

O/0817/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004042913
BY LEISA ROBERTS TO REGISTER:**

BROW SpA

AS A TRADE MARK IN CLASSES 3 & 41

**AND IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 448507 BY KEMMY MEHAN**

**AND IN THE MATTER OF REGISTRATION NO. UK00003921762
IN THE NAME OF LEISA ROBERTS FOR THE TRADE MARK:**

Brow spa

IN CLASS 44

**AND AN APPLICATION FOR A DECLARATION OF
INVALIDITY UNDER NO. 507526 BY KEMMY MEHAN**

**AND IN THE MATTER OF REGISTRATION NO. UK00004079833
IN THE NAME OF KEMMY MEHAN FOR THE TRADE MARKS:**

BROWSPA

browspa

(SERIES OF TWO)

IN CLASSES 41 & 44

**AND AN APPLICATION FOR A DECLARATION OF
INVALIDITY UNDER NO. 508181 BY LEISA ROBERTS**

BACKGROUND AND PLEADINGS

1. This decision involves consolidated opposition and cancellation application proceedings between Ms Kemmy Mehan and Ms Leisa Roberts. I will summarise the relevant proceedings below, beginning with those brought by Ms Mehan, on the basis that they were brought first.

Ms Mehan's opposition

2. On 23 April 2024, Ms Roberts applied to register the trade mark 'BROW SpA' in the UK under registration number 4042913 ("the opposed mark"). The opposed mark was published for opposition purposes on 10 May 2024, and registration is sought for the following goods and services:

Class 3: Beauty lotions; Beauty care cosmetics; Beauty serums; Beauty creams; Perfumery products; Beauty gels; Beauty milks; Beauty masks; Beauty balm creams; Skincare cosmetics; Natural cosmetics; Beauty preparations for the hair; Distilled oils for beauty care; Beauty care preparations; Cleansing products for the eyes; Facial beauty masks; Cosmetics; Essential oils for use in the manufacture of scented products.

Class 41: Instruction in cosmetic beauty; Beauty school services.

3. This mark was opposed in full by Ms Mehan on 9 July 2024. The opposition is based on sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act"). Under the section 5(4)(a) ground, Ms Mehan relies on the sign 'BROWSPA', which she claims to have been using throughout the North East of England since June 2020 in respect of the following services:

"Beauty care and Beauty treatment services; Beauty spa services; Beauty consultancy services; Advisory services relating to beauty care; Consultancy services relating to beauty."

4. As a result of the claimed use, Ms Mehan alleges that she is the owner of a substantial goodwill. It is argued that any use of the contested sign, for identical and/or highly similar goods and services, will give rise to a clear likelihood of misrepresentation on the part of the relevant public. Such a misrepresentation will lead to damage by way of lost sales, reputational damage or dilution of Ms Mehan's business.
5. Under the section 3(6) ground, Ms Mehan's position is that Ms Roberts has attempted to register protection for a mark that Ms Mehan had been using for four years prior. It is claimed that this filing was made with the dishonest intention to free-ride on the reputation of her earlier right, or to benefit from an earlier right regardless of the degree of recognition it had acquired in the market (which she claims to be the niche beauty services market). Further, it is claimed that Ms Roberts seeks to block Ms Mehan from the market in which she has actively traded for the previous four years.
6. Ms Roberts filed a counterstatement wherein she denied the claims against her.

Ms Mehan's application for invalidity

7. Ms Roberts is the proprietor of the following trade mark ("the contested mark"):

Brow spa

UK registration no. 3921762

Filing date 12 June 2023; registration date 8 September 2023

Registered for the following services:

Class 44: Beauty care; Beauty treatment; Beauty spa services; Beauty care services; Facial beauty treatment services; Beauty consultancy services; Advisory services relating to beauty care; Consultancy services relating to beauty; Providing information relating to beauty salon services; Advisory services relating to beauty

treatment; Providing information about beauty; Rental of machines and apparatus for use in beauty salons or barbers' shops.

8. On 9 July 2024, the contested mark was subject to an application by Ms Mehan to invalidate it in its entirety. The application is brought under section 47 of the Act and is based on section 5(4)(a).
9. While the pleading of the invalidation differs slightly from that used in the opposition, the claim is substantively the same in that Ms Mehan claims to own goodwill in her business due to her use of the sign 'BROWSPA' throughout the North East of England since June 2020 in respect of the same services listed at paragraph 3 above. It is claimed that such goodwill means that use of the contested mark would give rise to a misrepresentation which would ultimately cause damage to Ms Mehan's business.
10. Ms Roberts filed a counterstatement wherein she denied the claims against her.
11. Upon the filing of Ms Roberts's counterstatements, the Tribunal consolidated the above proceedings in accordance with Rule 62(g) of the Trade Marks Rules 2008 ("the Rules"). This was communicated to the parties via written correspondence dated 13 September 2024.

Ms Roberts's application for invalidity

12. Ms Mehan is the proprietor of the following trade mark registration ("the contested registration"):

BROWSPA

browspa

(Series of two)

UK registration no. 4079833

Filing date 25 July 2024; registration date 25 October 2024

Registered for the following services:

Class 41: Education and Training; Beauty School Services; Beauty Art Instruction; Instruction in Cosmetic Beauty; Teaching of Beauty Skills; Eyebrow Tattooing Training; Educational Services relating Beauty Therapy; Educational Services relating to Beauty Schools.

Class 44: Beauty Care; Beauty Consultancy; Beauty Counselling; Beauty Consultation; Beauty Salons; Beauty Treatment; Beauty Advisory Services; Beauty Consultation Services; Beauty Care Services; Beauty Information Services; Beauty Therapy Services; Beauty Spa Services; Beauty Salon Services; Hygienic and Beauty Care; Providing Information about Beauty; Facial Beauty Treatment Services; Advisory Services relating to Beauty; Beauty Treatment especially for Eyelashes; Consultancy in the field of Body and Beauty Care; Eyebrow Dyeing Services; Eyebrow Tinting Services; Eyebrow Threading Services; Eyebrow Tattooing Services; Eyebrow Shaping Services; Cosmetic Eyebrow Care Services.

13. On 5 December 2024, the contested registration was subject to an invalidation application by Ms Roberts. The application is brought under section 47 of the Act and is based on sections 5(1) and 5(2)(b). Both grounds are reliant upon two earlier trade marks, being those targeted by Ms Mehan's opposition and invalidation. For the purpose of Ms Roberts's application, I will simply refer to these as the '913 mark (being that discussed at paragraph 2 above) and the '762 mark being that discussed at paragraph 7 above).

14. The section 5(1) ground is broken down so that Ms Roberts relies only on the class 44 services of the '762 mark against Ms Mehan's class 44 services and only the class 41 services of the '913 mark against Ms Mehan's class 41 services. Under this ground, it is claimed that the marks at issue are identical, so too are the

services. As such, it is claimed that the contested registration should be declared invalid.

15. Under the section 5(2)(b) ground, Ms Roberts is reliant upon the entirety of the '762 mark's specification, which is aimed at all of the services of the contested registration. However, she only relies on the class 41 services of the '913 mark which is, again, aimed only at the class 41 services for which the contested registration is registered. Under this ground it is claimed that the marks at issue are highly similar and that the goods and services at issue are identical and/or similar. As such, it is Ms Roberts's position that there exists a likelihood of confusion.

16. Ms Mehan filed a counterstatement wherein she argued that the marks relied upon by Ms Roberts are either to be declared invalid or refused registration and, as such, do not constitute valid earlier marks. In the alternative, if Ms Roberts's marks proceed to registration or remain registered, Ms Mehan accepts that the marks at issue are similar (or quasi-identical) but denies that the services at issue are identical or similar, which alleviates any risk of confusion between the marks at issue.

17. Upon the filing of Ms Mehan's counterstatement, the Tribunal added Ms Roberts' invalidation application to the already consolidated proceedings in accordance with Rule 62(g) of the Rules. This was communicated to the parties via written correspondence dated 18 March 2025.

18. Ms Mehan is represented by BRIFFA and Ms Roberts is represented by Forresters IP LLP. Both parties filed evidence in chief during these proceedings. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

19. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The

provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

EVIDENCE

20. Ms Mehan's evidence came via a witness statement in her own name dated 11 November 2024. Her evidence is accompanied by seven exhibits, labelled KM1 to KM7, and was adduced in order to demonstrate the existence of goodwill in the sign relied upon. Whilst it is noted that her opposition covers a section 3(6) ground, the evidence does not attempt to speak to any allegations of bad faith. I will discuss this issue further below.

21. Ms Roberts's evidence came in the form of the witness statement of Ms Kathryn Louise Cruse dated 19 May 2025. Ms Cruse is a Chartered Trade Mark Attorney at Ms Roberts's representative firm and is, therefore, duly authorised to file evidence on her behalf. Ms Cruse's evidence is accompanied by four exhibits, labelled KLC1 to KLC4, and was adduced in order to demonstrate the size of the relevant market and data surrounding Ms Mehan's business.

22. I do not intend to discuss the parties' evidence in full at this point but will, where necessary, discuss it below.

MY APPROACH

23. The actions brought by Ms Mehan are aimed at the trade marks upon which Ms Roberts relies for the purpose of her own invalidation application. Therefore, any success of Ms Mehan's proceedings has a direct impact upon Ms Roberts's invalidation application. For example, if Ms Mehan succeeds in full, Ms Roberts's marks will be incapable of being earlier marks relied upon for the purpose of her own action. Therefore, her invalidation application will fall away. Alternatively, if Ms Mehan's proceedings are only partially successful or fail in their entirety, Ms Roberts's invalidation application will proceed (albeit only partially if her marks

survive in part). As a result, it is necessary to consider Ms Mehan's proceedings first. In doing so, I note that the section 5(4)(a) grounds across Ms Mehan's invalidation and opposition are identical. Further, they are reliant upon the same evidence. I will, therefore, deal with these together.

DECISION

Ms Mehan's section 5(4)(a) ground

24. Firstly, it is necessary to point out that section 5(4)(a) grounds are automatically applicable to oppositions. However, insofar as invalidation actions are concerned, this ground has application by virtue of section 47(2)(b) of the Act, which states as follows:

“47. –

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(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.

[...]

(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.”

25. Section 5(4)(a) of the Act reads as follows:

“(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.”

26. 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.”

27. 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).”

28. 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."

Relevant Dates

29. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., 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.’ ”

30. The opposed mark was filed on 23 April 2024 and contested mark was filed on 12 June 2023. Neither mark has a priority date and Ms Roberts has filed no evidence of any earlier use that could be said to be the behaviour complained about. As such, the relevant date for Ms Mehan's invalidation proceedings is 12 June 2023 and the relevant date for her opposition is 23 April 2024.

Goodwill

31. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), 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.”

32. 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 than 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.

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.”

33. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any

absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

34. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the *Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.”

35. Goodwill results from trading activities in the UK. Ms Mehan’s evidence sets out that she is a professional make-up artist and brow specialist who, in June 2020, set up an exclusive make up and brow studio trading as ‘Browspa’. Screenshots taken from her website, ‘browspa.co.uk’, are provided.¹ These were obtained from the internet archive facility, the Wayback Machine, with the earliest screenshot being dated 28 November 2020. In addition, a screenshot from Nominet is provided

¹ KM1

showing that Ms Mehan purchased this domain name on 20 September 2019.² She confirms that this was done in anticipation of the launch of her brand.

36. In further confirmation as to when she launched her brand, a range of Instagram posts are provided from the account 'BROWSPABYKEMMY'.³ The first is dated 17 June 2020 and includes an announcement about her new 'BROWSPA' business by using the following sign:⁴



37. There are additional posts beyond this that demonstrate the services offered (such as pencilled henna eyebrows, for example). These are dated between 22 August 2020 and 28 March 2023. While noted, they show very limited levels of engagement with the highest number of 'likes' on one post (outside of the initial announcement which had 49 likes) being 30. In addition to the above, posts from different social media platforms are provided but, again, these show very low levels of engagement.⁵

38. Whilst still on the topic of social media, Ms Mehan has provided evidence of her following. This comes via printouts of the landing pages for her Facebook and Instagram accounts.⁶ It is noted that, in terms of branding, the Facebook account is named 'Brow Spa by Kemmy' and her Instagram account is, as above, 'browspabykemmy'. On this point, the Facebook account shows the following branding:

² KM2

³ KM3

⁴ For the avoidance of doubt, this sign is similar to the one used on the website discussed above. However, it is reproduced here for the first time because the sign used on the website appears as though the word 'brow' is presented in white on a white background, rendering it invisible on that screenshot.

⁵ KM4

⁶ KM5



39. The accounts show a following of 1,200 on Facebook and 891 on Instagram. It is stated in her narrative evidence that her followers are far reaching, in that they extend to London, Manchester, Derby, Durham, Coventry, Rotherham and Buckley. This is noted but the screenshots are undated and are, therefore, likely to have been obtained around the time the statement was made in November 2024. This is some six months after the relevant date for the opposition and approximately 17 months after the relevant date for the invalidation. As such, it is not possible for me to determine the accurate following numbers as at the relevant dates. Further, whilst her business is located in Newcastle, social media is often global in nature and it is not clear whether all of her followers are UK-based. Even if they were, I do not consider that a follow on social media automatically amounts to custom.

40. In respect of sales, Ms Mehan has provided a breakdown of her annual sales for the financial years 2021 to 2024. They are as follows:

Financial Year	Sales (£)
2021	15,604
2022	50,258
2023	46,349
2024	44,924

41. These figures are supported by financial accounts provided in evidence.⁷ These accounts confirm that the financial years are for the years ending on 31 March. As such, the sales figures provided cover 1 April 2020 to 31 March 2024.

⁷ KM6

42. While the figures are noted, I have no way to accurately determine the figures as they stood at the actual relevant dates. Therefore, I will take a relatively general approach and proceed on the basis that the total approximate sales pertinent to the invalidation are £112,211 (which covers 1 April 2020 to 31 March 2023) and, for the opposition, they are £157,135 (being the entirety of the figures provided above). I appreciate that the actual sales figures may vary slightly given the placement of the relevant dates but I have no way to accurately calculate the turnover beyond the breakdown of financial years provided.

43. In further support of the sales figures, Ms Mehan has provided a number of invoices from prior to 24 May 2023.⁸ These invoices cover a range of eyebrow treatments to customers in and around Newcastle as well as London. It is noted that each invoice includes the same 'BrowSpa' branding as that shown on Ms Mehan's Facebook page, being that which I have reproduced at paragraph 38 above.

Assessment of the evidence

44. Before moving to assess the evidence of Ms Mehan, I wish to discuss the fact that Ms Roberts has filed evidence speaking to the size of the relevant market.⁹ While this is noted, it speaks to the personal care industry at large and the only mention of the UK eyebrow market comes in comments from Ms Cruse that this market was part of the broader beauty industry and has been experiencing growth due to trends in eyebrow grooming.¹⁰ I do not consider that this comment from Ms Cruse is sufficient evidence of fact and is, instead, mere supposition. That being said, I do accept that the eyebrow grooming market in the UK is a sizeable one, with turnover in the multiples of millions of pounds per annum. In my view, this is a conclusion I can reach without the need for evidence as the relevant market is not a niche or specialist one.

⁸ KM7

⁹ KLC1

¹⁰ See paragraph f) of Ms Cruse's witness statement

45. In considering Ms Mehan's evidence, I bear in mind that there is very little to demonstrate any advertising or marketing attempts beyond a limited number of social media posts. For example, Ms Mehan has provided no evidence as to marketing expenditure and neither has she demonstrated that her social media posts have sufficient reach because, as set out above, they all attracted very low levels of engagement. Further, while a range of invoices are provided, the customers' names are redacted so I am unable to determine the level of any repeat custom for Ms Mehan's business. Lastly, the use provided covers 17 June 2020 to either 12 June 2023 or 23 April 2024 (depending on the relevant date) meaning that the period of use for the invalidation is just under three years whereas, for the opposition, it is just under four. Either way, this is not longstanding use.

46. Despite all of the above criticisms, Ms Mehan has provided evidence of her sales revenue between June 2020 and the relevant dates. During this time, she amassed a level of sales of approximately £112,211 in respect of the first relevant date and approximately £157,135 in respect of the second. Whilst this is reflective of a low level of sales (especially in the market within which she operates which, as above, is a sizeable one), I remind myself that even small businesses which have more than a trivial goodwill can protect signs which are distinctive of their businesses under the law of passing off even though its goodwill and reputation may be small.¹¹

47. Taking all of the above into account, I am of the view that despite the low level of use and lack of any material advertising efforts, Ms Mehan's business can be said to enjoy a protectable level of goodwill as at both of the relevant dates. While that may be the case, the present ground does not automatically proceed as I am required to consider whether the sign relied upon is distinctive of or associated with the goodwill of Ms Mehan's business.

48. In respect of the sign relied upon, it is noted that Ms Roberts's submissions discuss the fact that Ms Mehan's business is carried out under the branding 'BROW SPA BY KEMMY'. This is supported to a degree by Ms Mehan's own evidence as her

¹¹ See, for example, the case of *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

invoices and social media accounts feature such branding. This is noted and whilst I accept that Ms Mehan does use the word 'BY KEMMY' after use of 'BROWSPA' on occasion, there is also use of just the 'BROWSPA' branding on its own, via Ms Mehan's own website and in various social media posts.¹² Further, the description of the services in the invoices provided refer to 'BrowSpa' and, in addition, state that payment can be made to Ms Mehan or 'Browspa'. Therefore, I do not see any merit in the point raised by Ms Roberts in her submissions.

49. The above being said, I consider that the primary obstacle facing Ms Mehan and an association between the goodwill in her business and the sign relied upon is the distinctiveness of 'BROWSPA'. I say this because the sign relied upon, being 'BROWSPA', will immediately convey a message relating to Ms Mehan's business, in that it offers a 'spa' type service where the user can get their eyebrows groomed or treated.¹³ Whilst not directly descriptive as a whole, it does have an element of descriptiveness to it and, as such, would be a sign that only benefits from a low degree of distinctiveness. In considering signs of this nature under section 5(4)(a) grounds, I remind myself of the case of *McCain International Limited v Country Fair Foods Limited and Another* [1981] R.P.C. 69 (COA) wherein the Court of Appeal found that while a descriptive term may acquire a secondary meaning (as a reference to the source or maker of goods or services and, therefore, distinctive of the provider of those goods or services), any evidence in support of such must be extensive.

50. In addition, I also remind myself of the case of *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), wherein the sign 'reCUP' was relied upon. The level of use in that case amounted to almost 40,000 paper cups in total. On the face of it, this clearly appears to be a high level of unit sales. However, it was found by Mr Thomas Mitcheson QC (now KC), as the Appointed Person, at paragraph 41 of his decision that:

¹² See pages 1, 2, 4 and 6 of KM2 for example.

¹³ On this point, I consider that (1) the consumer will readily identify 'BROWSPA' as being the two words 'BROW' and 'SPA' conjoined and (2) 'BROW' will immediately be understood as short for eyebrows.

“Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. 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 sufficient goodwill in that sign so as to make it distinctive of Party A’s goods.”

51. I appreciate that there is no evidence before me of other entities seeking to use ‘BROWSPA’ for similar services at issue here. However, I am of the view that the message conveyed by ‘BROWSPA’ (being that which I have discussed above) is immediately graspable and, as such, is of a low distinctive character. Therefore, evidence of the sort discussed in the excerpt reproduced above is not a necessity in each case that brings up similar issues.

52. Taking the principles laid out in *McCain* and *Smart Planet* into account, I am of the view that the present case is one that falls in line with the findings made in those cases. I appreciate that whilst ‘BROWSPA’ is, clearly, not as directly descriptive as the sign ‘OVEN CHIPS’ was in *McCain*, it does consist of an element of descriptiveness. As such, I am of the view that in order for it to be distinctive of or associated with Ms Mehan’s business, it must be supported by use at higher levels or over a more longstanding period of time. That is not the case here and, as such, I find that the present ground fails because the sign relied upon is not distinctive of the goodwill vested in Ms Mehan’s business.

53. The consequence of the above is that Ms Mehan’s invalidation application fails in its entirety on the basis that it was only reliant upon the section 5(4)(a) ground. However, the opposition remains live because it included a section 3(6) ground, which I will now proceed to consider.

Section 3(6)

54. 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.”

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

“(i) [...]”

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

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

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45;

[*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45].

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

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

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

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

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

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

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

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

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

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

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

56. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. the balance of probabilities). 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).

57. It is necessary to ascertain what Ms Roberts knew at the relevant date: *Red Bull* (cited above). 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).

58. The relevant date for the present assessment is 23 April 2024, being the date on which Ms Roberts applied for the opposed mark.

59. The basis for Ms Mehan's claim under the present ground is that Ms Roberts has attempted to register protection for a mark that she had been using for four years prior. It is claimed that this filing was made with the dishonest intention to free-ride on the reputation of her earlier right, or to benefit from an earlier right regardless of the degree of recognition it had acquired in the market. In addition, it is claimed that Ms Roberts seeks to block Ms Mehan from the market in which she has actively traded for the previous four years.

60. As I have discussed above, Ms Mehan's evidence does not speak to any claims under the present ground. It appears that the sole support of her section 3(6) claim came via her submissions in lieu. These set out, at paragraph 39, that Ms Roberts was placed on notice of Ms Mehan's unregistered rights in the sign 'BROWSPA' under the cover of correspondence dated 16 April 2024 and that, applying for her mark seven days later, was for the sole purpose of undermining Ms Mehan in a manner inconsistent with honest practices. Firstly, the allegation that Ms Roberts was made aware of Ms Mehan's rights on 16 April 2024 is not borne out in evidence. Even if it were, knowledge of another user's use of a mark in the UK is not, by itself, sufficient to give rise to a finding of bad faith.¹⁴ Further on this point, at the time of this alleged correspondence, Ms Roberts was already the owner of the contested mark (being 'Brow spa' for beauty services in class 44), which she applied for around 10 months prior to this alleged correspondence.¹⁵ In short, I am of the view that applying for an identical mark to one she already owned for different (but associated)¹⁶ goods and services can simply be said to be a reasonable attempt to expand her business. Outside of this vague allegation in her submissions, there is nothing from Ms Mehan to suggest that Ms Roberts has attempted to block Ms Mehan from the market.

61. Taking all of the above into account and reminding myself that, as above, bad faith is a serious allegation that must be distinctly proven on the balance of probabilities, I find that Ms Mehan has failed to substantiate her claims under the present ground. Therefore, I find that the present ground must fail.

Final remarks in respect of the actions brought by Ms Mehan

62. Both the opposition and the invalidation actions brought by Ms Mehan have failed in their entirety. As such, Ms Roberts's marks remain valid earlier marks that are

¹⁴ See paragraph 40 of *Lindt* (cited above).

¹⁵ This is the mark that was subject to Ms Mehan's invalidation application.

¹⁶ I say 'associated' because the mark subject to the present ground relates to beauty educational/training services in class 41 and cosmetic goods in class 3. Such goods and services are, in my view, closely associated to the point that it cannot be said that it was unreasonable or unexpected for Ms Roberts to expand in this way.

capable of being relied upon in her invalidation application (more on this below). I will now proceed to consider Ms Roberts's invalidation action.

Ms Roberts's invalidation application

63. Ms Mehan's submissions discuss Ms Roberts's cancellation proceedings but only to the extent that they confirm her position in that they should fall away on the basis that her own actions succeed. She made no comment as to the position should her own proceedings fail, which they have. On this point, it is noted that in her counterstatement to Ms Roberts's invalidation, she accepts similarity (quasi-identity) of the marks but denies the goods and services are identical or similar.

64. Sections 5(1) and 5(2)(b) of the Act have application in invalidation proceedings by virtue of section 47(2)(a) of the Act, which states as follows:

“47. –

[...]

(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) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

65. Additional provisions under section 47 of the Act which are relevant here (but were not in Ms Mehan's invalidation above), are as follows:

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with 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 where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(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) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

[...]

66. For the avoidance of doubt, sub-sections (5), (5A) and (6) of section 47 (which I reproduced above) are also relevant to the present proceedings.

67. Given their filing dates, both of Ms Roberts’s marks qualify as earlier trade marks under the provisions set out in section 6 of the Act, which states as follows:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in

question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

68. As neither of Ms Roberts’s marks completed their registration processes more than five years prior to the filing date of the contested registration or the date of the application for invalidity, they are not subject to the use provisions set out at section 47(2B) of the Act. Ms Roberts may, therefore, rely on all of the goods and services for which her marks are protected.

69. In respect of the present application for invalidity, I will consider the section 5(1) ground first and will, if necessary, proceed to consider the section 5(2)(b) ground thereafter.

Section 5(1): legislation

70. Section 5(1) of the Act reads as follows:

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

Identity of the marks

71. It is a pre-requisite of section 5(1) of the Act that the trade marks at issue are identical. The marks at issue here are as follows:

Ms Roberts's marks	The contested registration
BROW SpA ("the '913 mark") Brow spa ("the '762 mark")	BROWSPA browspa (series of two)

72. All of the marks at issue are word only marks meaning that they are capable of being used in upper case, lower case or any customary combination of the two. On this point, I note that the '913 mark presents the word 'SPA' as 'SpA'. I am of the view that this is covered by the fair and notional use of word only marks.¹⁷ Bearing this in mind together with the fact that the different cases used across the remaining marks at issue are clearly all customary, the issue of capitalisation is not a point of consideration for the question as to whether the marks are identical or not.

73. In considering the issue of identical marks, I bear in mind the case of *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, wherein the Court of Justice of the European Union ("CJEU") held that:

"54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

74. The contested registration consists of two marks that are the conjoined words 'BROW' and 'SPA'. Despite the marks being presented as one word, I find that consumers will readily identify them as two words. As for Ms Roberts's marks, these are both word only marks that consist of the two words 'BROW' and 'SPA'.

¹⁷ In reaching this finding, I bear in mind the comments of Mr Iain Purvis QC in MR HERON (BL O/954/22), particularly his discussion surrounding the use of font and capitalisation at paragraph 15 of his decision.

In considering all of the marks at issue, the difference between them stems from the space (or lack thereof) between the words 'BROW' and 'SPA'. Such a difference is, in my view, so insignificant that it will go unnoticed by the majority of consumers. This is especially the case given that the marks in the contested registration will, as above, be readily identified as being the words 'BROW' and 'SPA' conjoined. As such, I find that these marks are identical.

Comparison of services

75. The comparison of the services under the section 5(1) ground can be broken down as follows:

Ms Roberts's services	Ms Mehan's services
<i>The '913 mark (aimed at the class 41 services only)</i> <u>Class 41</u> Instruction in cosmetic beauty; beauty school services.	<u>Class 41</u> Education and training; beauty school services; beauty art instruction; instruction in cosmetic beauty; teaching of beauty skills; eyebrow tattooing training; educational services relating beauty therapy; educational services relating to beauty schools.
<i>The '762 mark (aimed at the class 44 services only)</i> <u>Class 44</u> Beauty care; beauty treatment; beauty spa services; beauty care services; facial beauty treatment services; beauty consultancy services; advisory services relating to beauty care; consultancy services relating to	<u>Class 44</u> Beauty care; beauty consultancy; beauty counselling; beauty consultation; beauty salons; beauty treatment; beauty advisory services; beauty consultation services; beauty care services; beauty information services; beauty therapy services; beauty spa services; beauty salon services; hygienic and beauty care;

beauty; providing information relating to beauty salon services; advisory services relating to beauty treatment; providing information about beauty; rental of machines and apparatus for use in beauty salons or barbers' shops	providing information about beauty; facial beauty treatment services; advisory services relating to beauty; beauty treatment especially for eyelashes; consultancy in the field of body and beauty care; eyebrow dyeing services; eyebrow tinting services; eyebrow threading services; eyebrow tattooing services; eyebrow shaping services; cosmetic eyebrow care services.
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76. In order for the present ground to succeed, the services at issue must be identical. If they are not, the present ground fails. That being said, Ms Roberts also relies on section 5(2)(b), which only requires a degree of similarity to proceed. Therefore, where I find there to be no identity, I consider it appropriate to go on to consider similarity at this stage so as to avoid the need to return to a services comparison later on in my decision.

77. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

78. In addition to the above, and insofar as it relates to similarity only, I also bear in mind the fact that, when making a comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the

judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

79. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Class 41

Education and Training.

80. The above term covers any type of education or training which can include those that cover topics such as cosmetic beauty and beauty school services. I note that the '913 mark's specification includes the terms "instruction in cosmetic beauty" and "beauty school services". Both cover types of educational or training services. As such, I find that these services are identical under the principle outlined in *Meric*.

Beauty School Services; instruction in cosmetic beauty

81. These terms are self-evidently identical to the terms of "beauty school services" and "instruction in cosmetic beauty" in the '913 mark's specification, respectively.

Beauty Art Instruction; Teaching of Beauty Skills; Eyebrow Tattooing Training; Educational Services relating Beauty Therapy; Educational Services relating to Beauty Schools.

82. All of the above services relate to instruction relating to cosmetic beauty or are those that will be provided in beauty schools. As such, I find that they are all encompassed by the terms of "instruction in cosmetic beauty" and "beauty school services" in the '913 mark's specification. These services are, therefore, identical under the principle outlined in *Meric*.

Class 44

Beauty Care; beauty care services; beauty treatment; beauty advisory services; beauty consultancy; beauty consultation; beauty consultation services; advisory services relating to beauty; consultancy in the field of [...] beauty care; beauty information services; providing information about beauty; beauty spa services.

83. Ms Roberts's second mark's specification includes the following terms:

“Beauty care; beauty consultancy services; beauty treatment; advisory services relating to beauty care; providing information about beauty; beauty spa services”

84. Some of the services directly overlap and are, clearly, self-evidently identical. Even where the terms are worded slightly differently, I find that they are still self-evidently identical with the respective services of the “762 mark’s specification.

Beauty salons; beauty therapy services; beauty salon services; hygienic and beauty care; facial beauty treatment services; beauty treatment especially for eyelashes; eyebrow dyeing services; eyebrow tinting services; eyebrow threading services; eyebrow tattooing services; eyebrow shaping services; cosmetic eyebrow care services.

85. All of the above terms can be categorised as being beauty care or beauty treatment services. As such, I find that they are identical under the principle outlined in *Meric* with the terms “beauty care” and “beauty treatment” in the “762 mark’s specification.

Consultancy in the field of body [...] care.

86. As far as I am aware, the above services can cover not only consultancy in respect of physical wellbeing or rehabilitation of the body but also superficial body care for the beautification of the body. For example, it can cover the consultation relating to services that a beautician may also offer, such as treatments to reduce dry skin, wrinkles on the body or cellulite. In the latter context, I find that this term is identical under the principle outlined in *Meric* to “beauty consultancy services” in the “762 mark’s specification. I say this because Ms Roberts’s term is not limited to the beauty of the face so may, therefore, cover consultancy in relation to the beauty of the body.

87. I am conscious that if my interpretation of the term above is incorrect and only the former type of service applies, then Ms Mehan's term would not be identical to "beauty consultancy services" in the '762 mark's specification. I will, therefore, consider whether, in these circumstances, they are similar. Whilst the topic of consultancy may differ, the nature and method of use of the services will overlap to some degree with Ms Roberts's "beauty consultancy services". In terms of the purposes of these services, they are both consultancy services so there is some degree of overlap in their core purposes. The user will overlap broadly in that someone looking for beauty consultancy may also require consultancy in respect of looking after their body. Due to their topics, there will be no competitive or complementary relationship between these services. Lastly, I do not consider it common in the trade for an undertaking to provide consultancy for body care to also provide consultancy in respect of beauty. Overall, whilst the overlaps are somewhat general, they are numerous and, in my view, result in a finding that these services are similar to a medium degree.

Beauty counselling.

88. It is my view that the best comparator to the above term is the service of "beauty consultancy services" in the '762 mark's specification. Counselling is, as far as I am aware, a type of therapy where a therapist or counsellor will listen to someone and help them find solutions to problems or issues they are experiencing. In the context of 'beauty', this may include discussions surrounding someone's mental wellbeing regarding their own perceived beauty. Alternatively, it may include counselling in the context of listening to the customer's needs and advising or guiding them as to what beauty routine or products may benefit them or assist them in their areas of concern. It is my view that this is not a beauty consultancy service in the same way as covered by Ms Roberts's service. It is, therefore, not identical to that service, or any of the other services covered by Ms Roberts's specification for that matter.

89. The above being said, I am of the view that in the context of the alternative interpretation of Ms Mehan's term above, there is a degree of similarity between

the services. While their natures may differ, there is some overlap in method of use and purpose as both terms will be sought and provided in similar ways and aim to provide assistance to the beauty of the user. I am not convinced that there is an overlap in trade channels and I note that I have nothing before me to suggest otherwise. In terms of user, I am of the view that someone struggling with issues surrounding the perception of their own beauty will look for consultation in respect of the same but, also, seek counselling if the matter is not resolved. Further, there is also a degree of competition between the services as someone looking to improve their beauty may seek counselling over consultancy, or vice versa. Overall, I consider that these services are similar to a medium degree.

Conclusion on the services comparison

90. As set out above, a requirement of section 5(1) grounds is that the services are identical. In the present case, I have found the majority of the services to be identical meaning that the invalidation succeeds in respect of those. The contested registration is, therefore, to be declared invalid for the following services:

Class 41: Education and training; beauty school services; beauty art instruction; instruction in cosmetic beauty; teaching of beauty skills; eyebrow tattooing training; educational services relating beauty therapy; educational services relating to beauty schools.

Class 44: Beauty care; beauty consultancy; beauty consultation; beauty salons; beauty treatment; beauty advisory services; beauty consultation services; beauty care services; beauty information services; beauty therapy services; beauty spa services; beauty salon services; hygienic and beauty care; providing information about beauty; facial beauty treatment services; advisory services relating to beauty; beauty treatment especially for eyelashes; consultancy in the field of body and beauty care;¹⁸ eyebrow

¹⁸ It is my primary view that the 'body care' aspect of this term is identical but, if not, it will be subject to the section 5(2)(b) ground below.

dyeing services; eyebrow tinting services; eyebrow threading services; eyebrow tattooing services; eyebrow shaping services; cosmetic eyebrow care services.

91. In relation to those services that I have found to be similar, the application reliant upon section 5(1) must fail. As above, I will now proceed to consider the section 5(2)(b) ground.

Section 5(2)(b): legislation and case law

92. Section 5(2)(b) states that:

“(2) A trade mark shall not be registered if because-

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

93. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

94. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

My approach to the section 5(2)(b) ground

95. As per the statute reproduced above, section 5(2)(b) of the Act covers claims that the marks at issue are similar, not identical, and that the goods and services are identical or similar. In the present proceedings, I am of the view that it was more appropriate for Ms Roberts to rely on section 5(2)(a) of the Act as the alternative to her section 5(1) ground, as opposed to relying solely on section 5(2)(b). This is because section 5(2)(a) grounds cover instances where the marks are identical but the goods or services are only similar, which is the case for some of the terms at issue here.

96. Despite the above, I am of the view that I can take a pragmatic approach to the section 5(2)(b) ground and will, therefore, proceed on the basis that my finding in respect of identity of the marks was incorrect and that the marks are only similar. The consequence of this is that all of Ms Mehan's services remain at issue under the present ground. In proceeding on this basis, my above findings in respect of the services at issue remain relevant. I will, however, need to reassess the similarity of the marks in line with this approach.

Comparison of the services

97. I conducted a comparison of the services above and whilst that comparison did not factor in the class 3 goods of the '913 mark's specification,¹⁹ I do not consider that they offer any further assistance beyond the services relied upon under the section 5(1) ground. Therefore, I consider that the above comparison is equally applicable here. I do not intend to repeat it here, save to remind myself that the majority of the services at issue are identical, with "consultancy in the field of body care" attracting a back-up finding that it was similar to a medium degree (depending on the correct interpretation of the term) and "beauty counselling" also being similar to a medium degree.

The average consumer and the nature of the purchasing act

98. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

99. In *Iconix* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

¹⁹ Because they were not relied upon under the section 5(1) ground.

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

100. The services at issue are those that will be sought by members of the general public at large. They will be available from the provider of the services directly, be that via beauty salons (for the beauty care services), educational/training providers (for the class 41 services) or therapists' offices (be that counselling therapists for 'beauty counselling' or physical therapists for the body care services). Regardless of where the services are provided, they will be viewed by the consumer via lists on websites, on physical pamphlets or on placards at the providers' premises. As a result, I find that the selection process for the services at issue will be primarily visual in nature. That being said, the aural component will still play a role due to word of mouth recommendations and discussions with sales staff.

101. The services at issue are those that will be selected with varying degrees of frequency and at varying costs. I say this because beauty care services may be sought frequently and at a relatively low cost whereas training in respect of beauty

services will be sought on a relatively infrequent basis and may be rather expensive in comparison. As for the consultancy services relating to body care, these may only be sought on a very infrequent basis, such as soon after suffering an injury that requires advice on how to properly recover from the same, for example. In my view, regardless of the purpose of the services at issue, they will all attract consideration of similar factors such as the expertise of the provider, reviews or testimonials from previous customers and materials/techniques used. In my view, these are fairly ordinary factors and I say this regardless of whether the services relate to beauty care, counselling, education or consultancy of the body. As such, I find that the services at issue attract a medium degree of attention.

Comparison of the marks

102. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

103. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

104. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

105. The respective trade marks are shown below:

Ms Roberts's marks	The contested registration
BROW SpA ("the '913 mark") Brow spa ("the '762 mark")	BROWSPA browspa (series of two)

106. I repeat here what I have above with regard to the use of differing cases across the marks, in that they are irrelevant to the comparison of the marks. The marks are word only marks meaning that their overall impression is dominated by the words within them, being 'BROW SPA' in Ms Roberts's marks and the conjoined word 'BROWSPA' in the marks of the contested registration.

107. From a visual perspective, the marks at issue consist of the same words, being 'BROW' and 'SPA', albeit only differing in the presence of the space between the words in Ms Roberts's marks and the lack of a space in the marks of the contested registration. This is a very minor point of difference and, as such, I find that the marks are visually similar to a very high degree. In respect of the aural comparison, I find that regardless of the space (or lack thereof) in the marks, they will all be pronounced in the same way, namely 'BROW-SPAR'. They are, therefore, aurally identical. Lastly, I have discussed the concept of 'BROWSPA' when considering the section 5(4)(a) ground of Ms Mehan's actions above in that it will be readily understood as *a spa where the user will get their eyebrows treated*.²⁰ Regardless

²⁰ Even where the services at issue may not relate to 'eyebrows', this same concept will attach to the words.

of the presence of a space in the marks, this concept will be identified in both parties' marks and, therefore, they are conceptually identical.

Distinctive character of Ms Roberts's marks

108. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

109. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and while Ms Roberts has

filed evidence, it does not pertain to use of her marks so is not at issue here. As such, I only have the inherent position to consider.

110. As I have set out at various points above, I am of the view that consumers will readily identify 'BROW SPA' to be a reference to a 'spa' where they can seek treatments to their 'eyebrows'. On the services relied upon under Ms Roberts's marks, I do not consider that the words are directly descriptive but there is a strong allusion to their nature.²¹ As a result, I find that Ms Roberts's marks are inherently distinctive to a low degree.

Likelihood of confusion

111. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

112. I found the services at issue to be mostly identical, with two terms being similar to a medium degree.²² The average consumer base for the services at issue will

²¹ I acknowledge that some of her services are educational in nature. However, this still applies to those services due to their specific purpose of being the provision of instruction in cosmetic beauty and beauty school services.

²² I remind myself that the primary finding for one of these similar terms is of identity.

be members of the general public who will select the services via primarily visual means (though I do not discount an aural component) whilst paying a medium degree of attention. I have found the marks at issue are visually similar to a very high degree and aurally and conceptually identical. Lastly, I concluded that Ms Roberts's marks possess a low degree of inherent distinctiveness.²³

113. Taking all of the above factors into account, I find that the marks are likely to be mistakenly recalled or misremembered for one another due to their very high level of visual similarity and identity in their aural and conceptual elements. Whilst Ms Roberts's marks only enjoy a low degree of distinctive character, I have set out at footnote 23 above that this does not preclude a likelihood of confusion. On this point, the marks at issue are word only marks meaning that there are no other elements to detract from the fact that consumers will seek to pin their recollection of the marks on the words 'BROW' and 'SPA', regardless of the presence of the space between them. Further, it is my view that consumers will misremember which mark had a space between the two words, and which did not, especially when factoring in the principle of imperfect recollection and bearing in mind that the selection process does not attract a high degree of attention.²⁴ Consequently, I find that there exists a likelihood of confusion between the marks at issue. Further, given the very high similarity of the marks from a visual perspective as well as the identity in their aural and conceptual elements, I find that this applies regardless of whether the consumer is confronted with the marks on services that are identical or similar.²⁵

CONCLUSION

114. The opposition and invalidation brought by Ms Mehan have failed in their entirety. As such, Ms Roberts's opposed mark (4042913) may proceed to registration for all goods and services applied for. Further, Ms Roberts's contested

²³ On this point, I remind myself that, as per, *L'Oréal SA v OHIM*, Case C-235/05 P, a weaker distinctive character of an earlier mark does not preclude a likelihood of confusion

²⁴ Even if it did, the near identity of the marks would still overcome this factor.

²⁵ For the avoidance of doubt, if I were incorrect to find a medium degree of similarity and the level of similarity was actually low or even very low, the near identity of the marks would offset this.

mark (3921762) may remain registered for all of the services at issue. As for Ms Roberts's invalidation application, this succeeded in full meaning that Ms Mehan's contested registration (4079833) is declared invalid and is hereby deemed never to have been made. For the avoidance of doubt, all of my conclusions are subject to appeal.

COSTS

115. Ms Roberts has succeeded in defending the actions brought against her and in bringing the invalidation application against Ms Mehan's registration. She is, therefore, entitled to a contribution towards her costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I appreciate that Ms Roberts's evidence did not offer much assistance to the present proceedings. However, she still filed evidence and was also required to incur the costs of considering Ms Mehan's own evidence. Therefore, I am of the view that she is still entitled to an award in respect of this task.

116. I hereby award Ms Roberts the sum of £1,900 as a contribution towards her costs. The sum is calculated as follows:

Considering a notice of opposition and preparing a counterstatement to the same:	£250
Considering an application for invalidity and preparing a counterstatement to the same:	£250
Preparing an application for an invalidity and considering a counterstatement to the same:	£250
Considering the evidence of Ms Mehan and filing evidence:	£600
Written submissions in lieu:	£350

Official fees: £200

Total: £1,900

117. I hereby order Kemmy Mehan to pay Leisa Roberts the sum of £1,900. The above sum should 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 9th day of September 2026

A COOPER

For the Registrar