

O/0872/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003936636

BY NEXT RETAIL LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

SERAPHINE

IN CLASSES 3, 18 AND 25

AND

AN OPPOSITION THERETO UNDER NUMBER 444040

BY DERMO VENTURES LIMITED

BACKGROUND

Substitution

1. On 21 July 2023, Seraphine Limited (“the former Applicant”), applied to register in the UK the trade mark shown on the cover page of this decision (“the contested mark”). The contested mark was published on 11 August 2023. On 8 November 2023, Dermo Ventures Limited (“the Opponent”), brought this opposition. Following the administration of the former Applicant, Next Retail Limited (“the Applicant”) was substituted into these proceedings, providing, on 20 October 2025, the necessary undertakings with regard to: (i) confirming having had sight of all papers; (ii) standing by the pleadings of the former Applicant; and (iii) accepting liability for any costs that may be awarded against it.

2. The Applicant, following effective assignment on 30 July 2025, is the owner of the mark subject to opposition in these proceedings.

Pleadings

3. The application for the contested mark is for the following goods:

Class 3: Soaps; perfumes; cosmetics; lotions; balms; creams; body spray; baby wipes; moist wipes for sanitary and cosmetic purposes; skincare cosmetics; beauty masks; body care cosmetics; preparations for use in the bath and shower; bath and shower gels; bath salts; bath bombs; hand creams; body cream; sanitary preparations (other than for medical purposes); toiletry products; talcum powder; fragrances; make up; hair shampoo; hair conditioner; preparations for sun protection (toiletry); non-medicated lip care preparations; non-medicated preparations for use before, during, or after shaving; nail care preparations; nail varnish; nail cosmetics; nail care products; scented room sprays; reed diffusers; scented wax melts; essential oils.

Class 18: Bags; carrying bags; tote bags; baby carriers; pouch baby carriers; baby carriers [slings or harnesses]; baby carrying bags; baby carriers worn on the body; infant carriers worn on the body; backpacks for carrying infants; nappy bags; sling

bags; sling bags for carrying infants; slings for carrying infants; covers for baby carriers; cosmetic bags.

Class 25: Clothing; maternity clothing; maternity wear; maternity sleepwear; coats; dresses; nursing dresses; jackets; parkas; hooded parkas; trench coats; down coats; over coats; blazers; hoodies; jumpers; knitwear; tops; nursing tops; blouses; nursing blouses; tunics; tank tops; sweatshirts; shirts; t shirts; vests; leggings; tights; jeans; dungarees; trousers; shorts; skirts; loungewear; underwear; lingerie; knickers; bras; briefs; shapewear; hosiery; nursing bras; sports bras; nursing sports bras; beachwear; swimwear; bikinis; swimsuits; dressing gowns; nightwear; pyjamas; nursing pyjamas; nighties; kaftans; cardigan; wedding dresses; bridesmaid dresses; activewear; shawls; scarves; ponchos; belts [clothing]; gloves; mittens; layettes [clothing]; sleepsuits; baby clothes; all of the aforesaid related to maternity and nursing; footwear; headgear; hats; beanies.

4. The Opponent opposes the application in full, based upon section 3(6) of the Trade Marks Act 1994 (“the Act”). The Opponent claims that the former Applicant applied for the contested mark as part of a pattern of behaviour of “tactical” trade mark filings aligned with opposition proceedings in order to manipulate legal proceedings. It also argues that the former Applicant inconsistently enforces its trade mark rights, selectively opposing some marks whilst not opposing other similar marks in the marketplace; the Opponent suggests this behaviour is aimed at hindering competition rather than being consistent with the function of a trade mark, i.e. to protect a prior right. Further, the Opponent claims that choosing to register the contested mark in upper case despite already having registrations in lower case or title case constitutes a calculated strategy in which the former Applicant is aiming for the “broadest shield”. The Opponent also claims that the former Applicant has made the application for the contested mark to gain a procedural advantage in terms of avoiding the requirement to demonstrate the mark’s use for the usual five-year period.

5. In its statement of grounds, the Opponent has also cited other actions of the former Applicant which it claims goes to the former Applicant’s integrity, or lack thereof. Such actions include: (i) relying on an unregistered sign in separate opposition proceedings whilst actively seeking registration of the (identical) contested mark; (ii) sending

correspondence to the Opponent in relation to the Opponent's trade mark filings in an aggressive manner; and (iii) applying pressure tactics in such correspondence, thereby attempting to bypass the normal avenues of dispute resolution via the trade mark tribunal system. I have separated these pleadings from those in the previous paragraph on the basis that they do not directly relate to the filing of the contested mark in these proceedings, but to the former Applicant's overall behaviour. I will return to this later in my decision.

6. The former Applicant filed a defence and counterstatement denying the entirety of the Opponent's claims and responding to each of the points made by the Opponent in its statement of grounds. I will address the former Applicant's various submissions if and when it becomes necessary to do so.

7. The Opponent and the former Applicant filed evidence in these proceedings. No hearing was requested but the Opponent and the former Applicant filed written submissions in lieu. The Applicant is represented by Marks & Clerk LLP;¹ the Opponent is unrepresented.

EVIDENCE

8. The Opponent's evidence in chief is in the form of the witness statement of Tomas Serafinavicius dated 15 April 2024 and its corresponding 16 exhibits (TS1 – TS16). Tomas Serafinavicius is the director and owner of the Opponent.

9. The former Applicant's evidence in chief is in the form of the witness statement of Heather Wood dated 17 June 2024 and its corresponding 15 exhibits (HW1 – HW15). Heather Wood made the statement in their capacity as Chief Financial Officer of the former Applicant.

10. The Opponent chose not to file evidence in reply.

¹ The former Applicant was represented by Fox Williams LLP.

11. I have taken the entirety of the evidence into account in reaching this decision and will refer to it below where necessary. As there was no hearing, this decision is taken following a careful consideration of all the papers before me.

DECISION

Relevance of EU law

12. 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.

Section 3(6)

Statutory provisions

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

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

Relevant case law

14. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevenet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”)], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”)], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”)], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention 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, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant

had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

15. In the same case, Lord Kitchin also considered the question of what amounts to bad faith. He explained that the categories of bad faith and the circumstances which may constitute bad faith are not 'closed', and continued:

"152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able

to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...]."

16. The following further relevant points also arise from the case law:

(a) 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. However, Arnold J (as he then was) said that "*cogent evidence is required due to the seriousness of the allegation*". This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133;

(b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and

(c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3023 (Ch), paragraph 167.²

Relevant date

17. The relevant date is the filing date of the contested mark: 21 July 2023.

Assessment

18. The case law shows that the initial evidential burden falls upon the Opponent: the Opponent must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If it does that, then the burden shifts to the Applicant to rebut the allegation.

19. As a preliminary point, I remind myself that there is no obligation on me to discuss every argument raised by the parties: this was reiterated recently by Mr Phillip Johnson, sitting as the Appointed Person in the decision at BL O/0121/26. At paragraph 12, Mr Johnson cited *Eagil Trust Co Ltd v Pigott-Brown* [1985] 3 All ER 119, 122 and *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, [2014] FSR 2, in which Lewison LJ explained, at paragraph 115:

“The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing

² Approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.

up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted [...].”

20. With this in mind, I turn to the Opponent’s pleadings and evidence: these are substantial and so I will focus on the crucial points, combining some arguments where it is appropriate to do so, and covering others only to the extent I consider necessary.

21. The Opponent has referred to, and provided in evidence,³ multiple pieces of correspondence between the Opponent and the former Applicant, in which separate proceedings were discussed and the former Applicant offered the Opponent to withdraw its trade mark applications prior to filing oppositions against the same. I am conscious that some of the communications between the parties may constitute without prejudice correspondence; however, even if I did not disregard the evidence on this basis, it does not assist the Opponent. Whilst the Opponent highlights the former Applicant’s “aggressive manner” in the exhibited letters and claims that the former Applicant applying pressure is an attempt to circumvent the usual dispute resolution avenues, there is nothing in the correspondence that raises any doubts about the contested mark in these proceedings having been filed in good faith. This line of argument does not amount to a *prima facie* case of bad faith for the Applicant to answer and so I dismiss the submissions and evidence related thereto.

22. The former Applicant relying, in separate proceedings, on a similar or identical unregistered right for grounds under section 5(4)(a) of the Act is simply not relevant to whether the contested mark in these proceedings was filed in bad faith. Regardless of the former Applicant’s reasons for relying on an unregistered right, it strikes me as plausible for this to simply be a decision made in the course of conducting business to register as a trade mark a sign which it has already been using as an unregistered right. In the same vein, there was no requirement for the former Applicant to communicate, in the separate proceedings, that it intended to, or had already, applied to register the mark upon which it relied as an unregistered right. The arguments discussed in this paragraph do not amount to bad faith and so I will say no more about them.

³ TS2-5.

23. I will deal with the following arguments simultaneously: the former Applicant's trade mark filings being tactically aligned with opposition proceedings in order to manipulate proceedings; the former Applicant inconsistently enforcing its trade mark rights by choosing to oppose only some 'Seraphine' marks and not others; and applying for the word 'Seraphine' as a trade mark in both upper and lower case. Even considering the Opponent's full submissions on these points and the detailed evidence going thereto,⁴ I do not find there to be anything that corroborates an allegation of bad faith. All the aforesaid actions by the former Applicant are consistent with purposes falling within the functions of a trade mark, namely the protection of its prior rights. Making decisions as to: (1) which trade mark applications to oppose; (2) which fonts and stylisation to use in its own trade mark applications; and (3) choosing to apply for new trade marks because, amongst a variety of other reasons, the business has expanded or the business has been using marks which have so far been used as unregistered, are decisions open to the former Applicant (and Applicant) to make and are as consistent with good faith as they are bad faith. I am not persuaded that the aforesaid behaviour indicates that the contested mark the subject of these proceedings was filed in bad faith.

24. Lastly, I will address the Opponent's claim that the contested mark was filed with the intention of gaining a procedural advantage by way of avoiding the five-year proof of use period. Refiling a trade mark identical to an existing registration and for the same specification before the five-year proof of use period expires, in order to circumvent the requirement to provide evidence of use, may constitute an act of bad faith. However, the Opponent has not provided any compelling evidence that this was the former Applicant's intention: it has simply exhibited a table (shown below) containing the filing dates, representations, trade mark numbers and Nice classes for six of the Applicant's (or former Applicant's) 'Seraphine' marks, which includes the contested mark.⁵ All this tells me is that the Applicant (or former Applicant) has filed several trade mark applications with differing specifications between 2002 and 2023 and, further, that the contested mark relevant to these proceedings is its first

⁴ TS8-13.

⁵ TS8.

application for goods in class 18. I am not satisfied that the argument as put forward by the Opponent raises a *prima facie* case of bad faith.

Filing Date	Trade Mark	Trade Mark Number	Class
01 March 2002	Séraphine (word mark)	UK00002294219	3, 20, 24, 25
09 December 2009	Séraphine (word mark)	UK00002533959	9, 35
29 December 2009	Séraphine (word mark)	UK00908786352	9, 25, 35
01 November 2012	Séraphine (word mark)	UK00002640537	25
12 July 2016	seraphine (word mark)	UK00003174272	3, 20, 24, 25, 35
21 July 2023	SERAPHINE (word mark)	UK00003936636	3, 18, 25

25. Having considered the entirety of the Opponent's submissions and evidence, I do not find that it has established a *prima facie* case, and so the section 3(6) claim fails.

CONCLUSION

26. The opposition has failed and, subject to any appeal against this decision, the Applicant's contested mark may proceed to registration in full.

COSTS

27. The Applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 1/2023. I have calculated the award as follows:

Considering the Opponent's statement and preparing a counterstatement:	£400
Preparing evidence and considering the Opponent's evidence:	£900
Preparing written submissions in lieu of a hearing:	£350
Total	£1650

28. I therefore order Dermo Ventures Limited to pay Next Retail Limited the sum of £1650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 25th day of September 2026

MRS E FISHER
For the Registrar