

O/376/20

TRADE MARKS ACT 1994

TRADE MARK REGISTRATIONS 3339150 & 3339152

IN THE NAME OF GARBETT LICENSING LIMITED

AND

APPLICATIONS 502489/502510

BY THE PYJAMA FACTORY LIMITED

FOR DECLARATIONS THAT THE TRADE MARKS ARE INVALID

Background and pleadings

1. The Pyjama Factory Limited (“the applicant”) applied on 1st March 2019 for the registration of the trade marks shown below to be declared invalid and cancelled.

UK3339150

floss like a boss

UK3339152



2. These trade marks are registered with effect from 17th September 2018 (“the relevant date”) in the name of Garbett Licensing Limited (“the proprietor”).

3. The proprietor originally applied to register the marks in relation to:

Class 18: Luggage, umbrellas.

Class 25: Clothing, headwear, footwear.

4. However, following an objection from the examiner that the ‘150 mark was not distinctive in relation to T-shirts and other types of clothing commonly used to convey personal statements by the wearer, the specification of that application was restricted in class 25. The ‘150 mark is therefore registered in relation to:

Class18: Luggage, umbrellas.

Class 25: Trousers, dresses, underwear, socks and footwear.

No objection was taken to the ‘152 mark. It is registered for all the goods specified in paragraph 3 above.

5. The applicant for invalidation's case is that:

- (i) The term 'Floss Like A Boss' is a very common saying and is in widespread use, both commercially and non-commercially;
- (ii) It has been used in the UK since at least as early as 2014, well before the relevant date;
- (iii) The word 'Floss' describes a popular dance move;
- (iv) The phrase 'Like A Boss' is teenage-speak for doing something to the best of a person's ability and in a very "cool" manner;
- (v) The term 'Floss Like A Boss' garnered widespread appeal and spread virally amongst the online video game-playing fraternity, social media and the market beyond;
- (vi) An entire cottage industry has developed around the term in order to take economic advantage of its global, mass market appeal;
- (vii) There have been (and continue to be) numerous examples of enterprises using figures both identical and similar to the silhouette device in the '152 mark;
- (viii) Neither the words 'Floss Like A Boss', the silhouette device or the '152 mark as whole, show any departure from the "norm" that is already established in popular culture;
- (ix) Since at least as early as 2014 a wide range of merchandising goods, including clothing, bearing such signs, have been sold online by a plethora of enterprises.

6. The applicant therefore claims that registration of the contested trade marks was contrary to section 3(1)(b) and/or (d) of the Trade Marks Act 1994 (“the Act”), and that the registrations should now be invalidated under section 47(1) of the Act.

The relevant statutory provisions

7. The relevant parts of the applicable statutory provisions are shown below.

“3(1) The following shall not be registered –

(a) -

(b) trade marks which are devoid of any distinctive character,

(c) -

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

“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).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

“47(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.”

“47(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.”

8. The proprietor filed counterstatements in which it “*disagreed*” with the applicant’s claims under section 47(1) of the Act. I note that the proprietor:

- Accepted that ‘floss’ is the name of a dance;
- Put the applicant to proof that the contested marks are devoid of any distinctive character;
- Claimed that prior to their registration, clothing bearing the proprietor’s marks had become the number one fashion item on eBay and Amazon for several months;
- Claimed that people were starting to recognise and associate the floss dance with the contested marks;
- Claimed that competitors, including the applicant, were starting to copy the marks.

Representation

9. The applicant is represented by Stevens, Hewlett & Perkins, Trade Mark Attorneys. The proprietor represented itself for most of the proceedings. A hearing was held on 3rd July 2020. Shortly before the hearing, the proprietor appointed Mr Jonathon Moss to appear as its counsel. Mr Robin Webster of Stevens, Hewlett & Perkins represented the applicant at the hearing.

The evidence

10. The applicant’s evidence consists of a witness statement by Mr Mark Milner (with 15 exhibits) and two by Mr Robin Webster (with 10 exhibits). Mr Milner is a director of the applicant. As I have already noted, Mr Webster is the applicant’s trade mark attorney.

11. I note the following points from Mr Milner's evidence:

- (i) The applicant is an online trader in nightwear products;
- (ii) The products are usually emblazoned with animated figures from popular culture, such as Marvel 'super heroes', children's cartoon characters, or characters from Harry Potter, however, the applicant also uses some original designs;
- (iii) He first became aware that the word 'floss' denoted a dance when he saw his daughter performing it in March 2018;
- (iv) He later learned that the floss dance had been popularised by Russell Horning when he performed it on a popular US TV show in May 2017;
- (v) In December 2017, Epic Games, Inc. introduced a silhouette of a person 'flossing' as an emote in their popular online video game 'Fortnite';
- (vi) He considers that the dancing figure in the '152 mark closely resembles the emote used in the Fortnite game;
- (vii) The online dictionary, Dictionary.com, defines 'like a boss' as a colloquial expression meaning to do something with stylish confidence or authority;¹
- (viii) The term 'floss like a boss' therefore means to perform the floss dance with stylish confidence or authority;
- (ix) In April 2018, he first noticed the phrase 'floss like a boss' being used on general merchandise by Asda, when he saw an in-house (George) branded T-shirt bearing the slogan;
- (x) After noticing many products bearing signs like the contested marks being offered for sale on the internet, Amazon and eBay, he decided to produce a range of nightwear bearing 'Floss like a Boss' and dancing figure designs;
- (xi) He did this because he thought his company's customers would be attracted to the designs because they were very "*of the moment*";
- (xii) He commissioned designs which were sent to him on 21st June 2018;
- (xiii) The applicant subsequently ordered goods bearing the designs from a manufacturer in Bangladesh and these went on sale on 29th July 2018;

¹ See exhibit MM7

- (xiv) He first became aware of the proprietor when he found out that it had used the eBay VERO procedure to remove his company's 'Floss like a Boss' nightwear from the site because they infringed the contested trade marks.

12. To illustrate his claim that 'Floss like a Boss' and dancing figure designs were in widespread use when he decided to use such signs in his business, Mr Milner attaches to his statement the results of searches on Google for 'floss like a boss' and 'floss dance silhouette' as words, and 'floss like a boss' as an image search.² In an attempt to limit the search so as to identify only web pages that existed prior to the relevant date, the Google search range was restricted to find results prior to 1st April 2018 or, in one case, 1st September 2018. The search results in Mr Milner's evidence are pages of bare search results or 'hits', i.e. they do not show the actual webpages to which the hits refer.

13. The purpose of Mr Webster's first statement is to show that 'floss like a boss' was in widespread use, including on merchandise, prior to the relevant date. I note the following:

- (i) Exhibit RPW1 consists of 20 pages of search results or 'hits' resulting from a Google search on the words 'floss like a boss clothing' with the territory limited to the UK and the date range set as 1st January 2001 – 16th September 2018, i.e. the day before the relevant date;
- (ii) Exhibit RPW2 consists of 9 pages of 'hits' from Google searches on the words 'floss like a boss clothing', 'floss like a boss bag' and 'floss like a boss' together with 18 pages from around 12 different websites, which Mr Webster selected from the amongst the larger number of 'hits' in the search results;
- (iii) Exhibit RPW3 consists of 7 pages of 'hits' from an unrestricted Google search on the words 'floss like a boss merch' together with 18 pages from 6 of the websites identified in the 'hits';
- (iv) Exhibits RPW4 to RPW6 consist of 15 undated pages of images from Shutterstock and other digital libraries showing that it is possible to

² See exhibits MM8 - MM10

- download designs containing the words 'Floss like a Boss', including some that look very similar to the '152 mark;
- (v) Exhibit RPW7 consists of 10 pages of Google search results from an image search on the words 'free floss like a boss images in 2017' and 'free floss like a boss images in 2018', which include some images that look very similar to the '152 mark;
 - (vi) Exhibit RPW8 consists of 5 pages of Google 'hits' from a search on 'download floss like a boss images' with the time filter set to 'before 16th September 2018', together with 13 pages from 6 of the websites identified in the search results;
 - (vii) Exhibit RPW9 consists of an extract from the US trade mark database showing that the USPTO refused an application to register FLOSS LIKE A BOSS as a trade mark on the grounds that it is a commonly used slogan that consumers will be attracted to only because of their affinity with the message, and would not function as a trade mark.

14. The proprietor's evidence consists of witness statements by Mr Lawrence Garbett, Mr Richard Dawson and Mr Robin Hillson. Mr Garbett describes himself as a "*worker*" for the proprietor. I note the following from his evidence:

- (i) According to Mr Garbett, the silhouette of a boy flossing in the '152 mark is based on his son doing the floss dance;
- (ii) Although he knew of the floss dance and played the video game Fortnite (which includes a emote of a silhouette of a person flossing), he had never heard of the term 'Floss like a Boss' before the proprietor came up with the brand;
- (iii) The proprietor's 'Floss like a Boss' design was created in June 2018 and products (T-shirts and hoodies) were first listed on amazon.co.uk on 5th July 2018³;
- (iv) Between this date and the date of Mr Garbett's statement in December 2019, over 50k units were sold bearing the 'Floss like a Boss' mark;

³ See exhibit LG2

- (v) After the products became popular on Amazon and eBay, competitors starting copying the design and this resulted in the proprietor applying for registration of the contested mark.

15. Examples of the proprietor's products are shown below.⁴ Mr Garbett says that these include products that were on sale at the time of his statement and 'mock-ups' of future products.



⁴ From exhibit LG6

16. As regards the applicant's evidence, Mr Garbett makes the following criticisms:

- (i) The Google search results in exhibits RPW1 – RPW3, RPW7 & RPW8 to Mr Webster's statement are unreliable and/or include material from outside the UK and should, therefore, be disregarded;
- (ii) The results of searches of images from digital libraries contained in exhibits RPW4 – RPW6 are undated, include examples of people copying the contested marks, or are from outside the UK, and should also be disregarded.

In support of point (i) above, Mr Garbett claims that a 'hit' dated 26th September 2014 in the first page of the Google search results in exhibit RPW1 is in fact a reference to the proprietor's own product, which he points out was not available until 2018. In support of point (ii) above, Mr Garbett provides examples of images available for download from Shutterstock, which appear to include third party trade marks⁵.

17. Mr Dawson is a Graphic Designer for DinoTex Ltd, which he says created the final version of the 'Floss like a Boss' design (i.e. the '152 mark) for Mr Garbett and the proprietor. According to Mr Dawson, Mr Garbett had a picture of his son doing the floss dance and asked him to create a silhouette of it. He says that "we" then came up with the slogan 'Floss Like a Boss' to go with the logo. He provides a screen capture from his network files showing that the final design was created on 4th June 2018⁶.

18. Mr Dawson says that he had never heard of the floss dance until Mr Garbett told him about it, and he had never heard of the slogan 'Floss Like a Boss' before they came up with it.

19. Mr Hillson was UK Sales Manager of Trade Mark Collections Ltd, who he says were leading manufacturers of children's licensed luggage. He knew of the floss

⁵ See exhibit LG3

⁶ See exhibit RD1

dance, but had not heard of the phrase ‘Floss like a Boss’ before Mr Garbett spoke to him about licensing his newly registered trade mark.

20. Mr Webster’s second witness statement was filed as evidence-in-reply to the proprietor’s evidence. It consists mostly of submissions, which I will come to in due course, where necessary. However, I note that Mr Webster also provided some factual evidence from Companies House showing that DinoTex Limited and the proprietor are associated companies. Mr Garbett was also a director of DinoTex Limited until 27th June 2019. Therefore, Mr Dawson is not an independent witness, as it might have appeared, but a business colleague of Mr Garbett.⁷

What the evidence shows about the use of ‘Floss like a Boss’ and dancing figure silhouettes at the relevant date

21. The material in exhibits RPW3 – RPW6 to Mr Webster’s first statement do not purport to represent material from prior to the relevant date. By contrast, the contents of exhibits RPW1, RPW2, RPW7 and RPW8 are claimed to show use of ‘Floss like a Boss’ and dancing figure silhouettes prior to the relevant date. Exhibits MM8 – MM10 and MM13 to Mr Milner’s statement also consist of material claimed to pre-date the relevant date. In both cases, the applicant relies on search tools within the Google search system, or dates included in the search term itself, to have limited the search results to material that existed prior to the relevant date.

22. The proprietor disputes that such evidence is reliable to accurately date the material prior to the relevant date.

The use of Google date range tools, or dates entered in search terms, to identify material from prior to the relevant date

23. Much of the evidence in exhibits RPW1 and RPW2 to Mr Webster first statement consists of pages of bare Google search results or ‘hits’, i.e. a list of short titles, with dates, very short extracts from webpages, together with links to the relevant

⁷ See exhibit RDW10

websites and webpages. The short title appears to be influenced by the search term and often re-produces it. In my view, little weight can be attached to such evidence by itself. This is because it does not show how the webpages identified in the 'hits' looked, and it is not possible to tell exactly what was on them. For this reason, the contents of exhibit RPW1 do not support the applicant's case.

24. Exhibit RPW2 includes some examples of the actual webpages identified in the hits. This represents potentially more probative evidence. However, the applicant has chosen an unusual method to date the contents of these webpages prior to the relevant date. Instead of providing cached pages obtained from internet archive websites, as is customary in these types of proceedings, the applicant has added 'snippets' to the webpages with links revealing metadata purporting to show when those pages were first published.

25. At the hearing, Mr Moss drew my attention to a number of inconsistencies in this material. For example, a webpage in page 47 of exhibit RPW2 is from the website of 4UTODAY. According to the metadata in the 'snippet' added to the page in evidence, it was first published on 5th December 2017. The webpage includes a picture of a hoodie emblazoned with a design very similar to the '152 mark. It was on sale at the reduced price of £9.99. There is an associated voucher for use in redeeming this offer. It is shown as being valid from 17th November 2018 to 17th November 2019. It is very unlikely that anyone would make an offer in December 2017 to sell a garment at a reduced price between November 2018 and November 2019. It follows that the webpage in evidence could not have contained the offer to sell the 'Floss like a boss' hoodie when it was published in 2017. More likely the garment offer was added to the webpage around November 2018, i.e. after the relevant date. This begs the question whether the 'Floss like a Boss' garment was present on the webpage at all when it was first published in December 2017.

26. Mr Moss cited the following further examples of inconsistencies between the suggested date of publication of the webpages in evidence and the contents of those pages:

- (i) A webpage from Zazzle in exhibit RPW2 shows a 'Floss like a Boss' T-shirt for sale and has a 'snippet' purporting to show that the page was first published in December 2016, and yet the same page shows another T-shirt bearing a design for Christmas 2019⁸;
- (ii) A webpage from picclick in exhibit RPW2 shows a number of 'Floss like a Boss' T-shirts for sale and has a 'snippet' purporting to show that the page was first published in July 2018, and yet the same webpage has a copyright claim of 2008 - 2019⁹;
- (iii) A webpage from Groupon in exhibit RPW2 shows a 'Floss like a Boss' T-shirt for sale and has a 'snippet' purporting to show that the page was first published in July 2018, and yet the same webpage has a copyright claim of 2019¹⁰.

27. I asked Mr Webster at the hearing what I should find that these, and other similar webpages in evidence, showed. He submitted that I should find that:

"At the time that is what that search result was. If we click on that now, in certain instances we have now jumped to the live page because that page has not been cached, which does, yes, show the copyright notices."

28. This amounts to an acceptance that what is shown on the webpages in evidence is not necessarily the same as the content those pages would have had when they were first published. Mr Webster appeared to consider that the integrity of the Google search engine was being called into question. It is not. However, the Google search tools are not designed to show exactly what individual webpages looked like in the past. That is why internet archive websites are usually used for this purpose. The use of 'snippets' showing metadata, including the date of first publication of a webpage, is therefore an unreliable means of dating the content of the current webpage. Consequently, unless there is further corroborating evidence, the individual webpages in exhibit RPW2 cannot be relied on to show that 'Floss like a Boss' T-shirts were on sale prior to the relevant date.

⁸ See page 41 of exhibit RPW2

⁹ See pages 42 and 43 of exhibit RPW2

¹⁰ See page 54 of exhibit RPW2

29. In my view, the contents of exhibits RPW7 and RPW8 do not take the applicant's case any further. So far as I can see, none of the images in exhibit RPW7 produced by the search for 'free floss like a boss images in 2017' (and 2018) are dated. I am very doubtful that simply adding *“.in 2017/18”* to the search term was effective in limiting the hits to images that were first published in those years. Further, no attempt was made to limit these results to the UK websites.

30. The images in exhibit RPW8 produced by searching on 'images for download floss like a boss' were retrieved after using the Google search tool to restrict the results to material from before the relevant date. The dates associated with the 5 pages of search results in evidence are all prior to the relevant date. However, I note that despite being dated 5th February 2018, the title of the final 'hit' on page 117 of the evidence is 'Migos 2019 songs'. It therefore appears doubtful that the dates given in the search results can be used to reliably date when the titles of these 'hits' were first published, let alone the content of the linked webpages. The images shown in the remainder of this exhibit are mostly from digital image download websites. The first two pages of images (from Vectorstock) show no use of 'Floss like a boss' in the context of clothing or bags etc. Further, I note that the copyright date on the second of these pages is from 2019, i.e. after the relevant date. The images on the next 4 pages of the exhibit (from Etsy) do show designs very similar, if not identical, to the '152 mark being used on T-shirts. And I note that goods are priced in pounds sterling. However, I also note that the copyright claim on the final page of this part of the exhibit is dated 2019. This reinforces my impression that this material may not actually pre-date the relevant date.

31. Exhibit RPW8 also includes an article which is self-dated as being from 2015. It appears to come from a blog used by dental practices in the USA. It shows a framed poster bearing the words 'FLOSS LIKE A BOSS'. This shows use of the term in 2015, but not in relation to clothing, luggage or umbrellas (or in the UK).

32. The same general criticisms that I have made of Mr Webster's evidence also apply to the contents of exhibits MM8 - MM10 and MM13 of Mr Milner's evidence.

33. Mr Webster suggested that any shortcomings in the evidence were partly caused by the registrar's practice of limiting the number of pages of evidence to 300. I do not accept this. Firstly, there is no such limit. Tribunal Practice Notice 1/2015 merely requires parties proposing to file more than 300 pages of evidence to seek directions before doing so. No such directions were sought in this case. Secondly, and more importantly, the deficiencies in the applicant's evidence are not the result of a lack of quantity, but a lack of quality. Filing more of the same would not have assisted.

Other evidence of use of 'Floss like a Boss' prior to the relevant date

34. At the hearing, Mr Webster only placed specific reliance on a couple of pages of the evidence. The first of these is from exhibit MM12 to Mr Milner's evidence. In support of his claim that Asda sold its George-branded T-shirts bearing the phrase 'floss like a boss' in April 2018, Mr Milner provides an extract from the Asda website¹¹. The first page shows a picture of a children's T-shirt prominently bearing the term 'Floss like a Boss' superimposed on what appears to be a meerkat performing the floss dance. The product is marked 'out of stock'. The pages in evidence were printed on 10th September 2019, i.e. nearly a year after the relevant date. However, Mr Milner points out that 12 customer reviews of the product on the following pages of the website are dated as having been posted "*a year ago*." According to Mr Milner, this shows that the product was on sale around 10th September 2018, i.e. just prior to the relevant date.

35. Mr Moss submitted that this evidence could not be relied on to show that the Asda George product was marketed prior to the relevant date. He pointed out that it was very unlikely that all 12 reviews on the website were posted exactly a year before the date the webpage was printed in September 2019. Consequently the reviews could have been posted before or after the relevant date.

36. Mr Webster invited me to interpret the posting information on the Asda website as meaning that the 12 reviews were posted at least a year before the webpage was printed in 2019. However, there is no evidence about how these posts are dated,

¹¹ See exhibit MM12

and I see no reason to infer that 'a year ago' means 'at least a year ago', as opposed to, for example, 'in the previous calendar year'. On that view of the matter, the product reviews could have been posted any time in 2018, before or after the relevant date. However, I note that the search results on the first page of exhibit RPW2¹² include a 'hit' from the website playpennies.com for a 'Floss Like A Boss' T-shirt for sale at "Asda George." The date attached to this 'hit' is 24th May 2018. This is consistent with the Asda product having been on sale in May 2018 and thus generating the 12 reviews recorded on the Asda website during 2018. As I have already observed, the dates associated with the 'hits' in search results are not always reliable. In this case, I find that the search result page and the pages from the Asda website corroborate each other. They also tie in with Mr Milner's evidence that he first saw 'Floss like a Boss' merchandise on sale in Asda in April 2018. In my view, the evidence as a whole is sufficient to establish that, on the balance of probabilities, the Asda 'Floss like a Boss' children's T-shirt was on sale in the UK by April 2018, i.e. prior to the relevant date. However, as Mr Moss pointed out, there is no evidence as to the number of such products sold prior to that date (or at all).

37. The second specific example of use on which Mr Webster placed particular reliance comes from exhibit RPW3 to Mr Webster's first statement.¹³ It consists of a webpage from the Amazon.co.uk website. It shows a children's T-shirt for sale emblazoned with the words 'Floss like a Boss' together with silhouettes of five dancers 'flossing'. I note that the trade mark 'SHOT DEAD' is visible in the neck label of the T-shirts in question. The 'Floss like a Boss' design emblazoned on the front of the T-shirt appears to be purely decorative. The page in evidence seems to have been downloaded in 2019. However, the 'Product details' section of the webpage states that the product was first made available on Amazon on 22nd May 2018. I accept this shows that this product was on sale in the UK prior to the relevant date.

¹² Page 30 of the evidence

¹³ See pages 65/66 of the evidence

The section 3(1)(d) ground

The pleading point

38. At the hearing, Mr Webster submitted that the s.3(1)(d) ground for invalidation should be allowed because the proprietor had not denied it.

39. The proprietor was not professionally represented at the time the counterstatement was filed. Although a second ground for invalidation based on s.3(1)(b) of the Act was subsequently added, at the time the original counterstatement was filed, s.3(1)(d) was the only ground for invalidation. It is true that the s.3(1)(d) was not specifically denied. However, the very filing of a counterstatement indicated that the application was being resisted. Further, the narrative attached to the counterstatement reinforced the impression that the proprietor was defending the registration. I indicated at the hearing that, in my judgment, Mr Webster was attaching too much weight to the deficiencies in the proprietor's pleadings. The applicant clearly understood that its s.3(1)(d) ground was not admitted because it went on to file evidence to support its s.3(1)(d) case. If this pleading point was to be taken, it should have been taken when the applicant received the proprietor's counterstatement. It was not fair for the applicant to take the point for the first time at the substantive hearing of the case. I will, therefore, treat the proprietor as having denied (or, at least, not admitted) the s.3(1)(d)-based ground for invalidation.¹⁴

The case-law

40. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*¹⁵, the General Court summarised the case-law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

¹⁴ It is accepted that the later-added s.3(1)(b)-based ground was denied.

¹⁵ Case T-322/03

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 Merz & Krell [2001] ECR I-6959, paragraph 31, and Case T-237/01 Alcon v OHIM – Dr. Robert Winzer Pharma (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, Merz & Krell, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, Merz & Krell, paragraph 37, and BSS, paragraph 40).”

41. Article 7(1)(d) of Regulation 40/94 is identical to s.3(1)(d) of the Act. These provisions must be interpreted in the same way.

42. Mr Moss submitted that s.3(1)(d) only covered generic marks, such as ‘aspirin’, which have become customary in the trade to describe the goods. I do not accept that s.3(1)(d) is so limited in scope. The case-law cited above makes it clear that descriptiveness is not the correct basis for applying s.3(1)(d). It is sufficient that the sign has become *customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark* (emphasis added). Marketing a T-shirt as a ‘floss like a boss’ product is using those words to designate the goods. However, there are only two established examples of such use in the UK prior to the relevant date. And neither of those examples included the same silhouette device shown in the ‘152 mark.

43. I therefore find that there is no evidence that the ‘152 mark (as a whole) was in customary use in the UK at the relevant date in relation to any relevant goods.

44. I find that the term ‘Floss like a Boss’ was in use in the UK, prior to the relevant date, in relation to T-shirts. However, the extent of the use shown is insufficient to establish that such use had become a *customary* means of designating such goods in the current language or in the bona fide and established practices of the trade. Further, as I have already noted, the ‘150 mark is not registered in relation to T-shirts.

45. The s.3(1)(d)-based ground for invalidation therefore fails.

The section 3(1)(b) ground

46. The principles to be applied under article 7(1)(b) of the EU Trade Mark Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*¹⁶ as follows:

¹⁶ Case C-265/09 P

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (Henkel v OHIM, paragraph 34; Case C-304/06 P Eurohypo v OHIM [2008] ECR I-3297, paragraph 66; and Case C-398/08 P Audi v OHIM [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (Storck v OHIM, paragraph 25; Henkel v OHIM, paragraph 35; and Eurohypo v OHIM, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P KWS Saat v OHIM [2004] ECR I-10107, paragraph 78; Storck v OHIM, paragraph 26; and Audi v OHIM, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P Proctor & Gamble v OHIM [2004] ECR I-5173, paragraph 36; Case

C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 34; Henkel v OHIM, paragraphs 36 and 38; and Audi v OHIM, paragraph 37)."

47. Mr Webster relied on the following points to support the applicant's case under s.3(1)(b):

- (i) The 'floss' dance is a part of popular youth culture;
- (ii) The signs in issue were not created by the proprietor;
- (iii) The term 'Like a Boss' has a discernible meaning, i.e. to do something with stylish confidence or authority;
- (iv) 'Floss like a Boss' and dancing silhouettes the same as, or closely similar to, the device in the '152 mark were in widespread use both in the UK and abroad by the relevant date.

48. There being no copyright or other relative grounds to the applicant's case, Mr Moss submitted that point (ii) above was irrelevant. He accepted that 'like a boss' may be a colloquial expression which, to some, means to do something with stylish confidence or authority. However, he did not accept that the evidence showed that this meaning was widely understood. He also disputed that the evidence showed widespread use of signs corresponding to the contested marks prior to the relevant date.

49. I accept Mr Moss's submission that it is irrelevant who created the device shown in the '152 mark, or who coined the phrase 'Floss like a Boss'. This is because the distinctive character of the contested marks depends on the likely reaction to them of average consumers, i.e. whether they are likely to regard the signs as indicating the trade origin of the goods for which they are registered. Such consumers are unlikely to know or care who created the signs. Consequently, it does not matter whether the silhouette device in the '152 mark is based on Mr Garbett's son.

50. The evidence shows, and it is not in dispute, that at the relevant date, the 'floss' dance was popular, particularly amongst the young.

51. I have rejected the applicant's case that, at the relevant date, 'Floss like a Boss' and/or a dancing silhouette, like the one of the '152 mark, were in widespread use in the UK in relation to clothing, luggage or umbrellas. However, the evidence does support the applicant's claim that the meaning of the term 'Floss like a Boss' would have been widely recognised by, at least, a large section of the relevant public; namely, children, many of their parents, and young adults.

52. It appears to be common ground that the floss dance had become popular by the relevant date. And I note that the term 'like a boss' appears on Dictionary.com as a colloquial expression meaning 'to do something with stylish confidence or authority'. In any event, to anyone that knows that a 'floss' is a particular dance, the meaning of the composite phrase 'Floss like a Boss' is not difficult to discern from just the ordinary meaning of the words 'like a Boss' (i.e. as 'flossing' with authority). It is true that 'floss' has a different well-known meaning in a dental context, but this is unlikely to come to mind when the term is used in relation to clothing, luggage and umbrellas. It is even less likely to come to mind when seen in the context of the '152 mark, which includes a silhouette of someone performing the floss dance.

53. This conclusion is consistent with the evidence showing that, prior to the relevant date, at least two undertakings (Asda George and the user of the Shot Dead trade mark) were using 'Floss like a Boss' with (albeit different) 'flossing' designs to decorate and market T-shirts for children. Those undertakings must have expected those designs to appeal to a section of their customers. It follows that they must have expected the term 'Floss like a Boss' to convey a discernible personal statement with which potential wearers of the garment might wish to be associated.

54. In *AS v Deutsches Patent – und Markenamt*¹⁷ the CJEU held that all the relevant facts and circumstances must be taken into account when examining the distinctive character of a trade mark. In the absence of other indications, this means taking into account the types of use which, in the light of the customs in the sector concerned, can be "*practically significant*." Therefore, average consumers' reaction to the sorts of uses of a mark which are possible in theory, but unlikely in practice, do not need

¹⁷ Case C-541/18

to be factored into the assessment. However, unless expressly disavowed, the ways in which the proprietor itself appears to use the trade marks should be regarded as “*practically significant*” for these purposes.¹⁸ I will therefore take the proprietor’s actual and proposed use of the ‘152 mark shown in paragraph 15 above to be a “*practically significant*”¹⁹ use of the mark in relation to T-shirts and similar goods.

55. In *Audi AG v OHIM*,²⁰ the CJEU held that slogan-type marks can be distinctive, if they are not caught by s.3(1)(c) and their capacity to identify trade origin is discernible, even if secondary to a promotional function. The court stated that:

“44. However, while it is true – as was pointed out in paragraph 33 of the present judgment – that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character.

45. On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.

46. However, by the line of reasoning set out in paragraphs 42 and 43 of the present judgment, the General Court did not substantiate its finding to the effect

¹⁸ See *OPEN COUNTRY Trade Mark* 2000 RPC 477 regarding normal and fair use of a registered trade mark

¹⁹ As an example of ‘normal and fair’ use of the mark, as it has sometimes been called in earlier UK caselaw

²⁰ Case C-398/08 P

that the mark applied for will not be perceived by the relevant public as an indication of the commercial origin of the goods and services in question; in essence, rather, it merely highlighted the fact that that mark consists of, and is understood as, a promotional formula.

47. As regards the General Court's finding in paragraph 41 of the judgment under appeal that the mark Vorsprung durch Technik can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character."

56. The '152 mark consists of the device of a silhouette of a person 'flossing' above the words 'Floss like a Boss'. The words FLOSS and BOSS are in larger font than the intervening words 'like a', and the words are contained within lines which form a border above and below them. However, this arrangement will have a negligible impact on average consumers who will see the '152 mark as the silhouette of a dancer above the phrase 'Floss like a Boss'.

57. In my view, at the relevant date, average consumers of T-shirts would have regarded the '152 mark as conveying nothing more than the potential wearer's affinity for, and competence in, the floss dance. This would have made T-shirts bearing the marks attractive to those wishing to be associated with such a personal statement, and to those selecting clothing etc. on their behalf. However, I do not consider the '152 mark would have served to indicate the commercial origin of T-shirts, even as a secondary function of the sign.

58. Admittedly, the average consumer's reaction to the '152 mark may be more equivocal if the mark was used in a more conventional trade mark setting, such as in a neck label. However, considering all "*practically significant*" uses of the '152 mark, including the ways in which the proprietor actually uses it, I do not consider that it

would have served to indicate the commercial origin of T-shirts. The '152 mark is, therefore, devoid of any distinctive (trade mark) character in relation to T-shirts and *prima facie* excluded from registration by s.3(1)(b) of the Act.

59. The '152 mark is registered for other goods. And the '150 mark is not registered for T-shirts. It is true that T-shirts and hoodies are more commonly marketed bearing decorative slogans, statements and designs than is the case with articles of luggage, umbrellas, trousers, dresses, underwear, socks, footwear and other items of clothing. However, in my experience, all such goods are known to be sometimes marketed bearing the sorts of slogans, statements and designs more commonly seen on T-shirts. The average consumer's reaction to such signs is not likely to be different depending on whether the contested marks appear on T-shirts or (say) holdalls, children's umbrellas, vests, or socks. My finding in relation to the '152 mark for T-shirts therefore also applies to the other goods for which that mark is registered. For the same reasons, I make the same finding for the '150 mark in relation to the narrower range of clothing and luggage/umbrellas for which it is registered.

Acquired distinctiveness?

60. At the hearing, Mr Moss submitted that, even if they were inherently non-distinctive, the contested marks had acquired a distinctive character through use prior to the date of the applications for registration, or prior to the date of the applications for invalidation. Therefore, the applications for invalidation should be rejected under the proviso to section 47(1) of the Act.

61. Even making some allowance for the fact that the registered proprietor did not have the benefit of professional representation at the time the pleadings were filed, I am doubtful whether a claim of acquired distinctiveness through use was ever advanced. If I right about that, there is nothing further to decide.

62. However, even if I wrong about that, I would nevertheless reject such a claim because the evidence does not support it. The relevant case-law is set out in the CJEU's judgment in *Windsurfing Chiemsee*²¹. The court stated that:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 37).”

63. The onus is on the registered proprietor to show that the marks had acquired a distinctive character by, at the latest, the date of the applications for invalidation.²²

²¹ Joined cases C-108 & C-109/97

²² See *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV*, Joined cases C-217 and 218/13

64. Mr Garbett's evidence is that between 5th July 2018 and the date of his statement in December 2019, over 50k 'units' were sold bearing the 'Floss like a Boss' mark. However, I note that:

- (i) The applications for invalidation were filed on 1st March 2019 and the sales figures therefore include sales after either of the dates that are relevant for the purposes of s.47(1) of the Act;
- (ii) The goods in relation to which the claimed use relates are not entirely clear, but appear to be mainly T-shirts and hoodies;
- (iii) Although 50k units sounds a lot, there is no evidence as to the share of the market this represents;
- (iv) Given that the UK market for clothing runs into £billions per annum, it is unlikely to represent more than a tiny share of the relevant market;
- (v) There is no evidence of any use of the marks, prior to the relevant date, in relation to luggage, bags or umbrellas;
- (vi) There is no evidence of any expenditure on promoting goods under the marks, and no details of any such promotion.

65. I would add that if the use in question was limited to the sort of use shown in paragraph 15 above, which appears more decorative than trade mark in character, the absence of evidence that consumers now recognise the marks as indicating the commercial origin of the goods represents another important gap in the evidence.

66. The registered proprietor's belated claim of acquired distinctiveness is rejected for the reasons given above.

Overall outcome

67. The trade marks are invalid and the registrations will be cancelled with effect from 17th September 2018.

Costs

68. The applicant has been successful and is entitled to a contribution towards its costs. I assess these as follows:

£400 official fees for filing two applications for invalidation;
£400 towards the cost of completing and filing the applications;
£750 towards the cost of filing evidence and considering the registered proprietor's evidence;
£700 towards the cost of the hearing, including the preparation of a skeleton argument.

69. I order Garbett Licensing Limited to pay The Pyjama Factory Limited the sum of £2250. This to be paid within 28 days of the end of the period allowed for appeal or, if there is an appeal, within 28 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 4th day of August 2020

**Allan James
For the Registrar**