O/0337/24

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 801357927

IN THE NAME OF FOTONA d.o.o.

AND

APPLICATION No. 505045 BY EMBLATION LTD

TO INVALIDATE THE TRADE MARK REGISTRATION

BACKGROUND AND PLEADINGS

1. This application, filed on 27th June 2022, is made under section 47(2) of the Trade Marks Act 1994 ("the Act") by Emblation Ltd ("the applicant"). The applicant seeks to invalidate trade mark registration 801357927 in the name of FOTONA d.o.o., a Slovenian company ("the proprietor").

2. The registration concerned consists of the word SWEEPS. The proprietor applied on 9th January 2017 to register the mark as an international trade mark designating, inter alia, the EU. Priority was claimed from an earlier trade mark filed in Slovenia on 21st October 2016. This is the relevant date for assessing validity.

3. The IR was protected in the EU on 4th January 2018. Following the UK's withdrawal from the EU, the *"comparable mark (IR)"* was created in accordance with withdrawal legislation. It is treated as though it has been registered here throughout.

4. The comparable mark (IR) was originally registered in relation to:

> Class 10: Lasers for surgical and medical use; lasers for dental use; lasers for dermatological and aesthetic purposes; lasers for rejuvenation and tightening of the skin and mucosa; lasers for the cosmetic treatment of the face, skin and mucosa; lasers for the cosmetic therapy of the face and skin; surgical and medical apparatus and instruments for use in medical and dental procedures; surgical, medical and dental instruments and applicators.
>
> Class 44: Medical services; providing laser therapy for treating medical conditions; laser skin and mucosa rejuvenation services; laser skin and mucosa tightening services; cosmetic treatment of the face, skin and mucosa; laser aesthetic procedures, removal of tattoos and pigmented lesions; dental laser treatments; providing news and information in the field of medical laser treatment.

5. This was the specification when these proceedings started. The proprietor subsequently filed a request to partially surrender the trade mark for some of the goods/services. After this was actioned in December 2022 the specification of the comparable mark (IR) was reduced to:

Class 10: Lasers for dental use; surgical and medical apparatus and instruments for use in medical and dental procedures; surgical, medical and dental instruments and applicators.

Class 44: Dental laser treatments; providing news and information in the field of medical laser treatment.

6. The applicant is the proprietor of a series of three trade marks consisting of the word(s) SAFESWEEP, SAFE SWEEP and SAFE-SWEEP. The application to register these marks was filed on 28th February 2011, and the marks were registered on 10th June 2011. They are, therefore, earlier trade marks compared to the comparable mark (IR). For present purposes it is sufficient to concentrate on the (marginally) closest of the earlier marks - SAFE SWEEP. If the applicant succeeds on this mark there will be no point in looking at the other two. If it cannot succeed based on SAFE SWEEP, it will not do any better with the other two. Therefore, from here on I will refer to the earlier mark in the singular as SAFE SWEEP.

7. The earlier mark is registered for a long list of goods/services in, inter alia, classes 9, 10, 42 and 44. The full list of goods/services in the most relevant classes (9, 10 and 44) is at Annex A. The list includes *wave filters adapted for use with microwaves; wave meters adapted for use with microwaves; wave receivers adapted for use with microwaves* and *computer software* in class 9, *surgical, medical, dental and veterinary apparatus and instruments* (without restriction) in class 10, and *medical services* (without restriction) in class 44.

8. According to the applicant, the comparable mark (IR) is highly similar to the earlier mark, the respective goods/services are identical or similar, and there is a likelihood of confusion on the part of the public. Consequently, the applicant claims that the registration of the comparable mark (IR) was contrary to section 5(2) of the Act, which is as follows:

"(2) A trade mark shall not be registered if because—

(a) –

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

9. Further, the applicant claims that registration of the comparable mark (IR) was also contrary to section 5(3) of the Act, which is as follows:

"(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 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.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

10. The applicant claims the earlier SAFE SWEEP mark has a reputation in the UK for all the goods/services for which it is registered. According to the applicant, use of the comparable mark (IR) in the UK would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation and distinctive character of the earlier mark.

11. The applicant further claims that registration of the comparable mark (IR) was contrary to section 5(4)(a) of the Act, which 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.

(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."

12. According to the applicant:

(i) the SAFE SWEEP mark has been used in the UK "*and over Internet directed at UK consumers"* since February 2011 in relation to *medical devices and apparatus: medical and cosmetic services*;

(ii) it had acquired goodwill under the mark by the relevant date;

(iii) use of SWEEPS by the proprietor would have constituted a misrepresentation to the public that the user of that sign was connected to the applicant;

(iv) this would cause damage to the applicant's goodwill.

13. The proprietor filed a counterstatement denying the grounds for invalidation. I note that the proprietor admitted that the goods and services covered by Classes 10, 42 and 44 of the earlier mark (but not those in class 9) are similar to the goods and services covered by the comparable mark (IR). However, the proprietor denied that the applicant had used the mark in relation to all the goods/services for which it is registered. It put the applicant to proof of such use.

REPRESENTATION

14. The applicant is represented by Cloch Solicitors. The proprietor is represented by Boult Wade Tennant LLP. Neither side asked for a hearing. Consequently, this decision is taken from the papers.

EVIDENCE

15. The applicant's evidence consist of two witness statements by Philip Hannay of Cloch Solicitors. Mr Hannay's first statement (with 10 exhibits) appears to be intended to provide proof of use of the applicant's earlier trade mark. His second statement (with 4 exhibits) was filed in reply to the applicant's first witness statement and broadly contests its accuracy.

16. The proprietor's evidence consists of two witness statements (with 9 exhibits) by Ladislav Grad who is a director of the proprietor. Both of Mr Grad's statements provide information about the product the proprietor markets with its SWEEPS technology, which he says is for use in laser dentistry, and about the users of such products. Additionally, he provides some evidence about products incorporating the applicant's technology, which he says is microwave technology used for different medical purposes.

STATUS OF EU LAW

17. 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.

PROOF OF USE OF EARLIER TRADE MARK

18. The relevant parts of section 47 of the Act are set out below:

> *"(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—*
>
> > *(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or*

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) -

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) -

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) -

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).”

19. The procedure for registering the earlier trade mark was completed on 10th June 2011. The priority date claimed for the comparable mark (IR) the subject of these proceedings (from here on “the contested mark”) is 21st October 2016. As there is more than five years between these dates, proof of genuine use of the earlier mark is required for the period 22nd October 2011 to 21st October 2016, in accordance with section 47(2B)(ii) of the Act.

20. The application to invalidate the contested mark was filed on 22nd June 2022. Therefore, in accordance with section 47(2B)(i) of the Act, proof of genuine use of the earlier mark is also required for the period 23rd June 2017 to 22nd June 2022.

21. As noted above, the applicant’s evidence comes from Mr Hannay, its solicitor. In his first witness statement he states:

“The information in this statement comes from my own knowledge and experience or from UK Government sources or from sources located throughout the internet -- in which case I believe the same to be true and accurate to the best of my knowledge and belief.”

22. As to Mr Hannay’s own knowledge of the applicant’s use of SAFE SWEEP, he says:

“I began professionally representing the Cancellation Applicant in 2009…. . I was instructed to file the application for SAFE SWEEP in 2010. I was aware of its use at that time. In the period 2009-2016 I undertook and completed a mixture of high value corporate and also intellectual property instructions in the United Kingdom. I therefore have experience of what follows and can speak to the same.”

23. According to Mr Hannay, the applicant is a high growth international medical technology company. In support of this claim he exhibits various articles and

documents relating to the applicant.[1] There are numerous references to the applicant's SWIFT microwave technology and descriptions of how it is used in dermatology, podiatry and oncology. However, none of the 32 pages in these exhibits show any use of SAFE SWEEP.

24. The applicant holds 31 patents, a four-page list of which is in evidence.[2] Again, there is no reference to SAFE SWEEP.

25. Mr Hannay exhibits the applicant's public abbreviated accounts for the years 2011 to 2017, and 2022, as evidence of the applicant's goodwill and reputation.[3] He points out that the balance sheet for 30th April 2017 showed the company had intangible assets of over £4m. This figure had risen to over £6.5m by 2022.

26. None of the 52 pages of accounts show, or refer to, any use of SAFE SWEEP.

27. Mr Hannay says that as far back as 2010 the notes to the accounts disclosed R & D relating to *"three microwave based medical solutions"* one of which was, as he recalls, SAFE SWEEP. The applicant's accounts for 2010 are not in evidence. However, the 2011 accounts include the following note:

> *"The company Is currently developing three microwave based medical solution products and at 30 April 2011 commercial production of these products being developed had not commenced and as such no amortisation of the Development Costs capitalised in the period has been accounted for In the profit and loss account."*

28. One of the notes to the accounts for the year to 30th April 2017 states that:

> *"The company is currently developing three microwave based medical solution products and is in the early stages of commercially trading two of its products as at 30 April 2017. The development expenditure in relation to each product will be written off in line with future sales of the products."*

[1] See exhibits EMB-01 and EMB-04
[2] See exhibit EMB-03
[3] See exhibit EMB-02

29. These notes indicate there was no commercial production of any of the three unnamed, microwave based, medical products prior to 30th April 2011, and that commercial trading of two of the (unnamed) products was still in the early stages six years later.

30. This is in contrast to the equivalent note in the accounts to 30th April 2022, which states that:

> *"The Company has developed several microwave based medical solution products and is commercially trading two of these products along with associated applications at 30 April 2022."*

31. However, according to Mr Hannay, "*the SAFE SWEEP mark was first used by the Cancellation Applicant at least from 2010 and throughout the period until the relevant date,"* which he defines as 21st October 2016. In support of this claim he exhibits:

> (1) An article from the Microwave Journal dated 6th October 2011.[4] This is about the launch of the applicant's ISYS245 microwave generator product, which is described as using "*..Emblation's safesweep reflection measurement capability and temperature stability."*
>
> (2) An article dated 21 June 2012 from the website eeweb.com reporting on an 'Interview with Eamon McErlean', the applicant's Chief Technical Officer. Page 2 of the article quotes Mr McErlean as saying the applicant solved the hardest bug it ever had to fix *"using our Safesweep® technology."*[5]
>
> (3) Internet pages showing that videos were published on social media platforms Vimeo (in 2014), and YouTube (in 2015) entitled *"What is the Safesweep® function and what are the benefits for medical systems?"*[6] The videos themselves are not in evidence. The YouTube video had been viewed 71 times by 2023.

[4] See exhibit EMB-05
[5] See exhibit EMB-06. It is not clear what exactly this technology is. It appears to be hardware or software, or both, for accurately measuring the reflective power in microwave generators for mismatched loads. There is no information about users of the website eeweb.com.
[6] See exhibit EMB-07. There is no information about the social media platform Vimeo or its users.

(4) An article dated 14 October 2015 from the website scientificservices.eu entitled 'Use Science' regarding the applicant's ISYS24S product which is again described as using *"... Emblation's safesweep® reflection measurement capability and temperature stability.*"[7] The page was last updated in 2015. It had received 266 unique views when it was downloaded in 2023.

(5) The results of a Google search on 'safesweep medical' listing four videos and a reference to the applicant's safesweep technology in the only text result shown in the exhibit.[8] The videos are in date order. The one mentioning Safesweep comes first because it is the oldest (2014).

(6) A 5 page brochure published and, according to Mr Hannay, "*heavily used"* by the applicant prior to 21st October 2016 which states, on page 4, that "*Emblation's patented advanced measurement technique, safe sweep®, comes as standard on all Emblation microwave generators."*[9]

32. In *Walton International Ltd & Anor v Verweij Fashion BV*[10] Arnold J. (as he then was) summarised the law relating to genuine use as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark.

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark.

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin. Accordingly, affixing of a trade mark on goods as a

[7] See exhibit EMB-08
[8] See exhibit EMB-09
[9] See exhibit EMB-10. According to this brochure *"The technology works by varying the operating frequency of the conditions - thereby ensuring a stable and regulated output power signal over a predetermined frequency band and as a result, shifting the position of the standing wave. By sweeping the frequency the full standing wave can be measured and an algorithm to accurately measure the level of reflection can be obtained."*
[10] [2018] EWHC 1608 (Ch)

label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality.

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns. Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter.

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use.

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

33. Section 100 of the Act states that:

> *"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."*

34. I find the applicant's evidence of use wholly unsatisfactory. Firstly, the evidence comes from Mr Hannay, an external solicitor, rather than from someone in the business. This inevitably raises a question as to how accurately he can give evidence about his client's use of the trade mark during the relevant periods. In this connection, I note that (1) Mr Hannay does not say he has access to the applicant's books and records, and (2) he does not adequately distinguish between facts within his own knowledge and those he has found through his own research of publicly available material. On the face of things, it looks like most of the information he has provided comes from the latter. This inevitably means that the contents of the exhibits to his first statement have, to a greater degree than usual, got to speak for themselves.

35. Secondly, the exact nature of the SAFE SWEEP technology or 'technique' referred to in the evidence has not been explained. It appears to be something used for reflective measurement purposes in microwave generators intended for certain medical treatments. However, it is not clear whether it is a piece of hardware forming part of the generator, or software (which is in class 9, not 10), or something used with the generator.

36. Thirdly, there is no evidence as to the scale and frequency of use of the mark. There is nothing to suggest there has been any use of the mark in relation to medical services in class 44. There are no sales figures for SAFE SWEEP goods, or for goods incorporating SAFE SWEEP technology. And if, as Mr Hannay *"recalls",* SAFE SWEEP was one of the three microwave medical solutions mentioned in the

applicant's accounts, the notes to the accounts indicate that it was still in the early stages of commercially trading two of these three [unnamed] products as at 30th April 2017. There are no marketing expenditure figures. The only evidence of conventional advertising is the brochure at exhibit EMB-10 which mentions SAFE SWEEP on the fourth of five pages. Mr Hannay says this brochure was, "*heavily used"* by the applicant prior to 21st October 2016. However, it is not clear how he knows this, or what he means by "*heavily used."*

37. Fourthly, the evidence does not show how the SAFE SWEEP mark has been used in relation to the goods. There are no exhibits showing the mark applied to any goods or their packaging, and the material showing the mark used in published articles to designate technology in microwave generators is vague as to the connection between the mark and the goods being marketed. Given that the burden is on the applicant *"to show what use has been made of it",* it is striking that the earlier mark is only *"shown"* at all on 7 of the 105 pages comprising the exhibits to Mr Hannay's first witness statement. His second witness statement takes the matter no further.

38, Fifthly, it is impossible to identify the territorial scope of the use. It is clear the applicant's business is not limited to the UK market. The evidence is so vague that it is impossible to say where any use of the mark by way of publicity took place.

39. As Mr Daniel Alexander KC as the Appointed Person pointed out in *Awareness Limited v Plymouth City Council*;[11]

> "*22. …… it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which*

[11] Case BL O/236/13

the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

40. For these reasons, I find the applicant has not shown that what use of SAFE SWEEP there is in the evidence would have been *"viewed as warranted in the economic sector concerned to maintain or create a share in the* [UK] *market for the goods and services in question"* during the first relevant period ending on 21st October 2016. Consequently, the applicant has not shown genuine use of the mark during this period, and has not satisfied the first proof of use requirement.

41. Mr Hannay's evidence does not even purport to provide proof of use of SAFE SWEEP during the second relevant period of 23rd June 2017 to 22nd June 2022. It is true that the proprietor's counterstatement said that:

"The Applicant for Cancellation's Mark was registered more than five years before the priority date of the Registration (21 October 2016). As such, the Applicant for Cancellation is put to proof of use of the mark in relation to the goods relied upon in the cancellation."

42. The applicant may have misunderstood this to mean that proof of use was only required for the period ending on 21st October 2016. However, that is not what the pleading says. The first sentence is a statement of fact. The second sentence is an unqualified request for proof of use.

43. The request for proof of use relates to the 'statement of use' made by the applicant in the application for invalidation. Question 2a on the Form TM26(i) asked the following question:

Has the trade mark been used within the 5 years prior to the date of the application for invalidity?

44. The applicant answered 'Yes'. This constituted part of the statement of use required by Rule 41(2) of the Trade Mark Rules 2008 (as amended), which states:

"41(2) Where the application is based on a trade mark which has been registered, there shall be included in the statement of the grounds on which the application is made a representation of that mark and—

(a) -

(b) -

(c) -

(d) where neither section 47(2A)(a) nor (b) applies [i.e. the registration procedure for the earlier mark either was not complete, or was completed less than 5 years prior to the date of the application for invalidation], *a statement detailing whether during the period referred to in section 47(2B)(a) it has been put to genuine use in relation to each of the goods and services in respect of which the application is based or whether there are proper reasons for non-use (for the purposes of rule 42 this is the "statement of use")."*

45. Section 47(2B)(a) is set out at paragraph 18 above. It identifies two periods, namely, 5 years ending with the date of filing of the application for registration of the later trade mark or the priority date, if applicable, and 5 years ending with the date of application for the declaration.

46. The Form TM8 filed by the registered proprietor responded to the applicant's statement of use by requesting [unqualified] proof of use of the earlier mark. By doing so the proprietor invoked Rule 42(3)(c), which states:

"where the truth of a matter set out in the statement of use is either denied or not admitted by the proprietor, the applicant shall file evidence supporting the application."

47. However, none of the 7 pages of evidence showing the earlier mark date from the second relevant period. It is, therefore, impossible to say whether any use of SAFE SWEEP there may have been between 2011 and 2016 to identify technology used in, or with, the applicant's microwave generators continued during the second relevant period.

48. In this connection, I note that the proprietor's witness, Mr Grad, says in his first witness statement that he conducted a search for 'safesweep' on the applicant's website on 19th April 2023, which returned no results. The applicant filed evidence in reply to Mr Grad's evidence (Mr Hannay's second witness statement) but did not respond to this part of his evidence.

49. I conclude that the applicant has not shown genuine use of the mark during the second relevant period, and has not satisfied the second proof of use requirement.

50. It follows that the applicant's case based on sections 5(2)(b) and 5(3) of the Act falls at the first hurdle and must be rejected.

51. I have considered whether to examine the remainder of the applicant's case under these sections in case I am found to be wrong about the applicant's failure to satisfy the proof of use requirements. I have decided not to do so. This is because (1) the evidence falls so far short of what is required, particularly for the second relevant period, that the chances of my being wrong overall are remote, and (2) the difficulty of identifying what SAFE SWEEP technology actually is would make it very difficult to construct a fair specification for the purposes of comparing the parties' goods/services.

THE SECTION 5(4)(a) GROUND OF OPPOSITION

52. In *Discount Outlet v Feel Good UK,*[12] 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.*

[12] [2017] EWHC 1400 IPEC

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

53. In *Sworders TM*[13] I said:

"*Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made."*

54. Mr Grad exhibits two invoices to his first witness statement showing sales of 'Lightwalker' medical lasers to customers in the UK in 2019 and 2023.[14] Mr Grad says that these goods *"incorporated"* SWEEPS technology. This is not apparent from the invoices. In any event, there is no evidence of any sales of SWEEPS products prior to the priority date claimed for the contested mark: 21st October 2016. Consequently, this is the relevant date for assessing the existence of the applicant's goodwill, and the likelihood of deception and damage.

Goodwill

55. The difficulty with the applicant's evidence of use of SAFE SWEEP also afflicts its claim to have acquired goodwill under the mark in the UK by the relevant date in 2016. There is no evidence of any sales of SAFE SWEEP goods/services, or of any promotion of the mark in relation to goods or services targeted at the UK market. The highpoint of the applicant's evidence is, again, the brochure at exhibit EMB-10.

[13] BL O-212-06. Subsequently approved by the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11
[14] See exhibit LG02

However, the same unanswered questions arise. How many were issued? Who were they sent to? Did they provoke orders? Were any orders or enquiries made by reference to the sign SAFE SWEEP? In the absence of better evidence, I find the applicant has not shown that it had customers in the UK at the relevant date who would have regarded SAFE SWEEP as distinctive of its goods or services. Consequently, the applicant's case under section 5(4)(a) falls at the first hurdle.

Misrepresentation

56. I will briefly consider the applicant's case on misrepresentation on the footing that, contrary to my primary finding, it had goodwill in the UK at the relevant date under the mark SAFE SWEEP. I will also assume that the goodwill was more than trivial in extent and therefore protectable under the law of passing off.[15]

57. The product to which, on this assumption, the goodwill attached is the applicant's 'safe sweep' technology. This appears to be some kind of hardware or software included in, or with, microwave generators marketed under different marks, such as SWIFT, and used in the fields of dermatology, podiatry and oncology.

58. According to Mr Grad, the proprietor's goods are medical lasers used for endodontic dental procedures. Mr Grad's provides a booklet confirming the uses of these goods, and gives evidence that they do not incorporate microwave technology. He also gives evidence the goods are "*purchased and used by highly skilled and trained individuals in specific medical fields."* Mr Grad's evidence is that:

> "*Laser dentistry is a specific niche field, and it is not common for manufacturers to incorporate both laser dental devices and microwave technology in their portfolio. It is very unlikely for one medical professional to purchase or even come into contact with the goods of both parties, as the customer for the dental laser device incorporating SWEEPS technology would be a dental professional, often specialising in endodontics, while microwave technology is exclusively used in the non-dental fields of medicine."*

[15] The law of passing off does not protect goodwill of only a trivial or nominal extent: see *Smart Planet Technologies, Inc. v Rajinda Sharma,* BL O/304/20

59. Mr Hannay replied to this evidence by providing a screenshot of the proprietor's website homepage showing that it also trades in aesthetics, gynaecology and surgery products.[16] He also pointed out that the 'About Fotona' section of the website says the proprietor produces laser devices for defence, optical communications, industrial, dental and medical applications.

60. As regards the proprietor's claim that goods incorporating SWEEPS are selected by highly trained professionals, Mr Hannay points to pages on the proprietor's website promoting a laser treatment product under the mark CARE Esthetics, with accompanying information apparently directed at the general public.

61. As regards Mr Grad's evidence that it is not common for manufacturers to incorporate both laser dental devices and microwave technology in their portfolio, Mr Hannay provided an extract from printout of the website of ECO Microwave.[17] The website owner describes itself as 'China No. 1 and world top level medical treatment manufacturer'. It advertises manufacturing services *"covering microwave, laser and high frequency fields."*

62. I gave the proprietor leave to file additional evidence addressing these points, which were raised for the first time in the applicant's evidence in reply. In his second statement, Mr Grad accepted that the proprietor produces lasers for a number of purposes. However, he maintained that the "*SWEEPS procedure and pulse modality are only used for treatments in endodontics and periodontics."* Mr Grad also maintained that all the applicant's devices "*are intended to be used by healthcare professionals trained in the operation of medical laser devices."* As regards the SWEEPS technology, he maintained that these are dedicated dental devices used by dental professionals. In answer to Mr Hannay's evidence that a Chinese manufacturer produces lasers and microwave products, Mr Grad says:

> *"My previous statement is correct and backed by a comprehensive insight in the medical (and dental) laser industry. In a niche market of laser dentistry, microwave devices are not present as competitors to laser devices. This space is dominated by only a few laser wavelengths, as high precision is necessary*

[16] See exhibit EMB-12
[17] See exhibit EMB-14

to avoid tissue damage and preserve the vitality of teeth — this can be best achieved with lasers of particular wavelengths, also incorporating many state-of-the-art pulse modalities and technical advancements. Microwave devices are therefore, as a general rule, not produced by dental laser companies."

63. In support of this statement, Mr Grad exhibits webpages from three of the applicant's competitors, all of which appear to specialise in laser dentistry.[18] As to Mr Hannay's reliance on the website of the China-based manufacturer, Mr Grad dismisses this on the basis that it is not a well-known producer. Additionally, Mr Grad points out there is no reference on the website to the company producing products for use in dentistry.

64. I accept Mr Grad's evidence that the kind of laser technology identified by SWEEPS is exclusively used in dentistry. I also accept his evidence that such goods are usually selected by skilled dental technicians. Given the nature of the goods, it would be surprising if this were not so. Such sophisticated consumers are likely to pay a high degree of attention when selecting such goods.

65. I prefer Mr Grad's evidence that dental laser technology for use in dentistry is generally not produced by companies making microwave devices for medical use, to Mr Hannay's evidence that they may be. This is partly because Mr Grad is a trader in the relevant field, whereas Mr Hannay is a lawyer with little apparent experience of the market for dental lasers. Additionally, as Mr Grad points out, the evidence Mr Hannay puts forward to contradict Mr Grad's evidence is just one isolated hit plucked from the internet which does not even mention dental lasers.

66. With these points in mind I find that, even if the applicant had goodwill under SAFE SWEEP at the relevant date, the use of SWEEPS in relation to:

Class 10: Lasers for dental use; dental instruments and applicators.

Class 44: Dental laser treatments; providing news and information in the field of medical laser treatment.

[18] See exhibit 9 to Grad 2

- would not constitute a misrepresentation to the public.

67. This is because:

(1) Even allowing for a degree of uncertainty as to the exact nature of SAFE SWEEP technology, the respective goods are specialist goods for use in different medical fields;

(2) SAFE SWEEP was not a highly distinctive mark at the relevant date, it being no more than averagely distinctive by its nature,[19] and there being insufficient evidence that it had become more distinctive through use;

(3) Dental lasers are selected by sophisticated consumers paying a high degree of attention;

(4) The same is likely to apply to medical microwave technology;

(5) In these circumstances, the difference between SAFE SWEEP and SWEEPS was, and is, sufficient to avoid the likelihood of a substantial number of the applicant's customers and potential customers being deceived.

68. The position is less clear-cut as regards the other goods covered by the original and revised specifications for the contested mark. However, having regard to (1) the uncertainty as to the exact nature of SAFE SWEEP technology, and (2) the applicant's case fails anyway because of the failure to show that it had the necessary goodwill in the UK at the relevant date, I see no need to extend this decision any further.

OVERALL OUTCOME

69. The application for invalidation fails and is rejected.

[19] The word 'sweeping' appears to be used to describe how the product works. See footnote 9 above.

COSTS

70. The proprietor has been successful and would normally be entitled to a contribution towards its costs. The applicant's representative submits that no costs should be awarded against the applicant because:

> (1) The applicant has already been partially successful by forcing the part cancellation of the registration;
>
> (2) The applicant attempted to settle the matter extra-judicially;
>
> (3) The applicant was not given fair notice of aspects of the proprietor's defence;
>
> (4) The proprietor filed additional and irrelevant material;
>
> (5) The proprietor's pattern of behaviour in 'approximating' a competitor's trade marks (cancellation 505044 against the proprietor's registration of MICROSWIFT is cited in this regard).

71. Point (1) suggests the proprietor has also tried to settle the matter extra-judicially.

72. It is not entirely clear what the applicant means by point (3). However, I note the applicant complained about the proprietor filing evidence going to non-similarity of some of the goods at issue. This was after having conceded, in paragraph 8 of its counterstatement, that the respective goods/services in classes 10, 42 and 44 are identical or similar. However, in paragraphs 6 and 20 of the counterstatement the proprietor denied that the earlier mark had been used for all the registered goods/services, and put the applicant to proof of use of the earlier mark, and associated goodwill. Therefore, the admission that the goods/services were similar was made in relation to the specifications as they stood at that time. It could not reasonably have been taken to apply to any reduced specification, or narrower goodwill, the applicant may have been entitled to after it had filed the requested proof of use. The fact that the applicant filed evidence in reply going to the claimed similarity of the goods confirms that, at least by this time, it understood this aspect of the proprietor's defence, and had the opportunity to deal with it.

73. As to point (4) above, the proprietor was given leave to file some additional evidence. The applicant did not object. This additional evidence was relevant. It is true that the proprietor also sought to file additional evidence that was not relevant. However, (i) this was an attempt to answer to some of the matters raised in Mr Hannay's evidence in reply, such as his claim that some ex-employees of the proprietor held it in low esteem, that was itself irrelevant, and (ii) the registrar's provisional response (which neither side challenged) was to refuse leave to file this part of the additional evidence. Consequently, there is nothing to suggest this part of the proprietor's application to file additional evidence caused the applicant any unnecessary additional costs.

74. If the applicant's complaint about irrelevant evidence extends to the evidence that was admitted, I see no merit in it. Further, given that the applicant filed 105 pages of exhibits to Mr Hannay's first statement purporting to provide proof of use, only 7 pages of which showed any use of the earlier mark, the complaint would have far more force if it had been made in relation to the applicant's own evidence.

75. There is no evidence that the proprietor engaged in a pattern of behaviour that involves intentionally (or otherwise) appropriating the applicant's trade marks. This is a serious allegation that should not be made lightly. It should not have been thrown in for good measure in submissions about costs.

76. I will therefore award costs in favour of the proprietor on the usual scale taking account of the proportion of the applicant's evidence that was or little or no relevance, but still had to be assessed.

77. I assess costs as follows:

£350 for assessing the application for invalidation and filing a counterstatement;

£2000 for considering the applicant's evidence and filing evidence in response.

78. I therefore order Emblation Ltd to pay FONONA d.o.o. the sum of £2350 within 21 days of the end of the period allowed for appeal, or if there is an appeal which is subsequently withdrawn, within 21 days of the date of withdrawal.

Dated this 12th Day of April 2024

Allan James
For the Registrar

ANNEX A

Class 9: Scientific apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; calculating machines, data processing equipment and computers; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications; Controlled impedance microwave feedthroughs; High pressure microwave supply apparatus for diamond deposition; Masers [microwave amplifiers]; Microwave antenna for the reception of satellite data; Microwave antenna for the reception of television signals; Microwave antennae; Microwave apparatus for communication; Microwave apparatus for laboratory use; Microwave cables with connector; Microwave communications apparatus; Microwave communications instruments; Microwave components; Microwave connectors; Microwave decomposing apparatus being scientific laboratory apparatus; Microwave detectors [radar]; Microwave engineering design software; Microwave filters; Microwave instruments; Microwave ovens for experimental purposes; Microwave sensing apparatus; Microwave sensing heads for fitting to bins; Microwave sensing heads for fitting to mixers; Microwave tubes; Microwave type intruder sensors; Pulse code modulation apparatus for transmission via microwave; Pulse code modulation instruments for transmission via microwave; Wave filters adapted for use with microwaves; Wave meters adapted for use with microwaves; Wave receivers adapted for use with microwaves; Antennas for the reception of electromagnetic waves; Antennas for the transmission of electromagnetic waves; Apparatus for receiving electromagnetic radiation; Detection apparatus employing electromagnetic waves [other than for medical use]; Electromagnetic apparatus for the communication of information; High frequency generators, other than for medical use; Wireless high frequency transmission instruments; Radio-frequency antennas; Radio-frequency components; Radio-frequency filters; Radio-frequency modulators; Radio-frequency power meters; Radio-frequency receivers; Radio-frequency transmitter; Heat sequence apparatus for biochemical reactions; Heat sinks for conducting heat away from electrical components.

Class 10: Surgical, medical, dental and veterinary apparatus and instruments; analysing apparatus for medical purposes; Analysis (Apparatus for use in medical)-; Analysis apparatus for medical use; Analytical instruments for medical use; Apparatus for analysis [for medical use]; Apparatus for applying laser radiation [for medical purposes]; Apparatus for medical analysis; Apparatus for medical diagnosis; Apparatus for medical diagnostic purposes; Apparatus for medical purposes; Apparatus for medical testing; Apparatus for medical use; Apparatus for producing oscillatory waves for medical application; Apparatus for producing ultrasonic waves for medical application; Apparatus for the application of laser radiation for medical purposes; Apparatus for use in the generation of laser radiation for medical purposes; Electrical apparatus for medical treatment; Electrical appliances for medical purposes; Electrically operated medical apparatus; Electro medical apparatus; Electro medical instruments; Electronic apparatus for medical purposes; Electronic apparatus for medical use with computers; Electronic medical apparatus; Electronic medical instruments; High frequency coagulation apparatus for medical purposes; High frequency coagulation devices for medical purposes; High frequency coagulation instruments for medical purposes; High frequency cutting apparatus for medical purposes; High frequency cutting devices for medical purposes; High frequency cutting instruments for medical purposes; High frequency generators for use in medical treatment; Laser beam delivery apparatus for medical use; Laser beam delivery instruments for medical use; Laser cutting apparatus for medical use; Laser cutting tools for medical use; Laser devices for medical application; Laser installations for medical use; Laser instruments for medical use; Laser light transmitting apparatus for medical use; Laser light treatment apparatus for medical use; Laser light treatment instruments for medical use; Laser machining tools for medical use; Laser scalpels for medical use; Lasers capable of producing pulsating laser beams [for medical use]; Lasers for medical purposes; Lasers incorporating optical fibres for medical use; Magnetic field generators for medical use; Magnetic resonance imaging apparatus for medical purposes; Magnetic resonance imaging apparatus for medical use in diagnostic evaluation; Magnetic resonance imaging instruments for medical purposes; Magnetic resonance imaging spectrometers for medical use; Magnetic treatment apparatus for medical use; Medical apparatus and instruments; Medical apparatus for producing laser radiation; Medical apparatus incorporating lasers; Medical electronic diagnostic apparatus; Medical electronic therapeutic apparatus; Medical instruments;

Medical instruments for application in animal bodies; Medical instruments for application in human bodies; Medical instruments for application on animal bodies; Medical instruments for application on human bodies; Medical instruments for the removal of warts; Medical instruments incorporating lasers; Medical laser apparatus; Medical laser beam apparatus; Medical lasers; Medical measuring apparatus for measurements on skin; Medical testing apparatus; Medical testing instruments; Medical therapy apparatus; Medical therapy instruments; Scientific electrical apparatus for medical diagnosis; Scientific electrical apparatus for medical treatment purposes; Scientific electronic apparatus for medical diagnosis; Scientific electronic apparatus for medical treatment purposes; Shock wave apparatus for medical use; Sources of electromagnetic fields for use in medical diagnosis; Sources of electromagnetic fields for use in medical treatment; Sources of magnetic fields for use in medical diagnosis; Sources of magnetic fields for use in medical treatment; Sources of ultrasonic fields for use in medical diagnosis; Sources of ultrasonic fields for use in medical treatment; Test apparatus for medical use; Testing apparatus for medical purposes; Vaporizers for medical purposes; Detection apparatus for medical use employing electromagnetic waves; Electromagnetic medical apparatus; Electromagnetic wave apparatus for use in therapy; Electromagnetic wave therapeutic instruments; Scalpels emitting electromagnetic rays; Sources of electromagnetic fields for use in medical diagnosis; Sources of electromagnetic fields for use in medical treatment; Hyperthermia apparatus for the treatment of diseases of the prostate; Hyperthermia apparatus for the treatment of urinary diseases; Coagulation instruments; High frequency coagulation apparatus for dental purposes; High frequency coagulation apparatus for medical purposes; High frequency coagulation devices for dental purposes; High frequency coagulation devices for medical purposes; High frequency coagulation instruments dental purposes; High frequency coagulation instruments for medical purposes; High frequency cutting apparatus for dental purposes; High frequency cutting apparatus for medical purposes; High frequency cutting devices for dental purposes; High frequency cutting devices for medical purposes; High frequency cutting instruments for dental purposes; High frequency cutting instruments for medical purposes; High frequency generators for use in medical treatment; High frequency surgical apparatus and instruments; Apparatus for the heat treatment of cancer; Apparatus for the thermal treatment of cancer; Apparatus for the treatment of cancer; Apparatus for the heat treatment of

cancer; Cushions (Heating-), electric for medical purposes; Cushions [pads] (Heating-), for medical purposes; Deep heat massage apparatus; Electric heating appliances for medical therapeutic use; Electrical heating apparatus for medical [therapeutic] use; Electrical heating pads for medical [treatment] use; Electrically heated clothing for medical use; Electrically heated cushions, other than for medical purposes; Heat pads for therapeutic treatment; Heat therapy apparatus; Heat therapy instruments; Heat treatment apparatus; Heat treatment installations [therapeutic]; Heating apparatus for medical purposes; Heating cushions [pads], electric for medical purposes; Heating cushions [pads], non-electric for medical purposes; Medical apparatus for heat exposure sterilisation; Medical heating units with body contact applicators; Pads (Heating-), electric, for medical purposes; Thermal protective aids [heated] for medical use.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; medical analysis for the diagnosis and treatment of persons; Clinic services (Medical-); Hiring of medical apparatus; Hiring of medical appliances; Hiring of medical instruments; Medical analysis services; Medical assistance; Medical services; Medical services for the treatment of conditions of the human body; Medical services for treatment of the skin; Medical treatment services; Rental of equipment for medical purposes; Rental of medical apparatus; Services for the provision of medical facilities; Heat therapy [medical].