

O/818/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3493289

BY SELF MADE GIRL BOSS LTD

AND

JOANNA BLASCO LOPEZ

TO REGISTER THE TRADE MARK:



IN CLASSES 16 AND 35

AND

OPPOSITION THERETO UNDER NO. 600001580

BY KHADIJAH WARD

Background and pleadings

1. On 25 May 2020, Self Made Girl Boss Ltd and JOANNA BLASCO LOPEZ (“the applicants”) applied to register the trade mark shown below and the application was published for opposition purposes on 16 October 2020.



2. Registration is sought for:

Class 16 Motivational cards.

Class 35 Selection of personnel; Brand evaluation services; Brand positioning; Business acquisitions; Business acquisitions (Advice relating to -); Business acquisitions consultation; Business administration; Business administration for others; Business advice; Business advice, inquiries or information; Business advice relating to marketing management consultations; Business advisory and consultancy services; Business advisory services; Business assistance relating to the formation of commercial undertakings; Business auditing; Business brokerage services; Business consultancy; Business consultancy and advisory services; Business consultancy, in the field of transport and delivery; Business consultancy (Professional -); Business consultancy relating to the administration of information technology; Business consultancy

services; Business consultancy services relating to data processing; Business consultancy services relating to disaster planning and recovery; Business consultancy services relating to insolvency; Business consultancy services relating to management of fund raising campaigns; Business consultancy services relating to manufacturing; Business consultancy services relating to product development; Business consultancy services relating to the marketing of fund raising campaigns; Business consultancy services relating to the promotion of fund raising campaigns; Business consultancy services relating to the supply of quality management systems; Business consultancy to firms; Business consultancy to individuals; Business consultation; Business consultation relating to advertising; Business consultation services; Business consulting; Business consulting for enterprises; Business consulting services; Business consulting services in the agriculture field; Business data analysis; Business data analysis services; Business efficiency advice; Business efficiency expert services; Business efficiency studies; Business Enquiries; Business enquiries and investigations; Business enquiry services; Business examinations services; Business expertise; Business expertise services; Business feasibility studies; Business file management; Business information; Business information agency services; Business information and inquiries; Business information and research services; Business information (Compilation of -); Business information for enterprises; Business information for enterprises (Provision of -); Business information (Provision of -); Business information services; Business information services provided online from a computer database or the internet; Business information services provided on-line from a computer database or the internet; Business information services provided online from a global computer network or the internet; Business inquiries; Business intelligence services; Business intermediary and advisory services in the

field of selling products and rendering services; Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; Business introduction services; Business introductions (Arranging -); Business investigation; Business investigations; Business invoicing services; Business management; Business management advice; Business management advice and assistance; Business management advice relating to manufacturing business; Business management advisory services; Business management advisory services relating to commercial enterprises; Business management advisory services relating to franchising; Business management advisory services relating to industrial enterprises; Business management analysis; Business management and administration; Business management and consultancy; Business management and consultancy services; Business management and consultation; Business management and consultation services; Business management and consulting; Business management and consulting services; Business management and enterprise organization consultancy; Business management and organisation consultancy; Business management and organisation consultancy services; Business management and organization consultancy; Business management and organization consultancy services; Business management assistance; Business management assistance for industrial or commercial companies; Business management assistance in the establishment and operation of restaurants; Business management assistance in the field of franchising; Business management assistance in the operation of restaurants; Business management consultancy; Business management consultancy, also via the Internet; Business management consultancy and advisory services; Business management consultancy in the field of executive and leadership development; Business management consultancy in the field of

transport and delivery; Business management consultancy services; Business management consultancy services provided via the Internet; Business management consultancy via the Internet; Business management consultation; Business management consulting; Business management consulting services; Business management consulting services in the field of information technology; Business management for a trade company and for a service company; Business administration consultancy; Business advice.

3. Khadija Ward (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the applicants’ Class 16 term alone and is reliant on the mark set out below.
4. Trade mark UK00003339896, filed on 20 September 2018, registered on 7 December 2018.



5. The mark is registered for a variety of goods. The opponent relies upon the goods below in her opposition:

Class 16 Activity books; Advent calendars; Advertisement boards of card; Advertising posters; Advertising publications; Announcement cards; Announcement cards [stationery]; Agenda books; Anniversary cards.

6. The opponent opposed the application using the “fast track” procedure by filing a Form TM7F. This procedure can be used when the grounds of opposition are limited to sections 5(1) and/or 5(2) of the Act.
7. In its Form TM7F, the opponent argues that the respective goods are identical or similar and that the marks are similar and that there exists a likelihood of confusion by virtue of a likelihood of “association” with the earlier mark.
8. The applicants filed a Form TM8 simply stating that they disagree with – thereby denying – the basis on which the opponent is relying on section 5(2)(b) of the Act.
9. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but it provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
10. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
11. In this case, neither party sought leave to file evidence.
12. A hearing was neither requested nor was it considered necessary.
13. Neither party elected to file written submissions.
14. Neither party is represented.

DECISION

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

“5(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

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

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

17. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined in section 6(1) of the Act. Also, as this trade mark had not completed its registration process more than 5 years before the filing date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act.

Section 5(2)(b) – case law

18. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in

accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

19. 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 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:

(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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

20. The goods in question are as follows:

Opponent's goods	Applicants' goods
<u>Class 16</u> Activity books; Advent calendars; Advertisement boards of card;	<u>Class 16</u> Motivational cards.

Advertising posters; Advertising publications; Announcement cards; Announcement cards [stationery]; Agenda books; Anniversary cards.	
--	--

21. 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 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. 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.”

22. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

23. 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 the responsibility for those goods lies with the same undertaking.”

24. I compare the applicants’ “Motivational cards” with the opponent’s “Anniversary cards”. The respective goods are the same in nature, being cards. They also have the same method of use – they are written in to convey a greeting – and the same users – members of the general public. They also have the same broad purpose – that of a greetings card, only differing to the extent that motivational cards are intended to motivate or inspire through uplifting messages, whereas anniversary cards mark a particular anniversary. In respect of trade channels, they would be the same in that greeting cards are sold through card shops and the cards section of a supermarket, albeit motivational and anniversary cards could be categorised separately on the racks. The goods are not complementary, but there could be a degree of competition in that one might choose to buy a motivational card and hand write greetings to mark an anniversary or one might choose to

buy a specific anniversary card. Overall, I find these goods to be highly similar.

25. No other of the opponent's goods put her in a stronger position.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 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 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.”

27. The average consumer in this case is a member of the general public buying a greetings card. While average consumers may pause to consider the design and message of the card, this is not a purchase that they would dwell on, nor is it one involving a significant degree of expense. I find that the level of attention paid during the purchasing process would be low to medium.

28. The purchase of a greetings card is unlikely to involve verbal interaction prior to visual scrutiny of the product on the shelves, so I find that visual considerations would predominate during the purchasing process.

Comparison of the trade marks

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. 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.”

30. 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.

31. The respective trade marks are shown below:

Opponent's trade mark	Applicants' trade mark
	

32. The opponent considers that, “The dominant and distinctive elements of the DARK GIRL BOSS Mark are the words 'GIRL BOSS' which is also a distinctive element of the Application.” She also considers that the public are likely to associate the “Dark Girl Boss” mark with the applicants’ mark due to media publicity about the opponent’s “exclusive motivational quotes”, although I note that I must consider the registered/applied for marks and goods on a notional basis.

33. I set out my analysis of the marks below.

34. The opponent’s mark consists of the words “Dark Girl Boss”, run together as one word in a slightly stylised text, presented on a bottom-left to top-right curve, set into a picture. The picture is a stylised one based on a black-and-white photograph of a woman’s head with dark hair (with the hair being depicted in black). The text is set into the woman’s hair. While the words are smaller than the picture, one’s eye is drawn to the word element given that it can be read. It is not as though the word is tiny in comparison to the picture. Consequently, I consider the two elements to play an equal role in the overall impression of the mark.

35. The applicants’ mark consists of the words “SELF MADE: GIRL BOSS” in capital letters, presented on a horizontal curve, below a colour cartoon of the head and shoulders of a woman. The woman has shoulder-length brown hair and is wearing make-up. Again, the words are smaller than the picture, but one’s eye is drawn to the word element given that it can be read. I consider the two elements to play an equal role in the overall impression of the mark.

36. Visually, the marks have the same last two words – “girl boss” – which are preceded by different words. Both feature pictures of women, but there are differences between the pictures. For example, one is based on a black-and-white photograph of the head alone, the other is a colour cartoon of the head and shoulders. The women’s features also differ. Overall, I consider the marks to be visually similar to a degree which is lower than medium.

37. Aurally, the words “girl boss” are identical. However, the preceding words in the opponent’s mark – “dark” – and in the applicants’ mark – “self made:” – are phonetically dissimilar. The pictures in the respective marks will not be pronounced by the consumer. I consider the marks to be aurally similar to a medium degree.

38. Conceptually, the marks share the same central concept, that of a girl boss – a girl who is in charge. The respective pictures serve to reinforce the concept. The preceding word in the opponent’s mark, “dark”, is descriptive of “girl boss”, with the mark taken as a whole as conveying the concept of a “girl boss” that is “dark” (the word “dark” being taken as a reference to the colour of the girl’s hair or skin tone). The preceding words in the applicants’ mark, “self made:” (meaning accomplished through one’s own efforts) are also descriptive of a “girl boss”, with the mark taken as a whole as conveying the concept of a girl who is the boss as a result of her own efforts. Overall, I consider the marks to be highly similar conceptually.

Distinctive character of the earlier mark

39. 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).”

40. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

41. I must make an assessment of the inherent distinctive character of the earlier mark. The phrase “dark girl boss” in the opponent’s mark is neither allusive nor suggestive of the goods for which the mark is registered. The figurative element of the mark only reinforces the concept conveyed by the words. The word and associated picture are not highly distinctive in the way that they might be if one was dealing with an invented phrase. Consequently, I consider the mark to be inherently distinctive to a medium degree. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks¹, namely the words “girl boss”. To that extent, I confirm that my view is that that the word is inherently distinctive alone to a medium degree.

Likelihood of confusion

42. 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

¹ See, *Kurt Geiger v A-List Corporate Limited*, BL O-075- 13,

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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, 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 they have retained in their mind.

43. I have found the parties' marks to be visually similar to a degree which is lower than medium, aurally similar to a medium degree, and highly similar conceptually. I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means. I have concluded that the average consumer will pay a low to medium level of attention when selecting the goods. I have found the parties' goods to be highly similar. I have also found the opponent's mark to have a medium degree of inherent distinctive character, including the common element "girl boss".

44. While the marks share the phrase "girl boss" and conceptually reinforcing pictures of women, different words precede that phrase in the respective marks and there are sufficient differences between the pictures to avoid the marks being mistakenly recalled as each other. For example, the picture in the opponent's mark is based on a photograph, is of the head alone, and is in black-and-white, while the picture in the applicants' mark is a cartoon, is of the head and shoulders, and is in colour. The features of the two women also differ. Such differences between the types of representation are likely to be recalled by the average consumer. I am therefore satisfied that there is

no likelihood of direct confusion, even taking into account the high degree of similarity of the goods under consideration.

45. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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 recognised 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.”

46. I am also conscious of the examples referred to in the *L.A. Sugar* case:

“17. Instances where one may expect the average consumer to reach such a conclusion [that the later mark is another brand of the owner of the earlier mark] 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).”

47. While the shared element is not an invented word, I consider it to be rather striking in the context of the goods at issue. Further, each mark has a conceptually reinforcing picture of a woman. In both marks, the differentiating verbal elements – the words “Dark” / “SELF MADE: – are positioned at the beginning of the mark and are of secondary importance as they qualify the words “girl boss” (which form a unit) without changing its meaning. This means that the shared element maintains an independent distinctive role in each mark. Looking at the goods under consideration, which are highly similar, I consider that the average consumer will conclude that the parties’ marks indicate goods sold by the same or economically linked undertakings. The differences that exist between the marks will be seen as symptomatic of a brand variation with the common basis of the marks being “girl boss”. I therefore consider that there is a likelihood of indirect confusion.

CONCLUSION

48. The opposition has succeeded in its entirety for those goods that were contested and so the application is refused for the following goods:

Class 16 Motivational cards.

49. The applicants’ uncontested Class 35 services will proceed to registration.

COSTS

50. The opponent has been successful in its opposition to those goods that she contested. The opponent is unrepresented and no Cost Pro Forma has been received, so she is entitled only to the official fee for filing the opposition. I award the opponent the following:

Official fees:	£100
Total:	£100

51. I therefore order Self Made Girl Boss Ltd and JOANNA BLASCO LOPEZ to pay Khadija Ward the sum of £100. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 4th day of November 2021

JOHN WILLIAMS
For the Registrar