

O/0803/25

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003874021

IN THE NAME OF BADE WORLD LIMITED

FOR THE FOLLOWING TRADE MARK:

BADE

IN CLASSES 3 & 44

AND

AN APPLICATION FOR A DECLARATION

OF INVALIDITY UNDER NO. 506383

BY OMOKOREDE BADEMOSI

BACKGROUND AND PLEADINGS

1. On 2 February 2023, Bade World Limited (“the proprietor”) applied to register the trade mark on the cover page of this decision in the UK (“the contested mark”). The application was published for opposition purposes on 24 February 2023 and registration was granted on 5 May 2023. The contested mark stands registered for the goods and services set out in the Annex of this decision.
2. On 2 August 2023, Omokorede Bademosi (“the applicant”) sought a declaration of invalidity against the contested mark in accordance with section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 5(4)(a) and 3(6) of the Act. In respect of the section 5(4)(a) ground, the applicant relies on the following signs, all of which are claimed to have been used throughout the UK since 8 September 2019:

BADE

(“the applicant’s first sign”);

BADE AESTHETICS

(“the applicant’s second sign”); and



(“the applicant’s third sign”).

3. The applicant claims to have used the above signs in respect of “eyelashes” and a range of services, namely “beauty salon services”, “beauty treatments”, “eyelash

extensions”, “beauty consultations”, “eyelash extension services”, “volume lash services”, “classic lash services”, “individual lash services”, “lash treatments”, “lash lifting facial services” and “eyebrow treatments”.

4. Under this ground, the applicant claims that, by the filing date of the contested mark, her business had acquired a reputation and goodwill in the UK in relation to the goods and services relied upon. As a result, and in light of the claimed identity/similarity of the parties’ mark/signs and the identity/similarity of the goods and services, the applicant claims that the relevant public will mistakenly believe that the goods/services offered by the proprietor are those of the applicant. The applicant claims that this misrepresentation will lead to irreparable damage.

5. Under the section 3(6) ground, the applicant claims that the act of filing the contested mark fell short of the standards of acceptable commercial behaviour. It is claimed that the proprietor had full knowledge of the applicant’s business and, in filing its mark (which is claimed to be without due cause), sought to cause confusion or ride of the coattails of the applicant. The basis for this claim is that the proprietor filed an identical mark to the applicant’s earlier rights for identical services.¹ In addition, it is claimed that the proprietor had no intention to use the mark but that its objective was to disrupt the applicant’s business by using the contested mark to suspend the applicant’s Instagram account and, therefore, interfere with the applicant’s business.

6. The proprietor filed a counterstatement wherein it denied the claims against it.

7. The applicant is represented by Inbrandgible Limited whereas the proprietor is unrepresented. Both parties filed evidence in chief and, in doing so, they also filed written submissions. The applicant also filed submissions in reply. No hearing was

¹ While the pleading makes reference to services only, I note that the applicant confirmed at Section D of its TM26I that this ground of opposition was targeted against all goods and services.

requested and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

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

EVIDENCE

9. The applicant's evidence came in the form of a witness statement in her own name dated 29 April 2024. The applicant's evidence is accompanied by nine exhibits, being OB1 to OB9, and was adduced in order to demonstrate the existence of a protectable level of goodwill in the signs relied upon. The applicant also sought to discuss the events that led up to the filing of the contested mark in order to demonstrate that it was made in bad faith.
10. The proprietor's evidence came in the form of the witness statement of Ms Grace Akingbade dated 9 July 2024. Ms Akingbade is the owner of the proprietor and her statement is accompanied by 13 exhibits, which are referred to in the body of her statement as 'Ref 1' to Ref 13'. Ms Akingbade's statement was adduced in order to refute the claims of the applicant and to demonstrate the earlier use of her company's branding.
11. I do not intend to summarise the evidence filed by the parties (or their submissions, for that matter) in full. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

12. Sections 5(4)(a) and 3(6) of the Act both have application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

“47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[...]

(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.”

Section 5(4)(a)

13. Section 5(4)(a) states:

“(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 contested mark does not have a priority date. While I note that the proprietor has filed evidence pertaining to the use of its ‘BADE’ brand, this is of no assistance to the present proceedings. I say this because the evidence does not contain any information that can categorically point to the first outward offering of goods to consumers in the UK. Even if it did, the proprietor's evidence all appears to stem from the fashion industry and relates solely to clothing goods. Therefore, such use is not capable of being considered earlier use that constitutes the start of the behaviour complained about as it relates to a different area of business. As a result, the relevant date for the purposes of the applicant's claim under the section 5(4)(a) ground is the filing date of the contested mark, being 2 February 2023.

Goodwill

19. The first hurdle for the applicant is to show that she had the necessary goodwill in her business at the relevant date and that the signs relied upon were distinctive of that goodwill. For ease of reference, the signs relied upon are:

BADE

("the applicant's first sign");

BADE AESTHETICS

("the applicant's second sign"); and



("the applicant's third sign").

20. Further, I remind myself that the applicant claims that her business's goodwill relates to "eyelashes" and a range of services, namely "beauty salon services", "beauty treatments", "eyelash extensions", "beauty consultations", "eyelash extension services", "volume lash services", "classic lash services", "individual lash services", "lash treatments", "lash lifting facial services" and "eyebrow treatments".

21. 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.”

22. Goodwill results from trading activities in the UK. Having considered the applicant’s evidence in full, I consider it necessary to first explain that some of the evidence provided is of no assistance. I do not intend to discuss this in full but, briefly, I note that some of the evidence focuses on how the proprietor uses its mark² and some covers activity from after the relevant date. In respect of the latter point, I refer, for example, to a screenshot of a conversation between the applicant and a customer wherein it appears that said customer travelled over three hours to use the applicant’s services (and expressed the intention to do so again).³ This conversation took place in November 2023 so it is not relevant here. Lastly, I note that the evidence discusses how lash technicians have purchased goods such as lash trays and tweezers from the applicant.⁴ This is noted but there are two issues with this evidence. The first being that the order dates provided on the screenshots covering these sales are from after the relevant date. The second, and perhaps more important issue, is that these goods are not relied upon under the present ground. Any use associated with the same is, therefore, of no assistance to the applicant.

23. The applicant’s evidence sets out that she is an ‘eyelash extension sole trader’ who also offers beauty therapy services, namely eyelash extensions. Further, she claims to sell products such as eyelash extension trays and eyelash adhesives but, as above, these are not goods that the applicant has sought to rely on.

24. The applicant registered her Instagram account in January 2019. The account was registered under the name BADEAESTHETICS. Printouts of this account are

² OB2

³ OB4

⁴ OB5

provided in evidence.⁵ It is noted that the account has over 11,000 followers. However, the printouts provided are not dated and, therefore, it is not possible for me to determine how many followers were in place as at the relevant date. While I note that some posts are dated from prior to the relevant date, they show goods that, again, are not relied upon here. Further, the level of engagement of these posts is either not shown or is low (the highest being just 259 likes).

25. I note that evidence is provided showing screen captures, seemingly of direct messages on Instagram or text messages, wherein payment for services is discussed with a number of clients.⁶ These are either undated or, where I can determine an actual date from them, they are from after the relevant date. For example, there is a screenshot showing a payment on 16 April 2024 on the second page of this exhibit.

26. The evidence does include turnover figures for the years 2019 to 2024. While the entirety of the figures is noted, the turnover for 2024 is wholly after the relevant date. Further, in respect of the 2023 figures, I remind myself that the relevant date is 2 February 2023. In light of this, I consider it reasonable to infer that the overwhelming majority of the turnover for that year falls after that date. On this point, I accept that one month of the 2023 turnover remains relevant but I have no way to calculate precisely how much as the applicant has provided no breakdown of her figures.

27. As a result of what I have said above, I will only reproduce the applicant's turnover figures from 2019 to 2022. These are as follows:

Year	Turnover (£)
2019	150
2020	600

⁵ OB1

⁶ OB6

2021	1,200
2022	5,000
Total	6,950

28. In respect of the total figures, I will bear in mind that the relevant turnover is likely to be slightly higher than that shown above given that it should include sales from January 2023. That being said, the turnover for 2023 stood only at £8,360 so just one month of that is unlikely to have any material impact on the total figure provided above.

29. In respect of the turnover provided, I also wish to set out that, in light of the evidence as a whole (in that it covers sales of goods such as lash trays and tweezers), it is reasonable to infer that the figures provided cover not only the actual goods and services relied upon but also those that are not. As a result, I consider it entirely reasonable to suggest that the above turnover figures are unlikely to be wholly attributable to the goods and services relied upon. On this point, I appreciate that I have no way of determining the relevance of the turnover figures provided but this is an issue I will bear in mind in making my assessment.

Assessment of the evidence

30. I note that the evidence sets out that the applicant's Instagram account was temporarily closed due to a complaint raised by the proprietor. At paragraph 22 of her statement, the applicant sets out that this was appealed and that she proved her *earlier rights*, which led to Instagram restoring her account. I have no information as to what this actually means as there is nothing to suggest how Instagram deals with these disputes or how it assesses an appellant's 'earlier rights' in such cases. I would imagine that this goes without saying but, for the avoidance of any doubt, the outcome of any Instagram dispute has absolutely no bearing on my decision. Instead, my assessment of the existence of a protectable

level of goodwill in the earlier unregistered rights is based on the evidence before me and the principles set out in the case law I have set out above.

31. In considering the issue of goodwill, I remind myself that even a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.⁷ As such, it is not necessary for the trading activities under the present assessment to be at a high level. That being said, I am of the view that the applicant's evidence falls far short of the threshold to warrant a finding of a protectable level of goodwill in her business. I say this because the turnover figure provided (being slightly in excess of £6,950) is at a very low level. While a low turnover is not fatal in itself, this issue is exacerbated by the fact that, as set out at paragraph 29 above, the applicant's evidence covers goods that are not relied upon here. Therefore, it is not possible for me to determine how much of the turnover relates to the goods and services relied upon. Outside of the issues with the turnover, there is nothing further in the evidence directed at the relevant date that provides any further support for the applicant's claim. On this point, I note that any evidence that can possibly point to repeat custom (which is a factor in favour of goodwill) is all directed at a period that falls after the relevant date so cannot form part of the applicant's present claim. Even ignoring this point, the reference to repeat customers or customers travelling a long distance to use the applicant's services (and expressing a willingness to do so again) is very limited. Lastly, there is nothing before me regarding any advertising or marketing efforts that could be said to point to a level of awareness across the relevant consumer base.

32. As a result of the above, and having taken all of the evidence of use into account, I find that the applicant's business does not benefit from any protectable level of goodwill in order to sustain a claim for passing off. Therefore, the present ground fails at the first hurdle. I will now consider the section 3(6) ground.

⁷ For example, see *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

Section 3(6): legislation and case law

33. 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”

34. 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 Ankenaevnet 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).”

35. 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. balance of probability). 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).

36. The basis for the present claim is set out above. In short, the applicant claims that the proprietor became aware of the applicant’s business and that, in filing for its mark, it did not intend to use it itself but sought to cause confusion, ride on the coattails of the applicant or to disrupt its business by (1) causing misrepresentation or (2) using the contested mark to interfere with the applicant’s activities. I will begin by considering the second aspect of this claim, namely that the proprietor intends to use the contested mark to interfere with the applicant’s business activities.

37. Before moving on, I wish to discuss that, in her pleadings, the applicant also made reference to a claim that the proprietor had no eyelash or beauty therapy qualifications. This point is explored further in the applicant's evidence wherein she states that it is against the law for offer such services without these qualifications or insurance. For the avoidance of doubt, this issue has no bearing on whether the contested mark was filed in bad faith or not. I say this because, even if such a practice were illegal,⁸ there is no evidence showing that the proprietor lacks the relevant qualifications or insurance. Even if it were true that the proprietor's owner, being Ms Akingbade, was not qualified or insured, there is nothing preventing her from hiring employees with said qualifications or from obtaining the necessary insurance. As a result, I will say no more about this part of the applicant's pleadings.

38. In assessing the nature of the applicant's claim, I turn to the key questions for determining a claim of bad faith which were set out in the case of *Alexander Trade Mark*, BL O/036/18. These questions are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

39. Answering these questions in turn, I note that, firstly, the proprietor is being accused of having no intention to use the contested mark and that it is using it solely to interfere with the applicant's business. Secondly, as per points (x) and (xi) of paragraph 240 of *Skykick* (cited above), I am satisfied that, if it is proven that the

⁸ On this point, I note that there is nothing before me confirming which law or regulation governs this.

proprietor only intended to use the mark to interfere with the applicant, this is a practice aimed at undermining the interests of the applicant in a manner inconsistent with honest practices. A conclusion that the proprietor behaved in this manner is capable of resulting in a finding of bad faith. In respect of the third question, it is necessary for me to consider whether the evidence before me establishes that this is why the proprietor filed the contested mark.

40. In considering the evidence before me, I will begin with the applicant's evidence. This appears to be aimed primarily at the events that took place on 2 February 2023. This is when the applicant first received correspondence from the proprietor wherein it claimed that the applicant was committing trade mark infringement by selling goods and offering services under the 'BADE' branding.⁹ This correspondence appears to have been sent at 16:43 on 2 February 2023. The applicant acknowledges that, upon receiving this correspondence, she checked the Trade Marks Register and found that the proprietor was the owner of a registered trade mark for the word 'bade' in respect of class 25 goods, being clothing, shoes and headgear.¹⁰ It is stated that this was the only trade mark on the register for 'bade' at that time, thereby confirming that the application for the contested mark had yet to be made. The applicant sets out that she believed she was being wrongfully accused of infringement and, in response, she wrote to the proprietor denying that she was infringing the proprietor's trade mark.¹¹

41. The applicant notes that it was on this day that the proprietor filed the contested mark and it is claimed that, in doing so, it had the intention to deliberately stop the applicant from using her brand name. Further to the initial correspondence noted above, it is confirmed that the proprietor proceeded to report the applicant's Instagram account seven times for an intellectual property violation. It is not confirmed when these reports were made but I note that the applicant's account

⁹ A copy of this email is found on page 1 of OB7

¹⁰ A printout from the Trade Marks Register is provided (at page 5 of OB7) that shows the presence of this mark on the register, being that under number 3769131.

¹¹ See page 2 of OB7

was subsequently suspended on 21 July 2023. Confirmation of the reason for the suspension was provided to the applicant by Meta (the owner of Instagram) by way of an email dated 31 July 2023. A copy of the email is provided in evidence and I note that the reason given is that the applicant's account was reported by a third party that it violated their intellectual property rights.¹² The applicant's evidence sets out that the result of this suspension was that she lost her client base and her marketing as she mostly does all of her business through her Instagram account.¹³ As such, it is claimed that this suspension caused harm to her business operation.

42. I turn now to consider the proprietor's evidence. Having done so, I note that, at paragraph 7.2 of Ms Akingbade's witness statement, she stated as follows:

"We have no intention of offering eyelash services, as this does not align with our mixed international male and female audience. Instead, our focus within class 3 and 44 encompasses a broad category of products, which is not limited to eyelash products and services."

43. Similar comments have been made in the submissions of the proprietor, being at paragraph 11 of the submissions filed alongside its evidence and at paragraph 5 of its written submissions in lieu of a hearing. These comments create some difficulty for the proprietor because its class 44 services include the terms "beauty treatment services especially for eyelashes", "eyelash perming services" and "eyelash curling services". Clearly, these terms expressly cover eyelash services. Further, an additional range of terms of the class 44 services are sufficiently broad so may also cover eyelash services.

44. Based on the above, the proprietor confirms that it has no intention to use its mark on such services which calls into question why it applied for them in the first place.

¹² Page 5 of OB7

¹³ While I found there to be no protectable goodwill in the applicant's business under the section 5(4)(a) ground, I do consider the evidence sufficient to demonstrate that there was at least some trade under the applicant's sign.

On this point, I note that when applying for a trade mark in the UK, the applying party is required to give a statement that it has the *bona fide* intention to use the mark on the goods and/or services applied for. By giving this statement without the intention to actually use the mark, the application is considered contrary to section 32(3) of the Act, which sets out as follows:

“32(3) - The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.”

45. While that may be the case, I refer to the case of *Sky Plc v SkyKick UK Ltd* (C-371/18) wherein the CJEU, at paragraph 86 set out that a statement on the application form that the mark is in use, or there is a *bona fide* intention to use it may, if untrue, provide evidence supporting a bad faith case. However, it is set out that this is not sufficient by itself to justify the refusal or cancellation of the registration. Therefore, this statement itself does not constitute confirmation that the contested mark was filed in bad faith, however, it is something that can be taken into account in my overall finding and I will bear it in mind going forward.

46. Turning to the proprietor’s evidence in respect of its own business operations, I note that Ms Akingbade sets out that her business’s extension into classes 3 and 44 (being the goods and services at issue here) is part of a strategic expansion plan that is entirely lawful and a common practice among businesses looking to diversify their offerings. In support of this claim, the proprietor refers to brands such as ‘Fenty’ which is claimed to have transitioned from fashion to beauty and haircare. Further, the proprietor refers to the brand ‘Skims’ which has expanded into multiple product categories. I note that the proprietor has filed a screenshot from the website WWD that shows the cover page of an article dated 20 February 2020 which discusses the ways in which the singer Rihanna has ‘electrified’ the

fashion and beauty industries.¹⁴ In respect of this evidence, I appreciate that 'FENTY' is associated with Rihanna but this evidence simply makes reference to Rihanna the individual and it is not clear to what extent the 'FENTY' brand or its expansion from fashion to beauty is discussed.

47. While the above evidence is noted, it covers just two brands, being 'FENTY' and 'Skims'. As far as I understand it, these are two large international brands which are associated with famous celebrities. That being said, aside from the proprietor's witness's assertion, I have nothing before me in the evidence to suggest that these companies have expanded in the way claimed.¹⁵ As such, I do not consider that this evidence is sufficient to establish that either of these brands have expanded in this manner. Even if it was established that these companies had ongoing and established business operations prior to their claimed expansions, the proprietor has offered just two examples of this practice. As a result, I do not accept that this evidence is sufficient in demonstrating that an expansion from the fashion industry to the beauty industry is common in the trade to the point that the proprietor's claim is automatically acceptable. This does not mean that the proprietor's defence is of no assistance as I will now need to consider whether the evidence before me demonstrates that in all the circumstances it is plausible that the proprietor's intention in applying for the mark was to obtain protection for goods and services into which it intended to expand its business. If it does, then the proprietor's rationale can be said to be demonstrative of an honest intention. However, if it does not, then it will call into question the motivations of the proprietor and I will then move to consider whether the evidence, as a whole, indicates that the proprietor was acting in bad faith.

48. Ms Akingbade sets out that she is a prominent British luxury fashion designer with over 15,000 followers across various social media platforms such as Instagram and TikTok. She confirms that her designs have been worn by international

¹⁴ Ref 6

¹⁵ Again, the evidence refers to Rihanna the individual as opposed to the brand 'FENTY'.

celebrities such as French singer Aya Nakamura, American star Kaliil and Nigerian-British art designer Olaoluslaw. Evidence in support of this comes via screenshots of various Instagram posts.¹⁶ One post appears to be dated 24 October 2022 but is in the French language and the price referred to for the product shown is in euros. The other post is dated 20 March but no year is specified. Further, neither of these posts appear to have any significant level of engagements.

49. In addition to the above, the evidence shows sales figures via Shopify for the month of May 2024.¹⁷ This is from over a year after the relevant date and nothing is provided to confirm what goods were actually sold at this time. Further, it is noted that the Shopify printouts include information as to the location of the 'sessions' for the users that visited the proprietor's Shopify account. While noted, the majority of these 'sessions' were from users in the USA, Canada and Australia, with only 43 'sessions' coming from UK users. In respect of sales around this time, I note that the proprietor has provided two reviews from June 2024 regarding sales of clothing goods.¹⁸ There is no indication where these customers were from and, without such, I am not willing to infer that they relate to sales from within the UK. Lastly, I note that images are provided of 'influencers' wearing the proprietor's clothing goods but this evidence is not dated and neither is it confirmed where these influencers are based.

50. While the evidence as to the proprietor's operations is noted, it hardly establishes the presence of a UK-based fashion business as at the relevant date. The consequence of this is that, in my view, it is less probable that the proprietor's intention was to expand its existing UK fashion business into a different field, since it appears that it did not even have an established clothing business in the UK to begin with. So while I accept that it may be the case that larger, established

¹⁶ Ref 1

¹⁷ Ref 10

¹⁸ Ref 13

companies expand into distinct fields of business, the proprietor's evidence does not establish the presence of a UK-fashion business to the point that such a finding could reasonably be applied to the proprietor. Without anything further, I am not convinced that it follows that any expansion in this way is normal simply based on the proprietor's assertion. In light of this, I consider it necessary to look at the remainder of the evidence in order to assess whether it is possible to determine the proprietor's rationale in applying for the contested mark.

51. In the present case, I note that the proprietor has not provided any documentary evidence of its expansion plans prior to the relevant date and neither has it provided any evidence that it has sold, or made any preparations for selling, class 3 goods or provided class 44 services to customers since making its application. On this point, I remind myself that while evidence under the present ground is to be targeted at the relevant date, evidence about subsequent events may be relevant if it casts light backwards on the position at the relevant date.¹⁹ It, therefore, follows that if the proprietor had provided evidence of sales of class 3 goods or the provision of class 44 services after the relevant date, it could be taken as demonstrating an intention at the relevant date to expand its business in this way. Instead, the evidence of any business activity (which I have discussed above), regardless of how limited it is, either points directly towards clothing goods or it is not sufficiently clear that it covers class 3 goods or class 44 services. Therefore, it cannot be taken as evidence that casts light backward so as to demonstrate that the proprietor had an honest intention to trade in these goods and services.

52. In terms of the timing of the application, I note that the filing date is the same day on which the proprietor contacted the applicant for the first time. On this point, I can see from the correspondence that it was sent at 16:43 on 2 February 2023. As set out above, when the applicant first received this correspondence, she checked the register and, at that point, the application for the contested mark was not

¹⁹ See *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).

showing. This would indicate that the application was yet to be made. On this point, the proprietor has filed nothing to the contrary to suggest that (1) the application was made prior to the initial correspondence being sent or (2) the application of the contested mark was in motion prior to this time. If such evidence existed, it would have been relatively easy to provide and would, in my view, go some way to dispelling the claim that the contested mark was filed in reaction to the proprietor discovering the applicant's business. As such, I consider it reasonable to conclude that the application was filed after the proprietor sent the applicant its initial correspondence.

53. Taking all of the above into account, I am of the view that the only logical conclusion that can be drawn from the evidence is that the proprietor, upon gaining knowledge of the applicant's activity on Instagram, filed the contested mark and then used it as the basis for a series of subsequent complaints to Instagram in order to get the applicant's account closed down. The evidence confirms that this greatly disrupted the applicant's business. This issue is compounded by the fact that at no point has the proprietor provided any cogent evidence (be that prior to the relevant date or thereafter) of its claimed intention to start offering class 3 goods or class 44 services. In my view, such evidence could have been easily provided if it was, in fact, the proprietor's true intention. On this point, I remind myself that the proprietor has even stated that it had no intention to offer some services applied for, being those that are in direct conflict with the eyelash services that the applicant appears to have provided (albeit to a limited extent). Even in relation to the goods or services that are not covered by these comments, I am of the view that the present circumstances are such that they fail to offer any reasonable rationale for such an application, other than being for the objective of disputing the applicant's business. Further, I do not consider that the mere assertion that the proprietor wished to expand its business is supported by the overall evidential picture and, as set out above, it has not established that it is a logical or common step for any fashion business to expand into beauty.

54. As a result, and on the balance of probabilities, it seems to me that the proprietor did not actually intend to use the contested mark but, instead, sought to disrupt the applicant's business in a manner inconsistent with honest business intentions. The contested mark is, therefore, declared as being filed in bad faith and the cancellation application hereby succeeds in full.

CONCLUSION

55. The application succeeds in full and, subject to any successful of my decision, the contested mark is declared invalid for all goods and services applied for. It is hereby treated as if an application for the contested mark was never made.

COSTS

56. The applicant 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 applicant the sum of £1,450 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of invalidity and considering the counterstatement:	£300
Filing evidence:	£600
Filing written submissions in lieu:	£350
Official fees:	£200
Total:	£1,450

57.I hereby order Bade World Limited to pay Omokorede Bademosi the sum of £1,450. 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 29th day of August 2025

A COOPER

For the Registrar

ANNEX

Class 3

Beauty serums; Beauty creams; Beauty lotions; Beauty care cosmetics; Beauty masks; Masks (Beauty -); Beauty soap; Beauty milk; Beauty milks; Beauty gels; Beauty creams for body care; Beauty balm creams; Facial beauty masks; Beauty care preparations; Distilled oils for beauty care; Beauty tonics for application to the face; Beauty masks for hands; Beauty serums with anti-ageing properties; Beauty tonics for application to the body; Natural cosmetics; Body cleaning and beauty care preparations; Non-medicated beauty preparations; Natural makeup; Skincare cosmetics; Body care cosmetics; Natural perfumery; Hair cosmetics; Body and facial creams [cosmetics]; Cosmetics; Skin care cosmetics; Colour cosmetics; Facial creams [cosmetics]; Colour cosmetics for the skin; Hair care creams [for cosmetic use]; Colour cosmetics for the eyes; Body creams [cosmetics]; Cosmetic products in the form of aerosols for skincare; Natural oils for cosmetic purposes; Hair care lotions [for cosmetic use]; Cosmetics for eye-lashes; Cosmetics for suntanning; Organic cosmetics; Facial makeup; Eye cosmetics; Decorative cosmetics; Skin masks [cosmetics]; Nail cosmetics; Eyelashes; Eyebrow cosmetics; Eyelashes (False -); False eyelashes; Eyes make-up; Cosmetic preparations for eye lashes; Eyebrow mascara; Eye makeup; Eye make-up; Skin make-up; Hair serums; Eyelash tint; Beauty preparations for the hair; Anti-aging moisturizers used as cosmetics; Sun care lotions [for cosmetic use].

Class 44

Beauty salons; Salons (Beauty -); Beauty treatment services especially for eyelashes; Services of a hair and beauty salon; Beauty salons for wig cutting ; Beauty care; Beauty treatment; Salon services (Beauty -); Beauty salon services; Beauty care of feet; Hygienic and beauty care; Pet beauty salon services; Facial beauty treatment services; Hygienic and beauty care for animals; Human hygiene and beauty care; Hygienic and beauty care for humans; Beauty counselling; Beauty spa services; Beauty consultancy; Beauty care services; Beauty care for

human beings; Hygienic and beauty care for human beings; Hygienic and beauty care services; Cosmetic treatment services for the body, face and hair; Eyelash perming services; Eyelash curling services; Consultancy in the field of body and beauty care; Beauty advisory services; Beauty consultancy services; Beauty care services provided by a health spa; Information relating to beauty care; Information relating to beauty; Advisory services relating to beauty care; Consultation services relating to beauty care; Providing information relating to beauty salon services; Cosmetic make-up services; Skin care salons; Hair salon services for women; Skin care salon services.