# O-0854-25

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO 3896562**

**IN THE NAME OF FB BEAUTY LTD**

**FOR THE FOLLOWING MARK:**


**IN CLASSES 3, 8, 18 & 21**

**AND**

**OPPOSITION THERETO (UNDER NO. 442821)**

**BY**

**HINA S ISA**

## BACKGROUND

1) On 03 April 2023, FB BEAUTY LTD ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of various goods in classes 3, 8, 18 & 21. For reasons which will become apparent, there is no need to list all of the goods here.

2) The application was published in the Trade Marks Journal on 30 June 2023 and a notice of opposition was subsequently filed, on 29 August 2023, by Hina S Isa ('the opponent'). The opposition, as originally filed, was deficient in a number of respects. The opponent was given several opportunities to amend its notice of opposition to address the deficiencies. An admissible notice of opposition was eventually filed on 28 November 2023. The opponent claims that the applicant's mark offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its opposition under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade mark registration:

- **UKTM 3196243**

  **(Series of 2)**

MUAUK

MAKEUP ADDICT UK

**Class 3:** Facial makeup; Makeup; Cosmetics in the form of powders; Cosmetics; Cosmetic preparations for body care; Cosmetics and cosmetic preparations; Face creams for cosmetic use; Body oils [for cosmetic use];Body oil [for cosmetic use];Cosmetic sun-protecting preparations; Cosmetic sunscreen preparations; Face powder [for cosmetic use];Face powders [for cosmetic use];Cosmetic oils; Cosmetics for eye-brows; Cosmetics for use in the treatment of wrinkled skin; Cosmetic creams for skin care; Cosmetics for personal use; Cosmetics for the treatment of dry skin; Cosmetics for use on the skin; Cosmetics in the form of milks; Cosmetics in the form of rouge; Cosmetics for eye-lashes; Eyelashes (Cosmetic preparations for -);Cosmetic preparations for eyelashes; Cosmetic preparations for eye lashes; Cosmetic powder; Cosmetic masks; Facial cleansers [cosmetic];Cosmetic preparations for skin care; Cosmetic face powders; Cosmetic moisturisers; Cosmetics for protecting the skin from sunburn; Cosmetic preparations against sunburn; Cosmetic preparations for protecting the skin from the sun's rays; Cosmetic rouges; Cosmetic tanning preparations; Colour cosmetics; Cosmetic products for the shower; Cosmetic preparations for skin firming; Cosmetic body scrubs; Exfoliating scrubs for cosmetic purposes; Anti-aging moisturizers used as cosmetics; Decorative cosmetics; Cosmetic creams for firming skin around eyes; Cosmetic nail care preparations; Cosmetic creams and lotions; Cosmetic preparations for skin renewal; Cosmetic preparations for dry skin during pregnancy; Beauty care cosmetics; Creams (Cosmetic -); Cosmetic creams; Cosmetic creams for the skin; Cosmetic skin fresheners; Cosmetic facial masks; Face packs [cosmetic]; Cosmetic pencils; Anti-ageing creams [for

cosmetic use];Anti-aging creams [for cosmetic use]; Mineral oils [cosmetic]; Mineral water sprays for cosmetic purposes.

**Class 8:** Hand tools for use in beauty care.

**Class 21:** Applicator sticks for applying makeup; Cosmetic brushes; Cosmetics brushes; Applicators for cosmetics; Cosmetics applicators; Cosmetic powder compacts.

**Filing date:** 11 November 2016
**Date of entry in register:** 31 March 2017

4) It is claimed that there is a likelihood of confusion between the parties' marks under section 5(2)(b) of the Act. It is also claimed, under section 5(3) of the Act, that the earlier marks in the series have a reputation in the UK and that use of the applicant's mark would lead to unfair advantage and damage to the earlier marks' reputation and distinctive character.

5) The trade marks in the series relied upon by the opponent are 'earlier marks', in accordance with section 6 of the Act. As the earlier registration completed its registration procedure more than five years prior to the date on which the applicant's mark was filed, the marks in the series are subject to the proof of use conditions, as per section 6A of the Act. I note that the opponent confirmed, explicitly, in its email of 28 November 2023 (which accompanied the final, and admissible, version of the notice of opposition) that it is not relying upon 'proper reasons for non-use'. In this regard, the opponent said: 'As the trade mark has been used section Q7b ['Please state any proper reasons for non-use'] is not completed'. Instead, the opponent made a statement of use in respect of all the goods relied upon.

6) Under section 5(4)(a) of the Act, the opponent relies upon the use of two signs which correspond identically to the two marks covered by its earlier registration, 3196243. It is said that those signs have been used since 2017. In response to the question 'Where used?' on the Form TM7, the opponent states: 'Liasing with business investors and scientists for products and services. Online promotion and digital social media services. (Global)'. In response to the question 'On which goods or services

has the earlier rights been used for?', the opponent states: 'Marketing and promotion digital data since 2018 to present day on social media such as Instagram, X (formerly known as twitter)'. It is claimed that the opponent has generated goodwill under the relevant signs and that use of the applicant's mark would lead to misrepresentation and damage to the opponent's goodwill.

7) The applicant filed a counterstatement. It puts the opponent to proof of use of its earlier series of marks and to proof of reputation and goodwill and denies the opponent's other claims.

8) The applicant is represented by Burges Salmon LLP; the opponent is without legal representation.

9) The opponent's evidence consists of a witness statement in the name of Hina Sajjad Isa[1] with exhibit A thereto. The applicant filed submissions[2] only during the evidence rounds. Neither party requested a hearing; only the applicant filed written submissions in lieu[3]. I now make this decision having carefully considered all the papers before me.

**DECISION**

**Proof of use**

10) Section 6A of the Act states:

> "(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
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> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

[1] Dated 17 May 2024
[2] Dated 07 August 2024
[3] Filed on 16 September 2024

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

11) Further, section 100 of the Act states that:

> "If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

Consequently, the onus is upon the opponent to prove that genuine use of the earlier marks in the series was made in the relevant period. In the instant case, that period is the five-year period ending on the date of filing of the applicant's mark, namely **04 April 2018 to 03 April 2023.**

12) In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

13) Before I assess the evidence before me, I remind myself of my comments at paragraph [5] of this decision regarding the opponent's explicit confirmation that 'proper reasons for non-use' are not relied upon. With that in mind, I turn to consider Ms Isa's evidence.

14) Ms Isa gives a lot of explanation about the intentions for her 'brand', its development and how she aims to establish a strong presence in the market under her registered marks. However, in terms of providing evidence of actual use that has already taken place of her marks, the evidence before me appears to be almost, if not entirely, non-existent, as set out below.

15) Ms Isa explains that she registered the earlier marks with a firm intention of establishing a strong and recognisable brand identity. She also states that her brand has been developing since its establishment in 2017. Ms Isa's plans to develop the

brand were interrupted by the COVID-19 pandemic. Ms Isa states that, despite that challenging time, MUA (UK) has persevered and continued its operations from the Cotswolds region where it was established. She states that the brand has a long-term vision of ethically produced, environmentally friendly, and high-quality products. It is said that, from 2017 onwards, MUA (UK) has actively engaged in product development and manufacturing plans for its cosmetic and lifestyle offerings under the MUA (UK) brand.

16) Ms Isa also states that MUA (UK) has maintained an active online presence and engagement with consumers through various media channels since 2017. The evidence in support of this is extremely thin. There is a single undated snapshot[4] of the opponent's website, www.muauk.com, and a snapshot[5] of a single post on Twitter, dated August 2023. The latter date falls after the filing date of the applicant's mark and is therefore outside the relevant period under consideration. Further, whilst a copy of the registration of the domain name, muauk.com, is provided from 2016[6], the mere registration of a domain name is not evidence of genuine use of the earlier marks. I also note that, although Ms Isa states that she has a personal blog at www.thec-word.com, there is nothing before me to show what, if any, advertising or promotion of the earlier marks and goods has taken place on that blog.

17) The single exhibit which has been provided[7] consists of what is described as a '2018 presentation'. There are images of various cosmetics shown in the presentation bearing the mark 'MUAUK'. I cannot tell how many customers, or potential customers, have been exposed to this 'presentation' (if any) or when any such exposure/promotion has taken place. There is nothing to indicate that there has been any customer-facing use of this document in 2018 or any other year(s).

18) In addition to the deficiencies identified above, there is also no evidence before me to show that any sales took place within the relevant period for any of the goods relied upon. There are, for example, no invoices, no sales figures, no evidence of

[4] Paragraph 17 of Ms Isa's witness statement
[5] Paragraph 18 of Ms Isa's witness statement
[6] Paragraph 19 of Ms Isa's witness statement
[7] Exhibit A

customer orders or any other kind of evidence to show that any sales were made in the UK within that period. There is also no evidence before me to show how much investment has been made in promoting the earlier marks.

19) As the case law above makes clear, the test for 'genuine use' requires that 'the use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services'. It will be clear from the various observations I have made above about Ms Isa's evidence that it comes nowhere near satisfying me that the earlier marks in the series have been so used.

20) The opponent has failed to establish genuine use in relation to any of the goods relied upon in the relevant period. Consequently, the opponent cannot rely upon its earlier series of marks under sections 5(2)(b) or 5(3) of the Act and the opposition on those grounds must fail.

**Section 5(4)(a)**

21) 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."

22) 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."

23) In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Relevant date

24) In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (as he then was), sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded 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.'"

The opponent must show that it had the necessary goodwill at the filing date of the contested mark, namely 03 April 2023.

Goodwill

25) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the Court stated:

> "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."

26) In terms of the evidence that is required to establish the existence of goodwill, 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 of 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."

27) 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."

28) Goodwill is the 'attractive force which brings in custom'. To establish that such goodwill exists there must, therefore, be evidence of custom as at the relevant date. As per my earlier comments about the opponent's evidence, there is nothing before me to show that the opponent has had any customers at all. The requisite goodwill has, therefore, not been established. Without goodwill, there can be no misrepresentation or damage. The claim under section 5(4)(a) of the Act fails.

**OVERALL OUTCOME**

29) **The opposition fails.**

**COSTS**

30) The applicant has been successful and is entitled to an award of costs. In its submissions filed during the evidence rounds and in lieu, the applicant requests that I consider awarding off-scale costs due to the 'voluminous' grounds pleaded which have not been substantiated. It is true that the opponent has failed to substantiate any of its grounds with sufficient evidence. However, I do not consider that the conduct of the (unrepresented) opponent has been such as to warrant an award of costs off the scale. I will award costs to the applicant based on the usual scale which can be found in Tribunal Practice Notice 1/2023. Using that scale as guidance, I award the applicant costs on the following basis:

| | |
|---|---|
| Preparing a counterstatement and considering the other side's statement | £300 |
| Written submissions filed during evidence rounds | £350 |
| Written submissions in lieu of a hearing | £350 |
| **Total:** | **£1000** |

31) I order Hina S Isa to pay FB BEAUTY LTD the sum of **£1000**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of September 2025**

**Beverley Hedley**
**For the Registrar**