

BL O/0551/26

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 00918299870 FOR THE FOLLOWING TRADE MARK IN CLASSES 3, 8, 35 AND 41 IN THE NAME OF SELITA SRL:

Brow Bomber

AND IN THE MATTER OF CANCELLATION NO. 505830 BY GLOBAL BEAUTY PRODUCTS LTD

AND IN THE MATTER OF AN APPEAL FROM THE DECISION NO. O/0027/26 OF TERESA PINTO DATED 19 JANUARY 2026

DECISION

Introduction

1. This is an appeal before me by Global Beauty Products Ltd (the “**Applicant/Appellant**”), appealing the decision of the Hearing Officer, Teresa Pinto, dated 19 January 2026 with number O/0027/26 (the “**Decision**”).
2. The Decision addresses cancellation action 505830 (the “**Cancellation Action**”) by the Applicant in relation to the Selita SRL’s (the “**Proprietor/Respondent**”) trade mark number 00918299870 depicted below in classes 3, 8, 35 and 41 (the “**Contested Mark**”).

Brow Bomber

Background

3. This Cancellation Action is one part of parallel proceedings, the other being an opposition by the Proprietor in relation to the Applicant’s trade mark. The chronology of events is as follows:
4. Between 20 September 2019 and 30 August 2020, the Applicant sold cosmetic products for eyebrows (eyebrow lamination products) under the BROW BOMB sign in the United Kingdom, with sales in excess of 18,000 units / £444,000. It also offered lamination courses under the BROW BOMB sign.
5. On 31 August 2020, the Proprietor applied for the Contested Mark, BROW BOMBER. This was then registered on 23 December 2020.
6. On 15 December 2021, the Applicant applied for trade mark number 3733375 for BROW BOMB in classes 3, 41 and 44. The Proprietor opposed this application in opposition OP000432650 (the “**Opposition**”) based on, *inter alia*, section 5(2)(b) of the Trade Marks Act 1994 (the “**Act**”), relying on the Contested Mark. The Opposition was consolidated with other oppositions.
7. On 14 February 2023, the Applicant commenced the Cancellation Action, seeking a declaration of invalidity in relation to the Contested Mark for all goods and services under sections 3(6) and 5(4)(a) of the Act. Under section 5(4)(a) of the Act, the Applicant asserted it had goodwill and relied upon its use of the BROW BOMB sign.
8. On 27 March 2025, in the Opposition, the Hearing Officer, Leisa Davies, in decision O/0286/25, came to the provisional conclusion that the Opposition was successful under section 5(2)(b) of the Act, holding that the Applicant’s application for BROW BOMB was invalid in light of the Contested Mark, BROW BOMBER. She suspended the proceedings until the outcome of this Cancellation Action. She explained that, if the Contested Mark remains registered for the goods and services which she had considered, her decision would become final.
9. On 19 January 2026, in the Cancellation Action, the Hearing Officer held that the action failed on all grounds and the Contested Mark should remain on the register for all goods and services. In particular, she held that the ground under section 5(4)(a) of the Act failed “for absence of misrepresentation” (see [74] of the Decision). She ordered that the Applicant pay the Proprietor the sum of £2,200 by way of contribution to the Proprietor’s costs.

10. On 13 February 2026, the Applicant filed a Notice of Appeal to the Appointed Person against the Decision under section 76 of the Act, appealing the decision in relation to section 5(4)(a) only. The Proprietor did not file a Respondent's Notice. Following written submissions, the appeal was heard on 15 May 2026.
11. Both parties has legal representation, with the Applicant represented by Mr Tom Broster of Ascenda Law Ltd and the Proprietor represented by Mr Rowland Buehrlen of Beck Greener LLP. I am grateful for their written and oral submissions, which were very helpful.

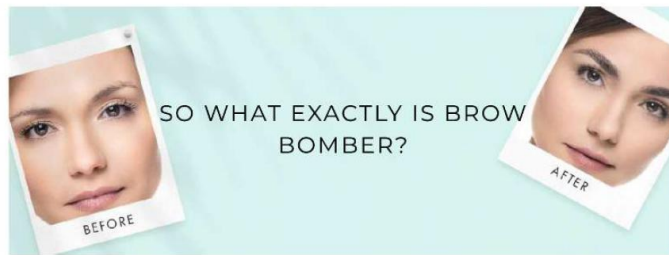
Decision

12. In her Decision, the Hearing Officer made the following findings which are not the subject of appeal:
 - a. The relevant date for the assessment under section 5(4)(a) of the Act was 31 August 2020 (the "**Relevant Date**"), namely the filing date for the Contested Mark (see [26]);
 - b. The use of the BROW BOMB sign was in relation to cosmetic products used in eyebrow lamination, a process which straightens, lifts and sets the user's eyebrow hairs in place for a fuller, prominent and more defined look (see [51] and [66]);
 - c. The use of the BROW BOMB sign was for less than a one year period prior to the Relevant Date (see [69]);
 - d. Between 20 September 2019 and 31 December 2019, the Applicant's sales of cosmetic products for eyebrows under the BROW BOMB sign in the United Kingdom were in excess of 5,500 units / £181,000 (see [46]);
 - e. Between 20 September 2019 and 30 August 2020, the Applicant's sales of cosmetic products for eyebrows under the BROW BOMB sign in the United Kingdom were in excess of 18,000 units / £444,000 (see [46]);
 - f. Prior to 31 August 2020, the Applicant had made reasonable marketing efforts by spending over £51,000 to promote products in the UK under the BROW BOMB sign (see [49]); and
 - g. While the above use was "not on a large scale, [it was] certainly more than trivial ..." (see [69]).
13. The Decision also contains much discussion as to whether the BROW BOMB sign is descriptive (see [51] to [67]). In particular, the Hearing Officer:
 - a. Concluded that the BROW BOMB sign was inherently distinctive to a low degree (see [54], [65], [66] and [69]) reasoning that it "sufficiently allusive not to be descriptive; nonetheless [it was] sufficiently allusive to create a mark which is inherently low in distinctiveness";
 - b. Placed limited weight on evidence from Ms Shcherbyna, a witness for the Proprietor, stating that, among beauticians, BROW BOMB was "the more descriptive term [than BROW BOMBER] for products that provide a fuller eyebrow". In so doing, she relied on evidence in exhibit TS15 (see [63]);

- c. Concluded that the evidence at exhibit TS15 (which showed the use of DUO in conjunction with LASH AND BROW BOMB, as depicted below) “convey[ed] 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” (see [55] and [66]);



- d. Held that the closest the Proprietor’s “evidence got to establishing that the [Applicant’s] mark has potential to be used descriptively to denote the lamination procedure for which the goods are used” was Mr Buehrle’s witness statement showing that “the term ‘BROW BOMB [was] used by third parties prior to the relevant date on the Internet in relation to cosmetics and beauty treatments for eyebrow lamination” including “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)’ (see [66]);
- e. Concluded that Google Adverts’ internal statements describing BROW BOMB as a non-brand, while not determinative, “add[ed] weight to [the Proprietor’s] argument about ‘BROW BOMB’ having an element of descriptiveness for cosmetic goods used on eyebrows ...” (see [54]);
- f. Concluded that the Proprietor “refer[red] to ‘BROW BOMBER’ as a brow lamination treatment” (for example, see below) (see [71] and [72]); and



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!

- g. Noted that the *Applicant*, in the context of its submissions on section 3(6) of the Act, said “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” (see [55] and [71]); but
 - h. Concluded that the Applicant’s invoices showed use of BROW BOMB as a trade mark in conjunction with descriptive words (such as ‘Lamination Course’) (see [59], [61] and [66]); and
 - i. Concluded that the Applicant’s website showed use of the BROW BOMB sign as a trade mark (see [60], [61] and [66]).
14. She then held that “... even if the applicant’s use might have been sufficient to create some goodwill, there would be no misrepresentation ...” Her reasons for this are addressed in more detail below.

Grounds of Appeal

15. The Applicant advances the following grounds of appeal:
- a. Ground 1: Error of law - Misstating/misapplication of the law of passing off;
 - b. Grounds 2: Error of law and principle - Errors of law in the concept of distinctiveness;
 - c. Ground 3: Error of law and principle - Errors of law in the concept of distinctiveness;
 - d. Ground 4: Error of principle - Distinctiveness in fact;
 - e. Ground 5: Error of appreciation / irrationality – Goodwill;
 - f. Ground 6: Error of appreciation / irrationality – Generic nature of BROW BOMB.
16. Under each ground it gives specific reasons in support, which I address below.

Preliminary Point

17. A preliminary point arose during the course of oral submissions as to the effect of grounds 5 and 6. Here, Mr Wood explained that the effect of these grounds is that the Applicant is

asking me to replace the evaluative decision of the Hearing Officer. Mr Buehrle challenged this, explaining that grounds 5 and 6 addressed issues of law and, if the Applicant wished to challenge a finding of fact, the grounds should have specifically identified the fact and explained why it was wrong.

18. Under ground 6, paragraph 23 of the Grounds of Appeal reads as follows:

“Having concluded that the sign BROW BOMB is inherently distinctive, it is irrational to then conclude that the sign is non-distinctive or generic or could be seen that way. Amongst the places where the Hearing Officer makes such a finding is at 73, where [the Hearing Officer] reaches a fall-back position of a lack of misrepresentation between the signs.”

19. During the course of the hearing, I asked Mr Buehrle to consider this paragraph. Here, Mr Buehrle explained that the Hearing Officer did not conclude that the sign BROW BOMB was inherently distinctive, rather she concluded it was of *low* distinctive character. Mr Buehrle reasoned that, if the Applicant wished to challenge a finding of fact, it was incumbent on it to correctly identify and expressly challenge it.

20. While I do accept that it is best practice that, where a finding of fact is to be challenged, the relevant party identifies that fact with precision, one should also avoid an overly meticulous analysis of the submission. Here, for the following reasons, I find that the Applicant’s intention is generally clear, namely that it challenges the finding of fact that there was no misrepresentation:

- a. Ground 6 is entitled “Error of appreciation / irrationality – Generic nature of BROW BOMB”. First, this is distinct from grounds 1 to 3, which specifically call out an “error of law”. Second, I understand “appreciation” to mean “the recognition of the worth of something”, namely an evaluation of fact. I also understand “irrationality” to be a reference to the legal test to be applied to an evaluative decision on appeal, namely that the Hearing Officer was plainly wrong;
- b. Paragraph 23 of the Grounds of Appeal then calls out the finding of fact to be challenged, namely a “lack of misrepresentation between the signs” (my emphasis).
- c. The paragraph then cross refers to paragraph 73 of the Decision, which explains that the Hearing Officer was “of the view that even if the applicant’s use might have been sufficient to create some goodwill, there would be no misrepresentation ...” (my emphasis). Paragraph 74 of the Decision concludes “[a]ccordingly, I find that the passing off claim fails for absence of misrepresentation” (my emphasis);
- d. Paragraphs 23 and 24 of the Grounds of Appeal also provide the Applicant’s reasons why the finding of no misrepresentation was wrong, for example an apparent inconsistency between saying that the sign BROW BOMB is inherently distinctive but concluding that members of the public would consider the term to be non-distinctive or generic and therefore not be misled.
- e. As to Mr Buehrle’s submissions, while paragraph 23 shortens the Hearing Officer’s finding (referring to “inherently distinctive”, when the Hearing Officer had concluded that the BROW BOMB sign was ‘inherently distinctive to a low degree’ (see, for

example, [65] and [66] of the Decision)), I do not think this negates the effect of the paragraph.

21. The same reasoning applies to Ground 5.

Standard of Review

22. The principles to be applied to an appeal are well established. They were summarised by Joanna Smith J in *Axogen Corp v. AVIV Scientific Ltd* [2022] EWHC 95 (Ch) at [24]. Further guidance has also been given by the Supreme Court in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25 at [93] to [95] as follows:

“94. It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions. While of course the decision of an appellate court trumps that of the court below, the law has imposed structured constraints designed to prevent a free for all in a higher court whenever a party (with the necessary resources) wishes to challenge the first instance decision of the trial judge. The reasons for these constraints are set out in a string of well-known authorities including, in the intellectual property context, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] FSR 29, per Lewison LJ at para 114. The reasons there set out relevantly include the following:

- (i) The trial is not a dress rehearsal. It is the first and last night of the show.
- (ii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court.
- (iii) In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.

95. In *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8; [2024] Bus LR 532 this court reviewed those constraints in a trade mark context. After citing from the *Fage* case this court in a joint judgment said, at paras 49- 50:

‘49. That does not, however, mean the appeal court is powerless to intervene where the judge has fallen into error in arriving at an evaluative decision such as whether an activity was or was not targeted at a particular territory. It may be possible to establish that the judge was plainly wrong or that there has been a significant error of principle; but the circumstances in which an effective challenge may be mounted to an evaluative decision are not limited to such cases. Many of the important authorities in this area were reviewed by the Court of Appeal in *re Sprintroom Ltd* [2019] 2 BCLC 617, paras 72–76. There, in a judgment to which all members of the court (McCombe, Leggatt and Rose LJ) contributed, the court concluded, at para 76, in terms with which we agree, that on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw

in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

50. On the other hand, it is equally clear that, for the decision to be 'wrong' under CPR r 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation.”

23. The Applicant also drew my attention to the decision by the Appointed Person, Mr Simon Clark, in O/1083/25 BETTER EGGS BEYOND ORDINARY [6], for which I am grateful.
24. I also note that disagreements about the precise ‘weight’ to be given to a factor has been consistently rejected as a proper ground of appeal from the Hearing Officer (see Ian Purvis KC, sitting as the Appointed Person in BL-0-106-20 GREYBOX).
25. Further, the Court of Appeal in *Unik Bond SA v. Catbalogan Holdings Sarl* [2025] EWCA Civ 1594 has given the following guidance to the way appellate courts should approach the writing of judgments:

“59. In *Re Portsmouth City Football Club Ltd (in liquidation)* [2013] EWCA Civ 916, [2013] Bus LR 1152 Mummery LJ (with whom Rimer and Underhill LJ agreed) posed the question at [36]:

“What sensible purpose could be served by this court repeating in its judgments detailed discussions of every point raised in the grounds of appeal and the skeleton arguments when they have already been dealt with correctly and in detail in the judgment under appeal? No purpose at all, in my view.”

60. He continued at [38]:

“The proper administration of justice does not require this court to create work for itself, for other judges, for practitioners and for the public by producing yet another long and complicated judgment only to repeat what has already been fully explained in a sound judgment under appeal. If the judgment in the court below is correct, this court can legitimately adopt and affirm it without any obligation to say the same things over again in different words. The losing party will be told exactly why the appeal was dismissed: there was nothing wrong with the decision appealed or the reasons for it.”

26. I have kept the above principles in mind when considering this appeal.

Discussion

Ground 1 (Error of law: Misstating/misapplication of the law of passing off)

27. The Applicant submits that the Hearing Officer erred in her application of the law in finding that, in any assessment of goodwill, she must consider the descriptiveness of the BROW BOMB sign and, in so doing, concluded that there was none. In particular, it says that a finding that a company with a turnover of £444,000 and a marketing spend of £51,000 has no goodwill is plainly wrong.

28. To this, the Proprietor asserts that, at [50] of the Decision, the Hearing Officer merely explained that this was the Proprietor's *submission*, with which she subsequently disagreed ([54] of the Decision). It further asserts that the Hearing Officer did not make a definitive finding in respect of goodwill, with the Hearing Officer making an assessment of misrepresentation on the presumption that there was goodwill. The Proprietor does not, however, resile from Mr Buehrlen's overarching submission (repeated below), which it maintained with some force during the hearing.
29. At [50] of the Decision, the Hearing Officer explained that, "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, [she] 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".
30. She then considered whether the BROW BOMB sign is descriptive at [52] to [54] of the Decision, before concluding (as set out above) that it is "sufficiently allusive to create a mark which is inherently low in distinctiveness." The discussion of whether the sign is descriptive then continued through [55] to [72] of the Decision, with the Hearing Officer reiterating that the sign is inherently distinctive to a low degree (see [64], [65], [66] and [69]) but noting that, in her assessment, it had been used descriptively sometimes.
31. In the course of this discussion, the Hearing Officer directed herself to *Wadlow on the Law of Passing Off*, 6th Ed., §8-7, which in turn considers the decision in *Burberrys v Cording* (1909) 26 R.P.C. 693. She introduced this section saying that *Wadlow* "clarifies that in claims for passing off it is important to distinguish between distinctiveness in fact and distinctiveness in law". Citing *Smart Plant Technologies v. Rajinda Shama* (BL O/304/20), she went on to say that "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." I will return to this below.
32. The Hearing Officer then stated that: "... even if the applicant's use might have been sufficient to create some goodwill, there would be no misrepresentation ..." (my emphasis) at [73] of the Decision.
33. My reading of this is that, having identified the Proprietor's *submission*, the Hearing Officer then proceeded to apply it to the facts. In so doing, she concluded that the sign is inherently distinctive to a low degree. However, she made no finding of whether, in addition to being distinctive in fact, the BROW BOMB sign is distinctive at law. She also failed to come to a conclusion as to whether there is goodwill. Rather, she proceeded to make a finding in relation to misrepresentation. In this respect, I understand her reference to "even if" to mean that she makes no finding on goodwill but proceeds nonetheless on the presumption that there is some when assessing misrepresentation.
34. The Hearing Officer's omission of a finding on goodwill warrants further discussion.
35. Lord Macnaghten described goodwill in *Inland Revenue Commissioners v Muller & Co's Margarine* [1901] A.C. 217 HL at 223 (my emphasis):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates.”

36. In the context of passing-off, Lord Oliver elaborated on this in *Reckitt & Colman Product v Borden* [1990] RPC 341, HL (my emphasis):

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get-up” (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services.”

37. It follows that, when establishing goodwill, a successful claimant in passing off needs to demonstrate more than just trade in a particular good or service. It needs to demonstrate that the trade has been such that it has resulted in members of the purchasing public recognising the sign or get-up used as being distinctive of the claimant’s goods or services.
38. Inherent to this is a discussion of the nature of the sign or get-up being used. Where a sign is descriptive (and therefore, in trade mark parlance, not inherently distinctive) a claimant will generally need to engage in higher level of trade before members of the public recognise the relevant sign or get-up as being distinctive of the claimant’s goods or services. This was the point made by the Appointed Person, Tom Mitcheson QC (as he then was), in *Smart Planet Technologies* [41] where he said:

“The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish goodwill in that sign so as to make it distinctive of Party A’s goods.”

39. Equally, where a sign or get-up is distinctive but not conventionally used to distinguish goods or services, further use may be required before members of the public recognise it as being distinctive of the claimant’s goods or services. It is for this reason that in *Jarman & Plan v Barget* [1977] F.S.R. 260 CA and *Hoffman-La Roche v DDSA* [2019] EWHC 2545 (Ch), furniture and black and green capsules respectively, while distinctive, were not distinctive of the claimant’s goods or services.
40. Therefore, I find that the Hearing Officer was correct to consider Mr Buehrle’s submission. While it is persuasive that the Applicant enjoyed a turnover of £444,000 and had a marketing spend of £51,000, something more is required. The Applicant needed to establish that its use was such that it had ‘goodwill attached to the goods or services which it supplies in the mind of the purchasing public by association with the BROW BOMB sign’.

41. The issue here, however, is that the Hearing Officer failed to make such a determination. Absent such a determination, it is difficult to understand how the Hearing Officer was able to make a finding in relation to misrepresentation. Expressed another way, if one does not know whether there is 'goodwill attached to the goods or services which the Applicant supplies in the mind of the purchasing public by association with the BROW BOMB sign', how does one make an assessment of whether a substantial number of members of the public will be misled into believing that the Proprietor's goods are those of (or are associated with) the Applicant?
42. Formerly, this means that the Applicant fails on this ground. The Hearing Officer was correct to consider Mr Buehrlen's submission and, absent a finding of goodwill, the Hearing Officer cannot be formerly criticised for finding there is no goodwill. However, her lack of conclusion on goodwill has a bearing on her assessment of misrepresentation, which I return to below.

Ground 2 (Error of law and principle - Errors of law in the concept of distinctiveness)

43. Here the Applicant submits that the Hearing Officer erred in her assessment of Ms Shcherbyna's witness statement.
44. In particular, the Applicant submits that the Hearing Officer misconstrued Ms Shcherbyna's evidence that BROW BOMB is "the more descriptive term [than BROW BOMBER] for products that provide a fuller eyebrow" to mean that the BROW BOMB sign was descriptive. Rather, the Applicant says that the Hearing Officer should have concluded that the effect of the evidence merely means that the BROW BOMB sign was less distinctive than BROW BOMBER. The Applicant submits that this then affects the Hearing Officer's assessment of misrepresentation.
45. The Hearing Officer addressed Ms Shcherbyna's evidence at [63] of her Decision, explaining that she does not consider it adds much to exhibit TS15 (considered at paragraphs 13.b and 13.c above). Further, she accepted the Applicant's submission that there is no evidence that Ms Shcherbyna is a beautician. She then concluded:

"... 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 [on bad faith] ... and the applicant did not challenge that evidence."
46. Having considered this, I am of the view that the Hearing Officer only placed limited weight on Ms Shcherbyna evidence and, in any event, did not conclude that she was saying that the BROW BOMB sign was descriptive, just more descriptive than other terms. Rather, the Hearing Officer repeated that the BROW BOMB sign was inherently distinctive to a low degree (see [65], [66] and [69]), something which the Applicant acknowledges in the context of Ground 6 (in which it says that the Hearing Officer concluded that the "sign BROW BOMB is inherently distinctive"). Elsewhere, she noted that it had been used descriptively.
47. Indeed, the absence of a conclusion on whether the BROW BOMB sign is descriptive is, crudely, the flip side of the coin of that discussed above, namely the Hearing Officer did not make a finding of whether the BROW BOMB sign was distinctive at law and whether

‘goodwill attached to the goods or services which the Applicant supplies in the mind of the purchasing public by association with the BROW BOMB sign’. This is explored further below under ground 3.

48. In this respect, formerly this means that the Applicant again fails on this ground. Absent a finding, it follows that the Hearing Officer did not err in law, misapply that law or make a finding of fact which was plainly wrong in the manner described in *Lifestyle Equities*.

Ground 3 (Error of law and principle - Errors of law in the concept of distinctiveness)

49. Here, the Applicant submits that the Hearing Officer erred in finding that, under the law of passing off, a legally distinctive mark can be held to be non-distinctive in fact. It then explains that the Hearing Officer should have concluded that, as a matter of law, passing off protects signs which are distinctive of a party’s business, whether that is via the use of a sign which is distinctive inherently or by reason of use.
50. This appears to be a reference to the Hearing Officer’s comment at [65] in which she says that “in passing off cases, whilst a sign might be inherently capable of distinguishing and inherently distinctive (which I have found to be the case here) that does not necessarily mean that it is distinctive in fact.”
51. This is a reference to the preceding paragraph in which the Hearing Officer explained that “[w]hilst 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” (my emphasis). The Hearing Officer then considered certain passages from *Wadlow*.
52. Having considered the Decision, it is correct that the Hearing Officer appears to have mis-paraphrased the passages from *Wadlow*. *Wadlow* explains that while a sign may be *distinctive in fact* it does not follow that *it is distinctive in law*. It gives the example of LINOLEUM which, as an invented and arbitrary term, is distinctive in fact, but is not distinctive in law if its true meaning is a generic name of a product. By contrast the Hearing Officer refers to something being inherently distinctive (namely, distinctive in fact) not necessarily meaning that it is distinctive in fact, which is a *non-sequitur*.
53. Nonetheless, I do not see (and the Applicant does not identify) that the Hearing Officer relies on her mis-paraphrasing of *Wadlow*. Rather, elsewhere, she appears to have correctly identified the law as expressed in *Wadlow* (see paragraph 31 above). Further, the Hearing Officer appears to have attempted to apply the law, finding that the BROW BOMB sign is distinctive in fact (albeit to a low degree) and engaging in lengthy discussions about its use both as a trade mark and descriptively.
54. The issue is that, again, the Hearing Officer does not make a conclusion as to whether the BROW BOMB sign is distinctive in law. Absent such a determination, it is again difficult to understand how she was able to make a finding in relation to misrepresentation. Expressed another way, if one does not know whether the sign is distinctive in law, how does one make an assessment of whether a substantial number of members of the public will be misled into believing that the Proprietor’s goods are those of (or are associated with) the Applicant? I return to this when considering misrepresentation.

55. I also note that I disagree with the Applicant's submission that passing off protects signs which are distinctive of a party's business, whether that is via the use of a sign which is distinctive inherently or by reason of use. To the contrary, the law of passing off requires something more than a sign being inherently distinctive (distinctive in fact), it requires it to be recognised by the public as distinctive specifically of the claimant's goods or services (distinctive in law). This is the point made at paragraphs 35 to 42 above.
56. This reflects the distinction between the law of trade marks and passing off. The former has to cater for the scenario where the mark being registered has never been used. It therefore contemplates whether the trade mark in question has the *ability* to distinguish goods and services of one undertaking from another (whether it is inherently distinctive). By contrast, the law of passing off does not (and cannot) arise until the relevant sign has been used.
57. For these reasons, formerly this means that the Applicant again fails on this ground. The Hearing Officer did not err in law, misapply that law or make a finding of fact which was plainly wrong in the manner described in *Lifestyle Equities*. However, as before, her lack of conclusion has a bearing on misrepresentation.

Ground 4: Error of principle - Distinctiveness in fact

58. Under this ground, the Applicant submits that the Hearing Officer erred in making a distinction between the goods and services provided by the Applicant. In particular, it asserts that, while the Hearing Officer held that the BROW BOMB sign was inherently distinctive to a low degree for goods, it was descriptive for lamination services. The Applicant points to [59], [71] and [72] of the Decision in support of its point. These are addressed below.
59. At [59], the Hearing Officer said that the use at paragraph 13.c above denotes the lamination procedure in itself rather than the origin of the goods. She contrasts this with the invoices which show the use of BROW BOMB as a trade mark in conjunction with descriptive words such as "Lamination Course". This is the opposite of that which the Applicant complains, with the Hearing Officer identifying descriptive use in relation to the goods, not services.
60. At [71], the Hearing Officer explained that the *Applicant's* statement (in the context of s. 3(6) of the Act) 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" adds weight to the Proprietor's (limited) evidence that the BROW BOMB sign has been used to describe cosmetic products. Again, this is the opposite of that which the Applicant complains.
61. At the end of [71] and [72], the Hearing Officer does then explain that, in her assessment, the use of BROW BOMBER by the Proprietor at paragraph 13.f was to describe the lamination treatment itself, from which she infers that BROW BOMB does the same. I have some misgivings about this finding. In particular, if one uses a sign (BROW BOMBER) but then has to describe the type of goods or services (eyebrow lamination), this is typically

indicative of the sign not being descriptive¹. Nonetheless, this is not the subject of the Applicant's appeal.

62. Taken together, I do not detect that the Hearing Officer drew a distinction between goods and services, finding that the BROW BOMB sign was inherently distinctive to a low degree for the former, but not the latter. To the contrary, I read these sections as explaining that, in her view, there had been trade mark use and descriptive use in relation to both goods and services.
63. For these reasons, it follows that again the Hearing Officer did not err in law, misapply that law or make a finding of fact which was plainly wrong in the manner described in *Lifestyle Equities*. This ground of appeal therefore also fails.

Ground 5 (Error of appreciation / irrational – Goodwill)

64. Here, the Applicant submits that the Hearing Officer erred in concluding that there was no goodwill. In so doing, it says that the Hearing Officer incorrectly relied upon *Smart Plant Technologies*.
65. I have addressed the finding of goodwill (or lack thereof) at paragraphs 33 to 41 above. It follows that for the reasons given in paragraph 42 above, this ground of appeal is formerly unsuccessful.
66. As to whether the Hearing Officer was correct to rely on *Smart Plant Technologies*, the principle on which she relied (that the descriptiveness of a sign can have a bearing on the amount of trade required to establish goodwill associated with that sign) is correct for the reasons also given above.
67. Nonetheless, the Applicant makes a fair point in terms of degree. In *Smart Plant Technologies*, the evidence was of some 10 invoices totalling €4,000 in a period from 8 December 2017 to 28 January 2018. The Applicant's use of the BROW BOMB sign is an order of magnitude bigger. This should be borne in mind in any assessment of goodwill, to which I return below.

Ground 6 (Error of appreciation / irrationality - Generic nature of BROW BOMB)

68. As explained above, the Applicant submits that the Hearing Officer erred in this assessment.
69. In support of this, the Applicant asserts that the Hearing Officer erred in concluding that: the BROW BOMB sign was non-distinctive or generic or could be seen that way; that there is a meaningful conceptual difference between a BROW BOMBER and a BROW BOMB; and that toiletries are not identical to cosmetics.
70. In response, the Proprietor submits that the Hearing Officer did not conclude that the BROW BOMB sign was non-distinctive, but reasoned that:

¹ Expressed another way, one does not have to describe the goods or services if the sign is descriptive.

- a. The signs 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”; and
 - b. The Hearing Officer was right in concluding that the toiletries are not identical to cosmetics.
71. The Hearing Officer addressed the law of passing off at [23] of her Decision, quoting from *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, which says of misrepresentation:
- “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 v Marks and Spencer* [2012] EWCA 1501)”
72. She then quoted from *Halsbury’s Laws of England*, Vol. 97A at [24] of her Decision. This provides further guidance on misrepresentation as follows (my emphasis):
- “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.”
73. These two factual elements are analogous to that identified above, namely:
- a. Whether ‘goodwill attaches to the goods or services which the claimant supplies in the mind of the purchasing public by association with the relevant sign’; and
 - b. Whether the relevant sign is distinctive in law.
74. The Hearing Officer addressed misrepresentation at [73] of the Decision. In concluding that there is no misrepresentation she found:
- a. The signs BROW BOMB and BROW BOMBER are not identical;
 - b. The signs are sufficiently different to avoid misrepresentation bearing in mind the inherently low distinctiveness of the BROW BOMB sign, the Applicant’s descriptive use and the different conceptual message conveyed by the Contested Mark²; and
 - c. The goods and services are not identical bearing in mind that the Applicant uses its sign for cosmetic and educational services whereas the registration is for toiletries.

² Which the Hearing Officer took to refer to a beautician who carries out the BROW BOMB lamination, distinct from a BROW BOMB lamination.

75. In so doing, as explained above, she omitted to make the factual findings at paragraph 73 above. This gives rise to the issues of which the Applicant complains. In particular, absent a finding on goodwill and distinctiveness at law, the Hearing Officer adopts the apparently incongruous position of the BROW BOMB sign being inherently distinctive to a low degree and descriptive³.
76. I also have misgivings about the Hearing Officer's reliance on the lack of identity between toiletries and cosmetics. In finding a lack of identity, the Hearing Officer used the definition for toiletries from the Cambridge Online Dictionary of "objects and substances that you use in washing yourself and preventing the body from smelling unpleasant". I note, however, that the Paperback Oxford English Dictionary, 7th Ed offers a slightly broader definition of "articles used in washing and taking care of the body, such as soap and shampoo". I also note that in decision O/0286/25 the Hearing Officer, Leisa Davies, considered toiletries to be "a broad term which includes beauty preparations and goods for personal hygiene to enhance a person's appearance". She subsequently found that these were identical to cosmetics and, if she were wrong, that they were highly similar overlapping in nature, purpose, end user, channels of trade and provider/producer, as well as being complementary.
77. I remind myself that for the decision to be 'wrong' under CPR r 52.21(3), it is not enough to show that the appellate court might have arrived at a different evaluation. Rather, something more is required. After careful consideration, I find there is an identifiable flaw in the Hearing Officer's treatment of the question to be decided. The absence on a conclusion of goodwill and distinctiveness at law is a significant gap and omission of material factors which undermine the cogency of the Hearing Officer's conclusion. For this reason, I allow the appeal on this ground.

Next Steps

78. The question arises as to how to proceed from here.
79. During the course of the hearing, I asked both parties whether, in these circumstances, the matter should be remitted back to a different Hearing Officer for further determination. Neither party forcefully argued for this. I am also mindful that the dispute has been extant between the parties (in one form or another) for four years. Remitting the matter back to a new Hearing Officer will only introduce further delay and the costs which flow from this.
80. Having reflected on this, however, I have decided to remit the matter back nonetheless. In addition to the issues above, the Proprietor makes the point that the Hearing Officer also omitted to address damage (a necessary component of passing off). Taken together, these are too many factual issues to be determined by an appellate body which has not had the benefit of all of the evidence⁴.

³ For example, at [73(b)] the Hearing Officer refers to the "weak distinctiveness/descriptiveness of the earlier sign..."

⁴ In its skeleton argument the Applicant makes an argument for me reversing a finding of no goodwill and/or no misrepresentation. However, here the issue is the absence of a finding of goodwill (as well as distinctiveness at law).

81. Accordingly, I set aside the Decision and remit the entirety of this Cancellation Action to be determined on behalf of the Registrar by a different Hearing Officer in accordance with the Act and the Trade Mark Rules 2008.
82. In so doing, while I invite the new Hearing Officer to consider the matter afresh, I encourage him/her to address the following in any subsequent decision:
- a. Did the Applicant, at the relevant date, have 'goodwill attached to the goods or services which it supplies in the mind of the purchasing public by association with the BROW BOMB sign'? Was the BROW BOMB sign distinctive at law?
 - b. By virtue of the Proprietor's use of the BROW BOMBER trade mark, would a substantial number of members of the public be misled into believing that the Proprietor's goods and services are those of (or are associated with) the Applicant? If so, does it depend on the goods in issue?
 - c. If so, has (or will) the Applicant suffer damage?

Costs

83. This leaves the question of costs. In my view the appropriate course is for the costs of the proceedings to date (including the costs of this appeal) be reserved to the Registrar on the basis that the question of how and by whom they are to be paid will be determined by the conclusion of the Cancellation Action in accordance with the usual practice.

Antony Craggs
Appointed Person
30 June 2026

Representation

Applicant/Appellant: Mr Tom Broster, Asenda Law Ltd

Proprietor/Respondent: Rowland Buehrle, Beck Greener LLP