as follows:

“It is noted that during the proceedings, the applicant has questioned the validity of the opposition on the basis of the opponent’s earlier registration being assigned from *So Susan Ltd* to *Beauty Everich Ltd* before the filing of the Form TM7.

[...]

In light of this, before the substantive matters can be considered, the Registry must decide if *So Susan Ltd* had the legal right to file the opposition.

The Registry will consider the comments made by the parties in their evidence and submissions filed during the course of these proceedings. However, if either party wishes to file any further submissions regarding this matter, they must do so on or before 23 July 2025.”

13. Both parties filed submissions on 23 July 2025.

14. Whilst I do not intend to summarise the evidence and submissions here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

DECISION

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

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

(a)...

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

16. Section 5A states:

“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.”

17. Section 6 of the Act defines an “earlier trade mark” as follows:

6(1) In this Act an “earlier trade mark” means—

(a) a registered trade mark [or] international trade mark (UK) ... which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired

(b) [...]

(ba) a registered trade mark or international trade mark (UK) which—

(i) prior to IP completion day has been converted from a European Union trade mark or international trade mark (EC) which itself had a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

18. The Trade Marks (Relative Grounds) Order 2007 (“the Order”) states:

Refusing to register a mark on a ground mentioned in section 5 of the Trade Marks Act 1994

“2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings **by the proprietor of the earlier trade mark or other earlier right.** (My emphasis).”

Validity of the opposition

19. In order to provide context, I note the chronological list of key dates and events below:

Date	Action
30 May 2023	A Form TM7A was filed by So Susan Ltd
1 August 2023	The earlier registration was assigned from So Susan Ltd to Beauty Everich Ltd
17 August 2023	The Form TM7 was filed in the name of So Susan Ltd
21 August 2023	The opponent filed a Form TM16 for their earlier registration to record the assignment from So Susan Ltd to Beauty Everich Ltd
25 September 2023	The registry wrote to the opponent requesting them to confirm undertakings
6 October 2023	The opponent confirmed undertakings

20. The applicant's submissions on this matter are as follows:

"In paragraph 5 of the Witness Statement, the opponent's witness confirms our assertions regarding the date of trademark ownership transfer, confirming that the ownership of the 'Seraphine Botanicals' mark (UK00915337173) was indeed transferred on 01 August 2023 from So Susan Ltd to Beauty Everich Ltd (China).

[...]

Consequently, it remains unclear whether So Susan Ltd formally transferred this opposition (No. OP000442563) against our trademark (UK00003907269) to Beauty Everich Ltd (China), or if any rights were retained by So Susan Ltd to formally oppose our mark. From our analysis, since So Susan Ltd ceased to be the proprietor of the 'Seraphine Botanicals' mark from 01 August 2023, they lacked the standing to oppose our mark."

21. In response, the opponent filed a copy of the assignment.³ I note that the assignment was executed on 1 August 2023. The opponent also filed further submissions:

³ See exhibit CPB1.

“15. Under Rule 17 of the Trade Mark Rules 2008, where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, the time prescribed for filing a notice of opposition in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning immediately after the date on which the application was published. As set out in the Witness Statement of Caroline Patricia Brooks, as the TM7A Notice of Threatened Opposition had been filed in the name of So Susan Ltd, before the assignment took place, a decision was taken to file the Opposition against the contested Application in the name of the same entity, So Susan Ltd (the Registered Proprietor at the time), and then to apply to record the change of ownership of the Opponent’s Registration to Beauty Everich Ltd thereafter.

[...]

18. The UKIPO formally substituted the Opponent in the opposition proceedings following the recordal of the assignment, without raising any formal objections. The effective assignment date of 1 August 2023 was included in the official request to record the assignment, and again in the Opponent’s letter to the UKIPO of 6 October 2023 in the opposition proceedings. The effective date of 1 August 2023 is also stated on the official records (under Event history) and the Tribunal Section was aware of the relevant dates when it substituted the Opponent.

19. The Opponent submits that the Applicant has not been disadvantaged by the change of Opponent in this matter.

20. If the Opposition were to be refused on the grounds that So Susan Ltd were not entitled to file the Opposition at the relevant time, the Opponent could simply commence invalidity proceedings on similar grounds once the Application had proceeded to registration. Such an outcome would be contrary to the overriding objective of enabling the tribunal to deal with cases justly and

at proportionate cost. It would not be procedurally economical for either party, or for the Office, if the present Opposition did not reach a substantive decision on the merits, and the Opponent was then forced to file an invalidity application refiling the same evidence and submissions.”

Key date

22. As highlighted in the Order above, for the opposition to be brought under section 5(2)(b), the opponent must be the proprietor of the earlier mark at the time of filing the Form TM7. i.e., 17 August 2023.

23. The chronological list at [19] shows that the earlier registration was assigned from *So Susan Ltd* to *Beauty Everich Ltd* on 1 August 2023. Although the registry received formal notification via Form TM16 on 21 August 2023, both the form and the opponent’s copy of the assignment confirm the transfer date as 1 August 2023. As the Form TM16 notes, it is not a replacement for the assignment document, so the effective date of transfer remains 1 August 2023.

Was So Susan Ltd the proprietor of the earlier mark on 17 August 2023?

24. As the assignment took place on 1 August 2023, *Beauty Everich Ltd* was the proprietor of the earlier mark at the time of the filing of the Form TM7. Accordingly, *So Susan Ltd* was not the “proprietor...of the earlier mark” as required under the Order and, therefore, not entitled to rely upon the mark under section 6 of the Act.

Consideration of Rule 17

25. In the opponent’s submissions at [21], they explain that they decided to file the Form TM7 in the name of *So Susan Ltd* because the extension of time for filing a Form TM7 only applies to the person (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) who filed the Form TM7A as stipulated in Rule 17(3) of the Trade Marks Rules 2008 (“the Rules”).

26. Although I acknowledge these submissions, I do not consider that Rule 17(3) of the Rules supersedes the Order's requirement that only the proprietor of the earlier trade mark can raise an opposition under relative grounds. So *Susan Ltd* had the right to submit the TM7A when it still owned the earlier mark, but this right did not continue after ownership was transferred. Consequently, once the mark changed hands, any opposition should have been filed by the new proprietor, *Beauty Everich Ltd*. In my view, the more suitable solution for the opponent would have been to submit the TM7 under the name of *Beauty Everich Ltd*, accompanied by a letter explaining the discrepancy between the names on the respective forms.

Overriding objective

27. I acknowledge the overriding objective of the Tribunal to deal with cases justly and at proportionate cost and also consider that the parties have gone to the time and expense of filing evidence and submissions in these proceedings. Whilst this is unfortunate, I do not consider that this is enough to justify the Tribunal to allow the opponent to circumvent the requirements of the Order. As the opponent has stated, it would be open to them to file an invalidity action if the applicant's mark did proceed to registration.

Conclusion

28. In order for an opponent to challenge a registration under section 5(2)(b) of the Act, they must be the proprietor of the earlier right, as defined by section 6. In this instance, at the time of filing the opposition, the opponent was not the registered owner of the earlier registration in which they rely upon. Therefore, the opponent does not have the *locus standi* to bring about the opposition. Accordingly, there is no requirement upon me to consider this matter any further.

Outcome

29. The opposition is dismissed.

30. I note that there is a separate ongoing opposition against this application that is aimed at all of the applied-for goods and services.⁴ Pending the outcome of that opposition, the application will proceed to registration.

COSTS

31. Since the opponent does not have the *locus standi* to maintain their opposition, the applicant has been successful and is entitled to a contribution towards its costs. As the applicant had not instructed professional representatives, they were invited by the Tribunal to file a cost pro-forma including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. On 27 August 2024, the applicant submitted a pro-forma requesting a total of 155 hours.

32. The Tribunal awards costs on a contributory rather than a compensatory basis. Further, I also note Mr Hobbs QC's comments in *Amaro* which observed that an award of costs is required to reflect the effort and expenditure to which it relates without inflation for the purpose of imposing a financial penalty by way of punishment on the paying party. The determination of a 'reasonable' amount to award must depend on the nature and circumstances of the case at hand.⁵

33. With consideration to the above, I have set out below what I consider to be reasonable allocations for the tasks claimed by the applicant. As outlined in TPN 1/2023, I will make the award of costs on the basis of £19 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended).

Preparing a counterstatement and considering the other side's statement (6 hours):	£114
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Preparing and filing evidence (10 hours):	£190
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Filing written submissions in chief

⁴ Opposition no. 442596

⁵ BL O/257/18 paragraph 17.

and response (8 hours): £152

Filing submissions in lieu and final remarks (6 hours): £114

Total: £570

34. I therefore order Beauty Everich Ltd to pay the sum of £570 to DERMO VENTURES LTD. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 22nd day of April 2026

**Catrin Williams
For the Registrar**

Annex 1

Class 3: Cosmetics; Skincare cosmetics; Perfumery products; Organic cosmetics; Cosmetics and cosmetic preparations; Multifunctional cosmetics; Perfume oils for the manufacture of cosmetic preparations; Cosmetic creams for the skin; Skin creams [cosmetic]; Skin creams [for cosmetic use]; Anti-aging creams [for cosmetic use]; Anti-aging creams; Anti-ageing creams [for cosmetic use]; Cosmetic creams and lotions; Creams for the skin; Skin creams; Cosmetic creams; Creams (Cosmetic -); Anti-ageing creams; Moisturising skin creams [cosmetic]; Sunscreen creams [for cosmetic use]; Skin care creams [cosmetic]; Cosmetic creams for skin care; Skin creams [non-medicated]; Non-medicated skin creams; Cosmetic creams for dry skin; Facial creams [cosmetics]; Cosmetic nourishing creams; Facial creams [for cosmetic use]; Facial creams [cosmetic]; Moisturizing creams; Sun creams [for cosmetic use]; Cleansing creams [cosmetic]; Moisturising creams; Exfoliating creams; Sunscreen creams; Moisturising skin lotions [cosmetic]; Creams for firming the skin; Facial creams; Toning creams [cosmetic]; Skin cream [for cosmetic use]; Skin conditioning creams for cosmetic purposes; Exfoliant creams; Moisturising creams, lotions and gels; Anti-aging moisturizers used as cosmetics; Skin moisturizers used as cosmetics; Suncare lotions [for cosmetic use]; Skin care lotions [cosmetic]; Skin balms [cosmetic]; Hydrating creams for cosmetic use; Beauty creams; Non-medicated creams; Cosmetic moisturisers; Skin lotions; Lotions for the skin; Skin cleansers [cosmetic]; Acne cleansers, cosmetic; Anti-aging moisturizers; Body and facial creams [cosmetics]; Fluid creams [cosmetics]; Night creams [cosmetics]; Cleansing creams; Cosmetics in the form of creams; Anti-aging cream; Skin toners [cosmetic]; Beauty balm creams; Skin moisturizers; Non-medicated skin lotions; Facial moisturisers [cosmetic]; Skin care creams, other than for medical use; Non-medicated cleansing creams; Eye creams; Facial lotions [cosmetic]; Cosmetic facial lotions; Skin cream; Retinol cream for cosmetic purposes; Skin moisturisers; Blemish balm creams; Perfumed creams; Non-medicated skin serums; Moisturisers [cosmetics]; Skin cleansing cream [non-medicated]; Anti-aging skincare preparations; Sun creams; Sun protecting creams [cosmetics]; Sun care lotions [for cosmetic use]; Face creams for cosmetic use; Facial cream [for cosmetic use]; Sunscreen cream; Cream soaps; Cosmetics in the form of lotions; Cosmetic sun milk lotions; Lip cosmetics; Facial

cream; Skin fresheners [cosmetics]; Milks [cosmetics]; Lip cream; Mattifying gel cream; Facial gels [cosmetics]; Skin masks [cosmetics]; Cleansing cream; Skin cleansing cream; Emollient preparations [cosmetics]; Non-medicated cosmetics; Lip stains [cosmetics]; Beauty care cosmetics; Cosmetics preparations; Natural cosmetics ;Eye cosmetics; Skin care cosmetics; Non-medicated cosmetics and toiletry preparations; Cosmetics for use on the skin; Powder compacts [cosmetics]; Sunscreens [for cosmetic use]; Sun blocking lipsticks [cosmetics]; Sunscreen [for cosmetic use]; Cosmetic soaps; Cosmetics in the form of powders; Cosmetic skin fresheners; Cosmetics in the form of oils; Beauty lotions; Cosmetics containing panthenol; Smoothing emulsions [cosmetics]; Perfumed powders [for cosmetic use]; Body and facial gels [cosmetics]; Cosmetic oils; Skincare preparations; Anti-ageing moisturiser; Beauty serums; Non-medicated skincare preparations; Suncare lotions; Beauty serums with anti-ageing properties; Anti-ageing serums for cosmetic purposes; Skin moisturiser; Skin moisturizer; Moisturisers; Moisturiser; Facial cleansers [cosmetic];Moisturizers; Skin cleansers; Anti-ageing serum; Skin moisturizer masks; Exfoliants for the care of the skin; Facial moisturizers; Exfoliants for the cleansing of the skin; Anti-aging serum for cosmetic use; Skin care oils [cosmetic]; Skin cleansing lotion; Skin cleansers [non-medicated]; Skin lotion; Skin hydrators; Cosmetics for use in the treatment of wrinkled skin; Cleansing lotions; Facial cleansers; Skin hydrators for cosmetic purposes; Moisturising gels [cosmetic]; Cosmetic preparations for skin firming; Moisturizing preparations for the skin; Lotions for face and body care; Non-medicated face care preparations; Hand masks for skin care; Face wash; Face wash [cosmetic];Face scrub; Facial care preparations; Cleaning masks for the face; Face masks; Skin care preparations; Face creams; Face and body masks; Face and body creams; Cleansing milks for skin care; Essences for skin care; Face and body lotions; Lip care preparations; Eye care products, non-medicated; Sun care lotions; Skin care (Cosmetic preparations for -); Cosmetic preparations for skin care; Face oils; Beauty care preparations; Exfoliating scrubs for the face; Milky lotions for skin care; Perfume oils; Perfumery, essential oils.

Class 35: Marketing research in the fields of cosmetics, perfumery and beauty products; Online retail store services relating to cosmetic and beauty products; Online retail services relating to cosmetics; Mail order retail services for cosmetics; Advertising services relating to cosmetics; Advertising services for the promotion of e-

commerce; Business consultancy services relating to product development; Providing consumer product advice relating to cosmetics; Online marketing; Online advertising; On-line advertising and marketing services; Promotion, advertising and marketing of on-line websites; Online advertising services; Advertising and marketing services provided via communications channels.