O/0027/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00918299870
IN THE NAME OF SELITA SRL
FOR THE FOLLOWING TRADE MARK:

Brow Bomber

IN CLASSES 3, 8, 35 AND 41

AND

IN THE MATTER OF AN APPLICATION FOR A DECLARATION
OF INVALIDITY UNDER NO. 505830
BY GLOBAL BEAUTY PRODUCTS LIMITED

BACKGROUND AND PLEADINGS

1. On 31 August 2020, Selita srl ("the proprietor") applied to register the trade mark UK00918299870[1] shown on the cover page of this decision in the UK ("the contested mark"). Registration was granted on 23 December 2020. The contested mark stands registered for the following goods and services:

> **Class 3:** *Essential oils and aromatic extracts; Toiletries; Cleaning and fragrancing preparations.*
>
> **Class 8:** *Hand-operated hygienic and beauty implements for humans and animals.*
>
> **Class 35:** *Advertising, marketing and promotional services.*
>
> **Class 41:** *Education, entertainment and sports; Education, entertainment and sport services; Publishing, reporting, and writing of texts.*

2. On 14 February 2023, Global Beauty Products Limited ("the applicant") sought a declaration of invalidity against the contested mark under Section 47(1) and (2) of the Trade Marks Act 1994 ("the Act"). The application is based upon Sections 3(6) and 5(4)(a) of the Act.

3. Under Section 3(6), the applicant alleges that the contested mark was filed in bad faith because the proprietor applied for the mark in order to (a) seek protection for goods and services for which there was no intention to use the mark and (b) harm the interest of the applicant. In particular, the applicant alleges that bad faith is supported by the following circumstances:

[1] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the proprietor's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

- The proprietor is a commercial entity incorporated in Italy. It does not have any UK subsidiaries.

- The proprietor trades under the name 'In Lei' via a number of websites including the business website www.inlei.it through which it promotes and markets its business. The business website states that the proprietor *"develops products for lash and brow lamination and tinting intended for professional use".* The proprietor does not claim to offer any other goods or services to the public under the contested mark. The proprietor also operates the retail website www.lightlashes.it which is used to market and promote cosmetic products for use on the eyebrows and eyelashes.

- Within the business website and the retail website, the contested mark is used solely in respect of an eyebrow lamination treatment product (i.e. treatment intended to detail, define and correct a user's eyebrow arch). Specifically, the contested mark is used in respect of a product described by the proprietor as a 'nourishing brow butter' which is designed to act as a pomade for use on the eyebrows for the purpose of making the eyebrow hair *"obedient, soft, silky and nourished"*. This product is marketed solely as an *"eyebrow treatment*". Further, the retail website warns users that the cosmetic product is to be used as an *"eyebrow treatment only*" and that it is "*absolutely forbidden to use it on eyelashes"* for safety reasons (namely, that "*it can cause serious eye damage"* if misused).

- Based on the above, the applicant submits that the proprietor intends to use the contested mark in respect of the cosmetic lamination product only and does not intend to use it in respect of any of the registered goods and services. However, despite the proprietor solely using the contested mark in respect of the cosmetic lamination product, the contested mark notably excludes cosmetic products in class 3 and the registered goods do not cover the cosmetic lamination product for which the mark is used. In particular, the applicant submits that *"toiletries"* for which the contested mark is registered are goods which differ significantly to *"cosmetics"; "toiletries"* are typically understood to

be goods used in cleaning and washing oneself such as soaps, shampoo and toothpaste, whereas *"cosmetics"* are products used to artificially change one's appearance. The applicant submits that the proprietor has no intention of using the contested mark across the goods and services for which the contested mark is registered as doing so would undermine the proprietor's safety message that the mark signifies an eyebrow lamination product. Therefore, the applicant submits that there is no foreseeable commercial prospect of use.

- In light of the above, the applicant submits that the proprietor lacked the *bona fide* intention required under Section 31(3) of the Act at the time of filing to use the contested mark in respect of the goods and services for which it is registered and alleges that the proprietor's rationale for filing the contested mark in respect of goods and services other than *"cosmetic products*" was tactical. In particular the applicant submits that:

    a. The contested mark was widely used in the UK to market an eyebrow lamination and cosmetic product at the time of filing the EUTM from which the contested mark derives.

    b. The word 'BOMB' is commonly used in trade to describe cosmetic products which add volume or thicken the appearance of one's eyebrows and eyelashes, and the word 'BROW' refers to the user's eyebrows. As such, the proprietor expected the relevant intellectual property office to object to any application for the mark in respect of "*cosmetics*" in class 3 on the basis that the contested mark was devoid of distinctive character and/or descriptive of such goods. Therefore, the proprietor chose not to file the contested mark in respect of "*cosmetics*" in class 3, despite using it solely in respect of the cosmetic lamination product.

    c. Instead, the proprietor sought to file the contested mark for goods and services for which the aforementioned objection was less likely to arise, but which could be argued to be similar to "*cosmetics*" (in which the owner bears an interest given that the mark is used solely in respect of a cosmetic product) when it came to opposing third party marks and for

the purpose of enforcement. As such, the applicant submits that the proprietor sought to obtain the registration for "*toiletries*" and other goods and services for which the mark is registered despite having no intention to ever use the mark in respect of such goods and services.

d. In summary, the applicant submits that the contested mark was filed:

   i. With the knowledge that the mark was only to be used in respect of the cosmetic product.

   ii. With the knowledge that an application for the mark covering *"cosmetics*" may be objected to on absolute grounds.

   iii. With the intention of filing the mark, instead, in respect of goods and services for which the owner lacked any bona fide intention to use the mark for the purpose of obtaining registered protection for the mark in respect of goods and services arguably similar to *"cosmetics*".

   iv. By applying to register the contested mark for goods and services other than "*cosmetic products*", the applicant submits that the proprietor has sought to bypass any objection on absolute grounds for the purpose of obtaining protection for the contested mark in respect of goods and services that, although the mark is not used in respect of, are arguably similar to "cosmetics" and which therefore can be weaponised against third party competitors legitimately using marks similar to the contested mark to market "*cosmetics*".

   v. Further, given the proprietor's use of the contested mark in respect of the cosmetic lamination product only and its prominent warnings that the contested mark signifies a product for use on the eyebrows only, there is no realistic commercial prospect of use of the mark other than in respect of the cosmetic product.

vi. In addition, and/or in the alternative, the applicant submits that the proprietor had knowledge of the applicant's use of the marks 'BROW BOMB' and 'LASH BOMB' within the UK prior to the date of filing the contested mark. In this connection, the applicant claims that it will file evidence that it made first use of the marks 'LASH BOMB' and 'BROW BOMB' in connection with cosmetics in class 3 in 2015 (in Europe) and September 2019 (in the UK) respectively, some 12 months prior to the filing date of the contested mark and that use was so substantial, that the proprietor must have been aware of it. As such, the applicant submits that the contested mark was filed with the knowledge that the applicant had a better claim to the mark 'BROW BOMB' in the UK or, in the alternative, that the contested mark was filed with reckless disregard to that fact. Further, the applicant submits that the proprietor seeks to rely on the contested mark to prevent the applicant's registration and/or use of the mark 'BROW BOMB' despite the applicant having made substantial use of the same prior to the date of application of the contested mark.

4. Under Section 5(4)(a), the applicant relies upon the sign 'BROW BOMB' which it claims to have used throughout the UK since 1 September 2019 in relation to *"cosmetic goods in class 3 and educational services in the field of cosmetics*". The applicant claims that it has acquired a substantial reputation and goodwill under the sign and that use of the contested mark by the proprietor will give rise to a misrepresentation that the goods and services marketed under it are those of the applicant or are marketed with the consent of, or in connection with, the applicant. This, the applicant contends, will cause it substantial damage resulting from misdirecting sales away from the applicant to the proprietor and otherwise diluting the inherent distinctiveness and repute of the applicant's 'BROW BOMB' mark.

5. The proprietor filed a counterstatement in which it denies the claims, but makes the following admissions:

- It admits that it is in an entity incorporated in Italy and does not have any UK subsidiaries. The proprietor says that its business was set up in 2017.

- It admits that it trades under the name 'IN LEI' via various websites including www.inlei.it. However, the proprietor denies that the website is only for one type of cosmetic product which enhances eyelashes and eyebrows and states that the 'IN LEI' website and the retail website offer other goods and services, including those covered by the registered mark. However, as the proprietor also refers to goods being provided under different trade marks, it is not clear whether the other goods and services are supplied under the contested mark.

- It admits that the contested mark derives from a EUTM application filed on 31 August 2020.

6. In addition, the proprietor submits that:

- The proprietor's business is a nascent young business currently developing and expanding its range of goods, including research and development of new goods and is not beholden or limited to its current range of products. The mark in suit is not only one product but does currently concern eyebrow and eyelash treatments. These goods are under ongoing development and improvements and the proprietor's eyebrow and eyelash treatments form part of a nascent business which is a growing range of products and use of the mark is not beholden to the current technology or forever limited to the current uses. The proprietor has every intention of developing and expanding its product range in accordance with the organic growth of its business and natural development of its industry.

- The original EUTM from which the contested mark derives was filed in Italian and featured a specification of goods and services in Italian specifically using the Italian word "*Toiletteria*" which although correctly translated into English as the word *"Toiletries*" has an underlying broader meaning in the Italian language, denoting not just personal hygiene but general grooming. In the same way that

the English word '*toiletries*' can extend to items used for personal hygiene and grooming (rather than the narrower traditional English meaning of articles used for washing) the distinction between "*cosmetics"* and "*toiletries*" in the Italian language is not as strict as the applicant for cancellation implies.

- The proprietor has every intention to use the contested mark in respect of the goods and services for which it is registered, regardless of current safety messages which may be applicable at this time. The remaining goods and services in the registered specification are used in conjunction with and in addition to such lamination product and the use of the contested mark is still nascent. The future development of the contested mark remains to be seen but the specification for which the mark is registered falls reasonably within the general fields in which the mark is likely to be used, and indeed the field in which the mark has been used. Consequently, the registered specification was applied for in good faith.

- Any alleged goodwill associated with the sign 'BROW BOMB' is denied, in that as stated in the statement of grounds, the term 'BOMB' is commonly used to describe cosmetic products which add volume or thicken, and the applicant's sign 'BROW BOMB' is entirely descriptive as opposed to the proprietor's mark 'BROW BOMBER' which is a fanciful concept.

7. The applicant is represented by Asenda Law Ltd, and the proprietor is represented by Beck Greener LLP.

8. Both parties field evidence-in-chief with the applicant also filing evidence in reply.

9. A hearing took place before me on 26 June 2025, by video conference. Mr Aaron Wood appeared for the applicant. Mr Rowland Buehrlen appeared for the proprietor. Both parties helpfully filed skeleton arguments in advance of the hearing.

The evidence

10. The applicant's evidence in chief consists of one witness statement from Warren Gavin and two witness statements from Thomas Broster. The applicant's evidence in reply consists of a further witness statement from Thomas Broster. In addition to this evidence, the applicant also filed written submissions dated 18 October 2023.

11. Mr Gavin is the CEO of the applicant, a position he has held since the applicant's incorporation in 2015. Mr Gavin's witness statement is dated 18 October 2023 and is accompanied by 27 exhibits, being those labelled WG01 – WG27. Mr Gavin's evidence goes to the applicant's use of the sign 'BROW BOMB'.

12. Mr Broster is a solicitor, and director and shareholder of Asenda Law Ltd, the legal representative for the applicant. Mr Broster filed three witness statements dated 16 October 2023 (with exhibits TB01 – TB03), 13 March 2024 (with exhibits STB01 – STB17) and 26 June 2024 (with exhibits THTB01 – THTB16). Mr Broster's evidence includes evidence relating to use of the contested mark by the proprietor, evidence of convergence on the marketplace of cosmetic products and educational services, as well as evidence of, among others, transcripts of YouTube videos referred to in the proprietor's evidence.

13. The proprietor's evidence in chief consists of three witness statement from the following individuals:

- Tetyana Shcherbyna
- Christian Rowland Buehrlen
- Alberto Brambilla

14. Tetyana Shcherbyna is the founder and director of the proprietor. Her witness statement is dated 8 February 2024 and is accompanied by 15 exhibits being those labelled TS01 – TS15. Ms Shcherbyna's evidence goes to the use of the contested mark by the proprietor; in addition, it includes evidence of use by the applicant of the earlier sign 'BROW BOMB' in an allegedly descriptive manner.

15. Mr Buehrlen is a trade mark attorney employed by Beck Greener LLP, the proprietor's legal representative; he also attended the hearing on behalf of the proprietor. Mr Buehrlen's evidence is dated 12 February 2024 and is accompanied by 11 exhibits being those labelled CRB01 - CRB11. His evidence goes to the use of the words 'BROW' and 'BOMB' by third parties on the Internet.

16. Alberto Brambilla is an IP attorney and EUIPO representative for the proprietor. His evidence is dated 8 February 2024 and is accompanied by one exhibit, being that labelled AB01. Mr Brambilla's evidence goes to the meaning of registered term 'toiletteria' which was applied-for when the EUTM from which the contested mark derives was filed.

17. I do not intend to summarise the parties' evidence (or their submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

EU Law

18. 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.

DECISION

Relevant statutory provision: Section 47

19. Sections 3(6) and 5(4)(a) of the Act both have application in invalidation proceedings because of the provisions of Section 47 of the Act, which states as follows:

> "47. (1) […]

(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) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) …
(2B) …
(2C) …
(2D)-(2DA) [Repealed]

(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) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(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).

(3) […]
(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

20. Since at the hearing the Section 5(4)(a) was discuss first, I shall follow the same order.

Section 5(4)(a)

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

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

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

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

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

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

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

24. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

25. Before I turn to the evidence, I need to determine what is the relevant date for the purpose of assessing whether the applicant has valid passing off claim. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (now KC), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'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.' "

26. At the hearing, Mr Wood submitted that the relevant date is the filing date, which is 31 August 2020. Mr Buehrlen did not argue with that approach.[2] Accordingly, I shall proceed on that basis.

Goodwill

27. There is one issue I need to focus on when looking at the evidence. The issue, which was raised by Mr Buehrlen at the hearing, is whether the applicant's evidence says what it appears to say. If I agree with Mr Buehrlen that the applicant's evidence gives a misleading impression of what the exhibits show, I must nonetheless consider whether Mr Buehrlen's late challenge to the applicant's evidence is barred as being out of time (and the applicant's evidence should be taken at face value). Alternatively, if I consider that despite the challenge being late it should be given some weight, I must consider whether (a) the applicant's evidence should be rejected or (b) it would be more appropriate to re-open the evidence round in order to give the applicant an opportunity to reply. The background of the challenge is as follows.

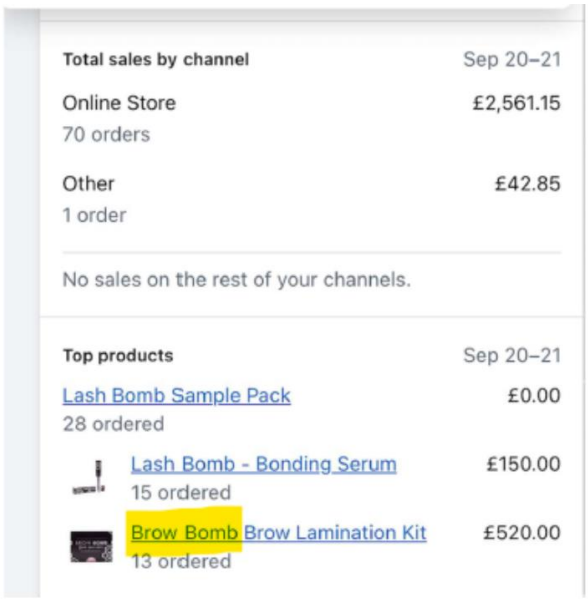
28. At paragraph 6 of his witness statement, Mr Gavin says that the first marketing of products in the UK under the earlier mark dates back to 20 September 2019 stating as follows (emphasis added):

> *"On 20 September 2019 we made eyebrow cosmetic products (including a cosmetic cream, a cosmetic lotion and a moisturising serum, all for use on the eyebrows) available for sale within the United Kingdom, via the Website, under the Earlier Mark, as well as associated ticketed training sessions relating to use of those products under the Earlier Mark* ***(the Products).*** *The Products were marketed and sold to the UK public via the Website under the Earlier Mark (either as individual units or with multiple units included within a ticketed training session). In evidence of the same, attached and shown to me at Exhibit WG1 is a social media post with a publication date of 20 September 2019,*

[2] Whilst Ms Shcherbyna referred in her witness statement to use of the word BROW BOMBER in an invoice dated 31.01.2020 and an email dated 29.11.2019, the documents are in Italian (without translation) and cannot establish "the beginning of the behaviour complained" about the UK.

published via our 'Beautiful Brows' Instagram account, which promoted the launch of the Products to the public under the Earlier Mark."

29. Mr Buehrlen started by saying that the above paragraph establishes that the products referred to as "*the capital P Products"* were marketed and sold in the UK via the website under the earlier mark. Mr Buehrlen then referred to the subsequent paragraph which introduces exhibit WG3, pointing out that it shows how on 6 August 2020 the applicant's website beautifulbrowsandlashes.com displayed, along with a 'Brow Bomb Brow Lamination Kit', other products featuring names which are descriptive and are not used as trade marks (i.e. Beautiful Brows Duo Eyebrow Kit, Eyelash and Eyebrow Tint, Protective Full Face Safety Pink Beauty Shield). The next paragraph to which Mr Buehrlen referred me is paragraph 8 which introduces exhibit WG4 – this is described as a document obtained from Shopify which sets out that 13 units were sold to the public, via the applicant's website, under the earlier sign 'BROW BOMB' between 20 and 21 September 2019. This evidence looks like this:



Total sales by channel	Sep 20–21
Online Store 70 orders	£2,561.15
Other 1 order	£42.85
No sales on the rest of your channels.	
Top products	**Sep 20–21**
Lash Bomb Sample Pack 28 ordered	£0.00
Lash Bomb - Bonding Serum 15 ordered	£150.00
Brow Bomb Brow Lamination Kit 13 ordered	£520.00

Source: order receipts demonstrating sale of 'BROW BOMB' products between 20 – 21 September 2019 obtained from the Applicant's internal records

30**.** Mr Buehrlen argued that this exhibit indicates that there is a distinction between *"capital P products"* which bear the earlier sign 'BROW BOMB' and *"lower p products"* which are other products that are not 'BROW BOMB' products. He also added that this

exhibit demonstrates how easy it is for the applicant to show the exact unit sales of *"capital P Products*" that are products sold under the sign 'BROW BOMB'.

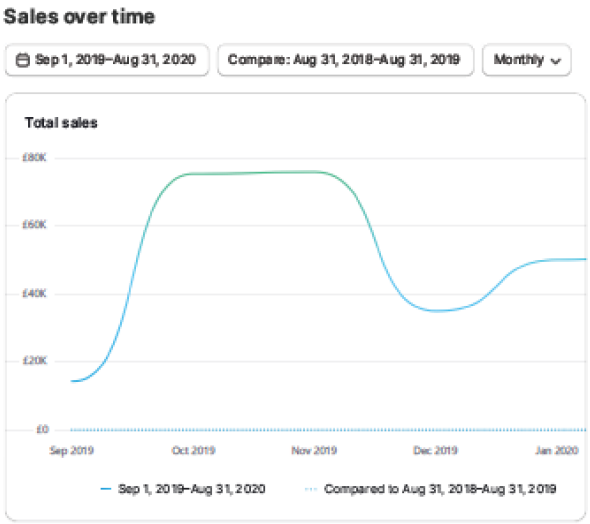
31. Then we moved on to the crux of the issue which are paragraphs 9 and 10 of Mr Gavin's witness statement which state:

> ***"Sales between 20 September 2019 and 31 December 2019***
> *9. Between the dates of 20 September 2019 and 31 December 2019 (circa 3 months), we:*
>
> a. ***sold in excess of 5,500 individual units of Products under the Earlier Mark via the Website to the British public.*** *In evidence of the same, attached and shown to me at Exhibit WG5 is a document obtained from Shopify, analytics provider in respect of the Website, showing data relating to the sale of products bearing the Earlier Mark only between the period of September 2019 and 31 December 2019 and which evidences that, during this period, 5,536 orders of products bearing the Earlier Mark were placed and accepted by us via the Website; and*
> b. ***generated in excess of £181,700 in gross sales in respect of the individual units of Products sold under the Earlier Mark via the Website to the British public.*** *In evidence of the same, attached and shown to me at Exhibit WG5 is a document obtained from Shopify, analytics provider in respect of the Website, showing data relating to the sale of products bearing the Earlier Mark only between the period of September 2019 and 31 December 2019 and which evidences gross sales income of £181,706.61 in respect of the aforementioned period.*
>
> ***Sales between 20 September 2019 and 30 August 2020***
>
> *10. Between the dates of 20 September 2019 and 30 August 2020 (circa 11 months) we:*
>
> a. ***sold in excess of 18,000 individual units of Products under the Earlier Mark via the Website to the British Public.*** *In evidence of the*

same, attached and shown to me at Exhibit WG6 is a document obtained from Shopify, analytics provider in respect of the Website, showing data relating to the sale of products bearing the Earlier Mark only between the period of 20 September 2019 and 31 August 2020 and which evidences 18,148 orders of products bearing the Earlier Mark; and

b. ***generated more than £444,000 in gross sales in respect of the individual units of Products sold under the Earlier Mark via the Website to the British Public.*** *In evidence of the same, attached and shown to me at Exhibit WG6 is a document obtained from Shopify, analytics provider in respect of the Website, showing data relating to the sale of products bearing the Earlier Mark only between the period of 20 September 2019 and 31 August 2020 and which evidences gross sales income of £445,940.58 in respect of the aforementioned orders."*

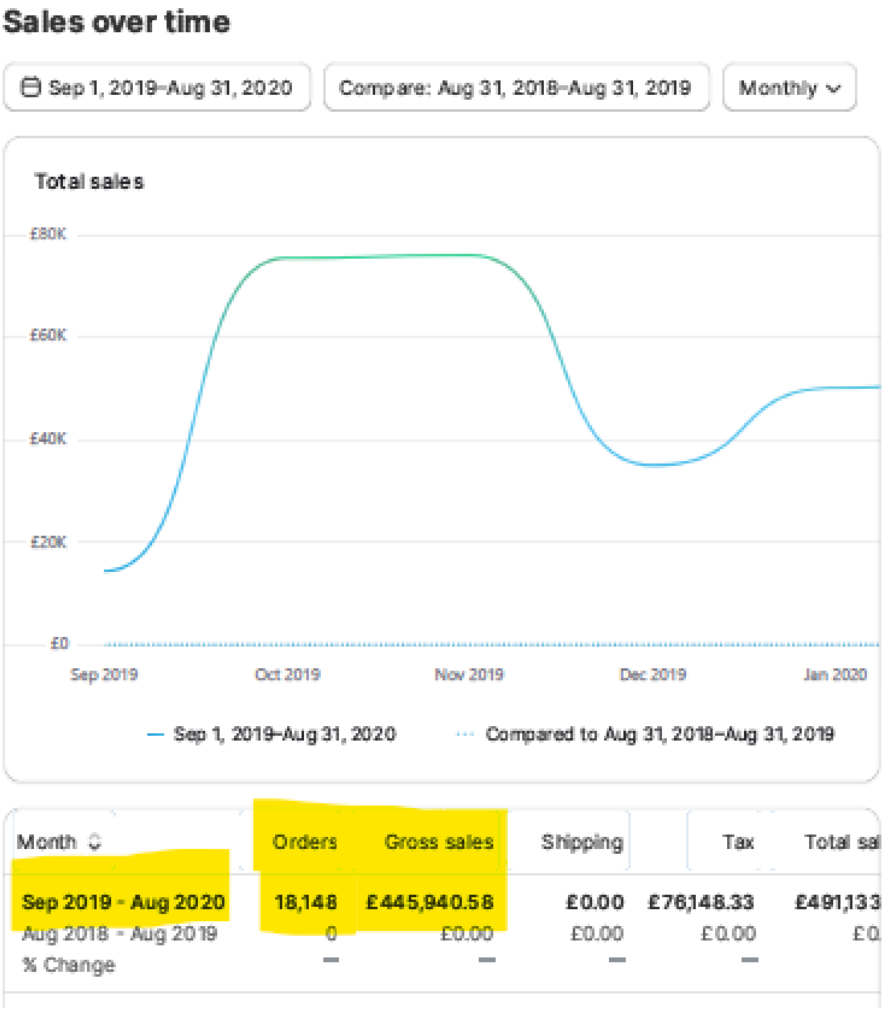
32. The two exhibits provided in support of these statements are Exhibit WG5 and Exhibit WG6. Exhibit WG5 looks like this:



Month	Orders	Gross sales	Shipping	Tax	Total sal
Sep 2019 - Aug 2020	18,148	£445,940.58	£0.00	£76,148.33	£491,133
Aug 2018 - Aug 2019	0	£0.00	£0.00	£0.00	£0.
% Change	–	–	–	–	
Sep 2019	225	£12,730.00	£0.00	£2,365.61	£14,313.
Aug 2018	0	£0.00	£0.00	£0.00	£0.
Oct 2019	1,301	£65,350.00	£0.00	£12,278.89	£75,253.
Sep 2018	0	£0.00	£0.00	£0.00	£0.
Nov 2019	2,363	£71,171.54	£0.00	£11,664.97	£75,807.
Oct 2018	0	£0.00	£0.00	£0.00	£0.
Dec 2019	1,647	£32,455.07	£0.00	£5,313.46	£34,927.
Nov 2018	0	£0.00	£0.00	£0.00	£0.

33. The total number of units sold between 20 September 2019 and 31 December 2019 is 5,536 and the total value of these sales is £181,696 confirming what Mr Gavin says at paragraph 9 point (a).

34. Exhibit WG6 looks like this:



Month	Orders	Gross sales	Shipping	Tax	Total sal
Sep 2019 - Aug 2020	18,148	£445,940.58	£0.00	£76,148.33	£491,133
Aug 2018 - Aug 2019	0	£0.00	£0.00	£0.00	£0.
% Change	—	—	—	—	

35. The total number of units sold between 20 September 2019 and 30 August 2020 is 18,148 and the total value of these sales is £445,9740 confirming what Mr Gavin says at paragraph 9 point (b).

36. When commenting on this evidence, Mr Buehrlen accepted that on a fair reading of this evidence all the 5,500 products sold in the period between 20 September 2019 and 31 December 2019 were 'BROW BOMB' products. I think this is right and it is how I read paragraph 9 in conjunction with Exhibit WG5. Likewise, a fair reading of

paragraph 10 is that the total number of units sold between 20 September 2019 and 30 August 2020 is 18,148 and the total value of these sales is £445,9740. This is how I read paragraph 10 in conjunction with Exhibit WG6.

37. However, Mr Buehrlen argued that the above evidence is misleading because: (1) Exhibit GW 4 demonstrates that the applicant could have easily proven that all of the orders it claims were made under the earlier mark were sales of 'BROW BOMB' products by providing similar product data from Shopify which it has not done and (2) in paragraph 9 and 10 of his witness statement, Mr Gavin refers to the products sold as *"small P"* products insofar as he states *"….attached and shown to me at Exhibit WG5 [and at Exhibit 6] is a document obtained from Shopify, analytics provider in respect of the Website, showing data relating to the sale of products bearing the Earlier Mark".* This, Mr Buehrlen argued, means that the exhibits show sales of *"lowercase P products"* (i.e. products which do not bear the earlier sign 'BROW BOMB').

38. Having heard Mr Buehrlen's submission, I pointed out that his reading of the evidence goes against what the witness unambiguously and clearly states, that is to say that all of the 5,500 and 18,148 products sold prior to the relevant date were products bearing the sign 'BROW BOMB'. I also asked Mr Buehrlen why the challenge was not made in time, to which he replied that he did not make any point until he had the opportunity to review the evidence in preparation for the hearing. I record that I was surprised by this answer since, as I pointed out at the hearing, someone else from the proprietor's representatives must have reviewed the applicant's evidence when it was filed. However, Mr Buehrlen's answer was *"Yes, we reviewed the evidence. This was evidence that we saw. We saw it for what it is"* which I take to mean that the inconsistency Mr Buehrlen identified was not obvious.

40. I do not think Mr Buehrlen's submission has any legs to stand. This is because:

i. Nowhere in his witness statement does Mr Gavin draw a clear distinction between *"capital P products*" and *"lower p products".* Whilst he admittedly referred to the products bearing the sign 'BROW BOMB' as *"capital P products"* he did not say that this reference means that when the word "products" is used with a lower case 'p' that rigorously means that the products are products sold

under different brands (i.e. non-'BROW BOMB' products). I am fortified in this conclusion by Exhibit WG4 which refers to 'BROW BOMB' products with a lower 'p' as shown below:

Source: order receipts demonstrating sale of 'BROW BOMB' products between 20 – 21 September 2019 obtained from the Applicant's internal records

ii. At paragraphs 9 and 10 of his witness statement, Mr Gavin refers to the applicant having sold *"in excess of 5,500 individual units of Products under the Earlier Mark"* and *"in excess of 18,000 individual units of Products under the Earlier Mark"*. In these sentences, Mr Gavin uses the *"capital P products"* to denote products sold under the sign 'BROW BOMB' in addition to clearly stating that the goods were sold under the earlier mark. The subsequent reference to "*lower p products"* in the same paragraph is likely to be an oversight and cannot be taken to signify an internal inconsistency in the evidence.

iii. At paragraph 11 of his witness statement, Mr Gavin states as follows:

"Further, between the dates of 20 September 2019 and 30 August 2020 (circa 10 months and 1 week), we also sold numerous other products bearing the mark 'BOMB' via the Website. Those sales amounts to in excess of 33,000 individual units of products marketed under a mark containing the word 'BOMB' (including Products bearing the Earlier Mark and 'LASH BOMB') and generated in excess of £900,000 in gross sales of the same. In evidence of the same, attached and shown to me at Exhibit WG7 is a document obtained from Shopify, analytics provider in respect of the Website, showing data relating to the sale of products bearing the mark 'BOMB' between the period of 20 September 2019 and 31 August 2020 and which evidences 33,262 orders of products were made and which evidences gross sales income of £914,864.43 in respect of the aforementioned orders".

The above paragraph confirms that, contrary to Mr Buehrlen's argument, Mr Gavin had clear in his mind the distinction between 'BROW BOMB' products and products sold under other brands containing the word 'BOMB'. In fact, he

provided separate unit and sale figures for these products, which are higher than the figures provided for 'BROW BOMB' products.

41. I should also say that although the invoices exhibited at WG8-17 are for single purchases of 'BROW BOMB' cosmetic products (i.e. creams and serums) and lamination courses sold between 4 September 2019 and 2 August 2020, these are only examples and, as noted by Mr Iain Purvis KC sitting as the Appointed Person in *DAILY RITUAL*, BL-O/005/21, it is not necessary for a witness to provide documentation showing each sale:

> "23. I see no difficulty with an informed witness summarizing in tabular form the records of his company as to the sales of a particular brand in the UK without exhibiting the actual records. Nor do I see any difficulty with them giving a general account of the lines of products sold under a brand, with some support in the form of archived website extracts, without providing documentation showing each and every item, when it was sold and for what price."

42. Lastly, I bear in mind that in *TUI v Griffiths,*[3] at paragraph 42, the Supreme Court endorsed the general rule set in out in *Phipson on Evidence* (20th ed. Paragraph 12), with an emphasis on ensuring fairness. The general rule being that:

> *"In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases…"*

43. It is our practice, in proceedings before this Tribunal, that in cases where criticisms of the other party's evidence are not broached until final written submissions, or at the hearing, and the hearing officer deems that this will cause unfairness to the other side, the submission will be given reduced or no weight, or, if deemed necessary, the proceedings may be delayed (with likely cost implications). This means that the outcome will always rely on the particulars of the case. Further, the Supreme Court expressly identified circumstances in paragraphs 61–67 of its judgment where

[3] *TUI UK Ltd v Griffiths* [2023] UKSC 48

previously unchallenged and uncontroverted evidence can properly be rejected, despite the absence of cross examination or prior notice. They include:

(1) The challenge is directed at collateral or insignificant evidence.
(2) The evidence is manifestly incredible.
(3) The 'evidence' consists of a bold assertion without supporting reasons.
(4) There is an obvious mistake on the face of the evidence, which includes internal inconsistency.

44. In this case, the evidence challenged by Mr Buehrlen is material. Further, Mr Gavin's evidence about the number of units sold and the turnover generated under the mark 'BROW BOMB' is not inconsistent and it is not manifestly incredible. Lastly, the evidence is supported by documentary evidence (although it is not as specific as Mr Buehrlen argues it could have been) and there is no obvious mistake.

45. Accordingly, for all of the above reasons, I have no reason to disbelieve Mr Gavin's evidence about the sales, and I reject Mr Buehrlen's challenge to that evidence.

46. Hence, I will proceed on the basis that the applicant's evidence establishes that:

- Between 20 September 2019 and 31 December 2019, the applicant sold in excess of 5,500 units of cosmetic products for eyebrows under the earlier sign 'BROW BOMB' in the UK generating a turnover of in excess of £181,000.

- Between 20 September 2019 and 30 August 2020, the applicant sold in excess of 18,000 units of cosmetic products for eyebrows under the earlier sign 'BROW BOMB' in the UK generating a turnover of in excess of £444,000.

47. These are all sales and turnover generated in the UK prior to the relevant date in relation to the goods claimed.

48. Whilst the evidence also establishes that the applicant sold in excess of 33,000 units of products under the brand 'BOMB' including 'LASH BOMB', it does not assist the applicant because those sales relate to different brands.

49. The rest of Mr Gavin's witness statement reinforces the evidence about the number of units sold and their value (as set out above), insofar as it demonstrates that the applicant made reasonable marketing efforts by spending over £51,000 in promoting its 'BROW BOMB' products to UK-based users of Google prior to the relevant date.

50. However, before reaching a conclusion on whether the amount of trading carried out by the applicant would be sufficient to establish an actionable goodwill at the relevant date, I must consider Mr Buehrlen's argument that the conclusion that the evidence falls short of what would have been necessary to establish sufficient goodwill to maintain a claim of passing off is fortified by the descriptiveness of the sign in issue.

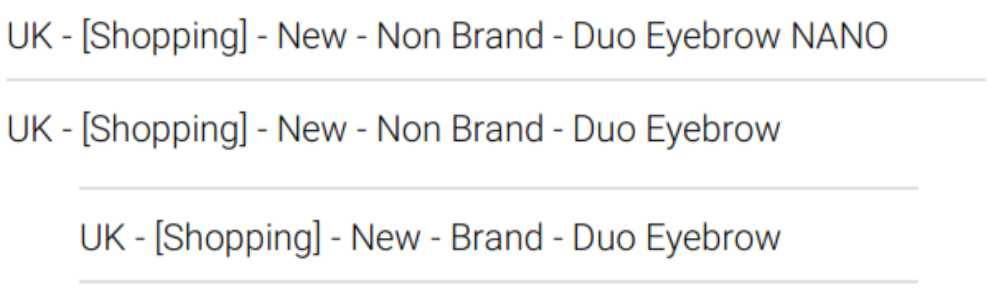
51. The goods and services in relation to which the mark has been used relate to a treatment called *"brow lamination"* or "*brow perming"*[4] which is a beauty treatment that straightens, lifts, and sets the user's eyebrow hairs in place for a fuller, prominent and more defined look. At the hearing, Mr Buehrlen argued that the applicant's evidence about Google Adverts[5] shows that 'BROW BOMB' is described as a non-brand as opposed to other terms such as "Duo" which is qualified as brand as shown below:

Description	Quantity	Units	Amount(£)
UK - Search - [Generic] - Brow Lamination	6470	Clicks	3,367.72
UK - [Shopping] - New - Non Brand - Brow Bomb	2368	Clicks	1,977.85
UK - [Shopping] - New - Non Brand - Lash Bomb	1498	Clicks	1,008.13
UK - Search - [Brand] - Duo	163	Clicks	112.51

52. The problem with this submission is that the Google Adverts statements are marketing-led and the way they qualify a term/keyword (for the purpose of targeting

[4] TS5
[5] Exhibits WG18-23

and driving search results), does not necessarily correspond to how the consumers of the relevant goods and services perceive the term/keyword, i.e. as a trade mark as opposed to a descriptive word. The unreliability of the Google Adverts description for the purpose of deciding whether the phrase 'BROW BOMB' is descriptive is also demonstrated by the fact that whilst some descriptions identify the word 'DUO' as a brand (and Mr Buehrlen accepted at the hearing that 'DUO' is a brand), other descriptions identify the same word as a "non-brand" as shown below:



53. The same goes for the phrase 'BROW BOMB' that is identified both as a brand and as a non-brand:[6]

54. Whilst this evidence is not determinative, it adds weight to Mr Buehrlen's argument about 'BROW BOMB' having an element of descriptiveness for cosmetic goods used on eyebrows and related beauty treatment services. However, in my view, the element of descriptiveness of 'BROW BOMB' lies in the word 'BROW' which is obviously descriptive of cosmetic goods and services directed at the eyebrows (see Cambridge online dictionary which defines "*brow*" as "*an eyebrow*"). Admittedly, the word 'BOMB' is likely to be perceived by the average consumer of products that make the eyebrows fuller as an allusion to the effects of the products, i.e. a product/beauty treatment that

[6] WG18 page 3

makes the eyebrows explode in a sense that they look fuller, more prominent and voluminous. However, this reference to the effect of the product is, in my view, sufficiently allusive not to be descriptive; nonetheless, I also find it sufficiently allusive to create a mark which is inherently low in distinctiveness.

55. Mr Buehrlen also submitted that the applicant admitted that the sign 'BROW BOMB' is descriptive. Mr Wood denied the claim and argued that although the applicant admitted that the word "BROW" means brow and that the word "BOMB" means bomb, it does not mean that they admitted that 'BROW BOMB' means a brow that is being bombed. Mr Wood further argued that the proprietor had mistakenly understood the applicant's pleadings and cannot rely on that misunderstanding to overcome the fact that it has not filed any evidence aimed at establishing the descriptiveness of 'BROW BOMB'. The relevant part of the applicant's pleadings is as follows (emphasis added):

> *"In particular,* ***the word 'BOMB' is commonly used in trade to describe cosmetic products which add volume or thicken the appearance of one's eyebrows*** *and eyelashes, and the word 'BROW' refers to the user's eyebrows*."

56. This statement was given in the context of the applicant saying that the proprietor applied for the contested mark in bad faith by not seeking protection for cosmetics in order to avoid the mark being found to be descriptive for those goods.

57. In my view, the above is a statement, not an admission. An admission is a response to an allegation. Technically speaking, something that was stated by the applicant in the context of its bad faith pleadings in relation to the distinctiveness of the contested mark is not an admission about the distinctiveness of the applicant's own sign in the context of the applicant's passing off claim. Having said that, inconsistencies in pleadings when multiple grounds are presented might weaken a claimant's case and its integrity and may tip the balance in favour of the respondent. In this case, the applicant's statement that the proprietor applied for toiletries as opposed to cosmetics in bad faith because 'BROW BOMB' would be descriptive for cosmetic products which add volume or thicken the appearance of eyebrows, certainly makes it difficult for the applicant to then turn around and argue that its own use of 'BROW BOMB' in relation

to cosmetics products for eyebrow lamination (a procedure designed to make the eyebrow look fuller and more defined) is use of a distinctive sign.

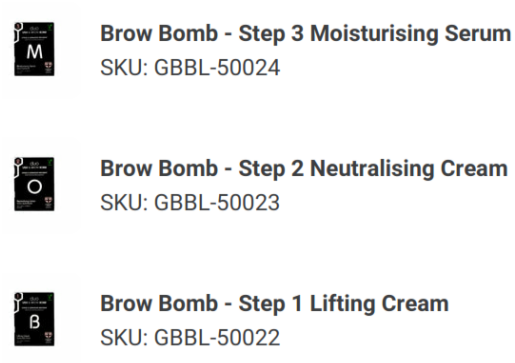
58. Mr Buehrlen also referred to Exhibit TS15 of Ms Shcherbyna's witness statement which, he contended, shows that the applicant uses the word 'BROW BOMB' descriptively within the phrase *"Lash & Brow Bomb"* in conjunction with the brand name 'DUO':

59. Whilst the above use tends to suggest that the words 'LASH & BROW BOMB' are used to denote the lamination procedure in itself rather than the origin of the goods, the invoices filed by the applicant show use of 'BROW BOMB' as a trade mark in conjunction with descriptive words such as 'Lamination Course' and 'Step 1 Lifting Cream', 'Step 2 Neutralising Cream' and 'Step 3 Moisturising Serum', as shown below:[7]

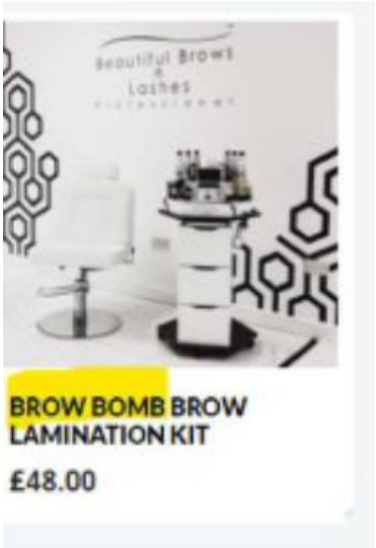
BROW BOMB
lamination Course

Brow Bomb Brow Lamination Course - Liverpool
SKU: BROWBOMB
Variant: Wednesday 16th October

[7] Exhibits WG8-17



60. A similar use can be seen on the applicant's website on 6 August 2020:[8]



61. This is, in my view, trade mark use in relation to the relevant goods because, as I have found above, the mark is not inherently descriptive, and it is used as a trade mark. The fact that, as Mr Buehrlen pointed out at the hearing, the invoices contain other items which are merely descriptive (e.g. eyebrow and eyelash tint starter pack, air blower), does not affect my conclusion.

62. Lastly, Mr Buehrlen argued that in her witness statement, Ms Shcherbyna says that 'BROW BOMB' is just descriptive. She stated at [16-17]:

> *"In the application for cancellation, it is suggested that my Company filed its European Union trade mark application and avoided the use of the word*

[8] Exhibit WG3

"cosmetics" to avoid potential objections or oppositions. This is simply not the case. The reality is that the specification, at least in the original Italian language, is a perfectly fair description of my Company's goods. That is to say that the product BROW BOMBER actually consists of essential oils and aromatic extracts, and can be fairly described in the broader category of "toiletteria". ***Furthermore the trade mark BROW BOMBER is an invented word to suggest or indicate a person who does a Brow Bomb who would otherwise be referred to as a beautician. The more descriptive term for products that provide a fuller eyebrow would be the simple term BROW BOMB.***

7. ***The words BROW BOMB are used descriptively by the Applicant for Cancellation.*** *There is now shown to me marked Exhibit TS15 a screenshot of the Applicant for Cancellation's product, using the descriptive phrase LASH & BROW BOMB. The actual trade mark used appear to be the mark duo. An ordinary consumer would simply understand the words LASH & BROW BOMB as merely descriptive of the purpose of the goods, namely, a treatment for your eyelashes and a treatment that provides a BROW BOMB for your eyebrow."*

63. I have already commented on Exhibit TS15 above and I do not think Ms Shcherbyna's statement adds much to it. In this connection, Mr Buehrlen submitted that among beauticians 'BROW BOMB' is just a descriptive term and that *"Ms Shcherbyna is a beautician",* and that "*she trains beauticians and she says it is a descriptive term"*. As Mr Wood correctly pointed out at the hearing, there is no evidence of Ms Shcherbyna being a beautician. However, the most important point here is that Ms Shcherbyna's evidence that 'BROW BOMB' would be *"the more descriptive term for products that provide a fuller eyebrow"* corresponds to the applicant's pleadings (though the same point was made by the applicant in the context of a different ground, namely that based on bad faith claim) and the applicant did not challenge that evidence.

64. Whilst I have rejected Mr Buehrlen's argument that the applicant's sign is entirely descriptive, Wadlow on the Law of Passing-Off 6th Ed. clarifies that in claims for

passing off it is important to distinguish between distinctiveness in fact and distinctiveness in law:

> "8-7 In considering whether a mark is distinctive for the purposes of passing-off, it is important to bear in mind that the matter relied on may be distinctive in the everyday sense but not in law. This arises particularly often in get-up cases but is not confined to them. The appearance of the furniture in *Jarman & Platt v Barget* was "distinctive" in the sense that the plaintiffs had virtually created the market for furniture of a striking design, although that appearance did not denote the trade source of the goods, so it was not distinctive in the legal sense. Conversely, in *Sodastream v Thorn Cascade* the colour grey was (arguably) distinctive of the plaintiffs' gas cylinders. In *Hoffman-La Roche v DDSA* the plaintiffs' black and green capsules were also novel, unique and eye-catching. The defendants' case, which was sound in law although it failed on the facts, was that they were not distinctive because to patients they denoted the chemical composition of the drug they contained rather than the identity of the manufacturer. In cases based on word marks too, even an invented and arbitrary term such as "linoleum" is not distinctive in law if its true meaning is as the generic name of the product.
>
> 8-8 Passing-off is relatively unconcerned with the distinction drawn in trade mark law between inherent capacity to distinguish and distinctiveness in fact. If factual distinctiveness exists, then it does not matter whether it was achieved with ease for a mark well adapted to distinguish or with difficulty for a mark of the opposite kind. If factual distinctiveness does not exist then a traditional passing-off case must fail. Passing-off never has to deal with the common situation in trade mark law of deciding how readily a mark not yet in use may become distinctive: the question is always whether an existing mark is distinctive in fact. Because of this and because there are few a priori restrictions on what may be considered distinctive, the supposed inherent capacity of a mark to distinguish is only one factor among many. If the claimant adopts a mark which is obviously descriptive or otherwise of low capacity to distinguish, then the evidential burden on him becomes higher but never impossible. The other effect of low inherent distinctiveness is that smaller differences will serve

to differentiate the defendant's goods when the claimant's mark is only marginally distinctive. However, this is true if the mark is weakly distinctive for whatever reason.

Burberrys v Cording

8-9The classic explanation of the principles on which the use of a particular word or other mark may be restrained as passing-off is that of *Parker J in Burberrys v Cording:*

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or, indeed, in any other way, to represent his own goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property to protect which it is granted is not property in the word or name, but property in the trade or goodwill which will be injured by its use. If the use of a word or name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure, another in his trade or business.

If no case of deception by means of such misrepresentation can be proved, it is sufficient to prove the probability of such deception, and the court will readily infer such probability if it be shown that the word or name has been adopted with any intention to deceive. In the absence of such intention, the degree of readiness with which the court will infer the probability of deception must depend on the circumstances of each particular case, including the nature of the word or name the use of which is sought to be restrained.

It is important for this purpose to consider whether the word or name is prima facie in the nature of a fancy word or name, or whether it is prima facie descriptive of the articles in respect of which it is used. It is also important for the same purpose to consider its history, the nature of its use by the person

who seeks the injunction, and the extent to which it is or has been used by others. If the word or name is prima facie descriptive, or be in general use, the difficulty of establishing the probability of deception is greatly increased, and again, if the person who seeks the injunction has not used the word or name simply for the purpose of distinguishing his own goods from the goods of others, but primarily for the purpose of denoting or describing the particular kind of article to which he has applied it, and only secondarily, if at all, for the purposes of distinguishing his own goods, it will be more difficult for him to establish the probability of deception.

But whatever be the nature of [sc or] history of the word or name, in whatever way it has been used, either by the person seeking the injunction or by others, it is necessary, where there has been no actual deception to establish at least a reasonable probability of deception. In such cases the action is, in effect a quia timet action, and unless such reasonable probability be established, the proper course is, in my opinion, to refuse an injunction, leaving the plaintiff to his remedy if cases of actual deception afterwards occur."

65. Accordingly, in passing off cases, whilst a sign might be inherently capable of distinguishing and inherently distinctive (which I found to be the case here), that does not necessarily mean that it is distinctive in fact.

66. In this case, the applicant has used the sign 'BROW BOMB' for cosmetic products used in brow lamination. As it will be recalled, I have concluded that whilst 'BROW BOMB' is sufficiently allusive not to be directly descriptive, the word 'BROW' is descriptive, and the word 'BOMB' is likely to be perceived by the consumer as being an allusive indication to the effects of the products creating a sign which is inherently low in distinctiveness. Furthermore, the way in which the applicant has used the sign on the products, i.e. along with the trade mark 'DUO' and within the words "Lash and Brow Bomb" does, in my view, convey to the consumer the message that 'BROW BOMB' is the name of the lamination procedure for lashes and eyebrows offered under the trade mark 'DUO'; the fact that the sign has also been used as a trade mark on the invoices and on the website does not take away from this fact. In addition, although neither party has referred to Mr Buehrlen's evidence in their oral submissions, there

is something in that evidence insofar as it shows that the term 'BROW BOMB' has been used by third parties prior to the relevant date on the Internet in relation to cosmetics and beauty treatments for eyebrow lamination; such evidence includes, for example, various YouTube videos entitled "*BOMB BROWS – HOW TO GET PERFECT EYEBROWS*" (2017), *"EYEBROW TUTORIAL – HOW TO GET BOMB BROWS"* (dated 5 years ago), "*BOMB BROWS – UPDATED TUTORIAL"* (dated 11 years ago), "*BOMB A** BROW!!SUPER EASY DIY BROW TINTING*" (2017) and *"TUTO LASHBOMB - BEAUTIFUL BROWS AND LASHES*" (2018). It also includes an Internet article date 4 January 2024 entitled "*How to get the perfect BROW BOMBS for beginners"*; and a printout of the website clarejamesbeauty.com providing 'BROW BOMB' lamination services with a copyright date of 2020.[9] This is the most the proprietor's evidence gets close to establishing that the applicant's mark has potential to be used descriptively to denote the lamination procedure for which the goods are used - and I have found that some of the applicant's uses are actually meant to convey the message that 'BROW BOMB' is the name of the lamination procedure for which the products are designed.

67. For the sake of completeness, I should mention here that the applicant filed evidence aiming at discrediting Mr Buehrlen's evidence. This consists of a witness statement from Thomas Broster introducing various exhibits including (i) a screenshot of a 'YouTube Help' webpage which describes the method by which a YouTube content creator is able to edit video settings, including by changing the title of an already uploaded and viewed video;[10] (ii) example of Mr Broster changing the name of a video he uploaded on his YouTube channel;[11] (iii) transcripts of YouTube videos referred to Mr Buehrlen's witness statement obtained using YouTube's auto-generated transcript function which it is said shows no mention of 'BOMB BROWS', 'BROW BOMB';[12] (iv) invoices demonstrating the sale of products under the mark 'BROW BOMB' made by the applicant to a 'Claire James' in Stafford;[13] (v) a screenshot of search results returning when searching for 'BROW BOMB' on www.google.com which Mr Broster says shows that the vast majority of search results

[9] Exhibits CRB1-11
[10] Exhibit THTB1
[11] Exhibit THTB2
[12] Exhibits THTB3, THTB4, THTB5
[13] Exhibits THTB8

returned (excluding references to the proprietor's products) are those of the applicant and its products.[14] I do not think this evidence gets the applicant anywhere in this case. It suffices to say that whilst the evidence at (i) and (ii) show that a content creator can change the title of the YouTube videos he/she uploaded on the Internet, there is no suggestion that the proprietor was the content creator of the videos introduced by Mr Buehrlen – hence I reject the suggestion that the titles of those videos were altered by the proprietor. Further, even if the applicant had sold 'BROW BOMB' goods to 'Claire James', descriptive use of the phrase 'BROW BOMB' on her business' websites only reinforces the conclusion that she understood 'BROW BOMB' to be the name of the treatment not the brand under which the goods were sold.

68. I now turn to draw together those findings as they apply to the issues I have to determine, which are goodwill, misrepresentation and damage.

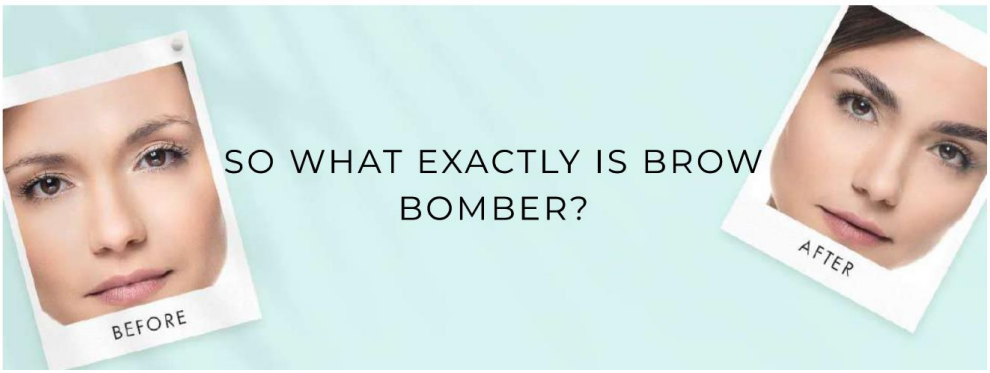
69. The applicant has used the earlier sign for less than one year prior to the relevant date. The use is not on a large scale, but is certainly more than trivial with more than 18,000 units of product being sold which generated a turnover of nearly £450K. However, inherently the sign 'BROW BOMB' is low in distinctiveness, and it is well established that for signs which are low in distinctiveness it will take longer to carry out sufficient trade with customers to establish enough goodwill in that sign so as to make it distinctive of the business which uses it.[15]

70. In this case, added to the shortness of the use, the applicant's sign is inherently low in distinctiveness and the applicant has used it not only for the purpose of distinguishing its own cosmetics goods from the goods of other traders, but also for the purpose of denoting or describing the lamination process for which the goods have been designed.

71. Lastly, although the applicant's statement that "*the word 'BOMB' is commonly used in trade to describe cosmetic products which add volume or thicken the appearance of one's eyebrows and eyelashes, and the word 'BROW' refers to the user's eyebrows*"

[14] Exhibit THTB16
[15] *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20)

is not an admission that the applicant's sign 'BROW BOMB' is descriptive, it definitely adds weight to the proprietor's limited evidence that the words 'BOMB' and 'BROW BOMB' have been used by third parties prior to the relevant date to describe cosmetic products of the kind of those sold by the applicant, whilst also corroborating my conclusion that 'BROW BOMB' has potential to be used, and has been used by the applicant, descriptively. I am fortified in this conclusion by the proprietor's own evidence of use, which refers to 'BROW BOMBER' as a brow lamination treatment as shown below:[16]



Brow Bomber

Eyebrow lamination

Brow Bomber is a treatment for eyebrows that aims to make natural eyebrows more beautiful, defined, tidy, nourished and easy to follow at home. Oh yes, this is the desire of every woman!

[16] Exhibit TS13

Brow Bomber is a brow lamination treatment where each product was carefully created to ensure that good care is taken of the eyebrow hairs and skin, resulting in healthy and shiny eyebrows!

GEL NAILS TRAINING EVENTS CLEARANCE

72. As it can be seen, the proprietor's website states: *"Brow Bomber is a brow lamination treatment where each product was carefully created to ensure that good care is taken of eyebrow hairs and skin, resulting in healthy and shiny eyebrows!".* It is therefore apparent that both parties have used 'BROW BOMBER' and 'BROW BOMB' to refer to the lamination treatment in itself, as well as a trade marks.

73. In those circumstances, I am of the view that even if the applicant's use might have been sufficient to create some goodwill, there would be no misrepresentation because:

(a) The signs 'BROW BOMB' and 'BROW BOMBER' are not identical and are sufficiently different to avoid misrepresentation bearing in mind the inherently low distinctiveness of the earlier sign, the applicant's descriptive use and the different conceptual message conveyed by the contested mark 'BROW BOMBER', which will be taken to refer to a beautician who carries out the 'BROW BOMB' lamination procedure. In this connection Mr Wood's submission that *"the case is made somewhat simpler by [the proprietor]'s admission that the word BROW BOMBER would be understood as a reference to BROW BOMB,* ***namely as indicating someone who does a BROW BOMB"*** further corroborates my conclusion that 'BROW BOMB' can be understood as the generic name of the lamination procedure itself.

(b) The goods and services are not identical. In this connection, I bear in mind that Mr Wood did not claim that the parties' goods and services are identical and in its

written submissions of 18 October 2023 the applicant carefully referred to the identity between the parties' businesses (as opposed to the identity between the goods in relation to which the applicant has uses the sign and the proprietor's registered goods and services) which share a common field of activity.[17] However, misrepresentation must be assessed based on the registered goods and services (which, according to the applicant's pleaded case do not include cosmetics) not on the goods effectively sold by the proprietor. Accordingly, the applicant's argument that the proprietor applied for the term *"toiletries*" as opposed to cosmetics to avoid the mark being refused for being descriptive in relation to cosmetics, means that I have to proceed on the basis that the goods (and services) are not identical, a fact which adds a further layer of distance between the signs. For the sake of completeness, I should also say that I agree with the applicant that the term '*toiletries*' in English would not cover the eyebrow cosmetic lamination products sold by the proprietor – in the absence of any evidence on the point, I base this conclusion on the dictionary definition of the word '*toiletries*' which is that of "*objects and substances that you use in washing yourself and preventing the body from smelling unpleasant"* (Cambridge online dictionary)*;* whilst this could also include some cosmetic products such as, for example, an exfoliant gel for washing that has both cleaning and beautifying properties, it would not include the proprietor's cosmetic lamination products for eyebrows. Lastly, even if there could be some degree of complementarity between the applicant's cosmetic products and the proprietor's registered goods and services (as for example, the evidence from Mr Broster[18] aims to establish this complementarity in relation to training services) that would not be sufficient to establish misrepresentation due to weak distinctiveness/descriptiveness of the earlier sign to which the applicant's goodwill (if it subsists) is associated.

74. Accordingly, I find that the passing off claim fails for absence of misrepresentation.

[17] Paragraph 55
[18] Second witness statement

Section 3(6)

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

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

76. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) ("SkyKick")* [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 Ankenaevnet 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 Mağazacilik 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)."

77. The essence of bad faith objection is that the applicant's (in this case the proprietor) intended conduct is a departure from accepted principles of ethical behaviour or honest commercial practices. Earlier in *SkyKick*, Lord Kitchin considered the question of what amounts to bad faith. He underlined 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 Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union*

Intellectual Property Office (EUIPO) (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 […]."

78. The correct approach to assessing bad faith was set out in *Alexander Trade Mark*, BL O/036/18, where Mr Geoffrey Hobbs sitting as the Appointed Person stated that the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

79. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

80. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

81. The caselaw shows that the initial evidential burden falls upon the applicant: the applicant 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 proprietor to rebut the allegation.

82. The applicant's bad faith claim contains two strands of allegations.

83. The first strand is that the specification for which the contested mark is registered does not reflect the proprietor's intended use which is in relation to cosmetics. In this connection, the applicant alleges that the proprietor uses the registered mark 'BROW BOMBER' only in relation to a cosmetic lamination product for eyebrows and that, had the proprietor sought to register the mark for cosmetics, it would have been refused for being descriptive or devoid of distinctive character. This is because, the applicant argues, 'BROW BOMB' is a descriptive term made up of the words 'BOMB' (which is commonly used in trade to describe cosmetic products which add volume or thicken the appearance of one's eyebrows and eyelashes), and 'BROW' (which refers to the user's eyebrows) and 'BROW BOMBER' derives from it, indicating a beautician who does a 'BROW BOMB'. In addition, the applicant pleaded case includes an allegation that since the contested mark is not registrable for cosmetics, the proprietor's intention was to obtain protection for goods and services which are sufficiently similar to cosmetics to enable the proprietor to prevent the use and/or registration of identical/similar marks in relation to cosmetics.

84. The second strand is that proprietor had knowledge of the applicant's use of the mark 'BROW BOMB' and 'LASH BOMB' within the UK prior to filing the contested mark and applied for the contested mark in order to prevent the applicant from registering and/or using the mark 'BROW BOMB' despite the applicant having made substantial use of the same in the UK prior to the filing date of the contested mark.

85. As regards the first strand, the witness statement from Ms Shcherbyna and that from Mr Brambilla both explain that the EUTM from which the contested mark derives was filed in Italian, and that the term "*toiletaries*" in the contested specification represents a translation of the term "*toiletteria*" as it appeared in the Italian specification. Ms Shcherbyna also explains that the products sold by the proprietor are directed at beauticians and professionals who attend the proprietor's 'BROW BOMBER' training course on how to use the associate products for the treatment of eyebrows and lashes.[19] Further, both Ms Shcherbyna and Mr Brambilla explain that

[19] Exhibits TS5-6

the product sold by the proprietor is a butter product comprising (and made from) essential oils and aromatic extracts for the purpose of stylising the eyebrows – this is why the registered specification include those goods. Lastly, both Ms Shcherbyna and Mr Brambilla explain that the Italian word "*toiletteria*" includes goods used in personal hygiene and grooming and could easily include cosmetics. Based on this, Ms Shcherbyna says that the registered goods are (a) an accurate and true reflection of the goods for which the contested mark is used and (b) a "*bona fide and honest description of [her] company's business interest".* Mr Brambilla added that the contested mark was filed by the proprietor itself and not by a representative and that whilst it is possible that had the contested mark been filed by an EUIPO representative, a more appropriate terminology might have been used, that does not alter the fact that the proprietor *"simply used words in the specification of goods applied for that seemed appropriate to the average Italian".*

86. At the hearing Mr Wood initially refers to the first strand of the pleaded bad faith claim as the *"SkyKick bad faith"* though he later said that this is the category of bad faith for which SkyKick is more known and that the second strand is also addressed in *SkyKick* under a different category (i.e. that of targeting).

87. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin considered whether the use of general terms precludes a finding of bad faith where there is an intention to use the trade mark for some but not all of the categories of goods/services covered by the general term. He concluded that it does not:

> "260. […] It would in my view be anomalous for traders who use broad terminology to describe the goods and services for which they seek protection to find themselves in a more favourable position than those who use appropriate sub-categories to describe the same goods and services, and I would reject any interpretation of the legislation that necessarily leads to that conclusion. Of course, the matter must be judged as at the time of the application. Further, in so far as the applicant was required or encouraged to use class headings or other terminology to describe the goods and services which are the subject of the application, this may be a matter properly to take into account in assessing whether the application was made in bad faith. But

subject to considerations such as these, I see no reason why a person should be permitted to apply to register a mark or retain a registration in respect of distinct categories of goods or services in relation to which it never had any intention to use the mark, simply because it chose to use a broad description of those goods and services which meant they were encompassed together with goods or services about which no complaint is made.

261. I would mention two other matters in this context. First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made *partly* in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corpn* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-249 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.

262. Secondly, it is now possible to dispel the concern expressed by counsel for the Comptroller-General that it is doubtful whether the introduction of restrictions on the use of broad terms in trade mark specifications will alleviate the problem of cluttering, at least without the objection of bad faith filing “having some teeth”. In my opinion, and for the reasons I have given, the objection does have teeth: indeed, it has essentially the same teeth whether one is concerned with an unduly broad specification which uses general terms or specific sub-categories to describe goods or services and which, in either case, includes or

identifies sub-categories of goods or services in relation to which the applicant never had any intention to use the mark."

88. Technically speaking, what Mr Wood refers to as the *SkyKick* category 1 relates to a different scenario compared to that of applying for goods that are different from those in relation to which the mark is effectively used and for which it would not be registrable, which is the cases pleaded by the applicant. *SkyKick* is, in fact, about specification which are manifestly and self-evidently broad and were filed without genuine intention to use across all claimed goods and services. In this case, Mr Wood did not say that the registered specification is too broad; instead, he stated that the proprietor applied-for it without having any intention to use the contested mark for the registered goods and services because they do not reflect the cosmetics products for which the mark is used. Mr Wood's allegation that the registered mark was filed without an intention to use the mark to avoid an absolute ground objection of descriptiveness and on-distinctiveness is therefore based on two facts, being (a) the allegation that the mark is descriptive and (b) the use of the mark made by the proprietor in relation to cosmetic products for eyebrow lamination which do not fall within the registered specification. As the applicant admitted in the written submissions of 18 October 2023, this allegation is based on speculation (emphasis added):

> *"For clarification, Paragraph 29(b) of the Statement of Grounds (when read in conjunction with Paragraph 29(c) of the Statement of Grounds, as intended) intends to speculate, that the Owner may have considered an application to file the Later Mark for "cosmetics" in class 3 to be undesirable because it wished to avoid either third party opposition brought by individuals using similar marks in respect of "cosmetics" within the UK (i.e. the Applicant) or a potential office action being raised by an examiner who may – on first examination – consider the Later Mark incorporating the terms 'BROW' and 'BOMB' (being arguably descriptive when assessed individually) to be lacking in distinctiveness in respect of "cosmetics" in class 3. This point is nuanced in that Paragraph 29 of the Statement of Grounds intends to speculate as to the Owner's intentions for filing for "toiletries", "essential oils and aromatic extracts" and "cleaning and fragrancing preparations" in class 3, when none of which seem to be associated with its actual core offering of "cosmetics", whilst not making assessments or*

submissions that the Later Mark or Earlier Mark are devoid of distinctive character or descriptive"

89. By the applicant's own admission, its bad faith case is based on speculation. It seems to me that the applicant picks and choose between 'BROW BOMB' (and 'BROW BOMBER') being descriptive or distinctive as it suits its pleadings, which indeed, affects the integrity of its case as I have already observed.

90. It is clear that the applicant's case on bad faith (strand 1) is highly speculative. The registered specification consisting of a few terms in four classes is obviously not manifestly and self-evidently too broad to conclude that it was filed without genuine intention to use across all claimed goods and services. Further I bear in mind that:

- The applicant did not file any evidence about the proprietor's intention at the time of filing the contested mark. Whilst this is not fatal, the proprietor has filed evidence explaining that the term 'toiletries', 'essential oils' and 'aromatic extracts' were selected because toiletries in Italian (the language in which the original EUTM was filed) includes goods used in personal hygiene and grooming and could easily include cosmetics whilst 'essential oils' and 'aromatic extracts' are the ingredients from which the proprietor's products are made. This seems to me a reasonable and consistent explanation. There is a difference between honest mistakes and misunderstandings and applying for a mark in bad faith. Further, the proprietor's evidence (unchallenged) that it applied for the contested mark without the assistance of a lawyer or trade mark expert makes it highly unlikely that the proprietor, who is in the business of selling cosmetic products, would have understood the complexity of trade mark law and sought protection of the mark in relation to goods and services for which it had not intention to use the mark only for the purposes of blocking applications by third parties.

- The applicant itself filed evidence aimed at establishing that brands which offer cosmetic products also offer training services (which are covered by the proprietor's register specification) and argued (in the context of its passing off

claim), that all of the proprietor's goods and services are somehow similar to the cosmetic goods in relation to which the applicant has used its sign. Once again, this adds credibility to the proprietor's version that it applied for the contested goods and services with an appropriate commercial rationale.

- Lasty, there is no requirement that when an applicant applies for a trade mark, it must actually trade in all of the goods and services for which it seeks protection, the registration of a mark granting a 5-year grace period during which the proprietor can commence use of the mark. In any event, the goods/services the proprietor applied for are in the same area or field from that in which it trades – in this connection, it is worth noticing that the proprietor did not apply for something so disparate to suggest it clearly had no intention.

91. Having considered all of the above, my conclusion is that the applicant has failed to establish that the proprietor applied for the mark in bad faith to 1) avoid an opposition on absolute ground and 2) obtain a protection for goods and services in relation to which it did not intend to use the mark for the only purpose of weaponising the registration again third parties. This part of the applicant's bad faith claim fails.

92. Turning to the second strand, at the hearing Mr Wood argued that the proprietor failed to explain how the name was derived. He stated:

> *"We say in light of what we have already said about the way in which our client had already launched its products, had launched it and had access, it is open to you to conclude that it is more likely than not that that mark was chosen in the knowledge of our client's mark, certainly in the absence -- once the prima facie case is there and that is the case that is set up by the section 5(4) evidence and also by the allegation that it was taken knowing of our client's mark, it falls on the other side to push away the inference whilst it is there….. Of course, if you find that they did know and they chose the mark intentionally, knowing of our client's mark and knowing of our client's better claim, that is bad faith. That is what is set out in SkyKick as the category 1 example of bad faith. Obviously the SkyKick case is more known for the category 2, which is the specification*

issue, and of course that is the part that they seem to have given more effort to in their evidence."

93. At the hearing Mr Wood relied upon the evidence that the applicant launched its 'BROW BOMB' products at the Olympia Beauty, London trade event on 29-30 September 2019 which was attended by 18,932 visitors and subsequently exhibited at the Cosmoprof Worldwide, Bologna trade event from 12 – 15 March 2020 (which was attended by over 265,000 cosmetic beauty professionals). However, there is not one piece of evidence showing that the proprietor attended those events. Lastly, whilst the proprietor is an Italian company, and the Bologna trade show took place in Italy five months prior to the relevant date, Ms Shcherbyna's evidence shows that the opponent was already working on the development of its 'BROW BOMBER' products in November 2019, as shown by an email dated 29 November 2019 from a laboratory in which the name 'BROW BOMBER' is mentioned as sampling.[20]

94. Bearing in mind all of the above, I conclude that the applicant also failed to establish a prima facie case of bad faith in relation to the second strand of allegations.

95. The bad faith claim also fails.

OUTCOME

96. The invalidity application has failed under all grounds and the proprietor's mark will remain registered.

COSTS

97. The proprietor has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the proprietor the sum of £2,200 as a contribution towards the costs of proceedings. The sum is calculated as follows:

[20] Although the email is not translated, the date and the name BROW BOMBER are visible

Filing a counterstatement
and considering the application for invalidity: £400
Filing evidence
and considering the other party evidence: £1,000
Attending a hearing: £800
Total: £2,200

98. At the hearing, Mr Buehrlen suggested that costs should be increased to take into account that due to the lateness of the application for invalidity, these proceedings were dealt with separately from other related proceedings resulting in work being duplicated. I reject the submission. As I explained at the hearing, costs in the other proceedings will be awarded separately and although it may be possible that proceedings could have been consolidated if the application had been filed earlier, I do not consider this to justify any increase in the award I make.

99. I therefore order Global Beauty Products Limited to pay Selita srl the sum of £2,200. 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 conclusion of the appeal proceedings.

Dated this 19th day of January 2026

TERESA PINTO
For the Registrar