BL O/0141/24

TRADE MARKS ACT 1994

CONSOLIDATED OPPOSITION/CANCELLATION NOS: OP000432650, OP000432652, OP000432654 AND OP00043285

DECISION

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1. This is an appeal against an interim decision made by Leisa Davies, on behalf of the Registrar, which was made at a hearing of a CMC on 22 November 2022 and which was subsequently set out together with reasons in a letter dated 30 November 2022 ("***the Decision***").

2. In the above consolidated proceedings Selita srl has been referred to as Party A ("***the Opponen***t"); and Global Beauty Products Limited as Party B ("***the Applicant***").

3. The hearing of the CMC took place by way of a telephone conference. Mr Rowland Buehrlen of Beck Greener LLP attended on behalf of the Opponent and Mr Matthew Kime instructed by Asenda Law Ltd appeared on behalf of the Applicant.

4. As set out in the letter dated 30 November 2022 the purpose of the CMC was to determine whether the Opponent should be granted an extension of time to file evidence.

5. That application for an extension of time was refused. That decision was not and is not the subject of an appeal (as to which see further below).

6. After the decision and further directions as to the conduct of the consolidated proceedings had been announced by the Hearing Officer, Mr Kime on behalf for the Applicant requested that the Hearing Officer '*deem the Opponent to have withdrawn its section 3 ground from the opposition, pursuant to Rule 20, as it had not filed evidence to substantiate this ground.*'.

7. In response Mr Buehrlen on behalf of the Opponent maintained that there was no need to file evidence in support of this ground given the admissions that had been made by the Applicant in its pleadings.

8. Mr Kime responded by submitting that as the pleadings contained both denials and admissions it still necessitated the Opponent to file evidence in support of its case.

9. After the conclusion of the hearing, at which the Applicant's request was refused, Mr Kime filed additional submissions which he submitted should be taken into account before the written decision was issued. For reasons that were explained in the letter of 30 November 2022 those additional submissions were not taken into account. As this is not relevant to the appeal before me, I say no more about this.

10. The reasoning for the refusal of Mr Kime's request made on behalf of the Applicant was refused was set out in the Decision as follows:

> The relevant sections of the pleadings and those referred to by the parties are as follows:
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> > "Opponent's TM7
> >
> > 24. The words BROW BOMB are widely used both by consumers and in the trade to indicate cosmetics used on eyebrows and/or eyelashes that are fuller thicker and/or longer. The term LASH BOMB or BROW BOMB are common expression used in the industry and by consumers for eyebrow or eyelash treatments.
> >
> > Applicant's TM8 and co unterstatement
> >
> > 29. Paragraph 24 is admitted in part and denied in part, as follows:
> >
> > a. The Applicant admits the term BROW BOMB is used to indicate some cosmetics used on eyebrows;
> >
> > b. The Applicant denies that the term 'BROW BOMB' is widely used to indicate the Class 3 goods specified in paragraph 19 of this Counterstatement;
> >
> > c. The Applicant admits the term 'LASH BOMB' is widely used to indicate some cosmetics used on eyebrows;
> >
> > d. It is denied that the term 'BROW BOMB' is widely used to indicate cosmetics used on eyelashes; and
> >
> > e. It is denied that the terms 'LASH BOMB' and 'BROW BOMB' are interchangeable."
>
> An admission avoids the necessity for a party to prove that aspect of its case, and in particular I note that Rule 20(2)(c) appears to envisage circumstances where no evidence is required following concessions made by a party. On this basis, I determine that the admission made by the Applicant in so far as it admits that the term BROW BOMB is widely used term to indicate some cosmetics used on eyebrows (both in the trade and for general consumers) gives rise to a sufficient prima facie case for me not to consider that the opposition based on section 3 be deemed withdrawn as a result of the Opponent not filing evidence. On this basis the proceedings will continue to the next stage.

11. On 20 December 2022 a form TM55P together with a 15 page document headed Reasons for Appeal which contained a number of pages of Grounds of Appeal together with a number of pages headed Case in Support of Appeal.

12. The gravamen of the appeal is that the Hearing Officer erred in the application of Rule 20 of the Trade Marks Rules 2008 as amended ("***the 2008 Rules***"). In particular it is maintained that the Hearing Officer was wrong not to have deemed the grounds under section 3 of the Trade Marks Act 1994 in the consolidated oppositions as having been withdrawn on the basis that no evidence had been filed in support of such grounds.

13. The appeal being an appeal against an interim decision has been made with the permission of the Registrar pursuant to Rule 70(2) of the 2008 Rules.

14. On 22 February 2023 a 6 page Respondent's Notice was filed on behalf of the Opponent. In the Respondent's Notice, the Opponent maintained that the appealed decision was correct. However, it also sought in the alternative for a further period of time to submit evidence in support of the section 3 ground of opposition. However, it is to be noted that, as was quite rightly accepted at the hearing of the appeal, the Opponent has at no stage sought to appeal any part of the Decision made below and therefore I say nothing further about the request for a further period of time.

15. At the hearing of the appeal which took place by video link, as below, the Applicant was represented by Mr Matthew Kime instructed by Asenda Law Ltd and the Opponent by Mr Rowland Buehrlen of Beck Greener LLP. Both parties filed skeletons of argument in support of their respective positions.

16. It was not disputed that the approach to an appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].

17. Rule 20 of the 2008 Rules provides as follows:

> **Opposition proceedings: evidence rounds**
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> 20.—(1) Where—
>
> (a) Form TM53 has been filed by either party;
> (b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2) and the applicant has filed a Form TM8; or
> (c) the registrar has indicated to the parties that it is inappropriate for rule 19 to apply,

the registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(2) Where—
(a) the opposition is based on an earlier trade mark of a kind falling within section 6(1)(c); or
(b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2); or
(c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant, the person opposing the registration ("the opposer") shall file evidence supporting the opposition.

(3) Where the opposer files no evidence under paragraph (2), the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on—

(a) the matters in paragraph (2)(a) or (b); or
(b) an earlier trade mark which has been registered and which is the subject of the statement of use referred to in paragraph (2)(c).

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

(5) Paragraphs (1)-(3) of this Rule shall not apply to fast track oppositions but paragraph (4) shall apply

18. It was not in dispute before the Hearing Officer or before me that:

(1) The grounds of the consolidated oppositions with which are the subject of the present appeal are grounds of opposition on the basis of section 3 of the Trade Marks Act 1994 i.e. grounds that fall within the scope of Rule 20(2)(b).

(2) No evidence has been served on behalf of the Opponent directed to the section 3 grounds relied upon for the purposes of the consolidated oppositions.

19. Rules 17 and 18 of the 2008 Rules set out the procedure for *inter alia* bringing and defending opposition proceedings. There was no suggestion that the statements and counterstatements filed by the parties had not been correctly filed by the respective parties. Nor, quite rightly, was it disputed that certain admissions were made in the relevant parts of the counterstatements filed on behalf of the Applicant including that '*the term BROW BOMB is widely used term to indicate some cosmetics used on eyebrows (both in the trade and for general consumers)*' as set out by the Hearing Officer in her Decision.

20. Further, it was not any part of the Applicant's position on appeal that it was not open to the Hearing Officer to find that there was a *prima facie* case raised on the pleadings

in particular on the basis of the admissions made therein with respect to the section 3 grounds of opposition.

21. Instead, what was maintained before me on behalf of the Applicant, was that, regardless of what was in issue in the relevant statements and counterstatements, if there was no evidence filed in support of a ground that fell within Rule 20(2)(b) it should be deemed withdrawn. Moreover, the submissions before me were to the effect that (1) the content of the statements and counterstatements was wholly irrelevant and/or (2) even if no evidence was required to support the ground of opposition, unless 'evidence' of some sort (or indeed of any sort) was filed, then the ground of opposition should be deemed withdrawn. That is to say absent the filing of evidence no substantive determination of any issue that fell within Rule 20(2)(b) could be made by the Registrar.

22. That in my view cannot be correct interpretation of the Rules for the reasons set out below.

23. Rule 20 of the 2008 Rules is concerned with evidence for the purposes of opposition proceedings. That is to say it is directed to issues where evidence is required in order for a case to be maintained by a party in opposition proceedings. What Rule 20 (3) of the 2008 Rules is directed to and provides for is what should happen in circumstances where evidence is required but is then not filed in support of the relevant statement of case.

24. What Rule 20 is not concerned with is the position where no evidence is required in order to support the case as put forward in a statement or counterstatement, for example where a pure point of law is relied upon or because admissions of relevant facts have been made in those statements. That is to say where there is a *prima facie* case put forward on the basis of the statements and counterstatements in the opposition proceedings which require no evidential support. In such circumstances it seems to me that it is necessary for the decision taker to go on to make a substantive decision on the basis of that *prima facie* case. That is to say the decision taker in such circumstances is simply not concerned with the rules relating to the filing of evidence i.e., Rule 20 of the 2008 Rules.

25. I am reinforced in my view by the Guidance in the Trade Marks Manual Tribunal Section at 4.12 Pleadings which states (emphasis added):

> The rules make no mention of the word 'pleadings' which is an alternative term for statements and counter-statements. **Pleadings serve a simple function: to identify the issues between the parties which will then be the subject of evidence**. Evidence and pleadings are quite different and should not be confused. Unless there is express provision in the rules, the Tribunal does not expect evidence to be filed at the pleadings stage. Pleadings should contain:

- the facts to be relied upon
- the basis in law for the action, and
- the relief being sought and whether costs are requested

> Parties to Tribunal proceedings should, in order to avoid wasted time and costs, provide fully focussed and particularised pleadings. Mere recitation of various sections of the Act will not suffice; **parties must know in detail the case they have to answer or the basis on which an attack is defended/accepted** (NASA (2000) RPC 21).
>
> The Tribunal, prior to formal serving of pleadings, will use appropriate powers to require a party to better particularise, or explain, its pleadings. Further, if in the view of the Tribunal, a particular ground of attack is plainly unsustainable, objection may also be raised. It is important to note, however, that the Tribunal does not intend to prejudge matters of substance, which should properly be decided once all the evidence and submissions have been made. Nor will the Tribunal force parties to incur unnecessary cost at an early stage of proceedings. There will be circumstances where the Tribunal will allow matters to continue but serve notice that it would expect evidence later filed to support a particular claim or indicate that there may be a penalty in costs.

26. That is to say the pleadings, as they do under the Civil Procedure Rules, identify the issues which are in dispute and will need to be resolved by the court or tribunal by way of a substantive decision and those which do not.

27. Moreover, as quite rightly drawn to my attention by Mr Kime, the relevant section on Evidence in opposition proceedings is in section 3.1.11 of the Guidance in the Trade Marks Manual Tribunal Section provides further confirmation of the position (emphasis added):

> **3.1.11 Evidence in opposition proceedings**
>
> Rule 20 of the Trade Marks Rules 2008
>
> The Tribunal will specify the periods for each of the parties to file evidence and submissions. This is entirely an issue of discretion and no fixed periods or sequences for filing evidence are specified within this rule. This discretion also extends to the sequence of filing evidence, as well as the period specified, and in certain circumstances it might be deemed appropriate to set concurrent rather than sequential evidence rounds.
>
> **Failure to file evidence in respect of those grounds which are entirely dependent on evidence to support and**

substantiate the claims will result in the opponent being deemed to have withdrawn the opposition.

For full details of the procedure for filing evidence in proceedings before the registrar see section 4.8.2.1.

28. In the premises, I am of the view that the decision made by the Hearing Officer was one that it was open to her to make. The appeal is therefore rejected.

29. I therefore direct that the Registrar take the necessary procedural steps for the section 3 grounds of opposition in the above consolidated oppositions i.e. the *prima* facie case referred to by the Hearing Officer in the Decision, to be the subject of a substantive determination.

30. As indicated at the time of the hearing the question of costs of this appeal has been left over. The Applicant's appeal has been dismissed and in the normal course the Opponent would be entitled to a contribution towards the costs of the appeal. It has been agreed that the parties would be given an opportunity to file submissions on costs once my substantive decision on the appeal was issued and that thereafter a decision would be made on the papers.

31. I therefore direct as follows:

(1) On or before 4pm on Thursday 7 March 2024 the Opponent is to file its submissions as to the appropriate order for costs.

(2) On or before 4pm on Thursday 28 March 2024 the Applicant is to file its submissions in answer.

(3) On or before 4 pm on Thursday 11 April 2024 the Opponent is to file its submissions, if any, strictly in reply.

Thereafter a Decision on costs will be made on the basis of the papers.

EMMA HIMSWORTH KC

Appointed Person

22 February 2024