

IN THE MATTER OF APPLICATION No 2060684  
BY LIFESYSTEMS LTD TO REGISTER A TRADE MARK IN CLASSES 1,3,5,9,11 & 24

5 AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 45619 BY PIFCO LTD

## BACKGROUND

10 On 12 March 1996, Lifesystems Ltd of 4 Mercury House, Calleva Park, Aldermaston, Berkshire,  
RG7 4QW applied under the Trade Marks Act 1994 for registration of a series of three trade marks  
- **LIFESYSTEMS / LIFE-SYSTEMS / LIFE SYSTEMS** - in respect of:

Class 1: "Water treatment preparations."

15 Class 3: "Skin protection lotions."

Class 5: "Insect repellent preparations: filled first-aid kits."

20 Class 9: "Electronic devices for attracting and killing insects; adapter plugs; strobe lights; thermal  
blankets and bags, all being for the purpose of lifesaving."

Class 11: "Water purifiers."

25 Class 24: "Mosquito nets."

Following publication of the application, opposition to the registration was filed by Pifco Ltd on  
9 October 1996. In summary the grounds of opposition are:

30 A) That the opponents have acquired the following six trade mark registrations:

- i) LIFE SYSTEMS in class 8
- ii) LIFE SYSTEMS in class 10
- iii) LIFE SYSTEMS in class 11
- iv) LIFE SYSTEMS in class 21
- 35 v) LIFESTREAM in class 3
- vi) LIFESTREAM in class 11

40 B) The assignors have made substantial use of the trade marks throughout the UK, thereby  
attaining considerable reputation and goodwill, subsequently acquired by the opponents.

45 C) That the application for registration in relation to the trade mark series  
LIFESYSTEMS should be refused as it offends Section 3 of the Trade Marks Act 1994,  
and in particular Section 3(1)(a).

D) That the application offends against Sections 5(1), 5(2)(a), 5(3)(a) and 5(4)(a).

50 The opponents further requested that the Registrar refuse application No2060684 in the exercise  
of his discretion. However under the Trade Marks Act 1994 the Registrar does not have a  
discretion to refuse an application as he did under the old law. An application can only be refused  
if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicants subsequently filed a counterstatement accepting that the opponents were the proprietors of the six trade marks listed but denying all of the other grounds of opposition. Both sides ask for an award of costs, neither party wished to be heard in the matter. My decision will therefore be based on the pleadings and the evidence filed by both parties.

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#### OPPONENTS' EVIDENCE

The opponents filed a statutory declaration, dated 14 July 1997, by Mr Andrew David Streets who is the Company Secretary of Pifco Ltd, a position he has held for eight years.

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In his declaration Mr Streets claims that his company acquired six trade marks from the administrator of Mountain Breeze Ltd on 6 September 1996. A copy of the trade mark assignment is filed at exhibit ADS1. This shows that the trade marks were assigned "with any goodwill attaching thereto".

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Mr Streets lists the trade marks acquired as:

Trade Mark	Registration number	Class	Goods
LIFE SYSTEMS	1567902	8	Hair care implements, tools, apparatus and equipment; razors; clippers; curling tongs; curlers; straighteners, clippers and waving apparatus and equipment, all for hair; parts and fittings for all the aforesaid goods;
LIFE SYSTEMS	1567903	10	Massage apparatus and equipment; body and facial massage apparatus and equipment; body massagers; foot spas; heating pads and facial heating packs; parts and fittings for all the aforesaid goods.
LIFE SYSTEMS	1567904	11	Air freshening apparatus; air cleaning apparatus; air sterilising apparatus; air deodorising apparatus; air ionization apparatus; air humidifiers; air dehumidifiers; air conditioning apparatus and equipment; aromatherapy diffusing apparatus; steam generating apparatus and equipment; saunas; facial saunas; heating pads; facial heating packs; fans and extractor fans; apparatus and installations for lighting, steam generating, drying and ventilating; lighting apparatus, installations and instruments; apparatus, installations and electrical units for dispensing fragrances in the air; lamps; lights; lamp bulbs; solar lamps; lamp units; solar lamp units; light sources; full spectrum light sources; infra-red heating lamps; hair-drying apparatus and equipment; hair-dryers; parts and fittings for all the aforesaid.

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LIFE SYSTEMS	1567905	21	Household or kitchen utensils and containers; combs and sponges; brushes; brush making materials; articles for cleaning purposes; oral care products, apparatus and equipment; toothbrushes (electric and non-electric); plaque removing and teeth polishing apparatus and equipment; plaque removers and tooth polishers; parts and fittings for all the aforesaid goods.
LIFESTREAM	1395255	3	Perfumes, fragrant preparations.
LIFESTREAM	1391142	11	Air freshening apparatus; air cleaning apparatus; air sterilising apparatus; air deodorising apparatus; air ionization apparatus; air humidifiers; air dehumidifiers; air conditioning apparatus; fans; parts and fittings for all the aforesaid goods.

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The opponents are now the registered proprietors of these marks. A copy of the assignment certificate is at exhibit ADS2.

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From the records available to him, Mr Streets states that the previous registered proprietor (Mountain Breeze Ltd) began using the mark LIFE SYSTEMS for a range of goods under class eleven in November 1994. An example of the packaging for an aromatherapy diffuser, as used by Mountain Breeze, is provided at exhibit ADS3. At exhibit ADS4 a sample of the current advertising literature showing use of the same mark is provided. These both show the mark being used in the following manner:

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**LIFE  
SYSTEMS**  
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Mr Streets asserts that the applicants' goods in class 9 for killing insects are effectively the same as the opponents' aromatherapy diffuser in class 11 as they work using the same principles. He describes this as basically using electricity to heat a pad which has been impregnated with chemicals, causing the pad to release the chemicals into the atmosphere. Mr Streets further claims that the applicants' goods under class 5 ("insect repellent preparations") refers to the tablets for such diffusers.

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In Mr Streets' view, because of these similarities, the use of the applicants' trade mark series (LIFESYSTEMS) on the goods in section 5 and 9 will cause confusion with the opponents' trade mark.

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Finally Mr Streets states that according to the records, the previous registered proprietors (Mountain Breeze) used the LIFESTREAM trade mark on goods in both class 3 and 11 from November 1994. Exhibit ADS6 is an example of the opponents' current label showing use of this mark. Because of the similarities in the products, he believes that the use of the applicants' trade mark series LIFESYSTEMS on goods in classes 3, 5 & 9 is confusable with the opponents' LIFESTREAM trade mark

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## APPLICANTS' EVIDENCE

This consists of a statutory declaration, dated 6 October 1997, by Mr Mark Geoffrey Cobham who is the Managing Director of Lifesystems Ltd.

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In his declaration Mr Cobham states that the trade mark series LIFESYSTEMS was first used in 1989, with electric devices for killing insects being sold under the mark in September 1994. Copies of the artwork for the original packaging of the electric devices and tablets, bearing a date of September 1994, are provided at exhibits MGC1 and MGC2.

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Whilst Mr Cobham agrees that his company's insect killing device and the opponents' aromatherapy diffuser work on the same basis, he believes that the very specific nature of his product, the differences in design and packaging, and the reputation his company has gained means that his trade mark should be allowed to proceed to registration.

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Mr Cobham points out that the skin protection cream under the applicants' trade mark series LIFESYSTEMS (class 3) is a very different product to the opponents purely cosmetic perfumes and fragrances under the mark LIFE STREAM (class 3). He also claims that the difference in the marks is enough to avoid confusion.

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## OPPONENTS' EVIDENCE IN REPLY

This consists of a statutory declaration, dated 5 February 1998, by Mr Andrew David Streets.

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In response to the applicants' evidence Mr Streets claims that as the applicants accept that the insect killing device and the aromatherapy device work on the same basis the goods are identical. In addition he claims that as the marks used LIFESYSTEMS (series) - LIFE SYSTEMS are also identical, there will be confusion which will be to the detriment of the opponents.

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Mr Streets notes that in the applicants' evidence it is stated that the electric insect killing devices began to be sold under the LIFESYSTEMS trade mark series in September 1994. As this date is after the date of the opponents' application, 7 April 1994, for LIFE SYSTEMS (goods in class 11) Mr Streets claims that it should have been apparent to the applicants that there was a likelihood of confusion.

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Lastly, Mr Streets refers to two brochures originally filed as exhibits ADS6 (refiled as exhibits ADS7), which give details of the properties claimed for his company's LIFE STREAMS products. Two of the oils, which are intended for use in the LIFE SYSTEMS diffusers and are marketed together, state that they have a use as an insect repellent. In exhibit ADS7 these entries are highlighted for ease of reference. Mr Streets claims that this proves that the applicants' insect killing device and the opponents' aromatherapy diffuser share the same purpose.

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This completes my review of the evidence. I now turn to the decision.

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## **DECISION**

In their pleadings the opponents stated that the application "is objectionable under Section 3 of the Trade Marks Act 1994. Particularly, although not exclusively, the application is objectionable under Section 3(1)(a)."

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It is clear from exhibits ADS1 and ADS2 that the opponents are the proprietors of four registered trade marks for the words LIFE SYSTEMS and also the proprietors of two registered trade marks for the word LIFESTREAM. However the presence on the register of these marks does not have

a bearing on whether the applicants' trade marks in the series (LIFESYSTEMS ) meet the requirements of Section 1 of the Trade Marks Act 1994 which states:

5                    *"1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings."*

And Section 3(1)(a) which states:

10                   *"3.-(1) The following shall not be registered-*  
                      *(a) Signs which do not satisfy the requirements of section 1(1),"*

15                   Each trade mark must be considered on its own merits for the purposes of determining whether it meets the criteria in Section 1(1). The opponents have not shown why the trade marks in the series LIFESYSTEMS are incapable of distinguishing. Consequently the opposition under Section 1(1) and 3(1)(a) fails. As no other grounds under Section 3 of the Trade Marks Act 1994 have been specifically argued I move onto the opposition under Section 5.

20                   The opponents have not been specific in their opposition under Section 5, stating in their pleadings that "the application is objectionable under Section 5 of the Trade Marks Act 1994. Particularly, although not exclusively, the application is objectionable under Section 5(1), Section 5(2)(a), Section 5(3)(a) and Section 5(4)(a)." Section 5 of the Trade Marks Act 1994 states:

25                   5.-            (1)        *A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*

30                                (2)        *A trade mark shall not be registered if because -*  
                                      (i)        *it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or*

35                                        (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,*

40                   *there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.*

                                      (3)        *A trade mark which -*  
                                      (a)        *is identical with or similar to an earlier trade mark, and*  
                                      (b)        *is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

50                   *shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) 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.

(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, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.

In considering the opposition under Section 5(1) with regard to the opponents' trade mark LIFE SYSTEMS it is clear that the trade marks of the opponent and applicant are identical. I do not consider the joining of the words either directly or with a hyphen to amend the general perception of the mark. However, consideration of the goods under each mark shows that with the exception of the goods under class 11, all of the other goods are in different classes and are therefore not identical. Having considered the nature of the goods of each party within class 11 I conclude that the goods are not identical. Therefore the opposition under Section 5(1) fails as the goods are not identical.

Moving onto the opponents' mark LIFESTREAM, the mark is clearly not identical to the applicants' series of marks and so the opposition under Section 5(1) based on this mark also fails.

To determine the outcome of the opposition under Section 5(2) I must consider first the likelihood of confusion from use by the applicant of LIFESYSTEMS in light of the earlier registration in the opponents' name for an identical mark. In deciding this I have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

*"A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified."*

Later in the judgement they stated:

5                   *“It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”*

10 I shall first consider the opponents’ mark LIFE SYSTEMS which is registered for goods in classes 8,10,11 & 21 against the applicants’ series of marks LIFESYSTEMS / LIFE-SYSTEMS / LIFE SYSTEMS in classes 1,3,5,9,11 & 24 (the full specifications are given earlier in this decision).

15 Following the judgement in Case C-39/97 the factors set out in the British Sugar Plc v. James Robertson & Sons Ltd case [TREAT] (1996 RPC 281) can be regarded as no more than general guidance in the matter of similarity of goods, however it is a good starting point. Therefore, when comparing the goods of the applicant to those of the opponent in terms of:

a) the respective uses of the respective goods;

20 b) the respective users of the respective goods;

c) the physical nature of the goods;

d) the respective channels of trade;

25 e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

30 f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

35 I reach the conclusion that the applicants’ goods under classes 1,3,5 & 24 are not similar to the opponents’ goods in classes 8,10,11 & 21. This finding is confirmed by the fact that the opponent put forward no arguments or evidence to the contrary. The applicants’ goods in class 11 are “Water Purifiers”, whilst the opponents goods under class 11 have been listed earlier in this decision. None of the categories of goods listed would appear to be similar to the applicants goods even though they are in the same class.

40 The only area of contention is between the applicants’ goods in class 9 (electronic devices for attracting and killing insects) and the opponents’ goods in class 11 ( aromatherapy diffusing apparatus). The opponents’ product is designed to improve health by the absorption of essential oils either through the skin or by inhalation. The diffuser requires to be charged with the essential oil which the user deems to be the most suitable for them depending on whatever outcome they wish to be achieved eg relaxation, invigoration etc. The product is intended to be used throughout the year and in all parts of the UK. Out of the 35 fragrances offered by the opponents for use in their diffuser only two claim to have the properties to repel insects. In the TREAT case Jacob J. stated:

50                   “Notwithstanding what is said on the label, the use of the spread with a dessert is in practice likely to be slight. Mr Lloyd Jones, Robertson’s Marketing Director, thought that

all potential uses of the product, otherwise than as a spread, amounted to less than 5% of volume. The product comes in a jam jar because it is like a jam. No-one would describe a jam as a ‘dessert sauce’ in ordinary parlance, yet it too can be used on a dessert and everyone knows and sometimes does that. Supermarkets regard the product as a spread.  
5 The jam jar invites use as a spread. When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade. The Robertson product is not for the purpose of trade, a dessert sauce.”

10 By contrast the applicants’ goods are designed to attract insects and then to kill them. It has no other uses, although it might be argued that by killing insects such as mosquitoes there is a beneficial health effect. Utilising the TREAT test it is clear that the products will be seen in the trade as being different.

15 The users of the products will also differ with the opponents’ goods being purchased by those who have an interest in alternative medicine, whilst the applicants’ goods will be purchased by those either travelling to or living in an area where mosquitoes and other biting insects are prevalent. No evidence has been filed as to the channels of trade but I would expect the opponents’ goods to be sold in health shops whilst the applicants’ goods would I expect be sold alongside other travel  
20 related goods in a variety of different outlets. Neither has the opponent filed any independent evidence of confusion nor reputation. I therefore find that the goods are not similar and that there is no likelihood of confusion.

25 The opposition under Section 5(2) therefore fails

I now turn to the opponents other trade mark LIFESTREAM registered for goods in classes 3 & 11 and compare them with the applicants’ series mark LIFESYSTEMS / LIFE-SYSTEMS / LIFE SYSTEMS for goods in classes 1,3,5,9,11 & 24 (the full specification for the goods in each calls  
30 have been detailed earlier in this decision).

The goods of the two parties are not identical, although those covered under class 3 would be considered similar.

35 The marks are obviously not identical. Despite being of similar length and having the same number of syllables they are different enough, both visually and phonetically, that there is unlikely to be confusion even allowing for imperfect recollection. No argument has been made as to conceptual similarity, and in my view there is only a slight similarity in the images evoked by both marks. The differences between the marks LIFESTREAM and LIFESYSTEMS is sufficient to avoid a  
40 likelihood of confusion even if the respective marks were used on identical goods.

The opposition under Section 5(2), for the opponents mark LIFE STREAMS therefore fails.

I now move onto the opposition under Section 5(3). The opponent has not filed any evidence of reputation other than to state in his declaration that substantial goodwill and reputation has been  
45 acquired. No independent testimony has been filed, nor has any survey evidence from the relevant public. The opponent has not shown the turnover in their mark, or commented on their share of the market. Further, the opponents have not shown how the use of the applicants’ mark would damage them. In the absence of any evidence of how use of the applicants’ mark would take unfair advantage of or be detrimental to the distinctive character or repute of the opponents’ mark, I find  
50 that the opposition under Section 5(3) for both the opponents marks fails.



In considering the opposition under Section 5(4) I adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

5            *“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.*

10            *A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is ( with footnotes omitted) as follows:*

15            *‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:*

20            *(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*

25            *(2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and*

30            *(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.*

35            No evidence has been filed to show that there has been misrepresentation by the applicant or that the opponent has a reputation in the market, or that they have or are likely to suffer damage. None of the goods for which the opponents mark is registered are similar enough to give rise to a likelihood of confusion if the applicants marks are put into use. I therefore find that the opposition under Section 5(4) fails.

40            The opposition having been unsuccessful the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £ 735.

45            Dated this    3    day of February 1999.

50            George W Salthouse  
              For the Registrar  
              The Comptroller General