O/0637/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004036922

IN THE NAME OF BRESEGA LTD

FOR THE TRADE MARK:

forever beautiful

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 449836

BY GEM IMPORTS LTD

BACKGROUND AND PLEADINGS

1. On 9 April 2024, BRESEGA LTD ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 28 June 2024 and protection is sought for the following goods:

Class 3 Eyeliner pencils; Blusher; Blush pencils; Cleaner for cosmetic brushes; Make-up pencils; Makeup.

2. On 26 September 2024, the application was opposed by Gem Imports Ltd ("the opponent") based upon section 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the sign **Forever Beautiful** which it claims to have used throughout the UK since March 2018 in relation to:[1]

> "Hair brushes, facial cleansing brushes, make up brush sets, eyeshadow brushes, powder brushes, make up sponges, eyelash brushes, contour brushes, eyebrow brushes, nail brushes, concealer and blender brushes, foundation brushes, lip brushes, make up blender sponges, eyeshadow applicators, body brush and body sponges, hair clips, hair bobbles, headbands, hair rollers, false eyelashes, eyelash glue, eyelash curlers, pedicure sets, nail clippers, nail buffers, emery boards, false nails, nail brushes, tanning brushes, cosmetic pencil sharpeners, facial cleansing cloths, exfoliating gloves, vanity bags, beauty scissors, facial cleansing brushes, eyebrow trimming scissors, tweezers, mirrors, infused beauty blender, scrunchies, combs, spray bottles, travel bottles, self-tan applicator mitts, manicure sets, spa slippers and ruffles."

The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

[1] I note that in its Statement of Grounds the opponent also relies upon a device which consists of the words FOREVER BEAUTIFUL in a square border. Whilst it was mentioned in the Statement of Grounds, the TM7 was not completed in respect of this device. However, for reasons that will become clear, nothing will turn on this and so I do not need to address it any further.

3. The applicant filed a counterstatement denying the grounds of opposition. As it is the only statement that has been provided by the applicant in these proceedings, I have reproduced it in full below:

> “We disagree with the counter party as we are the right owner of the said trademark and we are selling the products under the trademark from 2021. We did not find any infringement or allegation from any party since then. If counter party can provide any prrof [sic] of use that would be great.”

4. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

REPRESENTATION

5. Neither party is represented.

EVIDENCE

6. The opponent filed evidence in the form of the witness statement of Mark Rigby dated 19 February 2025, which is accompanied by 13 exhibits (MR1 to MR13). Mr Rigby is Quality Assurance and Compliance Manager for the opponent, a position he has held since January 2018.

7. The applicant did not file evidence.

RELEVANCE OF EU LAW

8. 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

9. Section 5(4)(a) of the Act states as follows:

> "5(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."

10. Subsection (4A) of section 5 of the Act 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."

11. 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)."

Relevant date

12. 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.' "

13. The prima facie relevant date is the filing date of the contested mark i.e. 9 April 2024.

14. The applicant has not filed any evidence to show use of the mark in question prior to the prima facie relevant date. However, I note that the opponent does appear to

accept that the applicant has been using the mark prior to the filing date.[2] As such, I will also consider the position as of 2021.

Goodwill

15. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

> "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."

16. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C*. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

[2] At paragraph 17 of his witness statement, Mr Rigby states: "As stated by the Applicant in their TM8 Form which was submitted to the IPO, the applicant only began selling products under the "Forever Beautiful" brand in 2021. This timeline clearly demonstrates that the Applicant has been infringing on the Company's unregistered rights for up to four years."

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

17. The opponent is an importer and supplier of a range of goods that it sells to UK-based retailers. Mr Rigby has provided two spreadsheets which include a selection of products that he states have been sold under the sign relied upon prior to the prima facie relevant date.[3] These include goods such as hair colouring sets, hair bobbles, grips and clips, nail care goods (such as clippers, files and buffers), make up blenders, brushes and sponges. A second spreadsheet shows some of the quantities of these items that have been ordered.[4] By way of example, this included over 300,000 hair colouring sets, over 130,000 "no crease" hair clips sets and over 160,000 make up sponges. This evidence is further supported by invoices which Mr Rigby states were issued to UK customers prior to the relevant date.[5] Mr Rigby has highlighted the terms within the invoices that he states were sold under the sign relied upon. Mr Rigby explains that the opponent also grants re-sellers licences to use its trade marks on platforms such as Amazon, including the sign relied upon.

18. Mr Rigby has provided the following turnover figures for goods sold under the sign relied upon:

1 February 2018 to 31 January 2019	£243,043
1 February 2019 to 31 January 2020	£400,200
1 February 2020 to 31 January 2021	£693,805
1 February 2021 to 31 January 2022	£835,935
1 February 2022 to 31 January 2023	£987,854
1 February 2023 to 31 January 2024	£982,062

[3] Exhibit MR2
[4] Exhibit MR3
[5] Exhibit MR4

19. Mr Rigby has also provided a breakdown of units sold per product per year.[6] By way of example, I have identified some sales from the years prior to each relevant date:

2023

Manicure set (5 piece)	Over 29,000 units
Hair claw clips (3 pack)	Over 40,000 units
Hair clips (4 pack)	Over 31,000 units
Make up blenders (8 pack)	Over 24,000 units
Hair grips with case (60 pack)	Over 34,000 units
Coloured coiled hair bobbles (6 pack)	Over 18,000 units
Premium make up brush set	Over 32,000 units

2020

Manicure set (5 piece)	Over 15,000 units
Hair claw clips (3 pack)	Over 13,000 units
Hair clips (4 pack)	Over 19,000 units
Make up blenders (8 pack)	Over 14,000 units
Coloured Coiled Hair Bobbles (6 pack)	Over 12,000 units
Premium make up brush set	Over 9,000 units

20. In terms of promoting its brand, the opponent has provided evidence of advertising spend.[7] By way of example, the opponent invested over £23,000 in the year leading up to the prima facie relevant date in Google Ads and over £120,000 in promotion at trade shows. The equivalent spend in the year ending 1 February 2021 (so leading up to the earlier relevant date) was over £14,000 on Google Ads and over £72,000 on trade shows.

21. I bear in mind that none of the evidence filed by the opponent has been challenged by the applicant, nor has the applicant filed submissions commenting upon it in any

[6] Exhibit MR6

[7] See paragraph 13 of Mr Rigby's witness statement.

way. I also bear in mind that the opponent's turnover figures represent sales in relation to a broad range of goods. However, taking the evidence as a whole into account, it is possible to identify the goods in relation to which at least a reasonable proportion of these figures can be attributed. In my view, it seems that the opponent plainly had a modest (but protectable) goodwill at both relevant dates in relation to, at least, make up brush sets, make up blenders, hair clips, hair bobbles and manicure sets.

Misrepresentation and damage

22. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341* at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis* " and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and

concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

23. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

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. I have found that the opponent benefitted from a modest (but protectable) degree of goodwill at the relevant dates in relation to, at least, make up brush sets, make up blenders, hair clips, hair bobbles and manicure sets. Whilst not identical to the goods for which the application seeks protection, they are plainly within the same field of activity (all being goods used in the process of enhancing one's appearance). The application is a word-only mark, so could be used in any font. As such, the mark and sign are identical. Accounting for the fact that the mark and sign are identical, and are within the same field of activity, it seems to me that there will plainly be misrepresentation, and damage arising from diversion of sales. As such, the opposition succeeds in its entirety.

26. In reaching this conclusion, I have borne in mind the statement by the applicant that they have seen no evidence of "infringement". What I understand them to mean by this, is that there is no evidence of customers having been confused by the parties' respective marks in use. In this regard, Mr Justice Arnold said the following in *Samuel Smith Old Brewery (Tadcaster) v Lee (trading as Cropton Brewery)*:[8]

> "95. […] It is common ground that there is no evidence of any actual confusion. Understandably, counsel for Cropton Brewery relied strongly on this as indicating that there is no likelihood of confusion. As he rightly accepted, however, this is not conclusive. In considering the weight to be attached to this factor, it is relevant to consider what opportunity there has been for confusion to occur and what opportunity there has been for any such confusion to be detected."

27. Whilst this was said in the context of likelihood of confusion, it seems to me that the same is equally applicable when assessing whether deception is likely to arise in a passing off case. In this case, I have no evidence from the applicant to provide any information about the scale of their operation, how many units they have sold in the UK (and in relation to what products) or the way that their mark is presented in practice. In the absence of this information, it is difficult to know whether there has been opportunity for customers or potential customers of the opponent to be misled, or for it to be detected. Consequently, I do not find that this line of argument assists the applicant.

CONCLUSION

28. The opposition is successful and, subject to appeal, the application is refused.

COSTS

29. As the opponent has been successful it would ordinarily be entitled to a contribution towards its costs. However, as the opponent is unrepresented, the Tribunal wrote to it

[8] [2011] EWHC 1879 (Ch)

following the conclusion of the evidence rounds, inviting it to file a costs proforma if it wished to make a claim for costs. The opponent was informed that, if it did not do so, then no costs (other than official fees) would be awarded. As no proforma was filed, the only costs that I award the opponent are in respect of the official fee i.e. £200.

30. Consequently, I direct that BRESEGA LTD pays Gem Imports Ltd the sum of **£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 22nd day of July 2026

S WILSON
For the Registrar