BL O/0957/26

TRADE MARKS ACT 1994
IN THE MATTER OF REGISTRATION NO. 3958711
IN THE NAME OF PIXEL MAVEN LTD FOR THE SERIES OF TWO MARKS
RUN BNC Run Bnc
IN CLASSES 9, 35, 38, 41 AND 42
AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THEREOF
UNDER NO. 507623 BY RUN BNC LTD

AND IN THE MATTER OF APPLICATION NO. 4044460
IN THE NAME OF RUN BNC LTD FOR THE MARK
RUN BNC
IN CLASSES 35, 38, 40, 41 AND 42
AND AN OPPOSITION THERETO UNDER NO. 449116
BY PIXEL MAVEN LTD

DECISION

---

1. On 20 September 2023, the Appellant and Party B in the proceedings below, Pixel Maven Ltd, applied for the series of two trade marks RUN BNC and Run Bnc (number 3958711) for goods and services in classes 9, 35, 38, 41 and 42. The application was registered on 16 February 2024.

2. On 1 August 2024, the Respondent and Party A in the proceedings below, Run BNC Ltd, applied for a declaration that Party B's mark was invalid under section 5(4)(a) of the Trade Marks Act 1994. Party A claimed that it had goodwill in its film production business distinguished by the sign RUN BNC and that it first used the sign in the UK in 2016. It filed evidence in support of its case from Joe Coffey, who is the director and sole shareholder of Party A.

3. In addition, Party A filed a trade mark application (number 4044460) for RUN BNC on 26 April 2024 for goods and services in classes 35, 38, 40, 41 and 42. Following publication, Party B partially opposed the application on 15 August 2024 under section 5(2)(a) Trade Marks Act 1994, based upon its earlier trade mark registration

the subject of Party A's invalidity application. The proceedings were then consolidated.

4. In a decision dated 23 July 2026 and based on the papers, the Registrar's Hearing Officer, Judi Pike, upheld Party A's s.5(4)(a) objection to the registration of Party B's mark and allowed Party A's application to proceed to registration. Party B appeals that decision before me.

5. In a hearing which took place on 21 October 2026 the Appellant, Party B, was represented by Aman Rana of Agile IP LLP. The Respondent, Party A, was represented by Angel Chan instructed by Trade Mark Wizards Limited. I am grateful to both of them for their written and oral submissions.

Standard of Appeal

6. This is now well established. The principles are set out in the well-known cases of *Axogen v Aviv Scientific* [2022] EWHC 95 (Ch), *Lifestyle Equities v Amazon* [2024] UKSC 8 and *Iconix v Dream Pairs* [2025] UKSC 25. I summarised the approach in SOCIAL WORK NEWS (O/0050/24) at [13]:

> To paraphrase, an appeal should only be allowed where the decision of the lower court was "wrong". Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible". In the case of a multifactorial assessment and in the absence of a distinct error of principle, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere.

7. I have sought to apply those principles. It is not enough that a different tribunal might have reached a different conclusion; I must be satisfied that the Hearing Officer was wrong in the conclusions she reached.

The Decision

8. The Hearing Officer first set out the law of passing off. Then she reviewed Party A's evidence (no evidence having been relied on by Party B). There was a dispute about the date upon which Party B commenced use of its mark (which is no longer live on this appeal). As a result of this, the Hearing Officer determined the relevant date for the assessment of Party A's goodwill on two alternative basis for the reasons she explained in her §25.

9. In §26 the Hearing Officer noted that 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". The Hearing Officer also reminded herself that a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill, by reference to a previous decision of my own, *Smart Planet Technologies, Inc. v Rajinda Sharma*, Case BL O/304/20

10. In §27 she recorded:

> 27. At the prima facie relevant date of 20 September 2023, Party A had a total turnover of £524,225. I bear in mind that the relevant date is three quarters of the way through 2023, so adjusting the 2023 turnover figure to match (i.e. £86,490 rather than £115,321), that is still a total of £495,394. The turnover figures show a steady annual income, increasing markedly in 2022 and 2023. The two agreements show Run BNC Ltd. Party B submits that this is not use of the sign relied upon; however, the distinctive part of Run BNC Ltd is Run BNC, which is the sign relied upon (albeit in capital letters, which makes no difference). The 2023 agreement is in relation to work carried out for Wicked; elsewhere in Mr Coffey's statement Wicked is listed as a production by Universal Studios, a major film company. Furthermore, Mr Coffey has stated that RUN BNC has been used since 2017.

11. The Hearing Officer went on to record in §32 that the relevant industry, namely the film production industry, was small. Applying *Lumos Skincare Ltd v Sweet Squared Ltd* [2013] EWCA Civ 590 and *Neutrogena Corporation v. Golden Limited* [1996] RPC 473 she held that Party A's actual or potential customers were likely to be small in number because of the nature or extent of the business and also the market itself.

12. Applying the law to the facts, she concluded:

> 36. Recalling that goodwill is "the attractive force which brings in custom", this attractive force was evident throughout the years 2017 to 2023 and the sign relied upon is in evidence in the agreements, as well as Mr Coffey's statement that it was the sign used by Party A. The turnover figures show a steady annual income, increasing markedly in 2022 and 2023. There was also repeat custom from at least Sky TV and Universal Studios, which is a hallmark of goodwill; although I place less reliance on that because the list of productions is said to be since 2021 without tying the work done to before the relevant date. In any event, latterly, by the end of 2022, Party A was turning over £115,321 in a small market.
>
> 37. I must decide whether Party A has shown a small goodwill (which the law will protect) or only a trivial goodwill (which it will not). I do not think that this case boils down to just a question of numbers (as was said in Lumos). Unlike *Smart Planet Technologies, Inc. v Rajinda Sharma*, the market is niche/small. Also unlike *Smart Planet Technologies, Inc. v Rajinda Sharma*, the sign is not low in distinctiveness.

The evidence shows a steady and, latterly, increasing annual turnover since 2017, with examples of film company agreements in 2018 and 2023. Comparisons with the facts of other cases only get one so far. It is all the facts and circumstances of the evidence before me that I must assess. I find that, at the prima facie date of 20 September 2023, the combination of factors in Party A's evidence means that, at that date, Party A has established that it had a small, but protectable goodwill in its business of data management for digital imaging technicians, on set workflows and support for directors of photography, of which RUN BNC was distinctive. Its pleadings rely upon "film production" but I consider that film production appears wider than the services in which the business had goodwill at the prima facie relevant date.

38. Although the turnover was smaller between 2017 and 2021 (or even 2020), I consider that all the facts and circumstances of the evidence show that there was a small but undeniable attractive force bringing in regular custom which was enough to give rise to a small but protectable goodwill at 15 April 2021 as well as at 20 September 2023.

…

40. I have already referred above to what is meant by 'substantial number of members of the public', as explained in Lumos in the context of misrepresentation. It is not the public in general, but is Party A's customers or potential customers. Party A's sign is distinctive and identical to Party B's series of marks. The goods and services of Party B's registration will be a feature of the services for which Party A has goodwill because they relate to the same field of activity, involving image processing, data, image and data editing and retention of data in the cloud. As a consequence, there is no doubt in my mind that a substantial number of Party A's actual and potential customers would believe that Party B's goods and services were those of Party A.

41. Damage, such as diversion of trade and/or injurious association, is inevitable given the identity of the distinctive signs and the common field of operation. Party A was entitled to restrain Party B at 20 September 2023 and also at 15 April 2021 under the law of passing off from using its trade mark. This means that registration of the mark in the UK was contrary to section 5(4)(a) of the Act.

The Appeal

13. In its TM55 grounds of appeal, Party B ran multiple points alleging that the Hearing Officer had erred, which it summarised as follows, suggesting she had:

    a. failed adequately to distinguish Mr Coffey's personal reputation and relationships from goodwill belonging to the Respondent;

b. treated evidence of trading, turnover and commercial relationships as sufficient to establish goodwill in RUN BNC without adequately establishing the necessary connection between the sign, the services and the customers;

c. placed material reliance upon only two sales agreements without adequately addressing the significance of Mr Coffey's own identification in those agreements along with his own admissions that the industry operates on personal relationships and word of mouth;

d. Likewise, the fact that Sky TV or Universal Studios are substantial or well-known companies does not itself establish goodwill in RUN BNC. The relevant question is what those customers understood RUN BNC to denote and whether the sign itself generated or embodied the relevant customer attraction. An individual having worked for some of the largest brands in the world cannot be conflated with the goodwill associated with the invoicing company

e. relied upon uncorroborated evidence concerning the industry and market without that evidence establishing goodwill in the sign;

f. failed properly to maintain the Respondent's burden of establishing the goodwill relied upon; and

g. in any event, failed adequately to establish that the relevant customers would be deceived by the Appellant's use of its mark.

14. However, in its skeleton argument for the hearing and at the hearing itself Ms. Rana focussed on one point in particular, a. above. In short, it was said that the Hearing Officer had erred by attributing any goodwill earned by the business run by its director and sole shareholder Joe Coffey to the company, Party A, when in reality any goodwill would have accrued to Mr Coffey in person, such is the personal nature of the business he is in.

15. In support of that Ms. Rana relied on various authorities, including *CSB 123 Ltd, Re* [2021] EWHC 2506 (Ch). Although this was an insolvency dispute about the liquidation of the business of a fashion stylist, it contains the following observations about the distribution of goodwill where someone trades under their personal reputation:

> Ownership of the personal styling business
>
> 317. As will be seen from the foregoing summary, a central plank of the Respondent's defence is that there was no goodwill in SC1, only 'personal goodwill' vested in the Respondent, by virtue of her skill-set, her reputation for personal styling, her clients and her exceptional connections.
>
> …
>
> 320. Campbell and Johnson on the Valuation of Business Interests provides the following guidance on personal goodwill:

'Personal goodwill is goodwill that accrues to a specific person. It arises from his or her personal characteristics and attributes as evidenced by particular abilities, particular physical characteristics, good name and reputation.'

321. In *Whiteman Smith Motor Co v Chaplin* [1934] 2 KB 35, Scrutton LJ at 42 drew a memorable distinction between 'cat, rat and dog' goodwill:

'The cat prefers the old home to the person who keeps it, and stays in the old home though the person who has kept the house leaves. … The dog represents that part of the customers who follow the person rather than the place … There remains a class of customer who may neither follow the place nor the person, but drift away elsewhere. They …. have been called 'the rat' for no particular reason except to keep the epigram in the animal kingdom.'

322. In the Scottish case of *Reid v Reid* 1938 SLT 415 (at 416-417), the court recognised that there was generally likely to be little goodwill in the business of those with a highly personal profession, such as surgeons, artists or advocates. In such cases, the goodwill is personal to the individual. At 417, Lord Keith makes reference to the valuation case of *Drummond v Assessor for Leith* (1886, 13 R 540), in which Lord Fraser referred to cases of 'personal goodwill where the profits of the business result almost entirely from confidence placed in the personal skill of the party employed, as in the case of surgeons… in regard to whom the goodwill is really worth nothing.'

323. The HMRC Capital Gains Tax Manual (CG68010 Goodwill) recognises that personal goodwill falls to be treated differently from other forms of goodwill on the transfer of a business. Whilst confirming (with emphasis added) that 'When a business is disposed of as a going concern any goodwill *attributable to the business* will be transferred to the new proprietor', it goes on to state:

'Any goodwill *attributable to the personal skills of the proprietor*, for example, the personal skills of a chef or a hairdresser, will not be transferred to the new proprietor'.

…

327. Whilst not a comprehensive list, this assessment will generally include consideration of the following factors:

(1) whether the business attaches to an individual (i.e. their abilities, characteristics, name or reputation) or a company (i.e. its brand name, location or resources);

(2) whether the business would remain with the company in the event that the individual ceased to be employed by the company;

(3) whether customers engage with and enlist the services specifically of the individual, or contact and enlist the services of the company first, with the individual contact/relationship remaining a secondary issue; and

(d) whether the individual's name or the company name would have any bearing on the customer's desire to carry out business with the individual.

16. Ms. Rana accepted that the present case did not involve the valuation of personal goodwill, and so to this extent it was different to *CSB 123* (and §§323-328 of that case are less relevant to the facts before me). But she did rely on the observations about the separation of personal and business goodwill and submitted that the Hearing Officer erred by failing to take this into account in the present case. In particular, it was said that the evidence was that the film industry was built on personal relationships, and so any goodwill that had been attributed to Party A should in fact have been attributed to Mr Coffey. As such, the claim by Party A under s.5(4)(a) should have been rejected.

17. I accept the principle discussed in the cases referred to in §§321-322 of *CSB 123* that in certain professions (e.g. medicine) goodwill may accrue personally rather than to a corporate body or institution. This will all be a matter of fact and degree and Scrutton LJ's dog, cat and rat analogy lives on.. However, in the present case there are two significant problems with Ms. Rana's arguments.

18. First, they were not run below. It was never suggested to the Hearing Officer by Party B that even if (which was denied) there was sufficient goodwill arising from the work referred to in the evidence, this goodwill should be attributed to Mr Coffey and not Party A. Ms. Rana for Party B appeared to accept that.

19. Ms. Rana sought to justify this by saying that it was not for a party to proceedings to be "psychic" and second guess what the Hearing Officer might find. Therefore she suggested that Party B was justified in raising the point only now in light of the Decision. She stated on more than one occasion in submissions that another hearing officer might have come to a different conclusion, perhaps to justify her client's apparent "surprise" in the outcome. But of course it is very well established that this is not sufficient grounds for an appeal, and for the same reason it cannot be used to justify running a point which was not run below.

20. For Party A, Ms. Chan countered that litigation in this jurisdiction is adversarial and not inquisitorial and that therefore the burden is on the parties to raise all relevant arguments below.

21. I agree. "*The trial is not a dress rehearsal. It is the first and last night of the show*" per Lewison LJ in *Fage v Chobani* [2014] EWCA Civ 5 at [114]. That comment was made about appeal courts being asked to interfere with findings of fact made below. However, the Court of Appeal in that case was also asked to determine a new point,

not argued below. Lewison LJ referred at [150] to "*the well-known principle that, as a general rule, a party is not entitled to raise on appeal a point which could have been raised in the lower court*". Although there are limited circumstances in which this is permissible, I do not consider that they arise in the present case, and other than the "psychic" point referred to above, which I reject, no justification was given for why it was not argued below.

22. Second, in any event, even if I were to allow the point to be run on appeal (e.g. by accepting that the general challenge to ownership of goodwill included an implied query as to whether any such goodwill had accrued to Party A or Mr Coffey), the evidence and findings of the Hearing Officer do not support the finding that Party B argues that I should make.

23. It is right that Mr Coffey explained that the film production industry is built on personal relationships. This was §14 of his witness statement, quoted by the Hearing Officer at [17] – so she clearly had the point in mind. Nevertheless, his evidence was that the goodwill arising from the work he referred to accrued to Party A. Indeed, his §14 concluded: "*My Company is well-known in the UK withing the film production industry, as can be seen from the various high profile productions in which we have been involved*". Notably, no attempt was made to challenge this below, whether in evidence, submission or by seeking to cross-examine Mr Coffey.

24. The fact that goodwill accrued to Party A was reflected in the Decision. The Hearing Officer accepted the evidence of Mr Coffey which made clear that the goodwill which his witness statement sought to support was that of Party A and not his own. See [15] and [16] set out below (with emphasis added), and [37] quoted above.

> 15. Mr Coffey states that, between 2016 and 2020, **Party A** offered support and data management to Digital Imaging Technicians and on set workflows. He states that, in 2021, **Party A** launched its full set of services offered directly to production companies manufacturing films or episodic services. The services provided include the management and transport of all recorded data from set to post-production and direct collaboration with (and support for) the Director of Photography. Mr Coffey states that, since 2021, **Party A** has provided these services for the creation of the following UK film and TV productions:
> a) The Amazing Mr Blunden (Sky TV);
> b) Landscapers (Sky TV);
> c) Hijack (Apple TV);
> d) Argylle (Matthew Vaughn production);
> e) Wicked (Universal Studios);
> f) Paddington in Peru (Studio Canal);

g) The Magic Faraway Tree (Neale Street Productions); and
h) How to Train Your Dragon (Universal Studios)

16. Mr Coffey exhibits a copy of the agreements for film production services under the sign RUN BNC which **Party A** entered into in 2018 for the production of the DEVS series and in February 2023 for the production of Wicked. …

25. Party B did argue that there was an absence of evidence of Party A's marketing activities below and it put Party A to proof of its claims. The Hearing Officer commented on this at [33] but went on to deal with Party B's putting to proof at [34]:

34. If this is a challenge to the truthfulness of Mr Coffey's statement regarding the norms in the sector, it is opaque. Moreover, at the beginning of Party B's submissions, it says:

"The registrant [Party B] is not necessarily disputing the validity of the facts presented, but legal submissions concerning the veracity of the claims themselves are abhorrently denied."

26. This is yet further reason not to entertain a new point on appeal which is contrary to the evidence presented to the Hearing Officer.

27. Further, it would not be right for me to seek to go behind the evidence adduced before the Hearing Officer. That is one of the reasons why parties are not allowed to run new points on appeal, because it either involves the time-consuming and costly exercise of having to remit the case back to the first instance tribunal or the undesirable exercise of the appellate court attempting to assess multifactorial issues for the first time. As Lewison LJ also observed in *Fage*, "*In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping*". The exercise urged on my by Party B was considerably more than island hopping – it amounted to an invitation to disbelieve the totality of the evidence adduced and impose instead a finding that any goodwill accrued to Mr Coffey and not Party A. The simple acknowledgement that the film industry is built on personal relationships does not permit that in the face of the evidence taken as a whole.

28. For all these reasons I reject Party B's submissions about (mis)attribution of goodwill.

29. As I have recorded above, the hearing before me focussed on the question of where any goodwill might have accrued. These are grounds a, c and d above.

30. I have also considered the other grounds. None of them raise a separate error of law on the part of the Hearing Officer or justify me in finding that she was wrong. They are merely invitations for me to reassess the evidence and come to a different conclusion to that reached below. The points on turnover (grounds b and e) were properly dealt with by the Hearing Officer at [27] of the Decision. The remaining grounds f and g were also properly assessed at [37], [40] and [41] cited above.

31. In conclusion, I reject the appeal for the reasons given above. As recorded by the Hearing Officer, the application for a declaration of invalidity is successful and registration 3958711 is deemed never to have been made. The opposition against application 4044460 fails and this trade mark application may proceed to registration.

Costs

32. Below, the Hearing Officer awarded Party A £1650.

33. For consideration of the (extensive) written grounds of appeal and preparation for and attendance at the hearing before me I award Party A the additional sums of £600 and £1000 respectively.

34. Therefore I order that the total sum of £3250 be paid by Pixel Maven Ltd to Run BNC Ltd by 4pm on 16th November 2026.

Thomas Mitcheson KC
The Appointed Person
23 October 2026