

O/0572/24

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003685271
BY DRAGONFLY CREATIVE SERVICES LTD TO REGISTER:**

This Girl Came

AS A TRADE MARK IN CLASSES 4, 5, 10, 25 & 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 429980
BY ENGLISH SPORTS DEVELOPMENT TRUST LIMITED**

AND

**IN THE MATTER OF REGISTRATION NO. 3648000 IN THE NAME OF
DRAGONFLY CREATIVE SERVICES LTD FOR THE FOLLOWING TRADE MARK**

This Girl Came

IN CLASS 10

AND

**AN APPLICATION FOR DECLARATION OF
INVALIDITY THERETO UNDER NO. 504532 BY
ENGLISH SPORTS DEVELOPMENT TRUST LIMITED**

BACKGROUND AND PLEADINGS

1. These consolidated proceedings involve both an opposition and an application for a declaration of invalidity brought by English Sports Development Trust Limited (“ESD”) against trade marks owned by Dragonfly Creative Services Limited (“Dragonfly”). I will summarise the respective proceedings below.

The opposition

2. On 23 August 2021, Dragonfly applied to register the trade mark “This Girl Came” under registration number 3685271 (“the opposed mark”) in the UK for the following goods and services:

Class 4: Lubricants.

Class 5: Vaginal lubricants; Personal lubricants; Hygienic lubricants; Personal sexual lubricants; Lubricants for medical use; Silicone-based personal lubricants; Water-based personal lubricants; Lubricating agents for medical use; Lubricant gels for personal use; Sexual stimulant gels.

Class 10: Sexual activity devices; Sexual activity apparatus, devices and articles; Massage apparatus; Vibration generating apparatus for massage; Condoms; Menstrual cups.

Class 25: Underwear; Women's underwear; Underwear for women; Clothing; Footwear; Lingerie; Body stockings; Bodies [underclothing]; Stockings; Stocking suspenders; Nightwear; Fancy dress costumes.

Class 41: Education; Providing of training; Entertainment; Arranging of cultural events; Conducting of educational events; Arranging of educational events; Conducting of entertainment events;

Conducting of live entertainment events; Arranging and conducting of entertainment events; Arranging and conducting of live entertainment events; Conducting of cultural events; Organisation of entertainment events; Conducting of entertainment activities; Organisation of entertainment and cultural events; Arranging and conducting of educational events; Presentation of live entertainment events; Provision of entertainment via podcast; Party planning; Party planning [entertainment]; Entertainment in the nature of fashion shows.

3. The opposed mark was published for opposition purposes on 8 October 2021 and, on 7 January 2022, it was opposed by ESD. The opposition is aimed at all goods and services for which Dragonfly seeks to register the opposed mark and is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

4. Under both grounds, ESD relies on the following marks:

THIS GIRL CAN

UK registration no. 3069563

Filing date 21 August 2014; registration date 30 January 2015

(“the ESD’s first mark”); and



UK registration no. 801338370¹

Filing date 17 October 2016; registration date 8 September 2017

(“ESD’s second mark”).

¹ ESD’s second mark is a comparable mark based on an earlier International Registration designating the EU. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IRs designating EU. Those comparable marks all retained the earlier filing and registration dates of their EU counterpart marks.

5. Under both marks and under both grounds, ESD relies only on some goods and services for which its marks are registered. The goods and services relied upon under the section 5(2)(b) ground are set out at **Annex 1** of this decision whereas those relied upon under the section 5(3) ground are set out at **Annex 2**.
6. Under the section 5(2)(b) ground, ESD claims that there exists a high degree of similarity between the parties' marks and that the goods and services that Dragonfly wishes to register its mark for are identical and/or similar and/or complementary to the goods and services that ESD relies on. As such, ESD claims that there exists a likelihood of confusion between the marks on the part of the public in the UK.
7. Under its section 5(3) ground, ESD claims to have established a significant reputation and, as a result, Dragonfly, by using a similar mark, would benefit from an unfair advantage and use of the same would be detrimental to ESD's reputation and/or be detrimental to the distinctive character of the earlier marks.
8. Dragonfly filed a counterstatement denying the claims made against it.

The invalidity application

9. Dragonfly is the owner of the trade mark 'This Girl Came', being that registered under trade mark number 3648000 ("the contested mark"). The contested mark has a filing date of 27 May 2021, a registration date of 15 October 2021 and stands registered for the following goods:

Class 10: Sex toys; adult sexual aids.

10. On 26 January 2022, ESD made an application to have the contested mark declared invalid by virtue of section 47 of the Act. The application is based on sections 5(2)(b) and 5(3) of the Act and relies upon the same marks as the opposition, being those marks listed at paragraph four above.

11. While the goods and services relied upon under the section 5(2)(b) grounds of the application differ from those relied upon under the opposition, the goods and services under the section 5(3) grounds are the same (being those set out in Annex 2). The goods and services relied upon under the section 5(2)(b) ground of the application are set out in **Annex 3** of this decision.
12. As for the pleaded arguments of the application, these very closely mirror the pleadings of the opposition set out above. I do not intend to reproduce those here save to say that ESD's claims that there exists a likelihood of confusion between the marks at issue and that there exists an unfair advantage and a risk of detriment to repute and/or distinctive character.
13. Dragonfly filed a counterstatement denying the claims made against it.
14. Upon the filing of counterstatements in both proceedings and in accordance with Rule 62 of the Trade Marks Rules 2008, the Tribunal consolidated these proceedings. This was communicated to the parties via written correspondence dated 25 August 2022.
15. ESD is represented by Fieldfisher LLP and Dragonfly is unrepresented. Both parties filed evidence in chief with Dragonfly also filing written submissions during the evidence rounds. ESD also filed evidence in reply. No hearing was requested and only ESD filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

17. ESD's evidence in chief came in the form of the witness statement of Ali Donnelly dated 25 October 2022. Ms Donnelly is the Executive Director of Digital, Marketing and Communications of the English Sports Council. The evidence sets out that ESD is a subsidiary of the English Sports Council. Ms Donnelly's evidence is accompanied by 11 exhibits, being those labelled AD1 to AD11 and purports to demonstrate that ESD's marks enjoy a reputation.
18. Dragonfly's evidence came in the form of the witness statement of Charlie Southall dated 2 October 2023.² Charlie Southall is the Director of Dragonfly, a position they have held since 2021. Their statement is accompanied by four exhibits, being those labelled Exhibit A to Exhibit E (with Exhibit B being deemed inadmissible by way of an unchallenged preliminary view dated 19 July 2023). Charlie Southall's evidence is, for the most part, submissions as opposed to evidence of fact. It does, however, seek to raise issues as to the common use of 'THIS GIRL' marks.
19. ESD's evidence in reply came in the form of the witness statement of Tim Hollingsworth dated 23 February 2023. Mr Hollingsworth is the Chief Executive Officer at the English Sport Council and his statement is accompanied by five exhibits, being those labelled TH1 to TH5. Mr Hollingsworth's evidence seeks to demonstrate reasons why the goods and services at issue are similar. Further, it discusses third party marks and the accusations against ESD that it has lost control of its marks.
20. I do not intend to summarise the parties' evidence or submissions in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

² It is noted that the witness statement was originally filed on 21 December 2022. This evidence required amending, hence the reference to a date that post-dates the correspondence of the Tribunal discussed in this paragraph.

PRELIMINARY ISSUES

Dragonfly's position regarding common use of 'THIS GIRL'

21. In both counterstatements, Dragonfly made reference to the existence of other trade marks on the UK trade mark register that include the words 'THIS GIRL'. In support of this point, Dragonfly argues that a number of the marks referred to existed before ESD registered its own marks. Further, Dragonfly argues that the existence and approval of these marks sets a precedent that the UK IPO accepts multiple parties registering marks using these words. In addition to the marks referred to by Dragonfly in its counterstatements, Dragonfly has provided evidence that shows marks on the trade mark register and on various printouts taken from the internet.³ In its evidence, Dragonfly argues that it is reasonable to draw the conclusion that the words 'THIS GIRL' are so widely used and in so many different contexts that they form a generic term. This argument indicates to me that Dragonfly's position is that ESD's marks are of a weak distinctive character.

22. While Dragonfly's evidence on this point is noted, I am of the view that it is of no assistance in the present case. This is because neither the register evidence before me or the print-outs of third party websites demonstrate any use of the marks in the marketplace. On this point, I refer to the findings of the General Court ("GC") in the case of *Zero Industry Srl v OHIM*, Case T-400/06, namely that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word

³ Exhibit C and D

‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71).”

23. While I accept that the evidence does point to products bearing the words ‘THIS GIRL’ on them, there is a significant amount of evidence that is either undated or from after the relevant date for both sets of proceedings (being the filing dates of Dragonfly’s marks). Such evidence cannot point to a weakening of the distinctive character of ‘THIS GIRL’ by the relevant dates. Even for those goods that were available prior to those dates, there is no evidence as to any levels of use in the UK in relation to the same (be that in the way of sales or website visits, for example). In short, I am of the view that the simple production of products via internet printouts is not sufficient to warrant a finding that the distinctiveness of the words ‘THIS GIRL’ has been weakened.

24. In addition to the above argument, Dragonfly submits that its fundamental point is that if ESD was genuinely concerned about protecting its marks, why have they allowed such a vast number of other uses. For the avoidance of doubt, this is not a relevant consideration that I must assess in this decision. My decision must be based on the factors set out in the relevant legislation and case law (which I will set out throughout this decision) and the decision by ESD to oppose or not oppose third party marks is not one of those factors.⁴

Inadmissible evidence

25. During the course of these proceedings, Dragonfly sought to file evidence in reply to ESD’s evidence in reply. This came in the form of the second witness statement of Charlie Southall dated 11 August 2023. As per ordinary Tribunal procedure, the

⁴ On this point, I note that ESD, in evidence in reply, filed evidence of discussions between ESD and its legal representative regarding decisions not to oppose certain marks applied for. While noted, this is also of no assistance here.

filing of such evidence by an applicant/proprietor in opposition/invalidation proceedings is not permitted.⁵ On this point, I note that the timetable for evidence rounds in the present case was set out in correspondence from the Tribunal dated 25 August 2023. Further, the position regarding the Tribunal's procedure was set out via an email from the Tribunal to Dragonfly on 13 October 2023. As a result, I will give no consideration to the second witness statement of Charlie Southall as it does not form part of these proceedings.

MY APPROACH

26. While Dragonfly's marks are identical to one another, the proceedings brought by ESD are targeted at different trade mark registrations. Therefore, neither the invalidation application or the opposition have any bearing on one another. As such, it is of no consequence as to which set of proceedings I begin with. Simply because it was brought at an earlier date than the invalidation application, I will consider the opposition first.

DECISION

Section 5(2)(b): legislation and case law

27. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

⁵ I appreciate that parties have the opportunity to formally file additional evidence outside of ordinary evidence rounds but this has not been the case here.

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark.”

28. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

29. ESD’s marks qualify as “earlier trade marks” for the purposes of this decision since they were applied for at an earlier date than the filing date of the opposed mark.⁶ ESD’s first mark had completed its registration process more than five years prior to the filing date for the opposed mark. It was, therefore, open for Dragonfly to request proof of use of the same. However, it did not elect to request proof of use meaning that ESD may proceed to rely on all of the goods and services of its first mark that it highlighted in its notice of opposition. As for ESD’s second mark, this did not complete its registration process more than five years before the filing date of the opposed mark so it is not subject to the proof of use provisions set out in section 6A of the Act. Therefore, ESD may also rely on all of the goods and services highlighted in the notice of opposition regarding its second mark.

30. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

⁶ See Section 6(1)(a) of the Act.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

31. Dragonfly's goods and services are reproduced at paragraph two of this decision whereas ESD's goods and services are reproduced at Annex 1.

32. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

33. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

34. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

35. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

36. For the purpose of this assessment, I will refer to the opposed mark's specification simply as Dragonfly's specification. In respect of the parties' submissions, I note that both have made comment in relation to the similarity/identity (or lack thereof) of the same. I have given these due consideration and will discuss them further below where necessary.

Classes 4 and 5

37. I will deal with these classes of goods together because ESD's submissions regarding them are the same, namely that they are complementary to ESD's services in class 41 that relate to sport or healthy living. As such, I will compare "lubricants" in class 4 and "vaginal lubricants", "personal lubricants", "hygienic lubricants", "personal sexual lubricants", "lubricants for medical use", "silicone-based personal lubricants", "water-based personal lubricants", "lubricating agents for medical use", "lubricant gels for personal use" and "sexual stimulant gels" in class 5 of Dragonfly's specification with ESD's class 41 services. In support of its argument, ESD refers to Mr Hollingsworth's evidence at paragraph 8 to 12. While this evidence is noted, it relates to menstruation (and goods such as sanitary towels and tampons, which are not at issue here)⁷ and I fail to see how it relates to the use of Dragonfly's lubricant goods in classes 4 or 5.⁸ In addition to this point, I note that reference is also made to the comments of Charlie Southall in their second witness statement. However, this evidence has been deemed inadmissible so forms no part of these proceedings. In considering the necessary factors, I am of the view that the goods and services clearly differ in nature, method of use and purpose. The goods and services are not complementary in the way described by the case law and neither are they competitive. As for trade channels, I have nothing to suggest that it is common in the trade for a producer of lubricant, for example, to offer the class 41 services of ESD. Lastly, I appreciate that there may be some overlap in user, this is likely to be at too high a level and is not enough to warrant

⁷ See pages 12 to 17 of TH2

⁸ I appreciate that these submissions also make reference to the menstrual goods of Dragonfly in class 10, which I will deal with separately below.

a finding of similarity between the parties' goods and services. They are, therefore, dissimilar.

Class 10

38. "Menstrual cups" in Dragonfly's specification are subject to the same evidence I have discussed in the preceding paragraph. The evidence goes over the connection between women's health, sport and exercise and makes reference to articles written by various undertakings such as ESD itself⁹ (which has been covered by publications such as the Guardian and the Independent)¹⁰. Further, the evidence discusses sportswear brands such as Adidas and Modibodi that have produced sportswear that incorporates menstrual hygiene elements.¹¹ I note that these products appear to be referred to as 'period proof' clothing. In addition, there is reference to Nike producing an app called 'Nike Sync' that allows a user to monitor their menstrual cycle.¹² This evidence is noted and I appreciate that there is some connection between menstruation and women's health in sports, however, I fail to see how this evidence points to an overlap in trade channels between sportswear manufacturers or providers of class 41 services and producers of menstrual cups. For example, I have nothing to suggest that the aforementioned producers of 'period proof' clothing (or menstrual cycle tracking apps, for that matter) also produce and sell menstrual cups and neither is there anything to lead me to conclude that they are goods that will share similar distribution channels. As such, I consider these to be no overlap in trade channels between such goods and services. As for the remaining factors, plainly, menstrual cups, clothing and class 41 services are all of different natures and have different methods of use. As for purpose, the class 10 goods of Dragonfly are clearly different to the purpose of the class 41 services of ESD. I appreciate that the evidence shows some items of sportswear that are 'period proof', these are not the same as menstrual cups and, plainly, the core purpose of those goods differ from Dragonfly's menstrual cups. Further, I do not consider that a user would seek to select 'period proof' clothing

⁹ Pages 2 and 3 of TH1

¹⁰ See pages 4 to 7 of TH1

¹¹ See pages 2 to 5 TH2

¹² See pages 6 and 7 of TH2

over menstrual goods or vice versa meaning that they share no competitive relationship. As for user, there may be some overlap at a very high level on the basis that the goods and services discussed here may all be sought by members of the general public at large. However, this is not sufficient to warrant a finding that these goods and services are similar to any degree. As a result, I consider them to be dissimilar.

39. “Condoms” in Dragonfly’s specification is a term that is also subject to evidence of ESD. This evidence points to a multinational consumer goods company, being Reckitt Benckiser Group PLC, being appointed as the official intimate wellness provider of the Birmingham 2022 Commonwealth games. The evidence sets out that this company distributed 100,000 condoms to athletes throughout the games.¹³ Firstly, this evidence comes from after the relevant date for the present opposition (being the filing date of the opposed mark, 23 August 2021) and, secondly, even ignoring this issue, I fail to see how this points to a sufficient overlap between “condoms” and any of the goods and services of ESD. If the fact that one large multinational consumer company provided free condoms to athletes is sufficient to warrant an overlap between any consumer goods products and condoms, this would offer far too broad a scope of protection for any and all marks which are protected for consumer goods. This plainly cannot be the case. Therefore, I dismiss ESD’s position and find that while “condoms” and ESD’s goods and services may share users, this is where any overlap ends. In short, I find that “condoms” and the goods and services of ESD differ in nature, method of use, purpose and trade channels. Lastly, there is no reason to find that the goods and services are complementary or competitive in nature. As a result, “condoms” are dissimilar to all of ESD’s goods and services.

40. Given the findings I have made above in respect of Dragonfly’s class 10 goods, it should come as no surprise that, following similar reasons to those discussed above, I find that “sexual activity devices”, “sexual activity apparatus, devices and

¹³ See pages 8 to 11 of TH2

articles”, “massage apparatus” and “vibration generating apparatus for massage” are all dissimilar to the goods and services of ESD.

Class 25

41. “Clothing” appears in Dragonfly’s specification and both of ESD’s marks’ specifications. These goods are plainly identical.

42. As above, ESD’s marks are both protected for “clothing” at large. Given that Dragonfly’s class 25 goods, namely “underwear”, “women's underwear”, “underwear for women”, “clothing”, “footwear”, “lingerie”, “body stockings”, “bodies [underclothing]”, “stocking suspenders”, “nightwear” and “fancy dress costumes” are all types of clothing, I find that they are identical under the principle outlined in *Meric* with “clothing” in ESD’s specifications.

Class 41

43. “Education” and “entertainment” appear in both parties’ marks and are, therefore, self-evidently identical. “Providing of training” in Dragonfly’s specification has a counterpart in ESD’s marks being “provision of training”. Despite the difference in wording used, they are still self-evidently identical terms.

44. “Provision of entertainment via podcast” and “entertainment in the nature of fashion shows” in Dragonfly’s specification are both forms of entertainment. I am of the view that they are terms that are encompassed by “entertainment” in ESD’s marks’ specification. As such, I find that these services are identical under the principles outlined in *Meric*.

45. “Arranging of cultural events”, “conducting of educational events”, “arranging of educational events”, “conducting of cultural events”, “organisation of [...] cultural events” and “arranging and conducting of educational events” in Dragonfly’s specification are, despite their wording, all organisational services for events with cultural or educational purposes. As a result, I find that they are all encompassed

by the term “organisation of exhibitions for cultural or educational purposes”, which appears in both of ESD’s marks’ specifications. Therefore, I find that these services are identical under the principle outlined in *Meric*.

46. The actual conducting and arranging of entertainment events is not, in my view, an actual entertainment service as its aim is not to provide entertainment but to provide conducting/arranging services. As such, I do not consider that the below goods of Dragonfly can be said to be identical under the principle outlined in *Meric* with “entertainment” in ESD’s specifications.

“Conducting of entertainment events; Conducting of live entertainment events; Arranging and conducting of entertainment events; Arranging and conducting of live entertainment events; Organisation of entertainment events; Conducting of entertainment activities; Organisation of entertainment [...]; Presentation of live entertainment events; Party planning; Party planning [entertainment]”

That being said, I do consider that the above services are similar to ESD’s term of “organisation of competitions”, which appears in both of its marks’ specifications. I say this because the services overlap in nature as they all pertain to the organisation of an event. The services also overlap in method of use as they will be sought in the same way. The purposes of the event being organised may differ (though I do appreciate that some competition events may have entertaining qualities), but there is some overlap in that actual services themselves as they all aim to put on an event for the user. As for trade channels, I appreciate that the provider of the organisation of entertainment events may not necessarily organise educational or cultural events. Further, the user is unlikely to overlap either as I do not consider it common for those looking to have an undertaking arrange an entertainment event to also seek the same service for competition purposes. Lastly, the services are unlikely to share a complementary or competitive relationship. That being said, I consider that the aforementioned overlaps in nature, method of use and purpose are sufficient to give rise to a finding that these services are similar to a medium degree.

Conclusion of the goods and services comparison

47. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, this means that the opposition under section 5(2)(b) aimed against the following goods of Dragonfly will fail:¹⁴

Class 4: Lubricants.

Class 5: Vaginal lubricants; Personal lubricants; Hygienic lubricants; Personal sexual lubricants; Lubricants for medical use; Silicone-based personal lubricants; Water-based personal lubricants; Lubricating agents for medical use; Lubricant gels for personal use; Sexual stimulant gels.

Class 10: Sexual activity devices; Sexual activity apparatus, devices and articles; Massage apparatus; Vibration generating apparatus for massage; Condoms; Menstrual cups.

The average consumer and the nature of the purchasing act

48. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

¹⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

49.ESD’s position is that the average consumer for the goods and services at issue will be both members of the general public and business users. I agree. Plainly, clothing goods will be sought by members of the general public whereas the organisational services at issue are those that will be sought by business users.

50.The goods will be available via general retailers and their online equivalents. In physical stores, the goods will be available on shelves or racks where they will be self-selected by the consumer after a visual inspection. For online websites, the goods will be selected after consideration of images on webpages. As a result, I find that the selection process for the goods at issue will dominate, though I do not discount an aural component playing a role by way of advice from sales assistants or word of mouth recommendations. The goods at issue are ordinary consumer goods and will, therefore, be selected relatively frequently. In terms of cost, this will vary from cheap goods such as socks to more expensive clothing items such as designer leather jackets, for example. Regardless of the price paid, consumers will give consideration to ordinary factors such as fit, style and materials used. In my view, the level of attention paid will be mostly medium although I do appreciate that this may be lower for more casual purchases such as socks, for example.

51.As for the services at issue, these are likely to be available directly from the providers themselves. The services will be listed on placards, leaflets or on lists shown on webpages. While the selection process will be mainly visual (though not outright discounting an aural component) for the more general education or entertainment services, I consider that the aural component will play an equal role for the organisational services. I say this because such services will be selected after detailed discussions with sales assistants. Given the broad nature of the services, they can cover provision of cinema services which can be relatively frequent and inexpensive purchases that will be selected after relatively ordinary

considerations such as selection of films, times of showings, comfort and concession options. However, some services can cover infrequently selected and expensive services such as the organisation of large sporting events. Such services will attract relatively complex considerations such as testimonials from previous users, information in relation to transport options, health and safety records and information as to the capacity of the events that can be organised. So while some services will be selected with a medium degree of attention, some may be relatively high.

Comparison of the marks


52. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

53. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

54. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

55. The respective trade marks are shown below:

ESD's marks	The opposed mark
<p data-bbox="379 421 655 510">THIS GIRL CAN ("ESD's first mark")</p>  <p data-bbox="355 831 683 864">("ESD's second mark")</p>	<p data-bbox="986 622 1203 656">This Girl Came</p>

56. I have comments from both parties in respect of the similarity of the marks at issue. While these have been considered and are noted, I do not intend to reproduce them here.

Overall Impression

57. The opposed mark is a word only mark consisting of the words 'This Girl Came'. As I consider these words form a unit, they can all be said to play an equal role in the overall impression of the mark. As for ESD's first mark, I consider that the same finding will apply in that the overall impression will lie equally in the words 'THIS GIRL CAN' as a unit. Turning now to ESD's second mark, this is a figurative mark that features the words 'THIS GIRL CAN' displayed in descending order. These words are surrounded by a square black border. Despite being displayed on different lines, as was the case with the other marks in this assessment, the words form a unit. In terms of overall impression, it is the word element that dominates with the get up of the mark and the border element playing a negligible role. I say this because both form banal stylistic elements that are likely to be overlooked by consumers.

Visual Comparison

58. The opposed mark and ESD's first mark are both word only marks and while one is presented in title case and the other in upper case, this is not a point of visual difference between them. I say this because a word only mark is protected for use in either upper case, lower case or any customary combination of the two. In terms of visual similarity, the marks share their first two words, being 'THIS GIRL'. The third word of each mark differs but, even then, they share the first two letters, being 'C-A'. The only points of difference between these marks come at their very ends, with the letter 'N' in ESD's first mark and the letters 'M-E' in the opposed mark. Given the identity of the first two words and first two letters of the last words, I find that the marks are visually similar to a high degree.

59. The opposed mark and ESD's second mark share the same similarities and differences as discussed above. I appreciate that ESD's second mark includes additional stylistic elements, however, I have found these elements to play a negligible role in ESD's second mark. They are, of course, points of visual difference but, in my view, they are not sufficient enough to result in a finding of any lesser degree of similarity to that which I have made above. As such, I find that these marks too are visually similar to a high degree.

Aural Comparison

60. The only aural element in ESD's marks is the words 'THIS GIRL CAN'. This is just three syllables in length and will be pronounced the ordinary way. The opposed mark is 'THIS GIRL CAME' which is also three syllables in length and will be pronounced the ordinary way. The first two syllables of the parties' marks are identical; however, their last syllables differ entirely. On this point, I appreciate that the final syllables in both parties' marks begin with the same letters, being 'C-A', they will be pronounced differently (with 'CAME' having a long 'A' sound and 'CAN' having a short 'A' sound). Aurally, at just three syllables in length, I consider the parties' marks to be short marks. On this point, I remind myself that while there is

no special test which applies to the comparison of 'short' marks,¹⁵ I am of the view that in the present case, the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Taking into account the identical beginnings, different endings and length of the marks, I find that the marks are aurally similar to between a medium and high degree.

Conceptual Comparison

61. As was the case with the aural comparison, I can deal with ESD's marks together. When confronted with ESD's marks, I consider that consumers will view 'THIS GIRL CAN' as a phrase that possesses a unitary meaning. While I appreciate that it is not entirely clear what it is that 'this girl' can do, it is likely to be understood as a message of inspiration or motivation that 'this girl can do anything'. As for the opposed mark, this will also carry a unitary meaning. Depending on the consumer viewing the opposed mark, I consider that the opposed mark will carry different meanings. I say this because in the simplest sense, some consumers will view 'THIS GIRL CAME' as a statement that 'this girl' has arrived. Alternatively, there are other consumers that will understand 'CAME' as slang for a past-tense reference to reaching sexual climax.¹⁶ As a result, I find that these consumers will view the mark as a whole as a statement that 'this girl' has just reached sexual climax. For the avoidance of doubt, I consider that both sets of consumers form a significant proportion of average consumers.

62. Regardless of which message is identified in the opposed mark, the statements conveyed by both parties' marks share a reference to 'this girl'. Both parties' marks are, therefore, messages aimed at or about females. While this is noted, I do not consider that this alone necessarily means that the marks are conceptually similar. I say this because despite being messages aimed at females, the actual messages conveyed by the parties' marks differ. On one hand, there is an inspirational/motivational message about a female 'being able to do anything' but,

¹⁵ See paragraph 44 of *BOSCO*, BL O/301/20

¹⁶ While I appreciate that the term 'CAME' may have originally been in reference to a male's climax, it is my understanding that it is also commonly used in reference to a female's climax also.

on the other, there is either a factual statement regarding an arrival or a sexual statement regarding an orgasm. Taking this into account, I am of the view that the marks are conceptually dissimilar.

Distinctive character of ESD's marks

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

64. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up to those with high inherent distinctive character, such as invented words which have no allusive

qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In the present case, ESD has not expressly pleaded that its marks enjoy an enhanced degree of distinctive character in its notice of opposition (though it did submit as such in its written submissions in lieu). Having said that, ESD has filed evidence of use. In proceedings before the Tribunal, it is not necessary for a party to plead enhanced distinctiveness in order for it to be considered. As such, I will consider the evidence in support of such a position. Before doing so, however, I will consider the inherent position.

65. I have discussed above that 'THIS GIRL CAN' conveys an inspirational/motivational message. Such a message is not particularly remarkable from a trade mark perspective, especially on clothing goods (being the goods at issue here) as it will be seen as a statement that relates to the wearer of said clothing. In my view, such a message sits somewhere towards the lower end of the scale of inherent distinctiveness, but not outright low. On balance, I consider ESD's marks to enjoy between a low and medium degree of inherent distinctiveness. I make this finding in relation to both marks on the basis that the stylisation elements in ESD's second mark are banal and do nothing to contribute to the overall distinctive character of the mark beyond that which is created by the unitary phrase.

66. I turn now to consider the position regarding any potential enhanced distinctiveness of ESD's marks through use. The evidence suggests that the THIS GIRL CAN campaign was launched on 31 October 2014, with the first paid media promotions of the same broadcasting on 12 January 2015. The evidence sets out that the aim of the campaign is to encourage all women and girls to regularly participate in sport and physical activity regardless of their age, body shape or abilities. In terms of funding, the evidence confirms that ESD obtained over £17 million of National Lottery Funding between January 2015 and November 2021.

67. A breakdown of how the funding was spent is provided and I note that during 2019/2020 (seemingly the financial year running from 1 May 2019 to 31 April 2020), £3.2 million was spent on digital advertising and, in 2020/2021, this figure stood at £4.6 million. An additional £0.2 million was spent on media planning for 2019/2020

and £0.1 million was spent on the same over 2020/2021. ESD has provided printouts showing the campaign and I note that these span from 14 October 2014 to 18 April 2021.¹⁷ In addition to this, evidence of video campaigns is shown by way of screenshots taken from various YouTube video pages.¹⁸ The printouts themselves are not dated and while the posting dates for some videos are prior to the relevant date, some are from after. I note that the viewership figures are not overly significant and given the lack of printout dates, it is not possible to determine how many views these videos actually had at the relevant date. I also note that some of these videos are crossover videos, such as a video seemingly from Disney Junior which shows co-branding of Disney and THIS GIRL CAN on an instruction *Moana* dance video. This video has 1.1 million views and, as above, some of these may have come after the relevant date. It is, therefore, not possible to determine an accurate relevant figure.

68. In addition to the above mentioned videos, there are videos regarding crossovers with third party brands such as Sure body spray and the Strava running app. The former video is from prior to the relevant date but only shows 9,241 views. As for the latter, this has no posting date and shows no viewership figures.

69. In terms of website visits, the evidence sets out that between 1 January 2015 and 17 February 2022 (being after the relevant date), the THIS GIRL CAN website attracted 3,334,020 unique visitors. The evidence goes on to state that 67% of these users were UK based, meaning that the UK visitor figures for this time stood at over 2.2 million people. While some of these visits will have come after the relevant date, the proximity of the relevant date to 17 February 2022 (being around six months) suggests that the majority of the figures would still be relevant.

70. The evidence goes on to discuss press coverage for the THIS GIRL CAN campaign. Copies of ten articles are provided in evidence and while I do not intend to discuss these in full,¹⁹ I note that eight of them are from prior to the relevant

¹⁷ AD2

¹⁸ AD3

¹⁹ AD4

date and are from publications such as the Huffington Post, Sky Sports, The Telegraph, BBC Sport, The Guardian and STYLIST. The narrative evidence claims that they are publications that have a widespread UK audience. While I have no readership figures for these articles, I am inclined to agree with ESD and accept that they are large publications that will inevitably attract a significant level of readers.

71. Social media evidence is then discussed and I note that printouts are provided of various accounts for both 'officialsportengland' (or, simply, Sport England) and THIS GIRL CAN.²⁰ In respect of the Sport England accounts, they are not accounts that deal solely with the THIS GIRL CAN brand and, therefore, the follower figures are not reflective of an awareness of THIS GIRL CAN. On this point, the printouts are dated over one year after the relevant date meaning that even if the follower figures were relevant, it is not possible to determine the level of followers that existed as at the relevant date. I appreciate that some posts do show use of THIS GIRL CAN but I note that engagement with these posts is very limited. As for the THIS GIRL CAN accounts, I appreciate that the posts covered by the printouts show a higher level of engagement than those discussed above, however, they are still reflective of a low level of engagement.

72. While on the point of social media posts, I note that evidence is provided in relation to the top performing posts of the above mentioned accounts together with information regarding the engagement levels of these accounts.²¹ I do not intend to discuss each and every example but will briefly discuss the following:

- a. I note that the post from Facebook that achieved the highest level of reach is 57,729. The post shown is 10 October and while it does not specify the year, the narrative evidence confirms it as being 2019; and
- b. The 'THIS GIRL CAN' Instagram account seemingly had, by May 2021, a total of 412,037 impressions that year with an engagement rate per impression of 1.7%. The Facebook account, seemingly for that same period, had a total of

²⁰ AD5

²¹ AD6

818,402 impressions with an engagement rate for impression of 2.4%. As for the Twitter account, this had a total of 492,229 impressions with an engagement rate per impression of 1.3%. Lastly, the LinkedIn account had 14,228 impressions with an engagement rate per impression of 5%.

73. The above evidence is noted and I appreciate that the people reached and impression figures are not insignificant. That being said, the engagement rate for the accounts seems relatively low and, on this point, I have no evidence before me to suggest what is meant by the statistics provided. For example, it is not clear whether the figures provided for 'people reached' or 'impressions' are reflective of the amount of users who actually considered the posts or whether such statistics include the amount of times the posts simply appeared on a user's timeline but not necessarily reflective of any actual consideration of the same by said user.

74. The evidence turns to the issue of sponsorships and I note that, in 2020, THIS GIRL CAN sponsored a park run on International Woman's Day.²² The evidence sets out that 70,000 women took part in the event. In addition, this evidence discusses a fitness class called 'Noire Fit Fest 2021' which appears to also be sponsored by 'THIS GIRL CAN'. Unlike the park run event, there is no reference to how many attended this event. Lastly, there is reference to a Strava event but this is from May 2022 and, therefore, after the relevant date.

75. In terms of the provision of services regarding research, education and training, the evidence makes reference to guidance provided by ESD in conjunction with ukactive.²³ This guidance appears to have been published in November 2021, being after the relevant date. Even ignoring this issue, there is nothing to suggest its readership figures amongst the UK public. I note that there is further evidence in respect of this report that shows the findings being promoted and reported upon but, as above, the guidance was published after the relevant date and the lack of readership figures renders such evidence of no assistance.

²² AD7. It is noted that this evidence also covers an event from 2022 which is after the relevant date.

²³ Page 2 of AD9

76. The narrative evidence goes on to discuss a range of training courses, course materials and promotional posters, images of which are provided.²⁴ There is no indication as to when these materials were produced and while the narrative evidence sets out that, as at the date of the witness statement, they were provided to 571 instructors and leisure operators, this does not reflect the position as at the relevant date. Without anything sufficiently solid to demonstrate the reach of these materials prior to that date, I do not consider it reasonable to infer that they were in circulation at that time.

77. The evidence then reverts back to discussions regarding THIS GIRL CAN's collaborations with Disney and Sure.²⁵ Such evidence comes in the form of printouts of social media posts and YouTube videos. While noted, I fail to see what this evidence adds above and beyond that was already shown in the evidence discussed above.

78. A further partnership is discussed between THIS GIRL CAN and Bristol City Council in March 2021.²⁶ This evidence includes a printout from bristolgirlscan.co.uk and a printout of a Facebook account for 'Bristol Girls Can'. While the evidence shows ESD's branding, there is nothing to suggest the level of engagements with these posts at the relevant date or any engagement in the actual program/partnership itself. On a similar note, the evidence also discusses support from the University of Manchester.²⁷ Again, this is noted but nothing is provided in evidence that shows the level of engagement as at the relevant date for the websites/social media accounts provided.

79. This same evidence discusses another partnership, this time with clothing brand, Regatta Great Outdoors.²⁸ This evidence is dated May 2022 so is, therefore, after the relevant date. Lastly, there is repeated reference to the Strava partnership that,

²⁴ Pages 5 to 6 of AD9

²⁵ Pages 2 to 6 of AD9

²⁶ See pages 7 to 9 of AD9

²⁷ See pages 10 and 11 of AD9

²⁸ See page 12 of AD9

as was the case with the other Strava evidence provided, is from after the relevant date so is of no assistance.²⁹

80. For the first time, the evidence attempts to discuss the actual provision of goods under the THIS GIRL CAN branding. The evidence sets out that in January 2016, THIS GIRL CAN produced a range of clothing with Marks and Spencer that was sold in 32 different stores. The collection covered nine pieces of clothing including hoodies, t-shirts, vest tops, leggings, sports bras, socks and a bag. The narrative evidence then jumps to discuss the sale of approximately 3,000 t-shirts bearing the THIS GIRL CAN branding in September 2015 that sold out within a month. The evidence shows images of the various clothing goods provided.³⁰ Given the fact that the collaboration with Marks and Spencer appears to have been in January 2016, it is not clear to me whether the reference to clothing sold in September 2015 is a typographical error meant to read September 2016 or if it is in relation to a different collaboration or to goods produced and sold independently by ESD. If the latter, this means that there is very little information as to the level of sales achieved from the Marks and Spencer collaboration and, further, there is very little information regarding that run of sales in September 2015.

81. In respect of clothing, the evidence discusses the provision of clothing given to instructors who teach the THIS GIRL CAN fitness classes. The range of clothing includes a hoodie, t-shirt and vest top. An image of two t-shirts provided under this scheme is in evidence.³¹ While noted, there is no evidence as to how many of these items were given out or what was given out. Secondly, this does not appear to be the actual provision of goods to consumers in the marketplace but is, instead, provision of some form of uniform for instructors to wear when teaching classes. While such evidence may be of assistance in determining the fact that ESD did offer teaching classes, I repeat the fact that this evidence is undated.

²⁹ See pages 13 to 17 of AD9

³⁰ Page 2 of AD10

³¹ Page 3 of AD10

82. Again, the evidence goes into the partnership with Strava and the provision of clothing in relation to the same. As has been the case throughout the evidence, this partnership took place in 2022 and is, therefore, from after the relevant date so is of no assistance.

83. Finally, the evidence discusses an independent evaluation agency report of over 1,000 women and girls. This is referred to as the Walnut Report and a screenshot from this report from November 2021 is provided in evidence.³² The report surveyed women and girls in England aged between 14 and 60. The screenshot shows 18 different percentages on various dates between November 2014 and November 2021 which reflect the percentage of girls/women (of the 1,000 asked) whether they were aware of the THIS GIRL CAN campaign. The numbers range from 2% in November 2014 (understandable given the proximity to the launch of the actual campaign itself) to 48% in August 2021. For the most part, of the 18 different entries provided, the figures remain mostly in the 40s (with some prior to 2017 being in the 30s). The narrative evidence references other statistics from this report but these are not supported in the evidence and do not add anything beyond the actual level of awareness amongst the public surveyed. Another report is mentioned but this took place in 2022 so is not reflective of the position as at the relevant date.

84. In addition to all of the above, while it does not appear that ESD's evidence in reply was adduced to demonstrate use, I do note that it does include some evidence that warrants mentioning here. This evidence came in the form of an article from The Drum from January 2020 wherein a marketer discusses how she keeps the five-year idea of 'THIS GIRL CAN' fresh.³³ While noted, there is nothing of any real substance that points to any actual level of use in the goods and services of ESD's marks. In addition, this evidence goes on to show some examples of ESD's campaign work in conjunction with FCB Inferno.³⁴ This evidence is undated but does make several references to 2020, therefore indicating that it is evidence from

³² AD11

³³ Pages 2 to 4 of TH5

³⁴ Pages 5 to 7 of TH5

prior to the relevant date. While these printouts make reference to a number of partnerships, some of them appear under the branding Sport England. The evidence that does relate to the 'THIS GIRL CAN' branding is (as is the case throughout the majority of ESD's evidence) rather vague in respect of actual goods and services provided, though I do appreciate that it does make reference to the Disney collaboration that I have discussed above. While noted, it does not offer anything further than what I have set out already in this evidential summary.

85. The above summary reflects the entirety of the evidence before me. I appreciate that the evidence demonstrates that ESD was actively promoting its THIS GIRL CAN campaign in the years leading up to the relevant date (and spent significant sums in doing so), that it obtained a level of press coverage by way of articles from various large publications and that it achieved favourable results in the Walnut Report in 2021 (though only as a result of a poll of 1,000 women/girls). While such evidence is demonstrative of a level of awareness amongst the relevant public as at the relevant date, I consider that the main issue facing ESD here is the lack of specific reference to goods and services provided. It is my view that all the evidence shows is that the awareness of the 'THIS GIRL CAN' branding relates to a campaign wherein ESD has made efforts to encourage girls and women to live a healthy and active lifestyle. In terms of actual goods and services being offered under the mark, there is some vague reference to training classes being offered.³⁵ However, there is nothing to suggest when these classes were offered, where they were offered or what was the level of attendance for the same.³⁶ I appreciate that ESD undertook a collaboration with Disney in releasing dance tutorial videos and while one video is shown as having over one million views, I repeat my issues with that evidence here, namely that the printouts providing such information are from after the relevant date so are not reflective of the level of viewership at that time.

86. The only sufficiently solid finding I am willing to make, based on the evidence, is that ESD did, for a very brief time, produce and sell clothing goods. While I have

³⁵ Such a service can be said to fall within the term of "education and training relating to sports and healthy living".

³⁶ On this point, I refer to the evidence discussed at paragraph 76 above wherein I mentioned the provision of t-shirts for instructors to wear. Such evidence is undated and does not attempt to demonstrate the popularity of such classes.

issues with the clarity of this evidence, I consider that the sale of 3,000 items of clothing in just one month is not reflective of a small level of use. However, this is the only evidence of sales before me and relates to a very limited run of clothing in 2015 or 2016, being some five or six years before the relevant date. As a result, I do not consider the sale of 3,000 items of clothing over just one month approximately five or six years before the relevant date to be particularly compelling in the circumstances.

87. Taking all of the above into account, I am not willing to find that the evidence before me is sufficient to demonstrate that the distinctiveness of ESD's marks has been enhanced through use. As a result, I consider that the inherent position applies, namely that the marks are inherently distinctive to between a low and medium degree.

Likelihood of confusion

88. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of ESD's marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he or she has retained in his or her mind.

89. Not counting those that I have found to be dissimilar, the parties' goods and services that remain at issue are identical or similar to a medium degree. I have found the average consumer for the goods and services to be members of the general public at large and business users. The selection process will be primarily visual, though I do not discount an aural component playing a role. For some services selected by the business user, however, I have found that the aural component will play an equal role to the visual one. I have concluded that during the selection of the goods and services at issue, the level of attention paid by the average consumer will be mostly medium though I do appreciate some goods may attract a lower degree but some services may attract a relatively high degree. In respect of the similarity of the marks at issue, I have found them to be visually similar to a high degree, aurally similar to between a medium and high degree and conceptually dissimilar. I have found that ESD's marks are inherently distinctive to between a low and medium high degree.

90. In respect of confusion, ESD submits that for those goods and services which are similar to those for which ESD enjoys a reputation, the average consumer has a "tendency to see what they expect to see" when they see a similar mark. On this point, ESD has referred to the case of *Kennedy Fried Chicken* (Case BL O/227/04). This submission is noted but I do not consider that it offers any assistance in the present case. Firstly, I have not found ESD's marks to enjoy a level of enhanced distinctiveness (the submissions in relation to a reputation are relevant for section 5(3) grounds only). Secondly, the differences in *Kennedy Fried Chicken* were subsumed into the body of two similar marks that had identical beginnings *and* ends. This is not the case here. While I appreciate that consumers do tend to focus on beginnings of marks,³⁷ this is not always the case.³⁸ In the present case, I am of the view that the different concepts created by the marks will mean that the ends will not be overlooked.³⁹

³⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

³⁸ *CureVac GmbH v OHIM*, T-80/08

³⁹ In the cited case of *Kennedy Fried Chicken*, I note that the Appointed Person stated at both paragraph 16 and 19 that the marks were conceptually similar. I have not found this to be the case here and even if it could be said that the message of 'THIS GIRL' did give rise to some conceptual similarity, it would not be sufficient to persuade me to agree with ESD's submissions.

91. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that regardless of the high level of visual similarity between the marks and the fact that the goods and some services will be selected via primarily visual means, the conceptual differences created by the different unitary meanings of the marks at issue are sufficient to enable average consumers to accurately recall and remember the marks. On this point, I refer to the case of *The Picasso Estate v OHIM*, Case C-361/04 P wherein the CJEU set out that conceptual differences between marks may counteract the visual and phonetic similarities between them, a principle I consider applies in the present case. Even if I was wrong in respect of conceptual dissimilarity and it could be said that the marks shared some form of conceptual hook on the basis that they are statements that are aimed at ‘this girl’, I am not convinced that this would overcome the differences created by their overall messages. Again, the contrasting overall messages are such that consumers would be enabled to sufficiently recall them. Consequently, I do not consider that there exists a likelihood of direct confusion, even on goods and services that are identical or even in circumstances where consumers pay a lower degree of attention. For the avoidance of doubt, I am of the view that such a finding would apply even if I were satisfied that the evidence filed by ESD was sufficient to warrant a finding of enhanced distinctiveness. I say this because, again, the conceptual messages created by the marks are distinct and overcome any visual or aural similarities regardless of the level of distinctiveness of the earlier marks.

92. For the sake of completeness, I turn now to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

93. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there

must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

94. In considering the present assessment, I note that ESD has not made any specific argument as to why it considers there exists a likelihood of indirect confusion between the marks at issue. While this is not fatal to a finding of indirect confusion, it does provide some difficulty for ESD. I say this because (as I will discuss in more detail below) I do not consider that the present case falls into any of the above categories set out in *L.A. Sugar*. I appreciate that these categories are not exhaustive, however, any argument as to alternative scenarios is something that ESD is required to put forward. Having not done so, I do not consider it appropriate for me to attempt to formulate ESD’s case on its behalf. Even if I were to do so, I do not consider that any alternative scenario exists.

95. In considering the categories as set out in *L.A. Sugar*, I consider, firstly, that the words ‘THIS GIRL’ in ESD’s marks are not so strikingly distinctive that consumers would believe that only one undertaking would use them. Secondly, the difference between the marks is not a simply non-distinctive addition. The difference is, instead, one that alters the conceptual message conveyed by the mark. Lastly, I see no logical basis for consumers to think that an undertaking using ‘THIS GIRL CAN’ would alter the last word of its mark to ‘CAME’. Such a change only serves to alter the concept of the mark and does not, in my view, appear to be a change that consumers would consider logical or consistent with a sub-brand or brand extension. Taking all of this into account and also bearing in mind the comments of Mr Mellor Q.C. and Arnold LJ that I have discussed at paragraph 93 above, I find that there exists no likelihood of indirect confusion between the marks. I consider that this finding applies even in respect of goods and services that are identical and in circumstances where goods are selected with a lower degree of attention.

96. As a result of the above, the opposition reliant upon the section 5(2)(b) ground has failed. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

97. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

98. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks

and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial

compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

99. The conditions of section 5(3) are cumulative. Firstly, ESD must show that the marks are similar. Secondly, ESD must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the opposed mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

100. I remind myself that ESD relies upon the same two marks under the present ground that it did under the section 5(2)(b) ground. However, under the present ground, ESD relies on a broader range of goods and services, being those set out in Annex 2 of this decision. I also note that ESD's second mark is a comparable mark based on an earlier IR designating the EU. This means that EU use prior to IP Completion Day (being 31 December 2020) is relevant to the issue of reputation. While that may be the case, the evidence before me relates to UK use only.

Reputation

101. In its counterstatement, Dragonfly denied that its mark was similar to 'an earlier mark with a reputation'. It went on to state that it did not consider that ESD's reputation superseded any other use of the words 'This Girl' in culture. Further,

Dragonfly's evidence, at paragraph 8, set out its denial that its mark took unfair advantage of ESD's or that it was detrimental to the reputation of ESD's marks. Neither the counterstatement, evidence or submissions deny the existence of a reputation. Lastly, at paragraph 17 of its evidence, Dragonfly states that the evidence seems to suggest that ESD's evidence pointed to a reputation for the words 'This Girl'. To me, the way in which Dragonfly has defended this case suggests that it does not dispute the fact that ESD enjoys a reputation. That being said, it does not indicate what goods/services it considers the reputation lies in and neither does it suggest the strength of said reputation. I will, therefore, make my own assessment on this point.

102. I have summarised the evidence of ESD at paragraphs 66 to 87 above. That summary reflects the entirety of ESD's evidence (insofar as it relates to use) and while I do not intend to reproduce the evidence here, I remind myself of the main issue I have with the evidence, namely that it shows little by way of the provision of actual goods and services. That being said, given the above concession, I consider it necessary to find at least some goods and services in ESD's specification that I can point to in order to show that a reputation exists.⁴⁰

103. It appears to me that the main function of the THIS GIRL CAN brand is to encourage and promote healthy living/active lifestyles to women and girls in the UK. The evidence shows example of sponsorship activities in relation to a park run in 2020 that was attended by 70,000 people. This could be said to be the service of "obtaining, arranging and provision of financial sponsorship in sports". Further, the evidence shows that THIS GIRL CAN co-sponsored a number of dance tutorial videos with Disney, one of which is shown as being viewed over one million times (albeit the printout date confirming this figure is from after the relevant date). This could be said to be a service that falls within the category of "entertainment relating to sports and healthy living". I also remind myself that there is evidence showing the provision of clothing for sale in Marks and Spencer. While only very limited in

⁴⁰ I appreciate that I have found no enhanced distinctiveness in ESD's marks, however, the concession of Dragonfly does not speak to the issue of enhanced distinctiveness meaning that my evidential evaluation of the evidence on that point being insufficient remains.

time (one month worth of sales in 2015 or 2016), it does show the sale of 3,000 items of clothing. These goods would, plainly, fall within the category of “clothing”. Ordinarily, I would consider the evidence of sponsorship and dance tutorial videos to be vague and imprecise with the clothing evidence very limited in scope with any reputation vesting in the brand in 2015 likely to have dissipated by the relevant date in 2021. Having said that, Dragonfly’s concession is such that I must find there to be some reputation and, in my view, the above goods and services represent ESD’s best case scenario. Therefore, I consider that ESD’s marks have a reputation in the following goods and services (being either the terms as registered or reasonable sub-categories of the same based on the evidence before me):

Class 25: Women’s clothing.

Class 36: Obtaining, arranging and provision of financial sponsorship in sports.

Class 41: Entertainment relating to healthy living, namely dance exercise videos.

104. In terms of the strength of this reputation, it should come as no surprise that, based on my issues with the evidence, any reputation is weak.

Link

105. As noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

106. I have found above that the marks at issue are visually similar to a high degree, aurally similar to between a medium and high degree and conceptually dissimilar.

While that assessment was made under the section 5(2)(b) ground, it is equally applicable here.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

107. While ESD's reputed goods in class 25 are limited to women's clothing, they remain identical (based on the principle outlined in *Meric*) to the clothing goods in class 25 of Dragonfly's specification. As for the remaining goods in Dragonfly's specification, I find these to be dissimilar to any of the reputed goods or services of ESD. Having said that, the class 4, 5 and 10 goods of Dragonfly are, like clothing goods, ordinary consumer goods meaning that there is a degree of overlap between the relevant sections of the public that will select such goods.

108. As for Dragonfly's services, I find that the term "entertainment" in class 41 of its specification encompasses ESD's reputed services of "entertainment relating to healthy living, namely dance exercise videos". These services are, therefore, identical under the principle outlined in *Meric*. Dragonfly also seeks to register a range of educational services and while I consider these to be dissimilar to the reputed goods or services of ESD, there may be a degree of overlap in the relevant section of the public that selects such services. Lastly, I do not consider the organisational services of Dragonfly to be similar to any of the reputed goods and services and neither is there any obvious degree of overlap between the relevant section of the public that selects the goods and services.

109. To conclude, while some goods and services are identical, the majority of them are dissimilar. However, there is some degree of closeness between some goods and services in Dragonfly's specification on the basis that they will be selected by the same section of the relevant public as those who select ESD's reputed goods and services. While noted, the section of the relevant public that selects such goods and services is made up of members of the general public at large meaning that the degree of closeness between dissimilar goods is not overly compelling.

The strength of the earlier mark's reputation.

110. I have found the strength of ESD's reputation in its marks to be weak.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

111. Inherently, I have found ESD's marks to be distinctive to between a low and medium degree. I do not consider the evidence sufficient to give rise to a finding on enhanced distinctiveness but if I am wrong on this point, the evidence is such that it only enhances the position to a medium degree.⁴¹

Whether there is a likelihood of confusion

112. I have found there to be no likelihood of confusion under the section 5(2)(b) ground, even on identical goods.

Conclusions on link

113. The provisions of section 5(3) grounds offer additional protection which takes into account the repute and distinctiveness of the earlier marks. For example, some marks are so distinctive and well known that there is likely to be some confusion almost irrespective of the goods or services on which the marks are used. Therefore, while I have found there to be no confusion under the section 5(2)(b) ground, this does not mean that there cannot be a link. Having said that, in order to overcome such an issue, the reputation and distinctiveness of the earlier mark needs to be significant. This is clearly not the case here as I have found the level of reputation enjoyed by ESD is weak and the distinctiveness of its marks is, at best, medium. In short, I see no reason why a consumer who is aware of ESD's

⁴¹ While enhanced distinctiveness and reputation are different assessments based on differing factors, I make the back-up finding here on the basis that Dragonfly has conceded a reputation which, under the present ground, could also be said to be concession as to enhanced distinctiveness.

weak reputation would, upon seeing Dragonfly's mark, bring to mind the earlier 'THIS GIRL CAN' marks, especially given the distinct conceptual message conveyed by the marks. Therefore, following similar reasons to those I have given when considering there to be no likelihood of confusion, I find that there would be no link between the marks at issue, even when viewed on identical goods and services. As there exists no link between the marks, there can be no damage meaning that ESD's section 5(3) ground must fail at this stage.

Final remarks regarding the opposition

114. The opposition has failed in its entirety and I will now proceed to consider the invalidity application.

The invalidity application

115. Sections 5(2)(b) and 5(3) of the Act all have application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

"47. –

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) [...]

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

116. I remind myself that ESD relies upon the same earlier marks here that it did under the opposition above. Those marks remain earlier marks for the purpose of these proceedings as they both have filing dates earlier than the filing date of the contested mark. ESD relies on different goods and services under its 5(2)(b) ground (being those listed in Annex 3) but relies on the same goods and services

under its 5(3) ground as it did under the section 5(3) ground in the opposition above.

Section 5(2)(b)

117. The legislation and case law governing the present ground is reproduced at paragraphs 27 to 30 above.

Comparison of goods and services

118. The goods and services of the contested mark are reproduced at paragraph 9 above and the goods and services of ESD's marks are reproduced at Annex 3.

119. The case law reproduced at paragraphs 32 to 35 is equally relevant here.

120. The contested mark is registered for "sex toys" and "adult sexual aids". ESD's position is that these goods are similar to its own goods, being "toys, games, playthings" in class 28 and its service of "entertainment relating to sports and healthy living" in class 41. I will deal with the comparison against the class 28 goods first.

121. The Nice Classification in respect of class 28 goods sets out that they specifically exclude "sex toys and love dolls", which are proper to class 10. While this alone does not render the goods dissimilar, the goods clearly do not overlap in nature or method of use. Dragonfly's goods also have a very specific purpose, one that is not covered by ESD's class 28 goods. As for trade channels, I have nothing to suggest that a manufacturer of ordinary toys would venture into the sex toy market, or vice versa. Additionally, the goods will not be available via the same distribution channels. I see no reason why the goods would share a complementary or competitive relationship. Lastly, even if it could be said that someone who bought class 28 goods also bought the class 10 goods of Dragonfly, any overlap is insufficient to warrant a finding of similarity between the goods. They are, therefore, dissimilar.

122. As for the class 41 service of ESD, being “entertainment relating to sports and healthy living”, I see no reason to find why Dragonfly’s goods would be similar to these. The nature and method of use clearly differ. The purpose of Dragonfly’s goods are clearly for sexual reasons and not for entertainment in respect of sports or healthy living. I appreciate that the use of sex toys may promote a *healthy sex life* but this is not the plain meaning of the term ‘healthy living’ in the same way that is meant in ESD’s term. Further, I appreciate that it is a stretch to suggest as such but even if the purpose of Dragonfly’s goods can be said to be for ‘entertainment’ purposes, I do not consider the entertainment being provided is the same as the entertainment being provided by ESD’s service. In respect of trade channels, I do not consider that the provider of entertainment relating to sports and healthy living would also sell sex toys and aids and I have nothing to suggest otherwise. The goods and services are not complementary or competitive in nature and while some overlap in user may exist, this is not sufficient to warrant a finding of similarity.

123. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, this means that the invalidation application under section 5(2)(b) aimed against the contested mark fails.⁴²

Final remarks under section 5(2)(b) of the invalidation application

124. Even if there were some degree of similarity between Dragonfly’s goods and the goods and services of ESD, I am of the view that the same finding reached in the opposition in respect of confusion would apply equally here. I say this because even for identical goods and services under those proceedings, there was no confusion. Given that all other factors (in respect of the similarity of marks and distinctiveness) under the section 5(2)(b) ground of the invalidation application are equal to the opposition, the same outcome would be reached here.

⁴² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Section 5(3)

125. The legislation, case law and comments set out at paragraphs 97 to 99 above apply equally here.

126. As above, the marks relied upon under this ground are identical to those relied upon in the opposition, as too are the goods and services relied upon. I can, therefore, deal with this ground of the invalidity application swiftly. I say this because the same or very similar reasons to those already provided as paragraph 101 to 113 above in respect of the section 5(3) ground of the opposition are applicable here. Under that assessment I found that while there may exist a reputation, the evidence is only sufficient to find that it vests in only a limited number of goods and services and is weak in strength. As a result (and, again, following the same reasons as already set out above), I do not consider that there exists a link between the marks at issue. Without any link, there can be no damage and I, therefore, find that the section 5(3) ground of the invalidity application fails in its entirety.

Final remarks regarding the invalidation application

127. The invalidation application has failed in its entirety.

CONCLUSION

128. Both the opposition and the invalidation application brought by ESD have failed. As a result, the opposed mark may, subject to any successful appeal against my decision, proceed to registration for all goods and services. Further, the contested mark may, again, subject to any successful appeal against my decision, remain registered for all of the goods for which it is registered.

COSTS

129. As Dragonfly has successfully defended these proceedings, it would, in the ordinary course of these proceedings, be entitled to a contribution towards its costs. However, Dragonfly is unrepresented meaning that, in order to claim its costs, it was required to file a completed costs pro-forma. It did not do so. On this point, I note that a blank costs pro-forma was provided to Dragonfly under the cover of a letter from the Tribunal dated 13 October 2023. I also note that this letter set out that:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

130. No costs pro-forma was filed and neither did Dragonfly incur any official fees arising from this action. As such, I make no award and hereby order the parties to bear their own costs.

Dated this 20th day of June 2024

A COOPER

For the Registrar

ANNEX 1

ESD's first mark

Class 18

Leather and imitations of leather and articles made of these materials, namely belts, wallets, cases, briefcases, bags and purses; animal skins, hides; bags; luggage; sports bags; rucksacks; beach bags; handbags; briefcases; canvas bags; kitbags; satchels; shoulder bags; shopping bags; travelling bags; backpacks; haversacks; athletic bags; tote bags; knapsacks; toiletry cases sold empty; suitcases; garment bags for travelling; trunks for travelling; umbrellas; duffel bags; bootbags; holdalls; wallets; belts; purses; key cases; parasols and walking sticks.

Class 25

Clothing; footwear; headgear; articles of outer clothing; articles of sports clothing; leisurewear; shirts; boots; football boots and shoes; shorts; t-shirts; socks; pullovers; vests; skirts; dresses; overalls; bodysuits; warm-up suits; swimwear; ponchos; sweatshirts; sweaters; caps; hats; headwear; headbands; bandanas; scarves; jackets; wrist bands (sweat bands); track suits; ties; gloves; visors; waterproof clothing; belts.

Class 28

Toys, games, playthings; gymnastic and sporting articles; apparatus for ball games; balls for sports; nets for sports; sports whistles; apparatus for use in sports.

Class 41

Education; provision of training; entertainment; sporting and cultural activities; provision of information relating to sports, fitness, sporting activities, sporting events and sporting facilities; providing information relating to sports, fitness, sporting activities, sporting and cultural events and sporting facilities on-line from a computer database or the Internet; providing newsletters in the field of sport, volunteering and culture via e-mail; providing on-line non-downloadable publications; organisation of competitions; entertainment relating to sports and healthy living; education and training relating to sports and healthy living; education services relating to physical

fitness; exercise and fitness advisory and training services; instruction courses relating to sporting activities; provision of sports facilities; sport camp services; organisation of exhibitions for cultural or educational purposes; organisation and management of sporting activities, events, tournaments and competitions; rental of sports apparatus; management and supervision of sports and sports facilities; provision of training, coaching and instruction with regard to sports; organisation and management of leisure services; recreation and leisure centre services; arrangement, organisation and management of sporting events and competitions; provision of sports and games coaching; arranging and conducting of conferences, workshops and seminars in relation to sports, fitness and sporting activities; sports television programming services; publishing services including electronic publishing; certification services, namely operation of accreditation schemes and operation of accreditation schemes relating to sports and sporting events; information, advisory and consultancy services relating to all the aforesaid.

ESD's second mark

Class 18

Leather and imitations of leather and articles made of these materials, namely leather shoulder belts, wallets, cases, briefcases, bags and purses; animal skins, hides; bags; luggage; sports bags; rucksacks; beach bags; handbags; briefcases; canvas bags; kit bags; satchels; shoulder bags; shopping bags; travelling bags; backpacks; haversacks; athletic bags; tote bags; knapsacks; toiletry cases sold empty; suitcases; garment bags for travelling; trunks for travelling; umbrellas; duffel bags; boot bags; holdalls; wallets; purses; key cases; parasols and walking sticks.

Class 25

Clothing; footwear; headgear; articles of outer clothing; articles of sports clothing; leisurewear; shirts; boots; football boots and shoes; shorts; t-shirts; socks; pullovers; vests; skirts; dresses; overalls; bodysuits; warm-up suits; swimwear; ponchos; sweatshirts; sweaters; caps; hats; headwear; headbands; bandanas; scarves; jackets; wrist bands (sweat bands); track suits; ties; gloves; visors; waterproof clothing; belts.

Class 28

Toys, games, playthings; gymnastic and sporting articles; apparatus for ball games; balls for sports; nets for sports; apparatus for use in sports.

Class 41

Education; provision of training; entertainment; sporting and cultural activities; provision of information relating to sports, fitness, sporting activities, sporting events and sporting facilities; providing information relating to sports, fitness, sporting activities, sporting and cultural events and sporting facilities on-line from a computer database or the Internet; publication of non-downloadable newsletters in the field of sport, volunteering and culture; providing on-line non-downloadable publications; organisation of competitions; entertainment relating to sports and healthy living; education and training relating to sports and healthy living; education services relating to physical fitness; exercise and fitness advisory and training services; instruction courses relating to sporting activities; provision of sports facilities; sport camp services; organisation of exhibitions for cultural or educational purposes; organisation and management of sporting activities, events, tournaments and competitions; rental of sports apparatus; provision of sports facilities; provision of training, coaching and instruction with regard to sports; organisation and provision of leisure services; recreation and leisure centre services; arrangement, organisation and management of sporting events and competitions; provision of sports and games coaching; arranging and conducting of conferences, workshops and seminars in relation to sports, fitness and sporting activities; sports television programming services; publishing services including electronic publishing; certification services, namely operation of educational accreditation schemes and operation of accreditation schemes relating to sports and sporting events; information, advisory and consultancy services relating to all the aforesaid.

ANNEX 2

ESD's first mark

Class 25

Clothing; footwear; headgear; articles of outer clothing; articles of sports clothing; leisurewear; shirts; boots; football boots and shoes; shorts; t-shirts; socks; pullovers; vests; skirts; dresses; overalls; bodysuits; warm-up suits; swimwear; ponchos; sweatshirts; sweaters; caps; hats; headwear; headbands; bandanas; scarves; jackets; wrist bands (sweat bands); track suits; ties; gloves; visors; waterproof clothing; belts.

Class 35

Database management services; computerized database management services; management and compilation of computer databases; compilation, collection and systemisation of data and information into computer databases; overseeing and managing information issued via a computer database; advertising; marketing; promotional services; arranging of competitions for advertising purposes; business management, assistance and administration; organisation of exhibitions and trade fairs for commercial advertising; advertising and promotional services relating to cultural events, sport, exercise and health; preparation of publicity, promotional and marketing materials; business management of sport clubs; business management of sport venues; promotion of sports, fitness, sporting activities and sporting events; public relations services; providing an on-line directory of sporting activities and sporting facilities; Information, advisory, management and consultancy services relating to all the aforesaid.

Class 36

Financial services; monetary affairs; financial sponsorship; obtaining, arranging and provision of financial sponsorship in sports; management of sponsorship and sponsorship services; insurance services; information, advisory and consultancy services relating to all these services.

Class 41

Education; provision of training; entertainment; sporting and cultural activities; provision of information relating to sports, fitness, sporting activities, sporting events and sporting facilities; providing information relating to sports, fitness, sporting activities, sporting and cultural events and sporting facilities on-line from a computer database or the Internet; providing newsletters in the field of sport, volunteering and culture via e-mail; providing on-line non-downloadable publications; organisation of competitions; entertainment relating to sports and healthy living; education and training relating to sports and healthy living; education services relating to physical fitness; exercise and fitness advisory and training services; instruction courses relating to sporting activities; provision of sports facilities; sport camp services; organisation of exhibitions for cultural or educational purposes; organisation and management of sporting activities, events, tournaments and competitions; rental of sports apparatus; management and supervision of sports and sports facilities; provision of training, coaching and instruction with regard to sports; organisation and management of leisure services; recreation and leisure centre services; arrangement, organisation and management of sporting events and competitions; provision of sports and games coaching; arranging and conducting of conferences, workshops and seminars in relation to sports, fitness and sporting activities; sports television programming services; publishing services including electronic publishing; certification services, namely operation of accreditation schemes and operation of accreditation schemes relating to sports and sporting events; information, advisory and consultancy services relating to all the aforesaid.

ESD's second mark

Class 25

Clothing; footwear; headgear; articles of outer clothing; articles of sports clothing; leisurewear; shirts; boots; football boots and shoes; shorts; t-shirts; socks; pullovers; vests; skirts; dresses; overalls; bodysuits; warm-up suits; swimwear; ponchos; sweatshirts; sweaters; caps; hats; headwear; headbands; bandanas; scarves; jackets; wrist bands (sweat bands); track suits; ties; gloves; visors; waterproof clothing; belts.

Class 35

Database management services; computerized database management services; management and compilation of data into computer databases; compilation, collection and systemisation of data and information into computer databases; overseeing and managing information issued via a computer database; advertising; marketing; promotional services; arranging of competitions for advertising purposes; business management, assistance and administration; organisation of exhibitions and trade fairs for commercial advertising; advertising and promotional services relating to cultural events, sport, exercise and health; preparation of publicity, promotional and marketing materials; business management of sport clubs; business management of sport venues; promotion of sports, fitness, sporting activities and sporting events; public relations services; providing on-line commercial directory information services in the field of sporting activities and sporting facilities; sponsorship search; business management services related to sports and sports facilities; maintenance of computerized databases; Information, advisory, management and consultancy services relating to all the aforesaid.

Class 36

Financial services; monetary affairs; financial sponsorship; provision of financial sponsorship in sports; financial sponsorship services, fund raising and fund management services; insurance services; information, advisory and consultancy services relating to all these services.

Class 41

Education; provision of training; entertainment; sporting and cultural activities; provision of information relating to sports, fitness, sporting activities, sporting events and sporting facilities; providing information relating to sports, fitness, sporting activities, sporting and cultural events and sporting facilities on-line from a computer database or the Internet; publication of non-downloadable newsletters in the field of sport, volunteering and culture; providing on-line non-downloadable publications; organisation of competitions; entertainment relating to sports and healthy living; education and training relating to sports and healthy living; education services relating to physical fitness; exercise and fitness advisory and training services; instruction courses relating to sporting activities; provision of sports facilities; sport camp services;

organisation of exhibitions for cultural or educational purposes; organisation and management of sporting activities, events, tournaments and competitions; rental of sports apparatus; provision of sports facilities; provision of training, coaching and instruction with regard to sports; organisation and provision of leisure services; recreation and leisure centre services; arrangement, organisation and management of sporting events and competitions; provision of sports and games coaching; arranging and conducting of conferences, workshops and seminars in relation to sports, fitness and sporting activities; sports television programming services; publishing services including electronic publishing; certification services, namely operation of educational accreditation schemes and operation of accreditation schemes relating to sports and sporting events; information, advisory and consultancy services relating to all the aforesaid.

ANNEX 3

ESD's first mark

Class 28

Toys, games, playthings.

Class 41

Entertainment; entertainment relating to sports and healthy living; education and training relating to sports and healthy living; education services relating to physical fitness; exercise and fitness advisory and training services; organisation and management of leisure services; recreation and leisure centre services; information, advisory and consultancy services relating to all the aforesaid.

ESD's second mark

Class 28

Toys, games, playthings.

Class 41

Entertainment; entertainment relating to sports and healthy living; education and training relating to sports and healthy living; education services relating to physical fitness; exercise and fitness advisory and training services; organisation and provision of leisure services; recreation and leisure centre services; information, advisory and consultancy services relating to all the aforesaid.