O/0656/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003915397
BY EYEAM ENTERPRISES LTD
TO REGISTER:

No Baggage Eye Serum

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 442945 BY
COSMETIC DERMATOLOGY, LLC

BACKGROUND AND PLEADINGS

1. On 25 May 2023, EYEAM ENTERPRISES LTD ("the applicant") applied to register the trade mark on the cover page of this decision in the UK ("the applicant's mark"). The applicant's mark was published for opposition purposes on 9 June 2023 and registration is sought for the following goods:

   Class 3: Cosmetics.

2. On 7 September 2023, the applicant's mark was opposed by Cosmetic Dermatology, LLC ("the opponent"). The opposition is based on section 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is reliant upon the unregistered right 'NO MORE BAGGAGE' ("the opponent's sign"). The opponent claims that it has been using its sign throughout the UK since January 2017 in respect of the following goods:

   > "Cosmetics; skin creams; skin lotions; skin moisturizers; skin emollients; skin masks; skin cleansers; skin toners; eye creams and non-medicated skin serums; exfoliant creams."

3. The opponent claims that as a result of its significant use of the earlier sign, it has acquired goodwill in relation to its cosmetics business generally. The opponent further claims that use of the applicant's mark would amount to a misrepresentation, causing damage.

4. The applicant filed a counterstatement wherein it denied the claim against it.

5. Only the opponent filed evidence. A short format hearing took place before me on 6 June 2025, by video conference. The applicant was not legally represented at the hearing but Ms Margo Marrone appeared on its behalf. I note that Ms Marrone is confirmed in correspondence with the Tribunal as being a member of the 'EYEAM' team. The opponent was represented by Mr Julius Stobbs of Stobbs. Both parties filed skeleton arguments prior to the hearing.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

7. The opponent's evidence came in the form of the witness statement of Ms Tamara Matha dated 31 July 2024. Ms Matha is the Vice President of Finance of the opponent, a position that, as at the date of her statement, she had held for 18 years and 6 months. Her evidence was accompanied by 15 exhibits, being those labelled TM1 to TM15, though I note that a number of these exhibits are divided into several sub-exhibits under letter designations. The purpose of Ms Matha's statement was to adduce evidence supporting the opponent's claim to benefit from a protectable level of goodwill.

8. I do not intend to summarise the opponent's evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUES

9. There were two points that were raised in the applicant's skeleton argument that I considered necessary to raise at the hearing. For the sake of completeness, I will discuss those same issues here.

Sections 5(2) and 5(3) of the Act

10. In its skeleton argument, the applicant made a number of references to the above sections of the Act. As the present proceedings concern only section 5(4)(a) of the Act, any comments in respect of the other grounds are of no assistance here and will be disregarded.

The applicant's evidence

11. The applicant's skeleton argument also made reference to its own evidence in order to support its defence. By way of background, the applicant initially filed evidence with its Form TM8. As is ordinarily the case when such instances occur, the Tribunal wrote to the applicant (by way of an official letter dated 25 March 2024) confirming that the evidence would not be considered and that if the applicant wished for it to be before the Tribunal in these proceedings, it was required to file it during the allocated evidence rounds. No evidence was filed meaning that the evidence referred to in the applicant's skeleton argument is not before me in these proceedings. Therefore, it is of no assistance to the applicant.

12. For the avoidance of doubt, prior to the hearing I did review the evidence filed with the applicant's original Form TM8 and note that it appeared to have been filed to support a claim that the reference to 'BAGGAGE' is common across the trade. Under the present ground, such an argument could be used to support a claim that the opponent's sign is of a below average distinctiveness (being something that could potentially harm the opponent's claim to enjoy goodwill).[1] However, having considered the evidence, I can confirm that even if it were duly before me in these proceedings, it would be of no assistance. This is on the basis that, in order to support an argument of a weaker distinctive character in a common element, evidence of actual use of those other marks on the marketplace is required.[2] However, the applicant's evidence simply consisted of limited range of undated screenshots of goods listed for sale. There was nothing in the evidence to say when the screenshots were taken, whether they were aimed at the UK consumer and what level of sales could be said to be associated with such goods. As such, the evidence would have been incapable of demonstrating that the common element of 'BAGGAGE' had become weakened due to its common use in the market.

[1] See *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20) for an example of where a sign with below average distinctiveness was found to benefit from no protectable goodwill, despite the volume of sales associated with it.
[2] See *Zero Industry Srl v OHIM*, Case T-400/06. While this case related to evidence of marks on a trade mark register, the principle that there needs to be indications as to how the marks are effectively used in the market is applicable here.

DECISION

Section 5(4)(a)

13. 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."

14. 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."

15. 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)."

16. 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 Date

17. 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.' "

18. The applicant's mark does not have a priority date. In addition, there is no evidence before me that is capable of pointing to any earlier use by the applicant that could be considered the start of the behaviour complained about. As such, the relevant date for the present proceedings is the filing date of the applicant's mark, being 25 May 2023.

Goodwill

19. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in the sign relied upon as at the relevant date. I remind myself that the opponent claims that its sign enjoys goodwill owing to its use on the following goods:

> "Cosmetics; skin creams; skin lotions; skin moisturizers; skin emollients; skin masks; skin cleansers; skin toners; eye creams and non-medicated skin serums; exfoliant creams."

20. Goodwill was described in *Inland Revenue CommissiÖners 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."

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

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of

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

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."

22. 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."

23. 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."

The opponent's evidence

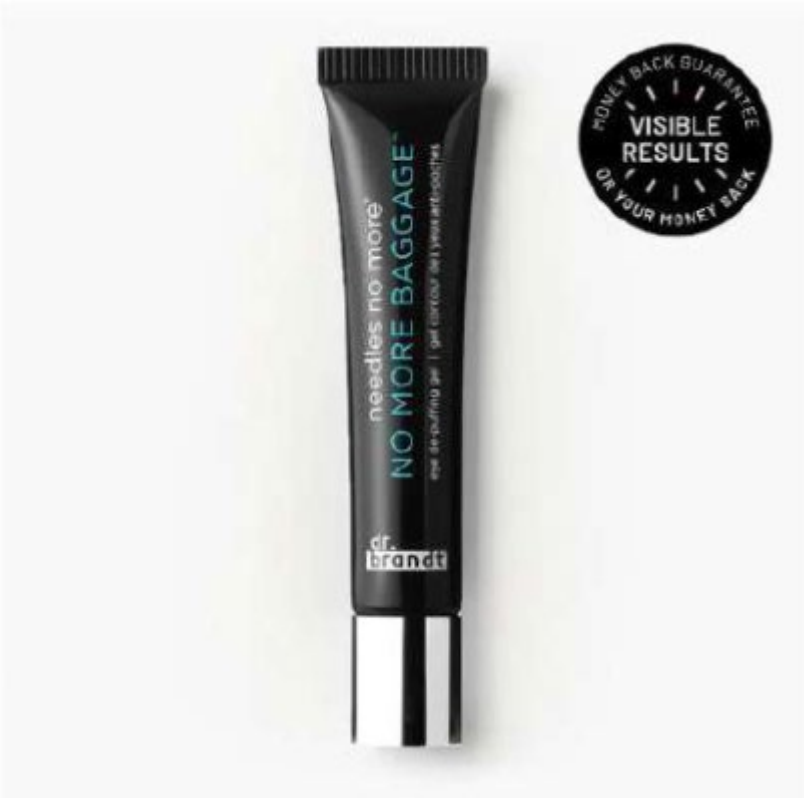
24. Goodwill arises as a result of trading activities. The evidence first sets out that the opponent's use is under the brand names 'Dr Brandt Skincare' and 'Dr Brandt'. The evidence confirms that all intellectual rights accrued under such branding is owned by the opponent. This is relevant here because, as I will come to discuss below, the opponent's use of 'No More Baggage' is shown as a sub-brand of the 'Dr Brandt' branding.

25. The evidence then moves to discuss the similarities between serums, gels and creams.[3] While noted, I do not consider this is of any assistance to the existence of goodwill in the opponent's sign. Therefore, I will only return to discuss this evidence if I consider it necessary below.

26. Screenshots are provided that show one of the opponent's products listed for sale on its own website.[4] While undated, the narrative evidence confirms that these

[3] Paragraphs 11 to 20 of Ms Matha's witness statement and TM1 to TM5.
[4] TM6

goods have been available for sale in the UK since January 2017. In addition, I note that the product is listed for sale in British pounds. As for the product itself, this is referred to as a lightweight gel cream that "instantly tightens and smooths the skin, de-puffs the look of under-eye bags and brightens dark circles."[5] For illustrative purposes, the product listed is shown as follows:



27. In respect of the above product, Ms Matha draws my attention to the last printout of the same exhibit,[6] which shows that the product has an average rating of 4.4-stars stemming from 1,563 reviews. The narrative evidence sets out that the opponent estimates that 20% of these reviews are from UK consumers. While this may be the case, it would only result in around 300 UK based reviews, being a very limited number. Further, the printout is undated so a number of the reviews could realistically be said to have come from after the relevant date. Without any breakdown of how the reviews apply to the relevant date, I do not consider that this evidence offers much assistance.

[5] See page 24 at TM6
[6] See page 30 at TM6

27. An additional printout is provided from Amazon.co.uk that shows the above product listed for sale.[7] While the printout is undated and the product shown is listed as being 'currently unavailable', the narrative evidence sets out that this is due to stocking issues but confirms that the product has been fully available for purchase via Amazon UK since January 2017.

28. The evidence then moves to discuss sales figures. On this point, the opponent estimates that the turnover for the 'NO MORE BAGGAGE' eye creams and gels products in the UK stands at almost £120,000. This is confirmed as being sales since January 2017. In support of this, a number of sample invoices regarding UK sales has been provided.[8] These only cover 7 October 2022 to 30 April 2023 but the evidence confirms that the opponent has had some difficulty in obtaining earlier invoices. However, it is claimed that the invoices that are provided are a good indication of the sales made by the opponent.

29. I do not intend to discuss the invoices in full here but note that the majority of them relate to goods (being eye cream/gel) shipped to the UK. On this point, however, I note that some have a UK address as a billing address but a US address listed as the shipping address. For example, some invoices are billed to THG Beauty at an address in Manchester, England but are shipped to Seko Logistics in California or THG in New Jersey.[9] Whilst this is noted, the undertaking buying the goods is based in the UK and, as such, I am content to conclude that these invoices cover sales to a UK customer, being the requirement under the present assessment. That being said, I do not consider that much turns on this as these invoices only cover 60 sales of products.

30. While remaining on the topic of the invoices, I note that the majority of the invoices show repeated sales to a UK retailer listed as The Hut.com, which is based in Cheshire. The opponent has provided a breakdown of the invoices[10] and, having considered this, I note that the invoices relating to The Hut.com cover sales for a total of 68 goods in October 2022, 106 in November 2022, 135 in December 2022,

[7] TM7
[8] TM8
[9] See TM8E and TM8H (for the California shipped goods) and TM8F (for the New Jersey shipped goods).
[10] See the table at paragraph 24 of Ms Matha's witness statement

74 in January 2023, 114 in February 2023, 106 in March 2023 and 76 in April 2023.[11]

31. Lastly, in respect of the invoices, the narrative evidence explains that while some of them are displayed in US dollars, this is due to a formatting inconsistency but it is confirmed that any payments made by UK customers was in British pounds.

32. In terms of how the goods reach the UK market, I note that a range of printouts are provided that show the opponent's eye gel for sale via different UK retailers.[12] I do not intend to go over these in any great detail save to say that all bar one of the printouts show goods listed in pounds (with one listing the goods in euros). While the printouts are undated, the narrative evidence confirms that sales of these goods via the third-party retailers have been made across the UK since at least January 2017. For the avoidance of doubt, none of these printouts appear to be from the retailers that are covered in the invoice evidence discussed above. Further, there is no breakdown of sales for these retailers.

33. The evidence then moves to discuss press coverage via third party publications. The first article comes from the Sheer Luxe website which, in March 2023, listed the opponent's eye gel as a recommended product when discussing ways in which to 'perk up' the readers' under-eyes.[13] The evidence sets out that Sheer Luxe is an online lifestyle magazine. The second article is one from Independent dated 20 March 2023 and lists the opponent's eye gel as the best eye cream for dark circles.[14] Independent is stated as being a large online news organisation that attracts a monthly readership of 21 million people. Lastly, there is an article dated 4 May 2023 from the UK edition of 'GoodToKnow' which shows a list of the best eye creams for dark circles.[15] The opponent's eye cream comes in at number seven and one that is said to be the best for puffy eyes. The evidence confirms that 'GoodToKnow' is an online publication that discusses family wellbeing, parenting advice as well as product reviews. Aside from the high readership

[11] See TM8A, TM8B TM8C TM8D TM8G TM8I and TM8J, respectively
[12] TM9
[13] TM10
[14] TM11
[15] TM12

figures for Independent, there is nothing to suggest the readership for the other two publications. Without such, I have no way to determine their popularity amongst the UK consumer.

34. In 2022, the opponent's eye cream/gel product was shortlisted under the category of 'Best Eye Product' of the year for 2022 at the 'Top Santé Beauty Awards'. This is supported by an article dated 7 February 2023 that was published on 'topsante.co.uk'.[16] The narrative evidence sets out that 'Top Santé' is the leading and longest running UK health magazine for women over 40. I have nothing to suggest the level of readership that Top Santé attracts but I see no reason to doubt the narrative evidence (especially in the absence of any direct challenge) that confirms that it is a leading and long running publication.

35. Lastly, the evidence turns to the opponent's social media presence. This comes in the form of the opponent's Instagram page, which has over 265,000 active followers. It is estimated that 20% of the followers are UK consumers. A printout of the account is provided in evidence.[17] While the account is for 'Dr Brandt', the printouts do show a focus on posts associated with the 'NO MORE BAGGAGE' product. While noted, the printout showing 265,000 followers is undated and, therefore, cannot be said to be an accurate reflection of the position as at the relevant date.

36. In addition to the opponent's own account, it has provided a number of printouts from other social media accounts that discuss the opponent's 'NO MORE BAGGAGE' product. These include posts by the international brand Sephora as well as posts seemingly from influencers such as Kathleen Jennings Beauty, Stefanie Anne Adle, Beauty by Reccie, Keelz Skincare, Alena07112 and Glam Orista. These posts all attracted a high level of likes (some in the tens of thousands) and engagement and I note that the narrative evidence sets out that it is estimated that a significant number of the users who are liking these posts are based in the UK. While the third-party posts are noted, I have nothing to

[16] TM13
[17] TM14

support such a claim as the posts were not made by the opponent itself so I do not consider that it is in a position to make such a statement.

Assessment of the evidence

37. In considering the evidence as a whole, I appreciate that it is reflective of a low level of use. I say this because I do not consider that a turnover of almost £120,000 over six years is particularly compelling. Further, in comparison to the likely size of the market at issue,[18] it is clear that this level of use is very low. That being said, I remind myself that even small businesses with more than a trivial level of goodwill can protect signs which are distinctive of that business.[19] As such, the opponent's claim does not simply fall away because the level of sales is low. On this point, I remind myself that even where the level of sales shown in evidence is not significant, evidence of repeat custom is a factor that may demonstrate the existence of goodwill. In the present case, I remind myself that there is evidence of consistent invoices to the UK based retailer The Hub.com. While the relationship does not appear to be particularly longstanding, I note that it does cover repeat transactions over the period of 7 months during 2022 and 2023. In addition, there is evidence of the opponent's brand appearing in three separate publications wherein its eye cream/gel was listed as a recommended product. I appreciate that this does not represent large scale coverage. However, this does not mean that it cannot be of assistance. In the present case, I note that the publications are all nationwide publications, with one of them (Independent) being shown as a very popular online news publication with 21 million monthly readers.

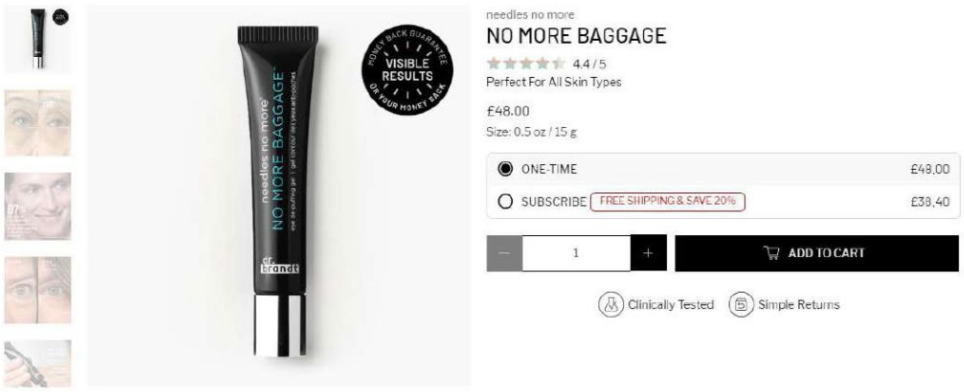
38. Taking all of the above into account, and despite the lower level of use, I find that the goodwill associated with the opponent's business in the UK sits at a protectable level. Such a finding is sufficient to sustain a claim for passing off. In terms of the actual level of goodwill that vests in the opponent, I am of the view that, upon taking into account the low level of use, the evidence supports a finding that the goodwill sits at a modest level.

[18] Being the cosmetic market, generally.
[19] *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

39. The above being said, this is not the end of the matter. The question now turns to whether the sign relied upon is distinctive of and/or associated with that goodwill. While, at the hearing, the applicant did not appear to contest the existence of goodwill in the opponent's business, it did argue that any goodwill was to be associated with the opponent's head brand, being 'Dr Brandt'. This argument is based on the claim that 'NO MORE BAGGAGE' is always used by the heading of that brand as well as alongside the wording 'NEEDLES NO MORE'. It appears that this argument is aimed at a claim that because 'NO MORE BAGGAGE' is never used alone, it cannot benefit from any goodwill. In response to this argument at the hearing, Mr Stobbs argued that 'NO MORE BAGGAGE' can enjoy goodwill as a sub-brand of 'Dr Brandt'. In making this argument, he made a reference to the brand Nike and the way it has used layered branding. In addition, he referred to the use of 'PlayStation' as a sub-brand of 'Sony' and how Sony would have goodwill vested in the 'PlayStation' branding as consumers would clearly notice the hierarchy of the brands. While there is no evidence before me regarding Nike and Sony, I consider that the points made by Mr Stobbs are relevant to the argument at issue here. I say this because I do not consider that Nike's use of well-known sub-brands such as 'Air', 'Air Max' or 'Air Jordan' and Sony's use of the well-known sub-brand 'PlayStation' are controversial or likely to be subject to any serious dispute.[20] As a result, I consider that I am entitled to take judicial notice of the points raised by Mr Stobbs. To conclude, I am of the view that it is entirely possible for sub-brands to be able to generate their own protectable level of goodwill.

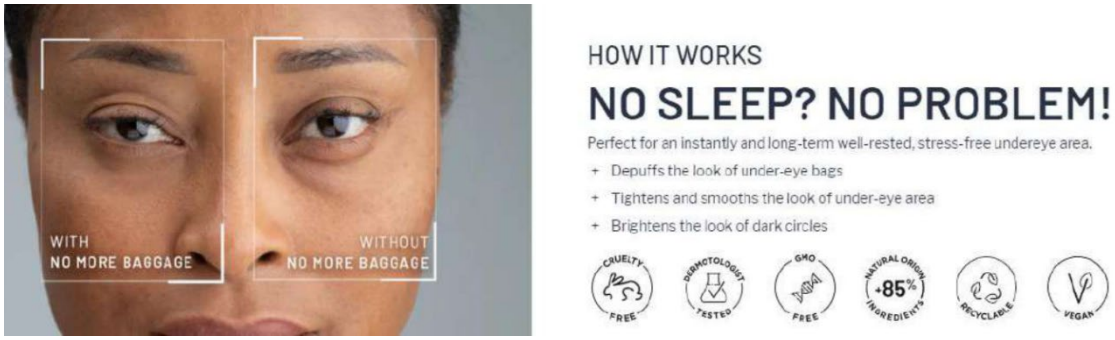
40. In applying this to the present case, I remind myself that, at paragraph 26 above, I reproduced an image of the opponent's product. For illustrative purposes, I consider it necessary to reproduce that image in the context of the actual listing of the product shown in evidence. This is as follows:[21]

[20] See *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08 wherein Ms Anna Carboni, sitting as the Appointed Person, described the limits to which judicial notice can be used.
[21] See page 24 of TM6



41. While the additional brandings of ‘Dr Brandt’ and ‘NEEDLES NO MORE’ are noted, the product is clearly labelled with the wording ‘NO MORE BAGGAGE’ as its largest element and, further, the description of the product is dominated by the wording ‘NO MORE BAGGAGE’. For the avoidance of doubt, this packaging is largely consistent with how the product is shown throughout the remainder of the evidence including that of third-party retailer listings and press coverage.

42. In addition to the above, I note that the evidence taken from the opponent’s website shows the following image which, on the left-hand side, refers to the product as ‘NO MORE BAGGAGE’:[22]



43. In respect of the above reproductions, I remind myself that the narrative evidence confirms that this is how the products have appeared since 2017. In the absence of any challenge to the same, I am content to proceed as if they are reflective of the position prior to the relevant date.

[22] See page 26 at TM6

44. As a result, I am content to conclude that consumers will, upon viewing the product demonstrated throughout the evidence, associate any goodwill with the opponent's business to the 'NO MORE BAGGAGE' sign.

45. Before moving on, I wish to point out that in making my assessment of goodwill, I have given due consideration to the distinctiveness of the opponent's sign. I have done so because I appreciate that a sign of lesser distinctiveness generally requires a higher level of use in order to demonstrate goodwill. In making this point, I refer to the case of *Smart Planet Technologies* (cited above) wherein it was found that the level of use (the sale of 40,000 recyclable cups) associated with a sign of below average distinctiveness (being 'ReCUP') was insufficient to demonstrate the existence of goodwill. While the present case is not on all fours with the above referenced case, I refer to it as an example where the lower distinctiveness associated with a sign may offset the level of use. In the present case, I appreciate that 'NO MORE BAGGAGE' may be viewed as having allusive qualities in the context of eye gels or creams on the basis that it may be associated with the removal of under-eye bags. However, the sign as a whole is a somewhat unique and playful take on the idea of not having to carry any baggage in the physical sense (such as luggage, for example) and under-eye bags (which the goods are intended to remove). Therefore, I consider that the quirky nature of the opponent's sign is such that it will be attributed a level of distinctiveness that, in my view, justifies my conclusion that there is a protectable level of goodwill associated with it.

46. The last issue for me to consider in respect of goodwill is the goods in which the goodwill is vested in. As above, the opponent relies on a relatively broad range of cosmetic products. While that may be the case, the evidence appears to focus solely on one type of product, being an eye cream or gel (or something referred to as both) for 'de-puffing' the eyes. As such, I do not consider it controversial to suggest that the opponent's goodwill in its 'NO MORE BAGGAGE' brand vests in "eye creams and gels" only. It is upon these goods that the opposition may proceed.

Misrepresentation and damage

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

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

48. And later in the same judgment:

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

49. In defence of the issue of misrepresentation, the applicant argued at the hearing that there is no evidence to show that it has deliberately tried to misrepresent the opponent's right. In the present case, I note that the opponent has not made an

allegation that the applicant has actively sought to deceive the consumer and, on this point, I remind myself that while proof of an intention to deceive is likely to result in misrepresentation being found,[23] it is not an absolute requirement.[24] Therefore, the absence of any evidence showing the applicant deliberately trying to misrepresent the opponent's right is of no assistance to the applicant. Instead, in the present case, the issue of misrepresentation that I have to consider is a notional assessment and while proof of actual misrepresentation may be of assistance to claims of passing off, it is not necessary.[25]

50. In considering the issue of misrepresentation, I remind myself that the opponent enjoys a protectable level of goodwill for the sign 'NO MORE BAGGAGE' in respect of "eye creams and gels". The applicant's mark is "No Baggage Eye Serum" for "cosmetics" in class 3.

51. Firstly, I will deal with the fields of business in which the parties operate. The opponent operates in eye creams and gels which are specific types of cosmetics. As such, it can be said that the field of business in which the opponent operates is 'cosmetics'. As for the applicant, given that it seeks protection for all types of cosmetics, it follows that its field of business is also 'cosmetics'. As such, I find that the parties' fields of business are identical. I will now turn to consider the similarity of the marks.

52. The applicant's mark is a word only mark that consists of the words 'No Baggage Eye Serum'. The words 'Eye Serum' are plainly descriptive of a type of cosmetic and, as such, will play a lesser role in the overall impression of the mark. As such, I find that 'No Baggage' dominates the overall impression of the mark. As for the opponent's sign, being the words 'NO MORE BAGGAGE', I find that the overall impression lies within the sign as a whole.

53. Visually, the marks share the words 'NO' and 'BAGGAGE'. They differ in the presence of 'MORE' in the opponent's sign and 'Eye Serum' in the applicant's

[23] *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] RPC 39 (HOL)
[24] See paragraph 636 of Halsbury's Laws of England Vol. 97A (2021 reissue), which is quoted above.
[25] See *Neutrogena* (cited above)

mark. These words will all act as visual differences between the sign and the mark regardless of their roles. Overall, I consider that the parties' shared use of 'NO' and 'BAGGAGE' at the beginning and ends of the sign's/mark's dominant element is such to give rise to a finding that the sign and the mark at issue are visually similar to a medium degree.

54. In terms of an aural comparison, I will say that despite the descriptive nature of the words 'Eye Serum', they will still be pronounced.[26] In comparing the sign and the mark at issue, I consider that they will be pronounced in the ordinary way, with the opponent's sign being four syllables in length and the applicant's mark being six syllables in length. Despite the applicant's mark being slightly longer, the shared use of an identical first syllable and the identity of the two syllables of the word 'BAGGAGE' are such that they give rise to a finding that the sign and the mark at issue are aurally similar to a medium degree.

55. The concept of the opponent's sign derives from the phrase 'NO MORE BAGGAGE'. The phrase will be understood as a reference to someone not having to carry more baggage. In light of the goods at issue, this will cross over into the idea that the *baggage* referred to is the bags under the users' eyes. While slightly allusive, I am of the view that it is a unique and playful take on the idea of physical baggage (as in luggage) and under-eye bags. As for the applicant's mark, I consider that because the words 'Eye Serum' are descriptive, they will have a very limited impact on the concept of the mark. This means that the concept of the applicant's mark derives predominantly from the words 'No Baggage'. Much like the opponent's sign, I consider that the phrase 'No Baggage' will be considered as a reference to the user not having any baggage which, again, will play on the concept of under-eye bags. As was the case above, this is slightly allusive but a unique and playful take on the idea of baggage and under-eye bags. In comparing the marks, however, this concept is very highly similar despite the use of the word 'MORE' in the opponent's sign. The only thing that can take away from this is the descriptive words 'Eye Serum' in the applicant's mark which, as

[26] See *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein it was found that the descriptiveness of words does not render them aurally invisible. While this related to a comparison under section 5(2)(b) of the Act, it is equally applicable here.

above, has very little impact. As such, I find that the marks are conceptually similar to a high degree.

56. Taking all of the above into account and even bearing in mind that the opponent's sign only benefits from a moderate level of protectable goodwill, I find that consumers who are aware of the opponent's goodwill will believe that the offering for sale of any cosmetic goods under the applicant's mark are those that originate from the same undertaking, being the opponent. I say this because the shared use of the words 'NO' and 'BAGGAGE' together with the concept associated with the same will lead consumers to being deceived as to the existence of a connection between the parties. In addition, I remind myself that the identical word 'NO' forms the beginning of the sign[27] and the mark at issue and, further, the identical word 'BAGGAGE' sits at the end of the dominant element of the sign and mark. As such, I find that the word 'MORE' is likely to be overlooked, especially given the highly similar concept. Even if it is not, I see no reason why consumers would not believe 'NO BAGGAGE' to be associated with or endorsed by the opponent, being the owner of the 'NO MORE BAGGAGE' sign.

57. Overall, I find that use of the applicant's mark for the goods applied for at the relevant date would have constituted a misrepresentation to a substantial number of consumers.

Damage

58. Having found the existence of goodwill and misrepresentation, I consider that damage through diversion of sales is easily foreseeable. As a result, the present ground succeeds in full.

[27] On this point, I appreciate that there is case law relating to the likelihood of confusion under section 5(2)(b) grounds that sets out that consumers tend to focus on the beginnings of marks. See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02. While applicable to section 5(2)(b) grounds, I am of the view that it is applicable to the present assessment of misrepresentation. In saying this, I remind myself that while the tests for confusion and misrepresentation differ, they are likely to yield the same results. See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

CONCLUSION

59. The opposition has succeeded in full and, subject to any successful appeal against my decision, the applicant's mark is hereby refused for all goods applied for.

COSTS

60. The opponent has succeeded in full and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,850 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the counterstatement:	£250
Filing evidence:	£600
Preparation for and attendance at a hearing:	£800
Official fees:	£200
Total:	**£1,850**

61. I hereby order EYEAM ENTERPRISED LIMITED to pay Cosmetic Dermatology, LLC the sum of £1,850. 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 17th day of July 2025

A COOPER
For the Registrar