

Neutral Citation Number: [2025] EWHC 3167 (IPEC)

Case No: IP-2024-000109

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)
INTELLECTUAL PROPERTY ENTERPRISE COURT

Rolls Building
New Fetter Lane
London

4 December 2025

Before :

HER HONOUR JUDGE MELISSA CLARKE
sitting as a Judge of the High Court

B E T W E E N :

DRYROBE LIMITED

Claimant

- and -

CAESR GROUP LIMITED
(trading as D-ROBE OUTDOORS)

Defendant

Mr Theo Barclay (instructed by Addleshaw Goddard LLP) for the **Claimant**
Ms Becky Knott (instructed by Lewis Silkin LLP) for the **Defendant**

Hearing dates: 23 and 24 June 2025

Judgment

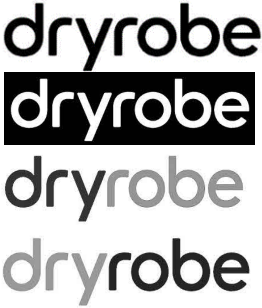
Her Honour Judge Melissa Clarke:

A. INTRODUCTION

1. This is a judgment in relation to a claim for trade mark infringement under sections 10(2) and 10(3) Trade Marks Act 1994 (“TMA”) and passing off with a counterclaim in invalidity alternatively revocation.

The Claimant

2. The Claimant is a company incorporated in England and Wales on 19 November 2013 with company number 08782079. It is a manufacturer and retailer of outdoor clothing products which it sells under its brand name DRYROBE. It has obtained a number of UK trade marks since 2013 which it says have acquired enhanced distinctive character through their use (together, “**the Marks**”):

Number	Mark	Filing/ Registration date	Goods including
UK00003001195 (“ the 195 Mark ”)	DRYROBE	9 April 2013 19 July 2013	Class 25 “Changing robes” “waterproof and windproof robes” “robes, gowns and capes of towelling material” “beach wraps”
UK00918088428 (“ the 428 Mark ”)	DRYROBE	28 June 2019 13 November 2019	Class 18: “Bags” Class 25 “Clothing”; “Waterproof clothing”; “Sports clothing” “Beach clothing” “Hats” “Beanies” “Beanie Hats” Class 35: “Clothing”
UK00003751826 (“ the 826 Mark ”)		7 February 2022 6 May 2022	Class 18: “Bags” Class 25 “Clothing”; “Waterproof clothing”; “Sports clothing” “Beach clothing” “Hats” “Beanies” “Beanie Hats” Class 35: “Clothing”


			
UK0003855456 ("the 456 Mark")	DRYROBE DRY ROBE	2 December 2022 3 March 2023	Class 18: "Bags" Class 25 "Clothing"; "Waterproof clothing"; "Sports clothing" "Beach clothing" "Hats" "Beanies" "Beanie Hats" Class 35: "Clothing"

Table 1

3. The Claimant's main product is a changing robe which was the first drying and waterproof changing robe on the UK market. This is an oversized waterproof coat with a towelled lining, designed for surfers or swimmers to change under whilst also drying them, keeping them warm, and protecting them from the weather. Mr Gideon Bright, the founder of the Claimant, says that it was inspired by a garment which his mother had made for him as a teenager, which he says was more of a towelling cape without sleeves, which pulled on over the head through an elasticated neck, and was covered in tent material to make it waterproof, and was further influenced by a 'swim parka' he encountered in 2009 in Australia. He described the swim parka as a large coat which keeps users warm and dry in between swimming or watersports, and which could repeatedly be reused without becoming damp and cold, but which was not big enough to get changed in. He said that he thought it would be great if that could be turned into something waterproof which you could change in, like his mother's waterproof cape.
4. Mr Bright's evidence that the type of outdoor/weatherproof changing robe that he developed and brought to market was entirely novel in the UK at the time was not challenged in cross-examination and the novelty of the product is accepted in the Defendant's skeleton argument and oral submissions.
5. Mr Bright began manufacturing his initial design in the UK in 2011, selling products under the sign DRYROBE direct to the public at outdoor sports events

and via a website. Those initial products had the brand name ‘Dryrobe’ together with a ‘™’ symbol prominently placed on, inter alia, the front and back of the product. In 2012 Mr Bright moved production of the goods from the UK to China. In 2013 he incorporated the Claimant as a trading vehicle for the Dryrobe business and also registered the ‘195 Mark. At some point after this, the Claimant transitioned from using the large ‘Dryrobe™’ logo on the back of the changing robe products with an equally large ‘Dryrobe®’ logo, although there seems to have been a significant period when both were in use.



Figure 1

6. The Claimant’s most popular product, introduced to the market by Mr Bright in 2012, was and remains the Dryrobe Advance changing robe, seen in the photograph above and available in adult and child sizes. The Claimant also sells a range of ancillary products, clothing and footwear including towels, coats and hats by reference to and incorporating DRYROBE. The Claimant registered the

later Marks for the sign DRYROBE in word form and a stylised form in 2019, 2022 and 2023 as set out in Table 1 above.

7. The Claimant's business succeeded and after a small start, grew significantly and rapidly. The Claimant's evidence, which was not challenged by the Defendant, is that:
 - i) net sales revenues reached in excess of £1.3m in 2017; £3.0m in 2019; £9.0m in 2020; £20.3m in 2021 (a boom year, reported by the directors in the Claimant's annual accounts to be due to the increased interest in outdoor sports and activities during the Covid pandemic); £14.7m in 2022 and £18.0m in 2023;
 - ii) it first recorded a profit of £59,037 in 2015 and this increased year on year to £4,427,958 in the year to 31 December 2020, £8,080,340 in the year to 31 December 2021 and falling to £3,233,699 and £2,335,450 in the years to 31 December 2022 and 2023 respectively;
 - iii) Mr Bright's evidence is that there have been just under 750,000 orders for the Claimant's goods between 2017 and 2024;
 - iv) the Claimant has supported the Marks with advertising and marketing spend, which rose from some £223,462 in 2019, £227,983 in 2020, £919,449 in 2021, in excess of £1.38m in 2022, almost £2m in 2023 and almost £3m in 2024.
8. The Claimant's evidence is that this marketing effort includes:
 - i) using Google Ads to advertise its products to consumers who search Google for, *inter alia*, 'dryrobe.com', 'dryrobe', 'dryrobe coats' or 'dryrobe towel changing robe';
 - ii) gaining extensive press coverage of the Marks and products sold by reference to the Marks;
 - iii) developing commercial relationships which are valuable marketing tools. For example, in 2016, it became change robe supplier to Team GB for the 2016

Olympics and Paralympics which involved team members wearing the Claimant's products bearing the Marks. Mr Bright says this increased visibility of and familiarity with the Dryrobe brand in the eyes of the UK consumer public and his evidence on this point was not challenged. That collaboration continued for the Olympic Games in 2022 and 2024. It has built other prominent long-term relationships with, for example, Red Bull, the RNLI and Surfing England as well as individual athletes;

- iv) gaining other media coverage of the Marks and products sold by reference to the Marks. For example, the Claimant's Dryrobe Advance product, prominently displaying the Marks, has been seen on television programmes from Top Gear to Comic Relief and Children in Need.
9. The Claimant's evidence that it was the only retailer in the UK of change robes of the type Mr Bright had created until around 2018 or 2019, when other entrants began to appear on the market, and that there are now around 200 competitor companies selling changing robes on the UK market, was not challenged by the Defendant.

The Defendant

10. The Defendant is a company incorporated in England and Wales on 25 January 2021 with company number 13157243. It was founded by its sole director and chief executive officer, Ms Chika Russell, who after a career in finance had become a serial entrepreneur. She incorporated the Defendant as a trading vehicle for a business in which the primary product was to be a waterproof or water-resistant and practical warm long changing robe similar to the Dryrobe Advance, but less oversized in design and therefore, she believes, more stylish and more suited for wearing in playgrounds, parks and sports fields than the beaches and lakes she considers is the natural home of the Dryrobe Advance. Ms Russell's evidence is that she wanted to produce a brand *"for people who want the freedom to be enjoying their life, cosily protected from the elements, while looking good"*.
11. Ms Russell chose the name D-Robe, obtained the domain name d-robeoutdoors.com and registered this on 6 February 2021. She worked with a

designer called Paul Austin to design the changing robe which was to be the Defendant's first product in January and February 2021. The Defendant pleads that this is a changing robe with a fleece inner for drying off and keeping dry between or during activities, known as the 'Beaufort Robe'. Ms Russell worked with several graphic designers from January 2021 to develop the logo and branding. The logos she chose were developed by Chris Long of Studio Bonaparte:



Figure 2

12. Ms Russell worked with a branding consultancy called the Consultancy Collective who prepared documents for a 'brand identity workshop' in March 2021 and resulted in the creation of a final 'brand book' at the end of March 2021. During the course of the development of the D-Robe branding, Ms Russell raised a query with Mr Long about whether he considered 'D-Robe' might be too close to the 'DUNLOP' mark. He did not think so, saying "*For me, DryRobe would be more of a potential issue, as they make the same product... I've deliberately steered away from branding that could be confused with them so far in the development.*".
13. The Defendant started trading in March 2022, achieving 967 orders in financial year 2022-2023, 4,551 sales in 2023-2024 and 13,687 sales in 2024-2025, of which around 95% are for the D-Robe Beaufort change robe. Ms Russell's evidence is that the Defendant's 2023-2024 sales revenue was some £1.7m. These figures have not been challenged. As well as selling change robes, the Defendant sells merino jumpers, beanie hats and roll-top bags.
14. The Defendant has pleaded the use of a number of signs in the course of trade in the UK of which the following are complained of by the Claimant:
 - i) D-ROBE OUTDOORS

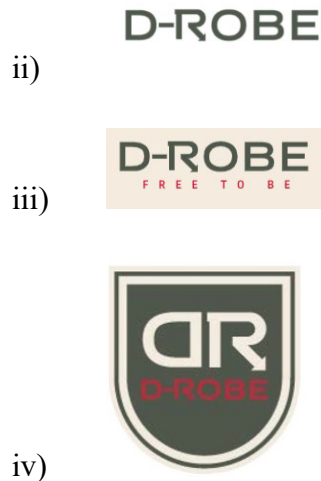


Figure 3

15. For the purposes of these proceedings the Defendant has indicated that it is content for the Court to treat the signs at paragraph 15 (i) to (iii) above as if they are use of the ‘D-ROBE’ word sign alone, given that, as Ms Knott for the Defendant accepts, “D-ROBE” forms the dominant and distinctive element of those signs (the “**D-ROBE Sign**”). I will refer to the sign at (iv) as the “**Shield Sign**” (which incorporates the D-Robe Sign).
16. In September 2024 the Defendant applied to register UK trade marks protecting the words D ROBE and DROBE. Those applications have been opposed by the Claimant.

B. Pledged case

Claimant

17. The Claimant claims for trade mark infringement under sections 10(2) and 10(3) TMA and in passing off.
18. In respect of trade mark infringement, it is the Claimant’s case that the D-ROBE Sign is highly similar to the Marks and, as the Defendant accepts, it has been applied to identical goods to those for which the Marks are registered. As a result of the similarities, the Claimant pleads:

- i) pursuant to section 10(2) infringement, that there is a risk that the average consumer of clothing, footwear and hats might be confused into believing that the Defendant's goods are those of the Claimant or an associated brand/economically linked undertaking because of the inherent and acquired distinctiveness of the Marks. The Claimant also relies on evidence of actual brand confusion amongst consumers: (a) which has come to the Claimant's attention; and (b) which has been disclosed to it by the Defendant during the course of these proceedings; and
 - ii) pursuant to section 10(3) infringement, that the Marks will be immediately and strongly brought to mind by the Defendant's use of the D-ROBE Sign, which: risks causing detriment to the distinctive character of the Marks from blurring or dilution of the origin function of the Marks; has or is seriously likely to change the economic behaviour of consumers of, at least, the Defendant's goods; and takes advantage of the distinctive character or reputation of the Marks by riding on the coat-tails of the Marks.
19. The passing off claim is based on what the Claimant pleads is a misrepresentation by the Defendant by its use of the D-ROBE Sign and decision to name some of its products 'Dry Robe'. The Claimant pleads these are liable to deceive members of the public into believing that the Defendant's goods are authorised or approved by the Claimant or are connected or associated in the course of trade with the Claimant and its DRYROBE brand.
20. The Claimant seeks injunctive relief, delivery up and destruction of infringing articles and materials, and at its option an inquiry as to damages for trade mark infringement and passing off or an account of profits. The Claimant further seeks additional damages from the Claimant pursuant to Regulation 3 of the Intellectual Property (Enforcement etc) Regulations 2006/1028 ("**IP Enforcement Regs**") on the basis that the Defendant knew or had reasonable grounds to know that it was engaged in infringing activity. Finally the Claimant seeks an order for dissemination and publication of this judgment at the Defendant's expense, interest and costs.

Defendant

21. The Defendant denies infringement (although it no longer pursues its pleaded defence under section 11(2)(b) TMA). It pleads that the terms ‘DRYROBE’ and ‘DRY ROBE’ consist exclusively of signs or indications which may serve in trade to designate the kind quality, intended purpose and other characteristics of the goods, or alternatively have become customary in the current language – in other words that they are descriptive, generic terms, solely capable of signifying to consumers a category of goods, rather than a brand. It alleges that the Marks are not inherently distinctive and pleads that they do not benefit from an enhanced reputation or acquired distinctive character in the UK. It denies that the Marks and the D-ROBE Sign are similar, although it has softened this position at trial and now accepts that they are, but submits it is only a low degree of similarity. Although it pleads that it is not aware of any actual confusion, denies that the communications relied on by the Claimant demonstrate actual confusion, and avers there is no likelihood of confusion between the Marks and the D-Robe Sign, in closing submissions the Defendant accepted there is evidence of actual confusion between the Marks and the D-ROBE Sign with the relevant public.
22. The Defendant denies passing off. It denies that the acts complained of amount to a misrepresentation as claimed or that the Claimant has or is likely to suffer any damage as alleged.
23. The Defendant counterclaims against the Claimant for:
- i) Invalidity of the Marks under sections 3(1)(b), 3(1)(c) and 3(1)(d) TMA (although at trial it focussed on sections 3(1)(c) and 3(1)(d) TMA, Ms Knott in her skeleton argument for the Defendant and at trial submitting that section 3(1)(b) TMA stands or falls with the other two);
 - ii) Revocation of the Marks under section 46(1)(c) TMA;
 - iii) Revocation of the ‘428 Mark in part under section 46(1)(a) TMA, for a subset of the goods and services for which it is registered.
24. In its Amended Reply to Defence and Counterclaim, the Claimant:

- i) denies that DRYROBE is descriptive or not inherently distinctive such that it is incapable of being viewed as a brand name by a significant proportion of the public; and
 - ii) denies that DRYROBE had become generic by any of the four relevant filing dates for the Marks.
25. If the Court is not with it on those points, the Claimant pleads that the Marks had acquired, at least, distinctive character (and it pleads enhanced distinctive character) by the time the counterclaim was filed in November 2024. It denies that the Marks should not have been registered and should be revoked.
26. Finally, the Claimant admits in the Amended Reply and Defence to Counterclaim non-use for a selection of the goods and services for which the ‘428 Mark has been registered, but disputes the remainder of the challenge by the Defendant under section 46(1)(a) TMA.

C. Issues

27. The issues to be determined are set out in the Schedule to the directions order of HHJ Hacon of 12 February 2025 and set out at Annex A to this judgment.

D. Evidence

28. The Claimant relies on the evidence of Mr Gideon Bright. He signed the Amended Particulars of Claim dated 13 December 2024 and the Amended Reply and Defence to Counterclaim dated 18 December 2024 and filed a witness statement dated 30 April 2025.
29. The Defendant relies on the evidence of Ms Chika Russell and Mr Matthew Salkeld, who is the Vice-President of Operations at the Defendant. Ms Russell signed the Amended Defence and Counterclaim dated 17 December 2024 and filed two witness statements dated 30 April 2025 and 22 May 2025. Mr Salkeld made a witness statement dated 30 April 2025.
30. Each of the witnesses attended court and were cross-examined. Mr Bright was also asked a few questions in evidence-in-chief by Mr Barclay.

31. I found all three witnesses to be good witnesses who came to court to assist it with their honest evidence to the best of their ability. Mr Salkeld was entirely straightforward. I think both Mr Bright and Ms Russell were a little concerned not to make concessions which might damage their respective cases, and to that extent each sought at different times to avoid making some concessions or to alternatively attempted to speculate about why certain things may have happened or the interpretation to give contemporaneous documentation to seek to explain them away. I do not put this too high. To the extent that is a criticism, it is a mild one in respect of both witnesses. I am satisfied neither sought actively to mislead the Court.

Mr Bright's evidence

Development of the changing robe

32. Mr Bright's evidence is that the first product he developed in 2009 was a towel intended to be used after surfing, which wrapped around the waist and attached with Velcro. He originally called these "Drywrap", but changed the product name to DRYRAP before launch in 2010.
33. When he then developed his new changing robe product in 2010, he said that he needed something that differentiated it from his DRYRAP product but fit with it. He said that he chose DRYROBE as he needed a product name quickly and he had heard swim parkas being referred to as robes in Australia. In cross-examination he accepted that it was a good name for "*a robe which dries you or a robe which keeps you dry*". It was put to him that he chose the name because he wanted to communicate what it does to people, and he said that it was more important that it sat in line with the DRYRAP product he was selling at the time. He said that he did not particularly like DRYROBE originally, he was worried that the words did not sit well together either graphically or when he was saying it, and he remembers asking his children whether it sounded ridiculous as he felt it did not naturally roll off the tongue. I accept that evidence.
34. Mr Bright's evidence is that he first put the DRYROBE name and logo on the back of the changing robes as in the early days when he was wearing one on the beach, people kept coming up to him to ask what the product was and who made

it. The factory made a sizing error in implementing that change and the logo on the back ended up much larger than he had expected. Unexpectedly, he liked it and it became standard. This account was not challenged. He said in cross-examination that he kept with the name DRYROBE, which he was initially so unsure of, because he was only selling a few products at trade shows and directly, he had marketing photos of one which he did not have time to replace, and he had the logo all set up with the embroiderers. He said that it was not until he moved production to China in 2013, after sales crept up, that the margins enabled the product to be sold in shops. By then, he said, after all his hard work “*it felt like a brand*”, so he kept it as DRYROBE. I accept that.

35. Although the Dryrobe Advance is the Claimant’s main product and the focus of its business (Mr Bright called it “*our hero product*”), the Claimant has developed ancillary products which complement each other and the Dryrobe Advance, such as gloves with finger sections that can be flicked off in order to manipulate zips, insulated boots and puffer coats which fit under a Dryrobe Advance each sold under and by reference to the Marks.
36. In 2022 the Claimant underwent what Mr Bright called a “*visual rebrand*” prompted by a dispute with Superdry, including an updated logo, being the stylised ‘826 Mark. Ms Knott put it to him in cross-examination that it was the distinctive swirl of the previous logo by which customers identified the Claimant’s products and not the DRYROBE name, but he disagreed, saying it was the brand name ‘DRYROBE’ within that logo. He said “*...even when we changed the logo, it is surprising how few people noticed it. You know, we rolled it through because we did not want to create any waste... so there is a process where we were swapping over [from one design to the other] where we were actually quite nervous that people would go “You have changed your logo”, but nobody to my surprise, nobody really noticed it. We did not have any comments about it on the rebrand, which I find amazing and slightly hurtful, being a graphic designer.*” I accept this evidence.

Reputation of the Marks

37. Mr Bright's evidence is that the Claimant has made extensive and widely promoted use of the Marks in the UK prior to the date of the Claim Form. Figures for the Claimant's net sales revenues, advertising and marketing spend and net profit have been set out in paragraphs 7 and 8 above. His evidence is that the marketing spend includes advertisements on social media prominently featuring the Marks, which regularly generate over 2.5m impressions. The Claimant's Instagram account had, at the date of the Amended Particulars of Claim of 13 December 2024, 129,000 followers. None of this evidence was challenged in cross-examination.
38. Mr Bright's evidence is that during the Covid pandemic, the Claimant could not attend trade shows and instead put in a lot of effort to generate marketing attention through press interviews and TV programmes, which led to "*an explosion of interest*" in the DRYROBE brand. This evidence has not been challenged. Since the Claimant was largely selling online, they were able to meet customer demand and revenue tripled. This can be seen in the financial information disclosed. He said he considered that the pandemic fast-forwarded the DRYROBE brand by 3-5 years, and prompted the Claimant's expansion into overseas markets.
39. Mr Bright has evidenced and disclosed extensive press clippings about the Claimant's changing robes prominently featuring the Marks, including in national publications including the Guardian, the Telegraph, Daily Mail and Mail Online. He has evidenced that the Claimant's DRYROBE branded goods have won a number of industry awards including 'Innovative Product of the Year' at the National Outdoor Expo 2024 awards at the Birmingham National Exhibition Centre, 'Best Cross Training Kit' at the UK 'Women's Running' magazine awards 2023 and 'Best Recovery Gear' at the 'Women's Running' Awards 2022. This evidence is not challenged.
40. His written evidence is that the Claimant has sought to build a community around the DRYROBE brand on social media, which includes supporting athletes as brand ambassadors, working with a network of brand collaborators, ambassadors and influencers who are required to "*promote the dryrobe brand in a way which generates high levels of engagement and is consistent with our*

brand ethos and guidelines”, which “*allow[s] us to reach hundreds of thousands of potential customers on an almost daily basis*”. Again, this evidence, including in relation to consumer reach, has not been challenged.

41. I have already referred to the relationship with Team GB during a number of Olympic Games and set out brief details of some of the Claimant’s other commercial partnerships which Mr Bright says have provided enormous value in terms of marketing and promotion of the Claimant’s DRYROBE brand on different channels, including broadcast, print and social media, to the general public. To take another example, Mr Bright said that the Claimant’s working relationship with Red Bull, who he described as “*iconic in the extreme sports and water sports world and has a huge following (over 26million followers on Instagram)*” has given it a “*massive amount of exposure*” and when Red Bull shared a picture featuring a Dryrobe Advance, he said “*the amount of engagement we received as a result was amazing*”. None of his evidence on this point was challenged in cross-examination.

Genericism

42. Mr Bright’s evidence is that since registration of the ‘195 Mark, the Claimant has put as many resources as it can into protecting the DRYROBE brand. As stated, his evidence is that there were no direct competitors for his changing robe products until about 2018 or 2019. He said that in around 2019 he spoke to the Claimant’s solicitors at the time, Stephens Scown, about the concerns he had with competitors describing their products as ‘dryrobes’ and people using the terms ‘dryrobe’ and ‘dry robe’ in a descriptive way, and received what he described as “*a bit of an education*” in being proactive in protecting the Claimant’s brand name. His evidence is that since 2019 the Claimant has sought to combat such generic use of ‘dryrobe’ and ‘dry robe’ and educate the public that DRYROBE is the Claimant’s brand which is protected by registered trade marks in the UK, by:

- i) budgeting for legal work and online brand protection;
- ii) writing to or communicating with third parties who have described their products as ‘dryrobes’ or ‘dry robes’, notifying them of the existence of the

Marks and, from 2021, specifically suggesting they describe their product as a ‘changing robe’, which he described as “*emerging as the general category term*”;

- iii) taking advice on the issue from Ben Langdon, a marketing consultant at the Claimant’s external PR company who, indirectly, introduced him to a specialist intellectual property solicitor Mr Geoff Steward who has provided IP advice to the Claimant ever since;
- iv) working with Mr Steward to develop a strategy to address the risk of genericisation by:
 - a) creating and posting on social media (Instagram, Facebook, TikTok, YouTube and the Claimant’s website) two “*no substitutes*” videos in November 2021 and April 2022 explaining that only a genuine Dryrobe from the Claimant can be called a Dryrobe;
 - b) creating and posting on social media in November 2021 a “*technical drench test video*” comparing the way a Dryrobe operates against a that of a generic changing robe competitor, demonstrating what the Claimant says is the Dryrobe’s quality and superior performance;
 - c) creating a section of the Claimant’s website explaining how to use the term ‘DRYROBE’, asking them to use the ‘®’ mark whenever talking about the brand to highlight that it is a registered trade mark, and explaining the matter visually in a video which was also posted on social media;
 - d) through the Claimant’s internal social media team, actively searching social media for ‘dryrobe’ and ‘#dryrobe’ on a weekly basis, and if it is used in relation to a product which is not the Claimant’s product, contact the user in an informal and friendly way to ask them to remove the reference and suggest using the category term ‘changing robes’ instead;

- e) through the Claimant's third party 'Online Brand Enforcement' company, utilising internet crawler technology, monitoring social media for use of the word 'dryrobe' to identify and enforce the brand across marketplaces, social media, web domains and paid search/AdWords;
 - f) instructing a PR Agency to monitor third party publications and similarly provide informal requests to amend articles and remind them of the Marks; and
 - g) investing in further legal action, where appropriate, if informal contact does not resolve the problem.
43. The fact of these activities was not challenged by the Defendant in its cross-examination of Mr Bright. In addition, there is extensive contemporaneous documentary evidence before the court of the work done internally and externally described in (d) and (f) above. For example, the Claimant has kept and disclosed records of all social media posts which it found and objected to from 15 December 2020, including but not limited to: details of the account name, type (brand, stockist, competitor, personal account etc) and URL of the poster; a screenshot of the post objected to; details of the action taken by the Claimant; a screenshot of the Claimant's contact; details of result/response; number of clicks, comments likes, etc. That log during 2021 rarely shows fewer than about 25 such contacts per month.
44. The relentless nature of the task of addressing generic use in the press and on social media can be seen from the documentation and records disclosed by the Claimant, in my judgment, and can also be inferred from an email Mr Bright sent on 6 August 2020 to the Claimant's external PR advisor Mr Langdon and Mr Neil Osmond in the Claimant's internal press team, notifying them of an article in which 'dry robe' is being used as a category term in relation to a competitor's product in a feature article in the Daily Telegraph. In that email Mr Bright describes the Claimant as being "*under attack*" but, in a reply to his own email an hour or so later acknowledges that this description is "*a b[i]t extreme :)*". He adds wryly, "*We can always switch over and become a*

dryrobe.com superstore and sell everyone else's dryrobes and get out of manufacturing all together. Off to tennis. Speak soon." It was put to him by Ms Knott in cross-examination that he was referring to competing third party products as 'dryrobes' in that email because this was the category term for those products, and he said *"No, it is completely sarcastic and just messing around with the dilemma that we had"*. It is entirely obvious to me that is the case and I accept his evidence. I do not consider that email is a serious use by Mr Bright of 'dryrobe' as a generic category term.

45. Mr Bright was asked in cross-examination about an email of 27 August 2020 from Mr Langdon to The Times newspaper, about a feature published the previous day which included reference to the Claimant's products. He thanked his contact at The Times for the coverage, and said *"As you can probably imagine, dryrobe have had an amazing year with sales that have gone through the roof, (especially post lockdown) and we're so pleased its getting the recognition it deserves... however they are keen to stand out as 'dryrobe@', given their name is relatively close to what is traditionally known as a dry robe."* It was put to Mr Bright that this was evidence that by August 2020, the term 'dry robe' for the Claimant's category of products was already a traditional or customary term and he denied it, saying it shows that the PR *"getting it wrong"* and making *"a very clunky mistake"*. I accept that it does show Mr Langdon getting the message wrong, given the systems and actions that the Claimant had put in place to combat generic use since 2019. I will come back to the question of whether there was generic use by August 2020 when I deal with the section 3(1)(d) TMA invalidity claim.
46. Mr Bright was then taken to an email he had written to Mr Langdon 10 days later, on 7 September 2020. In this he said that he had *"a few things on my mind to do with the brand and IP"* and then said *"I personally like dryrobe@ being the category term, BUT if we do have to defend it (which seems a bit counter-intuitive), do we continue saying to competitors – that they are a change robe or a robe for changing or drying? Q: Can we agree so we can be consistent on what our policy is and our respon[s]e. (keeping Changerobe.com in mind)"*. It was put to him again that by 7 September 2020 he understood dry robe to be the

category term, and again he denied it. He again described this wording as “clunky”, but explained that he was referring to a new company which entered the space called changerobe.com or Changerobe, and up until that time, he said, if third party competitors had been describing their product as a ‘dryrobe’, the Claimant had approached them by phone or email and said “*you cannot do that, you have to change and call yourself a change robe or a changing robe.*”. Mr Bright said “*So, this email chain is really about that, it is like, wow, what do we say now, do we point them towards a competitor’s product, you know, or build a competitor’s brand if I keep messaging the same?*”

47. I accept Mr Bright’s evidence on this point. It can be seen, in my judgment, that this issue (of a third party taking as a domain name ‘changerobe.com’ the category term that the Claimant had been requesting people to use rather than the Claimant’s brand name) continued to be an issue with which he and the Claimant’s advisors wrestled for some time. Mr Bright was taken to an email which he wrote to Mr Langdon and Mr Osmond almost a year later, on 2 August 2021, in which he said:

“We have made a call that change robe is the category term and dryrobe make change robes. So the game has changed to making dryrobe the most recognisable and popular change robe company.

It hurts to tell all of the people tagging #dryrobe that they should tag change robe if it's not a dryrobe brand product and it bolsters change robe as long as it continues to own a category URL / Domain.

Is our dryrobe registered trademark more valuable than change robe’s? Is it better to own dryrobe.com or changerobe.com. Ideally both, but does it matter?

Is it trade mark or domain name that really wins the war?

Should we play a different game and not worry about genericide if we always own the dryrobe.com domain?

Should we try to buy changerobe.com or try to get its trademark revoked before it starts to say we can't use the term change robe? Would that matter?

If change robe becomes *the* search term, we are fighting a losing battle over time surely unless we can own that term too.

Will we ever win over the URL and domain name?

These are big questions as we set up the strategy for IP.” (emphasis in the original)

48. Ms Knott for the Defendant put to Mr Bright in cross-examination that his references to “*the game has changed*”, and querying whether they should “*not worry about genericide if we always own the dryrobe.com domain*” are evidence that before this email he had been allowing the use of ‘dryrobe’ as a category term. He denied it, saying that if they had ever noticed somebody tagging #dryrobe when it was not a dryrobe, they had spoken to them. The contemporaneous documentation including inter alia, the contemporary logs of social media contacts mentioned above, supports his evidence, in my judgment. I am satisfied that the Claimant had since 2019 regularly, systematically and consistently been searching for, and challenging, use of ‘dryrobe’ as a category term on social media and in the press, as he has described. Mr Bright described the social media use in particular as “*quite easy to monitor and police*”, which I accept, and saying “*I would be really interested to know how many got through the net*”, implying that he did not think it would be many. I also accept that is more likely than not to be true, given the systems the Claimant has put in place.
49. Mr Bright in cross-examination described the questions he posed in the email above as “*a thought experiment*” about whether the Claimant’s approach of publicising ‘change robe’ and ‘changing robes’ as the category terms was still the correct approach once a competitor had bought the changerobe.com domain, saying “*...it makes you have to think about all scenarios, I suppose*”. I also accept that evidence. I am satisfied the purchase of changerobe.com by a competitor had prompted discussions of whether their approach remained correct for at least 11 months.
50. Ms Knott then put it to Mr Bright that the reason he was discussing genericide in this email in August 2021 was because it was already in the process of happening, and he also denied it. He said that it was “*on his radar*” that genericide “*was a thing*”, but that he did not think that it was something he had to worry about. I do not accept that latter point. It is clear that it was something that he had to worry about, and he had in fact been worrying about it since the “*education*” he had received in 2019, which caused him to put in place the

systems and take the actions described in paragraph 42 above. In relation to the question of whether it was “*already in the process of happening*” by August 2021, I will, again, return to that when I deal with the issue of invalidity under section 3(1)(d) TMA.

Confusion with D-Robe

51. Mr Bright’s evidence is that he first became aware of the Defendant and its use of the D-ROBE Sign in 2021 when he saw the Defendant’s products in a social media post, and at around the same time he started getting text messages from friends and business contacts about the D-ROBE brand. He said some were asking if D-ROBE was the Claimant’s new range, others were concerned about how similar it was to DRYROBE and were ensuring he knew about it. Mr Bright’s evidence that D-ROBE is the most similar brand name of the third party brands competing in the changing robe space in the UK, and the one which is causing the most damage was not challenged in cross-examination. He said in his witness statement “*Pretty much every time I have a conversation about work, people are asking me whether I’ve heard of D-ROBE and what I’m doing to address them*”.
52. Mr Bright says that actual confusion in the marketplace is significant and noticeable. The Claimant has disclosed documentation which it relies on as evidence of actual confusion in consumers who have contacted the Claimant in relation to the Defendant’s products, and Mr Barclay has summarised 34 such examples at Annex 1 to his skeleton argument for trial. These date from March 2023 to May 2025. The majority involve customers of the Defendant seeking to return or exchange D-ROBE branded items to the Claimant. Others are asking about their order for a D-ROBE garment, or asking for assistance with repairs of a D-ROBE garment, or raising questions about D-ROBE discount codes. Some, when informed by the Claimant of their mistake, make their confusion clear: “*I’m so sorry! I got that so wrong. I thought it was a dry robe!*” (Ms JP August 2023); “*I am sorry, maybe I confused you with d-robe*” (Ms NL November 2023); “*Sorry is this not the same company its so confusing*” (Ms AR March 2024); “*D-Robe Outdoors it says – please could you confirm that is you*” (Ms LW September 2024); “*I thought you were them what is their contact*”

please I am not impressed at all” (Ms KK, January 2025); “How confusing I thought I had bought dry robe” (Ms AW March 2025).

53. Mr Bright said in his written evidence *“People are coming to us every few weeks, trying to return their D-Robes, thinking that D-Robe and Dryrobe are the same company. All those instances of confusion hurt your business and damage your reputation, particularly when it’s so easy for confused customers to post incorrect information on social media and for people to believe that its true. D-ROBE has also made allegations that our trade marks are generic and free to use by our competitors. These allegations are really damaging to us, not least because they set back the work we are doing to educate the market on the correct use of our trade marks”.*
54. Ms Knott put to Mr Bright in cross-examination that in several examples of correspondence between consumers and the Claimant in which the consumers are asking about the Defendant’s products, the Claimant did not appear to have provided the full conversation. She asked why the Claimant had not provided this disclosure in native format, despite the Defendant’s request. He did not have an answer to those specific cases, but said that there were plenty of examples in the disclosure where the full email exchange could be seen. I agree that although there do appear to be one or two examples where the full extent of the conversation has not been provided, that is in the context of many other examples where it is, and nonetheless the fact that those consumers are contacting the Claimant about the Defendant’s goods is clear such the quality of the evidence as evidence of actual confusion is not significantly undermined.
55. The Claimant also relies on documentation disclosed by the Defendant as evidence of actual wrong-way confusion, being seven occasions that the Defendant was contacted by consumers about the Claimant’s products. Mr Barclay has also set those out in Annex 1 to his skeleton for the Claimant. Ms Russell was asked about the Claimant’s evidence of actual confusion in cross-examination and made concessions which I will return to when summarising her evidence.

56. Finally, Ms Knott asked Mr Bright about redactions in the documentation disclosed, and took him to several examples, including the Claimant's brand guidelines of December 2022. After being given a warning from the bench about legal professional privilege, Mr Bright said only that those redactions had been made on legal advice that the information was irrelevant or confidential. I accept his evidence and that it was reasonable for him to rely on such legal advice. Ms Knott then took him to a document in which details of a customer's credit limit had not been redacted, and put it to him that in light of those examples the Claimant's approach to disclosure had been inconsistent and selective. I do not consider that submission to be well-founded. The Defendant made no submission about the effect of the redactions in the brand guidelines, which it did not otherwise refer to, and the fact that a single piece of confidential financial information of a customer could have been redacted but was not, in the context of a trial bundle running to thousands of pages, is insufficient to make good the Defendant's submission in my judgment.

The Defendant's evidence

Development of the Defendant's brand D-ROBE

57. I have summarised Ms Russell's evidence about the development of the D-ROBE brand and products in the introduction to this judgment. In her witness statement she said that the brand was pronounced "duh-robe" or "der-robe" but this was not pressed at trial. Ms Knott for the Defendant accepted that the general public would likely pronounce it "dee-robe".
58. I have mentioned in my introduction that Ms Russell in brand development had raised a concern with Mr Long, her graphic designer, about whether D-ROBE was similar to the well-known brand DUNLOP, and he felt that the similarity between DRYROBE and D-ROBE was "*more of a potential issue [than Dunlop] as they make the same product*". She addressed this in her witness statement, saying "*He felt, and I agreed, that the two names, and particularly our logo, were different enough to avoid any confusion.*" In cross-examination it was put to her by Mr Barclay for the Claimant that Mr Long did not say in that email that the two names were different enough to avoid any confusion, and

he had rather expressed that they might be too similar, but he was trying to use the wider branding to differentiate them. She initially disagreed, but then conceded the point.

59. Ms Russell was also taken to another email she sent to Mr Long on 30 January 2021 following his production of an early iteration of the Shield Sign without the D-Robe Sign within it. She said to him *“How do you incorporate the D-ROBE into the shield. That is I mean using the actual name of the brand within the secondary logo. So that is clear for a passer-by to see. In this way those wearing the item also advertise for you.”* Mr Barclay noted that after saying it was not necessary, Mr Long did go on to incorporate the D-Robe Sign within the Shield Sign after Ms Russell emailed him on 2 February 2021 saying she wanted it *“...as it helps with marketing and brand awareness. I often see items of clothing I like on people and always grateful when I can read/decipher the brand. I go on Google, check out the range and order. So with every sale we have another person advertising for us”*. Mr Barclay asked if Ms Russell had requested that change so that the brand D-ROBE and knowledge of the D-ROBE could spread through use of the Shield Sign. She agreed, saying that she intended that if someone asked a person wearing one of the Defendant’s change robe products where it was from, they could very easily indicate the shield on the breast so the enquirer could read it, or open the coat where the D-ROBE branding was much larger on the inside, to show them the D-ROBE brand.
60. In terms of chronology, Ms Russell’s evidence is that the Defendant used the D-ROBE name internally from around January 2021, she registered the d-robeoutdoors.com domain on 6 February 2021 and began trading on 1 March 2022.

The Defendant’s evidence of the Claimant’s market position

61. The Consultancy Collective branding presentation of March 2021 commissioned by the Defendant (and referred to in the introduction to this judgment) contained an image headed *“competitive landscape”* showing 12 competitor brand logos. That showed DRYROBE as one of the 12 featured brands. It showed a second image headed *“competitive landscape”*, this time

with the same 12 brands on the left of the image, D-ROBE in the centre, and another group of 19 brands to the right of the image. A clue as to the reason for the spatial separation of those two groups of brands is found at page 32 of the document where the same, second image is repeated with the question “*How do we bridge the gap and uniquely position D-Robe a[t] the intersection between functional and aspirational?*”. Some of the brands to the left (where DRYROBE is found) were featured elsewhere in the document as ‘functional’, and some to the right (including MONCLER) were featured elsewhere in the document as ‘aspirational’.

62. Ms Russell in cross-examination accepted that these images “*set out a series of well-known outdoors brands*”. She further accepted that at the time the document was created in March 2021 the Dryrobe Advance was a well-known product in the market, and DRYROBE was a known brand, but was initially unwilling to agree to the specific contention that the Claimant was a ‘well-known brand’ at the time (despite already having conceded that the brands featured, including the Claimant, were “well-known outdoors brands”). Nor would she concede that the Claimant was ‘a significant player in the outdoor clothing market’ or that was the reason the Consultancy Collective had included it within its analysis of the competitive landscape. Ms Russell first said that it was “*a smaller player than some of the very large ones featured in the branding presentation including Barbour and Superdry*” which may be true but did not answer the question; then she said that “*Dryrobe was on our radar*”, before admitting that she did not play a part in choosing the brands featured in the presentation; then she said whether it was a ‘significant’ player “*depended on how you defined ‘significant’*” which seemed to me to be ducking the question given the context was whether the Claimant was “well-known” at the time; then she said that she did not believe Consultancy Collective chose them because they were a well-known brand or significant in the market, but rather because they wanted “*a variety of brands with some being smaller than the others*”, which contradicted her earlier evidence that the image “*set out a series of well-known outdoor brands*”. It was put to her that Mr Salkeld in a section of his witness statement dealing with search engine optimisation had described the Claimant as “*a significant player*” in the change robe category, and she agreed

that was the case when his witness statement was produced in 2024, by which time she said the Claimant was “*the biggest player*” in the outdoor changing robe market, but she noted the branding presentation was produced three years earlier and would only concede that in 2021, the Claimant was known to the Defendant and Consultancy Collective based on market research.

63. I consider that to be an attempt to resile from the concessions she had really already made. I am satisfied on the evidence that the Claimant’s Dryrobe Advance product, the DRYROBE brand and the Claimant itself were all well-known to consumers in the outdoor changing robe market in 2021.

The Defendant’s advertising and marketing activities and sales figures

64. Ms Russell gives evidence about the Defendant’s advertising and marketing activities. This is of limited relevance to the issues I have to determine save that it shows that the Defendant in many ways took a similar approach to the Claimant (and no doubt to many other clothing brands) to building its D-ROBE brand: maintaining an active social media presence; working with a range of social media influencers; seeking press comment and engaging professional PR firms to do so; seeking endorsement from celebrities and those in the public eye. I have already set out her evidence in relation to number of orders and sales figures, and that this evidence has not been challenged. I accept it.

The Claimant’s evidence of actual confusion

65. Ms Russell was taken to a number of contemporaneous documents of communications between customers and the Claimant’s customer service channels which the Claimant relies on as evidence of actual confusion as summarised in Annex 1 to its skeleton argument. Ms Russell conceded that they include examples where:
- i) a customer of the Defendant had bought a D-Robe Beaufort and then sought to complain to the Claimant about quality and repair issues;
 - ii) over thirty of the Defendant’s customers contacted the Claimant seeking to return the Defendant’s products; and

- iii) a consumer complained to the Claimant that she was unable to use the Defendant's discount code "DROBE10" on the Claimant's website, apparently being confused into believing it was a Dryrobe discount code.
66. Ms Russell was also shown a Facebook post by a member of the public Ms MP, which includes a short video in which she sings the praises of the coat she is wearing, tags #dryrobe, and in response to a question in the comment about what brand the coat is, says "*Mines [sic] a dry robe make but you can get lots of other brands*". She is, in fact, as Ms Russell accepted in cross-examination, wearing one of the Defendant's products in the video, not one of the Claimant's. I am satisfied that Ms MP appears to have been confused into believing that her D-Robe coat is one of the Claimant's products.
67. In her witness evidence Ms Russell says that she is aware of one example of confusion where a customer of the Defendant struggled to place an order online, telephoned the Defendant saying she was not familiar with online technology, and was assisted by customer service to complete her order online. When she tried to return the garment received, she mistakenly sent it to the Claimant before later telephoning the Defendant and asking for assistance in printing off the Defendant's return label. I accept her evidence. It seems more likely than not that this was a customer who struggled with the use of computers and was confused by the process of online shopping generally, such that I cannot be satisfied on the balance of probabilities that it evidences confusion for the purposes of section 10(2) TMA. The same can be said, in my judgment, of a Mr NB who in November 2023 emailed the Claimant saying, "*Dear D-Robe...*" and, when corrected by the Claimant, said "*...sorry my mistake, old person and I didn't have my glasses on*". It appears likely that is some sort of typographical or administrative error arising from poor eyesight, and not section 10(2) confusion.
68. However, in her witness statement, Ms Russell sought to explain away the other, in my view extensive, examples of actual confusion relied on by the Claimant by saying: "*My strong belief is that the majority of incidents of confusion have resulted either from busy or inattentive people who simply do not pay attention when trying to contact a company or Googling for a particular company, or as*

a result of Dryrobe ads being shown in response to searches for D-Robe on Google. I do not think such people are reflective of the vast majority of customers". She goes on to say that "if someone types into Google 'D-Robe' or 'D-Robe Outdoors', Dryrobe's adverts appear prominently as a sponsored link often above our own website. This can lead consumers into clicking on Dryrobe's ads as one of the top results returned, particularly if they are in a hurry and because our coat falls into the category of a "dry robe" or "changing robe" and many people are familiar with these terms."

69. I am of course willing to accept that customers may at times be merely inattentive or make mistakes. I have accepted that in relation to the examples in paragraph 67 above. There is another example in the bundle where a customer of the Defendant emailed both the Claimant and the Defendant at the same time with a request to exchange her D-ROBE coat, and later told the Claimant she had realised her mistake as soon as she had sent the email. I am also willing to accept that consumers who search for one company may accidentally click on a sponsored link for a different company, served as an advert in response to that search. However in my judgment the evidence does not support either of these contentions as being a common or significant issue in this case for the following reasons:

- i) Neither of these theories provide the explanation for the brand confusion evidenced by Ms MP in respect of the coat she is wearing and recommending in her video. In cross-examination Ms Russell was taken to, and accepted, a number of other examples in which this is patently not what has happened including:
 - a) Ms AW, who emailed the Claimant trying to return one of the Defendant's products, and when told by the Claimant that she has emailed the wrong company, replied "*How confusing I thought I had bought dry robe*". Ms Russell accepted that if the customer thought she was buying a Dryrobe, she intended to land on the Claimant's website;
 - b) Ms JP, who sought to exchange a garment for another size, but the Claimant could not locate the order. She sent a banking receipt which showed the payment had been made to the Defendant, not the

Claimant. The Claimant responded *“You have purchased a changing robe from an external source D-Robe... you will have to get in touch with them”* to which Ms JP responded *“Thanks, is D-Robe dry robe? Or a different company?”*. When the Claimant confirmed it was an entirely separate company selling different products, Ms JP wrote back, *“Wow! I thought I was buying a dry robe product. I wild water swim and have a dry robe and a towel and thought I’d buy a coat too. I think they are ripping off your brand.”* Ms Russell accepted that Ms JP cannot have been confused by clicking the wrong link on the internet;

- c) Ms EJ, who sought to return a garment pursuant to an order number which the Claimant did not identify as their own. She provided some documents including the purchase receipt which Ms Russell accepted showed that the purchase was from the Defendant. When the Claimant told Ms EJ that she had bought from a totally different company and the product was not one of theirs, she responded *“I’m so sorry! I got that so wrong. I thought it was a dry robe!”* Ms Russell was initially unwilling to accept in cross-examination that this customer believed she had bought a Dryrobe when she had in fact bought a D-Robe product from the Defendant, but later accepted that was more likely than not to be the case, and that this customer had not been confused by clicking a wrong link, conceding *“She thought it was a Dryrobe product ... she thought it was the Dryrobe product or brand”*.
- ii) Ms Russell accepted in cross-examination that the documentation relied on by the Claimant as evidence of wrong-way confusion did indeed show consumers contacting the Defendant to ask about the Claimant’s products (e.g.: Mr JB, who sought advice from the Defendant about the sizing of the Claimant’s Dryrobe Advance; Mr RH who was seeking from the Defendant details of the address to return a Dryrobe Advance which was too big; and Ms JD who asked the Defendant about stock levels of a particular size and colour of Dryrobe Advance). In her witness statement and initially in oral evidence Ms Russell suggested that these customers may not have been computer literate, but when pressed in cross-examination she accepted that they all contacted the Defendant by email, not by telephone, and so conceded that they appeared to know how to use a computer and were confused.

- iii) Apart from the few examples I have identified, there is little evidence of administrative confusion, or actual confusion which is not brand confusion. The remainder are consumers contacting the Claimant about the Defendant's goods or services (such as discount codes), or vice versa. On occasion, they ask about both, evidencing, in my view, confusion that both parties' goods have emanated from the same source. For example, Ms LE sent a message to the Claimant on Facebook asking, "*What is the difference between the Advance and the Beaufort?*", the Dryrobe Advance being the Claimant's changing robe and the Beaufort being the Defendant's. When told by the Claimant that they could not give her information about the Beaufort as it was not their product, she replied "*dryrobe oh so D-Robe is that not you?*".
 - iv) Mr Salkeld gave evidence and exhibited a report from the Defendant's Google account dealing with how often, following a search for "*d-robe and similar terms*", Google ads served a sponsored ad linking to the Claimant's website dryrobe.com which appeared above the Defendant's own ads. He said, "*This shows that for 28.37% of searches, the Claimant's dryrobe.com appeared as a sponsored ad, appearing above our own ads in 11.78% of searches when both the Claimant's and our ads appeared.*" At very best, then, only 3.34% of such searches would have the Claimant's ad above the Defendant's such that Ms Russell's theory could possibly be relevant.
70. Ms Russell in her witness statement also notes that the Defendant has had at least two consumers confuse the D-ROBE brand with a completely different brand altogether, being Sundfoerr. She says she cannot not explain it, saying "*Sometimes, some consumers just get confused*". However in cross-examination she accepted that at least one of the consumers said they were given the Defendant's contact details by Sundfoerr, and that the Defendant did not investigate that. In those circumstances her evidence is of little assistance.

E. Average Consumer

71. There appears to be no dispute between the parties about the identity of the average consumer in this case. Per *Jack Wills v House of Fraser* [2014] 110 (Ch), [2014] FSR 39 per Arnold J (as he then was), the average consumer is a

consumer of the goods or services for which the trade marks relied on are registered. The Marks save for the ‘195 Mark are registered in general categories of goods such as clothing, bags and hats and as such both parties accept that the average consumer is the general public in the UK. The parties agree that the average consumer in this case pays a moderate degree of attention when buying or considering a purchase of such everyday retail goods. I accept that he does, and am satisfied on the evidence before me about the Claimant’s sales channels that he often does so online.

72. The Claimant notes that the ‘195 Mark is registered for “changing robes”, “waterproof and windproof robes”, “robes, gowns and capes of towelling material” and “beach wraps”, so that it could be said that the average consumer in relation to that Mark is a member of the public who undertakes outdoor activities, but submits this is not a material distinction. I accept it is not.

F. Invalidity. Were the Marks validly registered and should they now be invalidated?

Law

73. Section 3 TMA provides, so far as is relevant, as follows:

3(1) The following shall not be registered-

...

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

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

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

74. Section 47(1) TMA provides as follows:

47(1) The registration of a trademark may be declared invalid on the ground that the trademark was registered in breach of Section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

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

75. Section 72 TMA provides that:

In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration.

76. It follows from registration being *prima facie* evidence of validity pursuant to section 72 TMA, that the burden is on the Defendant to satisfy the court to the civil standard that a reason or reasons for a declaration of invalidity exist under any these sections as at the relevant date for each registration, being the filing date for that registration. The burden then moves to the Claimant to satisfy the court to the same standard that each registered trade mark has acquired distinctive character either at the filing date per the proviso to section 3(1) TMA, or by the date of issue of the invalidity claim (being in this case the date the Defendant's counterclaim date was initially filed, being 11 November 2024) by the proviso to section 47(1).

Distinctiveness (section 3(1)(b)TMA) and Descriptiveness (section 3(1)(c) TMA)

77. Arnold J (as he then was) considered the authorities underlying an assessment of descriptiveness and distinctiveness (albeit under art.7(1)(b) and 7(1)(c) of the Council Regulation 207/2009/EC of 26 February 2009 on the Community trade mark, which are equivalent provisions and worded identically to section 3(1)(b) and (c) TMA) in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* [2012] EWHC 3074 (Ch), [2013] FSR 29 at [90]-[94], relying in particular on the summary of principles relating to distinctive character by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P)

[2011] E.T.M.R. 4 at [29] – [34], [37] and [45], and the summary of principles relating to descriptive character by the CJEU in *Agencja Wydawnicza Technopol sp z oo v OHIM* (C-51/10 P) [2011] E.T.M.R. 34 at [33], [36]-[39] and [46]-[50].

78. I will not set out those sections in their entirety here but I have them in mind and I apply them. I note in particular that per *BORCO-Marken-Import* at [31], for a trade mark to have distinctive character, it must be capable of functioning as an indicator of trade origin, and that (at [32]) distinctive character “*must be assessed, first, by reference to the goods and services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public*”.
79. *Agencia Wydawnicza* at [36] makes clear that each of the grounds for refusal must be interpreted in the light of the general interest underlying it, which in relation to Article 7(1)(c) (equivalent to section 3(1)(c)), is, per [37], “*that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services*” (from *OHIM v WM Wrigley Jr Co* (C-191/01P) [2004] 1 WLR 1728 and, per [38], in order to ensure that objective, it is “*not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes*” (per, inter alia, *OHIM v Wrigley*, at [32])).
80. The test is that a sign can be refused registration under, in our case, section 3(1)(c) “*only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics*” per *Agencia Wydawnicza* at [50], and if at least one of its possible meanings designates a characteristic of the goods or services concerned, per Arnold J at [92] of *Starbucks v BskyB* relying on *OHIM v Wrigley* at [32] and *Koninklijke KPN Nederland v Benelux-Merkenbureau* (C-363/99 [2004] ECR I-1619, [2004] ETMR 57 at [97]. It is irrelevant whether there are other, more usual signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (see *Agencia Wydawnicza*

at [39], from *Koninklijke KPN Nederland* at [57]). Arnold J further relied in [95] on the Court of First Instance's guidance at [27] of *Europig SA v OHIM* (T-207/06) [2007] ECR II-1961, that:

“...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see PAPERLAB, paragraph 25, and the case-law cited there).”

81. There is a measure of overlap between sections 3(1)(b) and 3(1)(c), but they are independent of one another. As stated in *Agencia Wydawnicza* at [33] and again at [46], if a sign is descriptive pursuant to, in our case, section 3(1)(c), it is also devoid of any distinctive character for the purposes of section 3(1)(b), but it may be devoid of distinctive character under section 3(1)(b) for reasons other than the fact that it is descriptive.
82. The Defendants rely on two cases which address the questions of distinctiveness and descriptiveness of novel products. The first is *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281, a case in which the plaintiff alleged infringement of its registered trade mark “TREAT” for dessert sauces and syrups in Class 30, which it had marketed and sold as “Silver Spoon Treat”. The defendant, who had launched a sweet spread called “Robertson’s Toffee Treat”, counterclaimed in invalidity. Jacob J held that “TREAT” was a sign capable of distinguishing British Sugar’s goods, but it was devoid of any distinctive character under section 3(1)(b) TMA as it consisted exclusively of a sign to designate the kind, quality and intended purpose of the product under section 3(1)(c) TMA (i.e. was purely descriptive) and probably had become customary in the English language within the meaning of section 3(1)(d) TMA (i.e. probably had become generic). British Sugar had not discharged the burden of proving under section 47(1) that the mark had acquired distinctive character in relation to the goods registered. At page 299 in a discussion of a section 11(2) defence to infringement and consideration of whether the defendant Robertson’s had used the sign “Treat” as a trade mark, Jacob J said:

“I turn to consider how the word “Treat” is used here. I have no evidence from the public in relation to this question. I have some evidence of internal

thinking at Robertson's but the most important thing of all must be my own impression from the label and all the surrounding circumstances. Looking at the label I think the average customer would not see "Treat" used as a trade mark. It is true that it is written as part of a phrase "Toffee Treat", but this is done in a context where the maker's name is plain. It is of course the case that you can have two trade marks used together (Ford Prefect), but whether the secondary word is used as a trade mark is a question of fact. If it is a fancy word, then obviously it is a trade mark because it could not be taken as anything else, but where it is highly descriptive, I see no reason why a member of the public should take the mark as a badge of origin. And that is particularly so where the product is a new sort of product, as here. The public are apt to take the name of a novel product as a description rather than a trade mark, particularly where the name is not fancy but is descriptive or laudatory. I do not think Robertson's use is as a trademark."

83. He went on to say at page 302 line 22:

"I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap, the word would not be distinctive of his goods. ... Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product, not a trade mark. Examples from old well-known cases of this sort of thing abound. The Shredded Wheat saga is a good example: the Canadian case is *The Canadian Shredded Wheat Co. Ltd v Kellogg Co of Canada Ltd*. In the Privy Council and the United Kingdom case *The Shredded Wheat Co. Ltd. V. Kellogg Co. of Great Britain Ltd*. In the House of Lords. In the former case Lord Russell said; "*A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else*". It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader. This is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark."

84. The second case relied on by the Defendant is *McCain International Limited v Country Fair Foods Limited* [1981] RPC 69 (the "*OVEN CHIPS* case") which was a passing off case relating to the plaintiff's introduction to the UK market

of oven chips, at that time a novel product, which it sold under the name “McCain Oven Chips”. The defendants launched their own oven chips products under the names “Country Fair Oven Chips” and “Birds Eye Oven Chips” respectively. They contended that the name “OVEN CHIPS” was descriptive of the product, that it had not subsequently acquired distinctiveness, and where a descriptive name had been applied to a product by the sole supplier of that product that name could not easily acquire distinctiveness. Templeman LJ explained the plaintiff’s submissions and his decision that the name was descriptive at page 72 line 37 to page 73 line 4:

“Mr. Harman, in a very forceful and if I may say so, very attractive argument, submitted that "oven chips" is a fancy name and not a phrase in common use in the English language, so that it will be associated with one particular manufacturer and not with a product. He said it is a novel phrase—and that is true; it has never been used before—that also is true. He castigated the phrase as an ungrammatical aggregate of two English nouns and said that it was nonsensical without an explanation. But in my judgment the words "oven chips", grammatical or not, constitute an expression which is an ingenious and apt description of the contents, namely, potato chips prepared for cooking in the oven; and although the consumer may not have been aware, and could not have been aware of what the expression meant until oven chips came on to the market, once they had come on the market he could recognise a name which is apt and appropriate to describe a produce rather than a manufacturer, the product being potato chips prepared for cooking in the oven. The fact that the name "oven chips" does not indicate that the chips may also be grilled is neither here nor there. The name does inform the consumer of what is inside the package so that he may know what he is purchasing.”

85. The Claimant relies on the Court of Appeal decision in *TVIS Ltd v Howserv Services Ltd* [2024] EWCA Civ 1103, [2024] FSR 34 (the “*VETSURE* case”) to support its case on non-descriptiveness of DRYROBE. However, as noted at [43] of the judgment of Arnold LJ, the validity of the claimant’s *VETSURE* trade mark had not been challenged by the defendant and so the question of descriptiveness was not fully argued either at first instance or on appeal. However, the judge at first instance had assessed *VETSURE* as having no distinctive character for the purposes of section 10(2) and 10(3) infringement, which assessment Arnold LJ described at [43] as “...leap[ing] from the

undisputed premise that the component parts of the Trade Mark are descriptive to the conclusion that the combination is descriptive. That does not necessarily follow.” Arnold LJ accepted the contention that VETSURE is an invented portmanteau word which is not to be found in any dictionary and went on to assess VETSURE as having a low – medium level of inherent distinctive character for the reasons set out at [43]:

“It certainly alludes to pet insurance, as TVIS accepts, but it does not describe it. For example, it could be understood to allude to professional indemnity insurance for vets, although again it does not describe such a service. It could also be understood to allude to something that does not involve insurance at all, such as a certification scheme for vets (“be sure of your vet”). Furthermore, it is on any view not descriptive of TVIS’s pet health plans... Indeed at one point in his submissions, counsel for Howserv went so far as to say that VETSURE and PETSURE “don’t have a meaning as such”.”

86. The Claimant also relies on the CJEU decision in *Procter & Gamble v OHIM* Case C-383/99P, [2002] Ch. 82 (the “*BABY-DRY* case”) in which Procter & Gamble applied for registration of *BABY-DRY* as a Community trade mark for baby’s nappies. An examiner refused it on the ground that, the purpose of nappies being to keep babies dry, the mark consisted exclusively of a sign or indication which designated the intended purposes of the goods such that registration was precluded. Following a number of intermediate stages, the matter came before the CJEU who allowed the applicant’s appeal. It held that it was relevant to consider whether the word combination or portmanteau would be “*a familiar expression in the English language*” either for designating the goods for which the marks are registered or for “*describing their essential characteristics*”, and that the determination “*depends on whether the word combination in question may be viewed [by the average consumer] as a normal way of referring to the goods or of representing their essential characteristics in common parlance*”.
87. The Defendant asks the court to exercise caution in respect of *BABY-DRY*, relying on and adopting the criticisms made of the case in Kerly’s *Law of Trade Marks and Trade Names* 17th edition at 10-105, in which the editors say in terms that “*parts of it are wrong and the remainder requires substantial qualification*

by reference to later Court of Justice judgments such that “it would be best if we were able simply to forget about BABY-DRY”. Ms Knott asks me to disregard it and consider and apply *OHIM v Wrigley* instead. Mr Barclay for the Claimant submits that it remains an extant decision of the CJEU which binds me as it has not been overruled, and is cited by Advocate-General Jacobs at 18-22.

88. I accept the *BABY-DRY* case remains an authority which binds me. All of these cases turn on their own facts. I have set out the test and principles which apply to my assessment of descriptiveness and distinctiveness at paragraphs 77-81 above and I will apply them to reach my conclusion.

Customary in the current language/generic (section 3(1)(d) TMA)

89. There does not appear to be any dispute on the law. In the context of an invalidity counterclaim, the Court must assess whether the relevant registered trade mark was customary for the purposes of section 3(1)(d) TMA as at the filing date of that trade mark. The General Court in T-322/03 *Telefon & Buch Verlagsgesellschaft GmbH v EUIPO* at [49]-[52] made clear that such an assessment must be carried out firstly by reference to the goods and services in respect of which the relevant mark is intended to be (or in the case of an invalidity counterclaim, is) registered, and secondly, on the basis of the average consumer’s perception of the mark. There has been no suggestion before me that perception in the trade has any relevance in this case, the parties’ goods being sold, in the main, direct to the public.

Acquired distinctive character

90. There is no dispute in relation to the law. If a trade mark was registered in breach of any of the absolute grounds set out in section 3 TMA, it shall be declared invalid, subject only to the exception that it will not be declared invalid where the ground for invalidity is section 3(1) (b), (c) or (d) TMA and it is shown that, in consequence of the use made of it, the mark has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

91. The Claimant relies on the guidance of Arnold J (as he then was) at [57] of *Société des Produits Nestlé SA v Cadbury* UK [2016] EWHC 50 (Ch), [2016] affirmed by the Court of Appeal at [16]-[22] and [52] of [2017] EWCA Civ 358, [2017] FSR 34. The Defendant cites Arnold J (as he still was) in *Frank Industries Pty Ltd v Nike Retail BV* [2018] EWHC 1893 (Ch), [2019] ETMR 4 at [72]-[76]. These cases summarise in guidance to the court the law deriving from the authorities referred to within them including, in particular, *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huer & Franz Attenberger* Case C-108/97 [1999] ECR I-2779, [2000] Ch 523 and *Koninklijke Philips Electronics NV v Remington Consumer Products Limited* Case C-299/99 [2002] ECR I-5475. That is that, in assessing whether a trade mark has acquired distinctive character, it must make an overall assessment of the relevant evidence which includes the nature of the mark itself (including that it does or does not contain an element descriptive of the goods or services for which it has been registered), but may include: (i) the market share held by goods bearing the mark; (ii) how intensive, geographically widespread and long-standing the use of the mark has been; (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor; (v) evidence from trade and professional associations (I pause to note there is none in this case); (vi) where the court has particular difficulty in assessing the distinctive character, an opinion poll (again, there is none in this case).
92. The assessment is again made through the eyes of the average consumer.
93. If, on the basis of that assessment, the court finds that the relevant class of persons, or at least a significant proportion of them, identifies goods as originating from a particular undertaking because of the trade mark, (in other words that the trade mark itself is fulfilling the origin function) then it has acquired sufficient distinctiveness to meet the requirements of registration/defend against a finding of invalidity and an order for revocation.

Submissions

Section 3(1)(c) TMA

94. The Defendant submits that the word DRYROBE and the figurative mark for it are descriptive of the goods for which they are registered; that they have no inherently distinctive character and are incapable of being viewed as a brand name by a significant proportion of the public, and so they should never have been registered. In particular, it submits, there is a sufficiently direct and specific relationship between the Marks consisting of the word ‘DRYROBE’ and the goods and services for which they are registered (including clothing) which “*allows the average consumer immediately to perceive, without further thought, a description of the goods ... in question or one of their characteristics*” (per Arnold J quoting *Europig* in *Starbucks*).
95. Ms Knott for the Defendant describes DRYROBE as being a straightforward combination of two ordinary English words, with no fanciful nature attached to it, to describe a robe which dries the wearer or user and so designates the intended purpose and kind of goods such that the *Europig* test is satisfied. The Defendant submits that the novel nature of the Claimant’s product reinforces the descriptiveness of the Marks.
96. The Defendant submits that although a consumer may not have known what a dryrobe was prior to the Claimant’s product being put on the market, once that product had been launched, that consumer could recognise the aptness and appropriateness of the name and, per *British Sugar*, take it as a description rather than a trade mark. It submits that because DRYROBE is an apt description of the product, this is an OVEN CHIPS -type case. Ms Knott in closing submissions reminds me that there is no requirement that the relevant mark be in use at the date of its filing or that there be a real, current or serious need to leave the mark free, and that it is irrelevant that there are other, more usual, ways of describing a product.
97. Although the Defendant accepts there is no requirement under section 3(1)(c) TMA for there to be evidence of the use of the Marks in a descriptive sense, it has pulled out into a 33 page annex to Ms Knott’s skeleton argument for trial (“**Defendant’s Annex 2**”) quotes or extracts from documentation in evidence

which it submits shows that the general public understands the Marks to be descriptive. Ms Knott submits for the Defendant that this “*reinforces the descriptive character*” of the Marks as does, she submits, Mr Bright’s acceptance in cross-examination that DRYROBE was a good name for a robe which dries or which keeps you dry. I am not with her on the latter point. Mr Bright is not in the position of the general public in relation to the Marks to be able to evidence the average consumer’s perception of them. On the former point, I have considered that evidence but exhibit caution to the extent that the quotes relied on relate to actual use made of the Marks. As noted in *Kerley’s Law of Trade Marks and Trade Names* at 10-034:

“...in *Mag Instrument* [(Shape of a Torch) Case C – 136/02 7 October 2004 ECJ at [50]], the court stated the well settled proposition that, when assessing whether a mark has distinctive character, the assessment must be carried out in relation to the presumed expectations of an average consumer of the goods or services in respect of which registration is sought. Nonetheless, the court accepted that evidence based on the actual perception of the mark by consumers may provide guidance, and continued:

“However, in order to contribute to the assessment of the distinctiveness of a mark for the purposes of Article 7(1)(b)..., that evidence must show that consumers did not need to become accustomed to the mark through the use made of it, but that it immediately enabled them to distinguish the goods or services bearing the mark from the goods or services of competing undertakings.””

98. The Claimant submits that the Marks are not descriptive of the goods for which they are registered in the sense set out by Arnold J in *Starbucks*. It submits that DRYROBE is a word invented by the Claimant which is, at most, allusive but which could refer to many other things, for example dry-cleaning ceremonial robes; that it is not used in ordinary English language to describe clothing, hats or changing robes; and it was not a familiar description in the English language at all at the time that it was coined by Mr Bright. It submits that the public would not perceive, without further thought, the word DRYROBE to be a description of any of the goods for which the Marks are registered. The Claimant submits that it may be allusive of one subsection of goods for which it is registered, but it is not wholly descriptive. The Claimant reminds the court that BABY-DRY for nappies and VETSURE for pet insurance were found not to be wholly

descriptive and did have distinctive character. The Claimant submits that although its inherently distinctive character may be only medium or low, DRYROBE falls on the VETSURE side of the line as it is not wholly descriptive.

Assessment

99. It is neither party's case that the figurative elements of the '826 Mark add anything to the distinctiveness of the '826 Mark. I am asked only to assess on the basis that the average consumer will perceive all of the Marks as the word DRYROBE.
100. I accept that this is a portmanteau word created out of the words DRY and ROBE which are ordinary English words. DRY is well-understood. The Oxford English Dictionary describes 'robe' as a noun being "*a long, loose outer garment reaching to the ankles*" and as a verb being to "*clothe in a long, loose outer garment*".
101. In my judgment DRYROBE cannot reasonably be considered to be descriptive of the goods for which each of the '428 Mark, '826 Mark and '456 Mark is registered in Class 18 ("Bags") or in respect of "Hats", "Beanies" or "Beanie Hats" in Class 25 and the average consumer would not recognise it as descriptive of those goods. It is a portmanteau word which does not describe one or more characteristics of those goods. Although one intended purpose and characteristic of a bag or a hat may be to keep dry the contents of the bag, or the wearer's head, respectively, the average consumer perceives the mark as a whole. The descriptive element of the mark ('DRY') when combined with the non-descriptive element ROBE (in the context of bags and hats) means the mark DRYROBE has no descriptive meaning in relation to such goods. I remind myself that the wording of section 3(1)(c) TMA provides that it is only "*trade marks which consist **exclusively** of signs or indications which may serve to designate the... characteristics of goods or services*" which are ineligible from registration under this section. Accordingly I do not consider that there is a sufficiently direct and specific relationship between the Marks consisting of the word 'DRYROBE' and those goods which "*allows the average consumer*

immediately to perceive, without further thought, a description of the goods... in question or one of their characteristics”.

102. I take a different view in respect of the remainder of the goods for which the Marks are registered, as set out in Table 1. Those include in respect of the ‘195 Mark “Changing robes” “waterproof and windproof robes” “robes, gowns and capes of towelling material” and “beach wraps” in Class 25, and in respect of the other Marks, “Clothing” in Class 35 and “Clothing” “Waterproof clothing, Sports clothing” and “Beach clothing” in Class 25. In my judgment:

- i) ROBE is a long loose garment or outer garment; DRY is an intended purpose of such a garment in both senses of ‘to dry’ the wearer and ‘to keep dry’ the wearer. As such, DRYROBE is easily recognisable by the average consumer as descriptive of at least one characteristic of the goods set out above, namely of being a robe which dries or keeps dry the wearer;
- ii) this goes beyond mere allusiveness, per VETSURE, and falls squarely into descriptiveness in my assessment;
- iii) although in this case the characteristic of the goods registered (being robes that both dry and keep dry the wearer) are in fact very significant commercially to the Claimant in relation to its “hero product” the Dryrobe Advance, the authorities make clear that the *Europig* test extends to any characteristic of the goods or services for which the mark is registered irrespective of how significant the characteristic may be commercially;
- iv) the fact that at the time of the registration of the ‘195 mark the word DRYROBE was not actually in use by the relevant public is not relevant (per *OHIM v Wrigley* at [32]). In my assessment, at that time it could have been used to designate a characteristic of the goods or services. In respect of the of ‘428 Mark, ‘826 Mark and ‘456 Marks, by the time of registration they were in use to designate a characteristic of the goods or services for which they were registered;
- v) although DRYROBE could be understood by the average consumer to have other meanings, as the Claimant submits, it is sufficient that at least one of

its possible meanings designates a characteristic of the goods or services concerned per *Starbucks* at [92];

- vi) similarly, the fact that the same goods could be described in a different way (e.g. changing robe, change robe, swim parka), or even are more usually described in a different way, is not relevant per *Agencia Wydawnicza* at [39].

103. To expand on (ii) above, I have considered carefully whether I have fallen into the mistake identified by the Court of Appeal as being made by the judge at first instance in the *VETSURE* case, namely concluding that merely because the component parts of the word DRYROBE are descriptive words, the combination of those words is descriptive of the goods and services for which the Marks are registered. I do not believe I have. The Court of Appeal disagreed with the proposition that VETSURE was descriptive as although it alluded to pet insurance, it did not describe it and did not describe the claimant's health plans. In my judgment DRYROBE does not merely allude to "Changing robes" "waterproof and windproof robes" "robes, gowns and capes of towelling material" and "beach wraps" "Clothing" "Waterproof clothing, Sports clothing" and "Beach clothing", all of which categories encompass a robe which dries or keeps dry the wearer, it describes them.

Section 3(1)(d)

104. The relevant dates for the assessment in respect of each Mark are the relevant filing dates set out in Table 1 above. The Defendant relies in particular on the evidence quoted in Defendant's Annex 2 to support its case under section 3(1)(d) TMA. As mentioned previously, this is a 33 page tabulated list compiling excerpts from documentation in evidence. However, at least 19 pages of this list relate to excerpts of evidence which are dated later than the latest relevant date of 2 December 2022 (being the filing date for the '456 Mark in respect of Classes 25 and 35) so I do not take that evidence into account in carrying out my section 3(1)(d) TMA assessment. Some (but not all) of this is relevant to the question of acquired distinctiveness and the section 46(1)(c) revocation counterclaim, where the relevant date in each case is the date of filing the counterclaim of 11 November 2024, so I will consider it for that purpose. At

least 4 further pages relate to excerpts from entirely undated evidence, such as print outs from competitor websites. As it is undated it cannot inform my section 3(1)(d) TMA assessment, or my assessments of acquired distinctiveness /section 46(1)(c), so I do not take that evidence into account at all.

‘195 Mark

105. The Defendant accepted in its skeleton for trial that there is no evidence before the Court that the term ‘dryrobe’ or ‘dry robe’ was customary in the language or used generically before the ‘195 Mark filing date (9 April 2013) and in closing Ms Knott confirmed that it does not to pursue a section 3(1)(d) TMA challenge on this basis.

‘428 Mark

106. In the Defendant’s Annex 2 I have found only two examples of what the Defendant relies on as generic use before the 28 June 2019 filing date of the ‘428 Mark:

- i) The first is from the Claimant’s own YouTube account dated 28 November 2013, in which the Claimant has posted a video captioned “*Some of the UK’s best surfers put their dryrobes through their paces*”. However, in the video all the changing robes shown appear to be their own heavily branded Dryrobe Advance product. Accordingly I do not consider this is generic use at all, as the Claimant is referring to its own products and so using ‘dryrobe’ in the trade mark sense, as a mark of origin.
- ii) The second is from a feature article from The Times of 9 June 2019 about the author’s experiences swimming between the Scilly Islands. Within it he says, that he is wearing a rash vest and a wetsuit: “*And above all this, a thick, boxing-style dry robe*”. He later says “*...we return our bags and dry robes and inch down the slipway*”. I am also not satisfied on the balance of probabilities that this is generic use. There are no photographs of the robes the author has referred to, and there is nothing else in the article which would lead me to draw the inference that the participants are using a competitor’s products such that this is generic use. Accordingly this does not provide any

support for the Defendant's case under Section 3(1)(d) TMA, for which it bears the burden of proof.

107. The lack of evidence of generic use by the relevant date means that the Defendant has failed to satisfy me that at the time of filing the '428 Mark DRYROBE had become in customary use by the general public so it was incapable of operating as a mark of origin for the goods for which it was registered.

'826 Mark and '456 Mark

108. In respect of the '826 and '456 Marks, the relevant filing dates are 7 February 2022 and 2 December 2022 respectively. Neither party suggests that there is any material difference between these two dates for the purposes of this assessment so I will consider the position as at the later date of 2 December 2022.
109. There are a number of examples in the Defendant's Annex 2 of generic use of the terms 'dryrobe' and 'dry robe' in publications, and in responses of social media posters to the Claimant's communications requesting them not to use 'dryrobe' generically but use the category term 'changing robe'.
110. In terms of publications from the relevant time, there is one in which the use is generic in relation to a third party product: "*Red Paddle has launched a new microfibre dry robe that's a whole load more compact...*" (Smarter Living, 7 October 2021).
111. However there are also press articles:
- i) from outside the jurisdiction (USA, Scotland, Ireland) with no evidence provided about readership in England & Wales and so I do not take them into account;
 - ii) which do not appear to use the term 'dryrobe' or 'dry robe' generically, or where it is not clear whether it is being used generically or as a reference to the Claimant's products, which I also discount:

- a) *“I used to take the mickey out of ‘dryrobes’, but they are brilliant... they start from around £45 and go up to around £140, from dryrobe”.* (the Guardian, October 2020). That appears to be referring to the Claimant’s products as it directs readers to the Claimant, and only the Claimant, for purchase;
 - b) *“I donned my dry robe and got out of my wet gear”* (50shadesofbrave, May 2021);
 - c) *“I’m now fully fledged with a dry robe that was found for me ‘as new’ for half the price on a selling site”* (Mental Health Swims, June 2021);
 - d) *“I’m not a “wild swimmer”, I don’t own a dry robe or bang on about icy seas curing everything....”* (The Times, May 2021);
 - e) *“...how a dry robe or a waterproof changing robe helps when wild swimming”* (the Shields Gazette, May 2022);
- iii) which use the term generically whilst also making clear their understanding that it is also a brand such that they do not provide support to the Defendant’s contention that DRYROBE was incapable of functioning as a brand name by the relevant date:
- a) *“What is a “dryrobe” you might ask – and so did I... A dryrobe is an extremely useful towel/coat combination... its generic term derives from its earliest iteration, the Dryrobe TM”* The Saturday Telegraph, March 2021;
 - b) *“Fast becoming the Hoover of changing robes, Dryrobe is the market leader here”* (YachtingWorld, October 2022);
 - c) an article from 220 Triathlon Magazine of 1 November 2019 which has a photograph of a Dryrobe Advance under a large heading *“Dryrobe Advance Long Sleeve”*, some text and then a flash box giving a highlighted score of 88% saying *“**Verdict** Not the cheapest, but still the best cold-water swimming robe around”*. The text the Defendant relies on says *“Hoover, Play-Doh, Pot Noodle... Not just some of our fun weekend picks but brands who, like Dryrobe, dominate a sector so much they become a generic term for a product.”* The remaining text refers to *“Dryrobe”* twice more (capitalised) and finishes *“dryrobe.com”*. In my judgment the author could not be making it clearer to his readers that Dryrobe is a brand name for a product he identifies as a *“cold-water swimming robe”*;

112. In terms of social media posters whom the Claimant has approached to seek to persuade not to use DRYROBE generically in the relevant period:

- i) there about a dozen or so examples where the response makes clear they were not aware that DRYROBE was a brand and believed that it was a product category. For example: *“I somewhat viewed it as a category of clothing”*; *“I thought that the similar products overall are called dryrobes”*; *“I did not realise this # was an actual brand! It was just a generic term we used.”*; *“Sorry for the #dryrobe confusion! I have edited it out but honestly thought that was the generic name for these robes that keep you dry...”*; *“I’m so used to the generic term of dryrobe from the camping and paddleboard scene I didn’t even think about it.”*;
- ii) However, there are a number of examples where although the use is generic, the responses show in my judgment that they were aware DRYROBE was also a brand. For example: *“I guess dryrobe is now a popular term for changing robe as you say.”*; *“You’ve become so synonymous with swim robes”*; *“Apologise, I have a dryrobe and just call them all dryrobes”*; *“It shows how influential your brand is that this is what we thought they were called.”*; *“I guess you suffer (and benefit) a little from being the “Hoover” of the category... a brand and also a product descriptor”*; *“dry robes... well its like hoovers isn’t it, its become the generic (have you looked up how many companies this has happened to?? It’s a mark of your success).”*.

113. The Defendant submits that Annex 2 to the Defendant’s Skeleton contains a plethora of examples of generic use of ‘dryrobe’, much of which, it submits, arises out of the Claimant’s own enforcement actions, the responses to which provide valuable evidence of the average consumer’s perception of use.

114. The Defendant acknowledges that some of the evidence relied on shows mixed use of ‘dryrobe’ as a generic term with an acknowledgment of the existence of the Claimant’s brand, but submits that is not enough to sway the assessment of generic use. It submits that ‘dryrobe’ has come to stand for all products of that type by the relevant date.

115. The Claimant accepts there is evidence of generic use of ‘dryrobe’ before the relevant dates, but submits that the fact that there is such generic use is not itself sufficient to prove that ‘dryrobe’ was incapable of functioning as a brand name on those dates.
116. I am with the Claimant. I have found in the context of my ‘428 Mark assessment that there is before me very little evidence of generic use of the terms ‘dryrobe’ and ‘dry robe’ before June 2019. As explained, I have found that much of Annex 2 post-dates the relevant date for the purposes of this assessment. Although I am satisfied that there is some evidence of increasing generic use of those terms after June 2019 and before December 2022, the list of examples which unequivocally use of the term ‘dryrobe’ generically is relatively small, particularly in the context of the Claimant’s sales volumes, which was the highest it has ever been in 2021, within the period of this assessment.
117. I have accepted Mr Bright’s evidence about the strategy that he put in place from 2019, with assistance from specialist lawyers and internal and external PR advisors, to combat against such use in the press and on social media and that this strategy was rigorously implemented from late 2020. I have rejected the Defendant’s submissions that the Claimant has used the word ‘dryrobe’ generically from the outset (in the context of the 2013 YouTube video; the sarcastic internal email about becoming a dryrobe.com superstore; and the internal emails over almost a year wrestling with whether to continue to inform people that the category term was changing robe after a competitor bought the changingrobe.com domain).
118. I also take into account the marketing and advertising spend up to the relevant date, and the very prominent appearance of ‘Dryrobe®’ as a large logo across the back of the Claimant’s ‘hero product’. I accept the Claimant’s submission that this serves as a prominent advertisement which serves to educate the general public that DRYROBE is a brand name every time a Dryrobe Advance is worn in public. That was also the view that Ms Russell set out to communicate to her brand designer (albeit in the context of placing the D-ROBE Sign on the outside of the Beaufort coat) and accepted in cross-examination.

119. It does not follow from the mere fact that a section of the relevant public uses a mark generically in the relevant period means that it has become customary so that it is incapable of functioning as a trade mark. As Mr Barclay submits, many (and perhaps most) of the general public in this jurisdiction, use the word “google” generically, as a verb to describe an internet search (including, I am sorry to say, the witnesses, counsel and judge in this case during this trial), but that is not to say that a significant proportion who do so are not fully aware that Google is a brand name and a mark or origin.
120. I have considered the target public’s perception of ‘dryrobe’ in the relevant period through the eyes and with the expectations of the average consumer in light of the evidence before me and whilst acknowledging the submission made by the Defendant that the descriptive nature a brand can hasten its slide into genericism. I am not satisfied that, in this case, the Marks were not capable of fulfilling or had lost their function of distinguishing the goods and services of one undertaking from those of other undertakings by the relevant date. In my judgment a significant proportion of persons with the characteristics of the average consumer (being reasonably attentive members of the general public) recognised and understood DRYROBE as a brand name in December 2022.

Acquired Distinctive Character

Submissions

121. The Claimant makes submissions that the Marks had acquired distinctive character by the date of the counterclaim in November 2024 on six main heads:
- i) **The volume of sales** of, in particular, the Dryrobe Advance and **the appearance of the Marks** on that garment acting as a form of advertising every time the coat was worn. Mr Barclay for the Claimant submits that with 750,000 orders for DRYROBE branded goods between 2017 and 2024, with the Dryrobe Advance being the main product, all of which will likely have been worn outdoors, it is likely that millions of members of the public will have seen the DRYROBE Marks clearly presented as a brand name on items worn by others;

- ii) **The Claimant's market position.** Although there is no evidence before me of the size of the changing robe market, or the outdoor clothing market, the Claimant submits that Mr Salkeld's evidence that the Claimant was a significant player in the market in 2024 and Ms Russell's admission in cross-examination that DRYROBE was "*the biggest player in the [UK changing robe] market in 2024*" answers the point.
- iii) **The sheer volume of media coverage of DRYROBE as a brand** which, per Arnold LJ in *Re: Oska's Trade Mark* [2005] RPC 20 serves two purposes: (a) showing how well known the DRYROBE brand was at the time of the press coverage; and (b) serving to increase and widen that knowledge. This includes: (a) an article in the Telegraph of January 2021 stating "*It is official: Dryrobe is the most wanted coat in Britain*"; (b) The Guardian featuring a photograph of a Dryrobe Advance on the front page of the Saturday edition with the headline "*The swim robe that swept the high street*"; (c) an article in the Independent in August 2024 describing DRYROBE as "*the best-known changing robe brand*"; (d) an article in Good Housekeeping of September 2024 saying "*Dryrobe is one of the most popular brands on the market*"; (e) the 220 Triathlon magazine article referenced previously which described DRYROBE as a brand which "*dominate[s]*" its market sector. There are many more;
- iv) **The extensive sums spent by the Claimant on marketing**, including just under £2m in 2023 and just under £3m in 2024, and Mr Bright's evidence on how those marketing efforts were focussed on building the brand (summarised in the introduction to this judgment) which was not challenged;
- v) **Direct evidence from members of the public** showing that they understood and used DRYROBE as a brand identifier, including:
 - a) a Facebook thread in which a consumer asks whether she should choose a Dryrobe or a D-Robe product: "*I've been looking at the Dryrobe and the D-Robe. I can't decide which is best? Any advice???*". One person replied saying "*no idea what a D Robe is but Dryrobe are the best.*". Another said "*I felt that the Dryrobe was*

really big...on the other hand The DRobe was still roomy but slightly more fitted”;

- b) a consumer messaged D-Robe saying “*forever procrastinating whether to take the jump from Dry robe! Convince me!*”;
 - c) a consumer messaged D-Robe and said “*Heard so much about dryrobe that in rain and wind ski jacket is not good. I never had one or thought they silly in town. But someone mentioned d-robe that no big logos...*”;
 - d) a consumer messaged D-Robe asking “*what sets this robe apart from the dryrobe company product*”;
 - e) Online reviews of D-Robe in which consumers compare D-Robe products to those of Dryrobe and other brands.
- vi) **Evidence of actual confusion by consumers** already referred to, (plus additional evidence from Annex 2 to the Defendant’s skeleton to the extent that pre-dates the assessment date) per the *VETSURE* case, where Arnold J held that evidence that people holding PETSURE insurance policies were phoning the claimant’s VETSURE brand was evidence that VETSURE was a brand name.
122. The Claimant submits that making an overall assessment of the relevant evidence, the Court can be satisfied that in November 2024 at least a significant proportion of the general public continued to identify goods bearing the Marks as originating from the Claimant because of those Marks, such that it has sufficient acquired distinctiveness to maintain its registrations of those Marks, which fulfil their origin function.
123. The Defendant submits that acquired distinctiveness is not made out on the evidence. It relies on the cautionary words of Jacob J (as he then was) in *British Sugar*:
- i) at page 306, when he said “*In the case of common or apt descriptive or laudatory words compelling evidence is needed to establish [acquired*

distinctiveness] and in particular mere evidence of extensive use is unlikely to be enough on its own. Of course the power of advertising may be able to turn almost anything (save a pure description) into a trade mark, but it must be shown in a case of this sort that the mark has really become accepted by a substantial majority of persons as a trade mark – is or is almost a household word.”; and

- ii) At page 302, when he quoted Lord Russell from *Shredded Wheat* (extract at paragraph 81 of this judgment).
124. The Defendant submits that it is particularly difficult to establish acquired distinctiveness when you have a word which is apt to describe the product per *British Sugar*, where compelling evidence is needed to establish it, and mere extensive use is unlikely to be enough on its own. It submits that in this case there is insufficient evidence to show that the Claimant has established a second meaning within the Marks, established through the use to which it has been put. It submits that it is particularly difficult to fix a descriptive mark as a badge of origin in the mind of the average consumer if, as was the case with the Claimant, you have changed the logo in 2022 following the Superdry dispute, as that would “*all get muddled in the sea of generic use*”. On this point, however, I have accepted Mr Bright’s evidence that consumers did not appear even to notice the logo change, to his chagrin as a graphic designer.
125. In the Defendant’s skeleton, criticisms are made of a number of matters, including the sales and marketing figures provided by the Claimant, and the geographic extent of sales/marketing within the UK but these criticisms were not put to Mr Bright in cross-examination so he could answer them and were not pressed in closing. All of the evidence that I have seen and summarised suggests that the geographic extent of both sales and marketing/advertising by the Claimant is nationwide.

Assessment

126. I have found that the Marks in relation to which I am assessing acquired distinctive character are descriptive in relation to some of the goods for which they are registered. This is the context against which I carry out this assessment.

127. I consider that the relevant evidence for the purposes of assessing acquired distinctiveness includes the matters relied on by the Claimant above. In particular:

- i) Of real significance, in my judgment, is Ms Russell's acceptance in cross-examination the Claimant was "*the biggest player in the [UK changing robe] market in 2024*", in the context of an earlier acceptance that even in 2021 DRYROBE was a well-known brand. Mr Barclay in closing submissions suggested that was really fatal to the Defendant's argument that the brand had not acquired distinctiveness. I do not go that far, as assessment of acquired distinctiveness remains for the Court and not the witnesses. Ms Russell's evidence does, however, serve to undermine the criticisms made of the Claimant's evidence that it has provided no evidence as to its market share;
- ii) That by the relevant date, use of the Marks since at least 2019 in respect of the '195 and '428 DRYROBE word marks and since registration in 2022 for the stylised series '826 Mark had been extensive and intensive as evidenced by the number of orders and sales revenues. I accept the Claimant's submission that each sale or promotional use of the Dryrobe Advance caused the Marks to be advertised to the general public each time it was worn outdoors. Mr Barclay reminds me that Arnold J (as he then was) when assessing acquired distinctiveness in *Jack Wills Ltd v House of Fraser Stores Ltd* [2014] FSR 39 held that the use of the Jack Wills pheasant logo on the left breast of shirts and sweaters supports an inference that the mark has gained additional distinctive character through use. I accept his submission that the support provided by the very large, visually arresting 'Dryrobe®' logo on the back of the Claimant's outdoor coat, which is much more prominent than the small and discreet Jack Wills pheasant on a shirt or sweater which will often be covered up by another layer or outerwear, is commensurately greater. The design of the Dryrobe Advance serves almost as a walking billboard, in my judgment.
- iii) The extremely high-profile commercial relationships entered into by the Claimant with such organisations as Team GB and Red Bull, and in

television programmes with high viewing figures such as Top Gear and Comic Relief, provide further support that the Marks have gained significant distinctive character. I pause to comment that it is difficult to understand why such organisations would enter into such relationships unless they believed that the Claimant's Marks were capable of functioning as marks of origin.

- iv) The very significant sums spent by the Claimant on marketing and advertising activities as described by Mr Bright, including the relentless efforts that the Claimant has made to seek to stop 'dryrobe' and 'dry robe' being used generically by the press, competitors and customers, and raising awareness of the Marks, since 2020. This is evidenced by the quadrupling of that spend from year ending 2020 to year ending 2021 (as set out earlier), and increasing each year thereafter.
- v) The widespread press coverage, particularly in the national newspaper and magazine press but also in more local publications, fulfilling the two purposes of *Re: Oska's Trade Mark*. Of course, as the Claimant accepts, there is an element of hyperbole in such articles which I am satisfied the average consumer will understand, but even taking that into account, they nonetheless provide some evidence of the knowledge of the general public of the DRYROBE brand as well as serving to educate their readership as to the fact that DRYROBE is a trade mark albeit it is descriptive.
- vi) Extensive material in the trial bundle showing that by November 2024 consumers consider DRYROBE to be a brand name, of which only a few examples have been summarised by the Claimant in its submissions above.
- vii) The examples of actual direct confusion summarised previously and accepted by Ms Russell in cross-examination which I accept are explicable only if DRYROBE is understood by those consumers as a brand. As Mr Barclay posed rhetorically in his closing submissions, why otherwise would so many people be contacting the Claimant about D-Robe's goods seeking to exchange or return them, unless they understood that DRYROBE is a brand name and not just a description of a coat?

128. In my judgment, and standing back and looking at all of the evidence through the eyes of the average consumer, I am satisfied that there is compelling evidence that a significant proportion of the general public as at the date of the counterclaim identified the Claimant's goods as originating from the Claimant because of the Marks, and that the Marks had by that date acquired a medium level of distinctive character. It follows that the invalidity counterclaim fails, and the Marks will not be revoked pursuant to the proviso to section 47(1) TMA.
129. After circulating this judgment in draft, the Defendant correctly identified that I had not made clear findings about whether and if so to what extent the Marks had acquired distinctive character by March 2022, when the Defendant began trading under the Signs, as that is the relevant date for the purposes of the infringement assessment. I am grateful for the opportunity to address that and I consider it convenient to do so here. By that date the '195 Mark and '428 Mark had been registered as word marks for DRYROBE, but the '826 Mark and '456 Mark had not. The latter was not filed until 2 December 2022 but the application for the '826 Mark, being the series of stylised logos, had been filed in February 2022. In my judgment the ability of the '195 Mark and '428 Mark to function as a mark of origin was certainly no lower in March 2022 than in November 2024 and in my view it was higher. Ms Russell accepted it was a well-known brand by 2021; there were many fewer competitors in the market; I have found that there is little evidence of generic use up to December 2022; in terms of sales, sales in the year to December 2021 were the highest it had ever made because of the Covid boom described by Mr Bright; there is evidence of extensive press interest including Telegraph article calling Dryrobe "the most wanted coat in Britain", by that date. In my judgment as at March 2022, the '195 Mark and '428 Mark had acquired a medium to high degree of distinctive character which was somewhat eroded to a medium degree of distinctive character by November 2024 by generic use.

G. Invalidity. Should the marks be revoked pursuant to section 46(1)(c) of the Act?

Law

130. There is no dispute on the law. Section 46(1)(c) provides that the registration of a trade mark may be revoked on the ground “*that in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered*”. It aligns with Article 12(2)(a) of the Trade Marks Directive (EU) 2015/2436. It covers a situation in which a previously distinctive trade mark which has functioned as an indication of origin has developed into a generic name and so ceased to perform that function (see *Biomekulla Fruktindustrier AB v Procordia Food AB Case C-371/02* [2004] ETMR 69 (where Advocate General Léger in his Opinion described this as “*the converse situation*” to one in which a sign has acquired a distinctive character which it did not originally have, see [48]), and *Backaldrin Österreich The Kornspitz Company GmbH v Pfahnl Backmittel GmbH Case C-409/12* [2014] ETMR 30, in particular the Opinion of Advocate General Cruz Villalon at [30]-[32] and the judgment of the CJEU at [32]-[35].
131. Both cases emphasise the balancing of interests between, on the one hand, the trade mark proprietor in protecting the rights which registration of a trade mark has given him and on the other, the interests of the public and of competitors in having the freedom to use a term which is no longer distinctive and associated with a particular origin. The Claimant relies in particular on Advocate General Cruz Villalon’s opinion at [30] that this ground for revocation had a “*far more serious*” consequence for the trade mark proprietor than “*the non-registration of a generic name as a trade mark at the beginning of its economic existence*”, saying:
- “The fact that a trade mark enters the current language as the term for the product itself is evidence ultimately of the success generated by the hard work, often over many years, of the trade mark proprietor, whose product has, in the eyes of the world, become the embodiment of the type of product itself. Indeed, in many cases, the trade mark proprietor created a new type of product through a particularly innovative product, whose name thereby became the designation of the type of product itself.”
132. He went on to note at [84] of his Opinion that “*It is for the national courts to determine, in each individual case, what measures it is appropriate and*

reasonable for the trade mark proprietor to take” but noted such measure could include the following:

“...advertising, placing warnings on labels for placards placed alongside the product which specify the product’s name or persuading dictionary editors to give an indication in the entry for a word that that word is a trade mark. The trade mark proprietor himself must avoid using the trade mark as a generic name and take reasonable steps to combat such use by others, while drawing attention of traders to the fact that the name of the product is a trade mark.”

133. The Defendant submits that this is not a closed list and I accept that submission. The CJEU noted that “*inactivity*” may be a failure of the proprietor to enforce its rights, but “*is not in any way restricted to that kind of omission*”.
134. In *Hormel Foods v Antilles* [2005] EWHC 13 (Ch), [2005] ETMR 54, Richard Arnold QC (as he then was) provided a summary of the law at [165], [167] and [170]-[172]. This includes guidance that: (i) it is sufficient if a mark has become *a* common name in the trade. It does not have to be *the* common name in the trade; (ii) the proprietor’s acts or inaction need not be the sole cause of the mark becoming generic, it is sufficient to show that they are *a* cause; and (iii) a proprietor who registers a highly descriptive trade mark “bears a heavier burden to take steps to prevent it becoming a common name than one who registers an inherently distinctive mark”. However, he noted it was not necessarily the case that use of a trade mark (in that case ‘SPAM’) by the public as a household name meant that the trade mark had become truly generic, “*still less that this is due to the acts or inactivity of [the proprietor of the registered trade mark]*.”
135. Whether or not a trade mark has become truly generic, and whether a cause is the acts or inactivity of the proprietor of the mark, are matters of fact to be determined in every case, and per *Rousselon Freres et Cie v Horwood Homewares Ltd* [2008] EWHC 881 (Ch), [2008] RPC 30 at [85], that must be “*cogent evidence*”.
136. There is no dispute that the relevant date for the assessment is the date of the counterclaim, i.e. the same date as for the assessment of acquired distinctiveness

already carried out, and that the assessment must be carried out from the point of view of the relevant public, which in this case is the general public.

Submissions

137. The Defendant submits that the descriptive nature of the Marks means that the Claimant has a heavy burden to take steps to prevent genericide and that burden has not been discharged. I accept that it does have such a heavy burden, per *Hormel*. In relation to the question of whether it has discharged that burden, the Defendant submits that:

- i) the Claimant has used the Marks generically from the outset, but I have rejected that the evidence the Defendant relies on to make good this point is evidence of generic use by the Claimant;
- ii) the Claimant has taught consumers to view the brand DRYROBE as synonymous with a category term, and has not taken a strategic approach to combatting genericism, which I have also rejected, finding rather that since 2020 the Claimant has been rigorous in implementing processes put in place in 2019 to combat genericism by contacting social media users and educating them (i) that DRYROBE is a brand and (ii) ‘change robe’ or ‘changing robe’ should be used as the category term;
- iii) the Claimant should have been rigorous in its approach well before 2020, since there was a competitor, Robie, on the changing robe market in 2013 and more competitors arrived from 2017/18 on Mr Bright’s evidence. In relation to Robie, I note that, as the Defendant accepts, that was a simple towelling robe introduced back in 2007, and was not waterproof. In my judgment that was not really a competitor product or a ‘dryrobe’ as the public came to understand that term following the introduction of the Claimant’s novel product in 2013 until Robie introduced a waterproof changing robe some time later, so I reject that submission;
- iv) that the Claimant has changed the presentation of its Marks in text by originally requiring the press and public to refer to its brand as ‘dryrobe’ and in 2024 changing this approach to ‘Dryrobe’, albeit not consistently across

all of its public-facing communications since that date. Mr Bright conceded that in cross-examination, saying that it took time to review and change that documentation, which I accept. That change is a recent one, occurring around the same time as, or at best a few months before the date of the counterclaim, and I do not consider that, if relevant at all (which I doubt) it can realistically be considered to be a cause of genericism by 11 November 2024.

138. The Claimant concedes that Dryrobe is a household name and has become such, as it is the brand name of a particularly innovative and successful product. It further concedes that it has sometimes been used as a category term by members of the public, the press and competitors. However it submits that ‘dryrobe’ is not the common name in the trade for any of the goods for which the marks are registered, i.e. has not become generic, as it has not lost its ability to function as a trade mark, i.e. as an indicator of origin, as it retains a high degree of distinctive character. Accordingly it is not susceptible to revocation under section 46(1)(c) TMA.
139. Even if the court is not with it on that point, it submits that any genericism is not in consequence of acts or inactivity of the Claimant, which has consistently sought to combat genericism.

Determination

140. As the parties agree, there is substantial overlap with the question of acquired distinctiveness, and the findings that I have already made have relevance (as I have already indicated in setting out the Defendant’s submissions above), but this is a separate issue to that of acquired distinctiveness.
141. On the question of whether DRYROBE was a common name in the trade in November 2024, I accept, as the Claimant concedes, DRYROBE has become a household name and there is significant evidence of its use by the general public as a category term by that date. However, I have found that by the relevant date it has acquired distinctiveness which it did not have inherently, being descriptive, and that distinctiveness is its ability to function as a trade mark to distinguish the goods and services of one undertaking from those of other undertakings. Although my determination of the earlier Marks as having a high

level of distinctiveness in March 2022 and all of the Marks as having a medium level of distinctiveness in November 2024 shows that the increasing generic use by competitors, press and the public in that time period has had, in my judgment, a prejudicial effect on ability of the DRYROBE brand to function as a mark of origin, nonetheless I am satisfied that it was able to, and did, still carry out that essential function by November 2024. Accordingly I find that it had not become a common name in the trade for the purposes of section 46(1)(c) by the relevant date, and so it is not susceptible to revocation pursuant to that section.

142. That disposes of the matter. If I was wrong on acquired distinctiveness such that it has lost the ability to function as a trade mark, then the Marks would be invalidated for descriptiveness, and there would be no need to look at section 46(1)(c) TMA at all, so I do not think it is necessary to go on to consider the question of acts and omissions of the Claimant as proprietor. If in some combination of circumstances it was necessary to do so (perhaps if I was also wrong on descriptiveness), then the findings I have made at paragraphs 42 and 43 about the Claimant's rigorous implementation of its policies to combat genericism means that I would be satisfied that any genericism in November 2024 was not "in consequence of the acts or inactivity of the trade mark proprietor" as required by section 46(1)(c).

H. Infringement. Has the Defendant infringed the Marks under section 10(2) TMA?

Law

143. Section 10(2) TMA provides:

10(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because –

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

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

144. As Arnold LJ set out in the judgment of the Court at [18] of the *VETSURE* case, a summary of the principles established by authorities of the Court of Justice of the EU as to the correct manner to assess likelihood of confusion, expressed in terms referable to the registration context, has been adopted in the UK, as set out below:

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

(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.”

145. As he went on to clarify at [19], “*The same principles are applicable when considering infringement, but it is necessary for this purpose to consider the actual use of the sign complained of in the context in which the sign has been used: see Specsavers International Healthcare Ltd v Asda Stores Ltd [2012] EWCA Civ 24; [2012] FSR 19 at [87] (Kitchin LJ)*”.

146. There is no dispute that confusion for the purposes of section 10(2) TMA can arise directly, indirectly, and the “wrong way round”, which is where consumers believe that goods or services denoted by the trade mark come from the same undertaking as goods and services denoted by the sign, or an economically linked undertaking.

147. The context in which the sign has been used was considered by Kitchin LJ in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24; [2012] FSR 19. He stated at [87]: “*In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.*”

148. Kitchin LJ summarised the ultimate test to apply in assessing likelihood of confusion under section 10(2) TMA in *Comic Enterprises v Twentieth Century*

Fox at [79]: “...the question in every case remains the same, namely whether, having regard to a notional and fair use of the mark in relation to all the goods and services for which it is registered and the actual use of the sign, there is a risk that the average consumer might think that the goods and services come from the same undertaking or economically linked undertakings, and that is all.” Per Arnold J in *Interflora v Marks & Spencer* [2013] EWHC 1291 (Ch), [2013] FSR 33 at [224], “The fact that many consumers of whom the average consumer is representative would not be confused does not mean that the question whether there is a likelihood of confusion is to be answered in the negative if a significant number would be confused”.

149. Finally, this is a case in which evidence of post-sale confusion exists. During the course of the trial the Supreme Court handed down judgment in the case of *Iconix v Dream Pairs* [2024] ETMR 13, which provided the following guidance on the question of whether and to what extent post-sale confusion can be taken into account in consideration of likelihood of confusion and amount to actionable infringement. Lord Briggs and Lord Stephens, with whom the other members of the court agreed, summarised their conclusions on the points in the following terms:

[86] Arnold LJ, at para 12 of his judgment in this case, stated that:

“... it is possible in an appropriate case for use of a sign to give rise to a likelihood of confusion as a result of post-sale confusion even if there is no likelihood of confusion at the point of sale.”

We agree with that statement of the law. We reject Dream Pairs’ submission that only post-sale confusion affecting or jeopardising the essential function of a trade mark as a guarantee of origin at the point of a subsequent sale or in a subsequent transactional Page 34 context can amount to an actionable infringement. We also reject Dream Pairs’ submission that before there is an actionable infringement the post-sale confusion must result in damage at the point of sale or in a transactional context in the sense of influencing consumers when they make a choice with respect to the goods or services in question; see para 69 above.”

150. They did so for the reasons set out at [87]-[92].

151. The parties agree that for the sake of procedural economy I should address the Claimant's claims of trade mark infringement on the basis of the '428 Mark only, which gives the Claimant the broadest scope of protection. If the claim does not succeed in respect of the '428 Mark then it will fail in respect of the other Marks.
152. In this case there is no dispute that what is pleaded, and what I am concerned with, is use of the D-Robe Sign whether as D-Robe solus or as the dominant and distinctive element of those signs set out at paragraph 14(i), (ii) and (iii) above. There is also no dispute that the Defendant has used the D-Robe Sign in the course of trade, without consent of the Claimant, and in relation to goods or services identical to those for which the '428 Mark is registered. The questions remaining for the Court are, first, whether the D-Robe Sign is similar to the '428 Mark and, second, if so, whether the use of the D-Robe Sign on the Defendant's goods and/or in advertising and marketing gives rise to a likelihood of confusion with the '428 Mark.

Similarity – D-Robe Sign

153. The first comparison is between the '428 Mark which protects the word DRYROBE and the D-ROBE Sign.
154. The Claimant's case is that there is a high degree of similarity of sign and mark in this case. It submits that visually, D-ROBE contains all but two of the letters of DRYROBE, presented in the same order, with the two missing letters replaced with a hyphen; aurally, the marks and sign would be pronounced DRI ROBE and DEE ROBE respectively, which sound similar; and conceptually, there is similarity between the mark and the sign because of the inclusion of 'ROBE' in both.
155. As set out previously, the Defendant's pleaded case was that the D-Robe Sign and the Marks were dissimilar. It altered its position at trial to an admission that there was an overall similarity, but submitted that was weak. It argues that D-ROBE is visually similar to a low degree to DRYROBE, being shorter than the 7 letters of DRYROBE and broken in two by the presence of the hyphen. It submits that the only visual similarity arises from the shared presence of

‘ROBE’ placed at the end of both the mark and the sign, but submits that the descriptive character of this verbal element will reduce its prominence in the mind of the consumer.

156. I have a number of difficulties with this submission. The first is that it ignores the presence of the letter ‘D’ at the beginning of both D-ROBE and DRYROBE, although the Defendant acknowledges that it is well-established that consumers tend to pay the greatest attention to the beginnings of marks. Although the average consumer rarely has a chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, I am satisfied that imperfect picture would include that both begin with the letter ‘D’ and end with ‘ROBE’. If I accept the Defendant’s assessment that the ‘ROBE’ has a reduced prominence in the mind of the consumer because it is descriptive, but give no value to the shared letter ‘D’ at the start of both mark and sign, it is difficult to understand what the Defendant says the average consumer would take visually from the D-ROBE Sign. All that is left is the hyphen. I disagree with this assessment.
157. In my judgment, D-ROBE and DRYROBE have a high degree of visual similarity, the sign sharing 5 of the same letters, in the same order, as the mark, both beginning with ‘D’ and ending with ‘ROBE’. If the average consumer is paying moderate attention to D-ROBE with DRYROBE imperfectly in his mind I am satisfied that he will likely consider that the hyphen in D-ROBE visually represents the missing letters “RY” in DRYROBE. As the ‘428 Mark is a simple and descriptive word mark there is little scope for imperfect recollection, in my judgment.
158. The Defendant accepts the aural pronunciation is as the Claimant submits but argues that D-ROBE is aurally similar only to a low degree to DRYROBE. I disagree with this assessment and I consider that they have a medium degree of aural similarity as both contain -ROBE pronounced identically, with the first syllable dri- and dee- having some aural similarity in starting with the same hard ‘d’ sound.

159. The Defendant submits that the D-ROBE Sign is conceptually dissimilar to DRYROBE, the former conveying a meaning of derobing or taking off a robe, and the '428 Mark conveying the idea of a robe which is dry or is used for drying, and that this conceptual difference will be remembered by the average consumer and will work to counteract any visual or aural similarities. In my judgment there is a degree of conceptual similarity between the mark and the sign because of the shared concept of a 'robe', and I am not convinced that the average consumer will understand D-ROBE as conceptually meaning to take off a robe. It is usual in the everyday English language (as opposed to language involving ceremonial robes which I am not satisfied is everyday language used by the average consumer) to describe somebody as **disrobing**, not **derobing**. I think it is more likely that the average consumer will understand the 'D' merely as a signifier or categorisation or capital letter that is without any particular meaning in itself and so, conceptually, of little relevance. I assess the mark and sign as having a medium level of conceptual similarity.
160. Standing back and taking all these matters into account I assess D-ROBE and DRYROBE as having a medium to high level of similarity. It is accepted by the Defendant that they are used on identical goods.

Similarity – Shield Sign

161. The Similarities between the '428 Mark and the Shield Sign arise from the incorporation of the D-ROBE element within it. There is nothing further that is similar between them. The differences include the elements of the shield device with its line around it and the 'DR' device.
162. Visually, I consider that both the shield device and DR device are dominant and distinctive elements of the Shield Sign visually. I accept the Defendant's submission that the D-Robe element is not a dominant element because of its small size, particularly compared to the DR element within the shield device, and the dominance of those two elements visually within the sign as a whole. However I disagree that it is not a distinctive element. Although the illustration in this judgment perhaps does not show it well, I consider the D-Robe element to be legible and will be noticed by the average consumer, placed as it is

centrally below the distinctive DR element. I consider they have a low degree of visual similarity.

163. Aurally, the average consumer will in my view consider the DR element to be pronounced as the two letters 'D' and 'R' if it seeks to pronounce them at all, but I do not think it is very likely that it will do so. That is because the D-ROBE element immediately below the DR-element will explain to the average consumer what the DR element stands for, and given that the average consumer will consider the sign as a whole, I consider that he will more likely pronounce the Shield Sign as "Dee-Robe" than "Dee-arr-Dee-Robe". I find that the '428 Mark and the Shield Sign a medium level of aural similarity.
164. Conceptually, as I have said, the dominant elements are the Shield element and the DR element, albeit as I have stated the DR-element will be conceptually understood as standing for D-ROBE, by reference to the D-ROBE element placed immediately underneath it. Accordingly I do not accept the Defendant's submission that the '428 Mark and the Shield Logo are conceptually dissimilar. However in my view they do not share the same level conceptual similarity as the '428 Mark and the D-ROBE Sign, because that is significantly weakened by the dominance of the Shield element and DR element together, which convey an image of some strength as a seal or mark of approval or origin, a concept which the '428 Mark simply does not convey. I consider that conceptually they have a medium to low level of similarity.
165. Taking a step back, considering each of the '428 Mark and the Shield Sign as a whole through the eyes of the average consumer, and bearing in mind the principle of imperfect recollection, I consider that there is a low to medium level of similarity between them.

Likelihood of confusion – D-ROBE Sign

166. The next question for the court is whether the similarity that I have found between the '428 Mark and the D-Robe Sign, and the '428 Mark and the Shield Sign, gives rise to a likelihood of confusion pursuant to section 10(2) TMA. Arnold LJ cited at [121] of *Lidl v Tesco Stores* [2024] FSR 17 what in his view was "*the best description of the correct approach to the assessment of likelihood*

of confusion in trade mark cases and misrepresentation in passing off”, being that of Jacob J (as he then was) at first instance in *Neutrogena v Golden* at 482 (in the context of passing off):

The judge must consider the evidence adduced and use his own common sense and his own opinion as to the likelihood of deception. It is an overall ‘jury’ assessment involving a combination of all these factors, see ‘GE’ Trade Mark [1972] FSR 225, [1973] RPC 297 at page 321. Ultimately the question is one for the court, not for the witnesses. It follows that if the judge’s own opinion is that the case is marginal, one where he cannot be sure whether there is a likelihood of sufficient deception, the case will fail in the absence of enough evidence of the likelihood of deception. But if that opinion of the judges supplemented by such evidence, then it will succeed. And even if one’s own opinion is that deception is unlikely though possible, convincing evidence of deception will carry the day. ... It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced, I said more and more ‘it depends on the evidence’.

167. On the evidence before me, the first date in which the D-ROBE Sign and the Shield Sign were used was when the products first were sold online, being March 2022 and this is the date of assessment.

Submissions

168. The Claimant submits that there is clearly at least a risk that a significant proportion of persons with the attributes of the average consumer might be confused by the D-ROBE Sign (and Shield Sign) into believing that the products it is applied to are those of the Claimant, or vice versa. This may be direct confusion, particularly when imperfect recollection is taken into account, meaning that consumers buying or considering to buy goods may see D-ROBE branded goods and think they are DRYROBE goods or vice versa, but the Claimant submits there is also a substantial risk of indirect confusion, where consumers consider that D-ROBE is a sub-brand of DRYROBE, perhaps, in the context of the Defendant’s marketing, a sub-brand focussed on non-sporting outdoor pursuits such as dog-walking.
169. The Claimant also submits that there is a likelihood of direct and indirect confusion in the post-sale context, where consumers see the D-ROBE branding

and the Marks on clothing perhaps worn by others, where consumers familiar with the DRYROBE Marks will likely be confused into believing that D-ROBE is connected with DRYROBE and vice versa.

170. The Claimant relies on extensive documentation of actual confusion (direct, indirect and wrong-way confusion), some of which I have summarised earlier in this judgment, and submits that is powerful evidence that there exists a risk of confusion, per Kitchen LJ in *Maier v ASOS* [2015] EWCA Civ 220, [2015] FSR 20 at [80]. As mentioned previously, Ms Knott in oral submissions for the Defendant accepted that there was evidence of actual confusion. As Arnold LJ stated in *Lidl v Tesco* at [120], “*Such evidence is relevant not because the real consumers involved stand proxy for the average consumer or for ordinary consumers, but because the evidence may assist the court to gauge the perceptions of the average consumer or ordinary consumers... the evidence does not have to be statistically significant in order to give the court insight into the perceptions of ordinary consumers.*” However, he caveated this with a warning that the court “*must evaluate such evidence with caution and must not treat it as determinative of the issue which the court has to decide.*”
171. Mr Barclay for the Claimant submits that the volume of such evidence of actual confusion is striking given the relatively small scale of D-Robe’s trading (20,897 orders in total), and the fact that there are likely to be many more confused customers who had no reason to contact the Claimant or the Defendant as they did not wish to return or exchange their products or need assistance in any other way.
172. Turning to the Defendant’s submissions, those are expressed in the Defendant’s skeleton to be based: (i) on a weak similarity between the ‘428 Mark on the one hand and the D-ROBE Sign or Shield Sign on the other, (which Ms Knott refers to as a primary factor which works against a likelihood of confusion), and I have found the similarity to be higher than that in each case, albeit not much in the case of the Shield Sign; and (ii) on an assumed weak and allusive distinctive character of the ‘428 Mark if the registration remains valid, however, I have found a medium to high level of acquired distinctive character as at the relevant

date for the infringement assessment of March 2022, although I have found that DRYROBE is descriptive to the extent previously explained.

173. The Defendant submits that the fact that the DRYROBE Marks are descriptive weighs heavily against a likelihood of confusion, although it does not preclude it. It submits that since the distinctive character lies in the use made of the Marks, it arises as a result of the Marks as a whole and does not give the Claimant a monopoly in the use of ‘ROBE’ for robes. It submits that it is not likely to cause confusion because, per Daniel Alexander KC sitting as the Appointed Person in *Elliott v LRC Products Ltd* [2014] RPC 13 at [57] “*a credible and dominant alternative explanation exists for the similarity in marks which has nothing to do with their denotation of a common trade source, namely that the similarity is attributable to their descriptiveness*”.
174. In relation to actual confusion, the Defendant now accepts there is such evidence. It submits that the Claimant has not called the individuals said to have been confused, and so there is no direct evidence before the Court of why confusion has taken place.
175. The Defendant submits that the Claimant must put up with a degree of confusion in circumstances where it chose a descriptive name as a brand for a novel product, in which it was a de-facto monopolist for about five years, when that product began to be sold by others, including the Defendant. It submits that this is not relevant confusion for the purposes of the Claimant’s case on likelihood of confusion.

Determination – D-ROBE Sign

176. I have found the ‘428 Mark and the D-Robe Sign have a medium to high degree of similarity and the ‘428 Mark and the Shield Sign to have a low to medium degree of similarity. It is common ground they have been used on identical goods. I take into account the principle of interdependency..
177. The context of the purchasing process for the goods to which both the ‘428 Mark and the Signs attach are that this is overwhelmingly likely to be online and so the average consumer’s contact with both mark and sign will be visual. Both

parties said that the internet is their main sales channel rather than retail stores, and neither offer customers a telephone ordering facility. I have found that the ‘428 Mark and the D-Robe Sign in particular to have a high degree of visual similarity, and the parties agree that the average consumer will pay an average degree of attention.

178. I accept, as the Defendant submits, the fact that a mark is descriptive weighs heavily against a finding of likelihood of confusion. However, against the mere fact that the ‘428 Mark is descriptive must be set the fact that I have found that the ‘428 Mark has acquired a medium to high level of distinctive character through use as at the relevant date of March 2022. This raised level of distinctiveness beyond the norm gives rise to a greater likelihood of confusion, in my judgment.
179. I also accept the Defendant’s further submission that, per *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch), [2015] ETMR 29, it is well understood that “*if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion*”, and that in such a case, the nature of the common elements needs to be considered.
180. I also agree with the Defendant’s submissions that in this case the distinctive character of the ‘428 Mark has arisen in the use of it as a whole, since that is the only manner in which it has been used as a trade mark, and that this does not give the Claimant any monopoly in use of the word ‘ROBE’ alone. However, I am not concerned with use of the word ‘ROBE’ alone. That is merely a common element in both the D-ROBE Sign (as also incorporated into the Shield Mark) and the ‘428 Mark.
181. The Defendant relies on a small snippet of Mr Daniel Alexander KC’s decision in *Elliott v LRC* but it is of greater assistance, I think, to read paragraphs [57] and [58] in their entirety:

[57] This is a case in which the well-known approach in *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 R.P.C. 39, [1946] 1 All ER 320 (from the law of passing off) to the effect

that, where an earlier mark is descriptive, small differences are enough to distinguish, is of some importance. That approach is not taken for any doctrinal reason but simply because, in practice, consumers are less likely to think that two descriptive marks denote businesses that are connected with one another, because a credible and dominant alternative explanation exists for the similarity in marks which has nothing to do with their denotation of a common trade source, namely that their similarity is attributable to their descriptiveness.

[58] Situations in which factors of this kind are of greater or lesser importance depend heavily on their facts. To take two examples from the cases cited before me, in T-169/ 02, Sergio Rossi SpA v OHIM, 1 March 2005, [2005] E.C.R. II-505, at [83], the Court of First Instance took into account, in holding that there was no likelihood of confusion, the fact that the common element of the marks was a common name “Rossi” and that consumers would therefore not believe that there was an economic link between all the proprietors of different marks containing that name. Conversely, in Case C-235/05, L’Oreal v OHIM [2006] E.C.R. I-57, the Court of Justice upheld a decision of the Court of First Instance to the effect that the partial descriptiveness of the earlier mark FLEX did not remove the likelihood of confusion with FLEXI AIR. This, perhaps, illustrates the futility of searching for general principles in this area. It suffices to say that, on the facts of the present case, in relation to goods concerned (broadly) with making love, there is no reason to believe that the average consumer will assume that there is an economic link between undertakings using the quite different spellings of the word “LOVE” and “LUV” even if the kinds of sex equipment are similar.

182. A few things then become clearer. First, the snippet relied on by the Defendant was said in the context of the circumstances of that case where there are “*two descriptive marks*”. Second, Mr Alexander KC is commenting on the principle that where the earlier mark is descriptive, small differences are enough to distinguish, from *Office Cleaning Services*. Again, that was a case where there were two descriptive marks. Third, these matters all turn on their facts.
183. In this case, the common element between the ‘428 Mark and the Signs is the word ROBE, which is itself descriptive and so non-distinctive for the goods for which the ‘428 Mark is registered (and the Signs are used on identical goods). In those circumstances the assessment of likelihood of confusion between the ‘428 Mark and the Signs must focus on the similarities or differences and distinctiveness of the non-common elements.

184. The non-common elements between Mark and D-ROBE Sign are ‘DRY’ and ‘D-’ respectively. Even though consumers will be alert to the differences, these elements are visually and aurally so similar, in my judgment, that when considered within the MARK and SIGN as a whole, and in the context of my finding that although ‘DRY’ is also a descriptive word DRYROBE has acquired a medium to high level of distinctiveness at the assessment date, it gives rise to a high likelihood of confusion that a significant proportion of the public might be confused into believing that the Defendant’s goods are those of the Claimant or an associate brand/economically linked undertaking. In addition, I have found (at paragraph 157) that even given the principle of imperfect recollection, the hyphen is likely to be perceived by the average consumer as replacing the letters “RY” in DRYROBE, and in my judgment that strengthens the likelihood that a significant proportion of the public will consider that there is a link between the Mark and the D-ROBE Sign, such that perhaps the D-ROBE Sign is a sub-brand of the Mark. After this judgment was circulated, the Defendant criticised me for taking this into account saying that it was not pleaded or argued by either party, but I have noted (at paragraph 154) the Claimant’s submission about the hyphen, and it is the judge who must look through the eyes of the average consumer (who in this case is a member of the general public), and that is what I have done my best to do.
185. In terms of the Shield Sign, the non-common elements with the Mark are those of the D-ROBE Sign but also the dominant and distinctive Shield element and DR element. However as I have explained, I consider that the average consumer will understand the D-ROBE element to explain what the DR element stands for, and that effectively ties in the dominant DR element to the D-ROBE element in the mind of the average consumer, who is looking at the Shield Sign with the ‘428 Mark imperfectly in mind, in my judgment. The average consumer looking at the ‘428 Mark with the Shield Mark imperfectly in mind might not recall the non-dominant D-ROBE element, however. Accordingly, I consider that there is a likelihood of confusion between the ‘428 Mark and the Shield Sign despite the low to medium level of similarity that I have found between them, although that is a low likelihood of confusion and significantly lower than between the ‘428 Mark and the D-ROBE Sign.

186. Turning to actual confusion, this is a case, in my judgment, where the evidence of actual confusion confirms beyond doubt the risk of confusion in relation to all the Signs, and I accept the Claimant's submissions on this point. The 'hero product' of the Defendant is the Beaufort robe which contains the D-ROBE Sign and the Shield Sign upon it, although only the Shield Sign on the exterior of the garment I understand. There are examples of actual direct confusion in which confused consumers have contacted Dryrobe seeking to return or exchange D-Robe products, demonstrating at the least clear potential for direct confusion; examples of actual indirect confusion where confused consumers have sought the assistance of Dryrobe to ask "*dryrobe... so D-Robe is that not you?*", demonstrating at the least clear potential for indirect confusion; and wrong-way confusion also demonstrating clear potential for both direct (Ms MP and her video of a D-Robe coat which she told those commenting on her video was "*a dry robe but you can get lots of other brands*") and indirect (confused customers contacting the Defendant seeking to return or exchange DRYROBE brand products) confusion.
187. The Defendant criticises of the failure of the Claimant to call evidence from those consumers who it says have suffered actual confusion. Firstly, this trial is in IPEC which is closely controlled both in relation to trial timetable and in relation to costs. At the CMC directions were given entitling each party to rely only on two witnesses. A single witness chosen from those many consumers whose confusion the Claimant relies on would provide little assistance to the court. If the Claimant had sought to call a roster of such witnesses that would not have met the IPEC cost-benefit threshold required to make such a case management decision or enabled the trial to be completed in two days. In any event, Ms Russell made a series of concessions in cross-examination on inferences which could safely be drawn from certain of the examples of communications evidencing confusion, as I set out previously.
188. I have dealt with and rejected the Defendant's arguments, based on Ms Russell's speculative evidence from which she resiled in cross-examination, that most of the confusion has arisen because of mistakes arising from the delivery of weblinks for the Claimant's website in response to searches for the Defendant,

or that consumers were just generally confused, and found very little evidence of confusion which is not brand confusion but administrative or arising from confusion for other reasons.

189. I do not accept the Defendant's submission that having chosen a descriptive name for a novel product, the Claimant must put up with a degree of confusion which is not relevant confusion for these purposes. As already stated, the relevant factor is distinctiveness, whether that is inherent or whether it is a descriptive (and so inherently non-distinctive) mark which has acquired distinctiveness, as I have found the Marks to be in this case. I accept the Claimant's submissions that:

- i) The Defendant's reliance on *My Kinda Town* [1983] RPC 407, a passing off authority decided over a decade before the TMA became law is ill founded; There is nothing in the TMA or relevant trade mark authorities that suggests that a finding of section 10(2) infringement where there is a likelihood of confusion should be refused on the basis that confusion should be tolerated; and
- ii) this was addressed by Arnold LJ in the *VETSURE* case where he explained that this is wrong. Confusion is material and relevant so long as it is the average consumer that is confused.

190. For those reasons I am satisfied that the uses of the D-Robe Sign and the Shield Signs complained of amount to section 10(2) TMA infringement of the Marks.

I. Infringement. Has the Defendant infringed the Marks under section 10(3) TMA?

191. I understood the parties to agree at trial that the outcome on section 10(3) infringement flows from the conclusions reached on section 10(2) infringement. In case I am wrong about that I will deal with it very shortly.

192. The question is whether the Defendant's use of the Signs on its goods dilutes the distinctive character and/or takes unfair advantage of the reputation of the

Marks. The parties do not dispute the law. The principles are well known and I will not repeat them here.

193. Although reputation and acquired distinctive character are, technically, different concepts, I am satisfied that the Marks had a reputation on the date that the Defendant began to trade (1 March 2022) which is the first date at which I am satisfied there is evidence of use of the D-Robe Sign and the Shield Logo in the course of trade, based on such of the evidence which I have relied on to find acquired distinctive character as predated 1 March 2022. I heard no submissions from the Defendant that there was further or different evidence to take into account.
194. In addition, I have found section 10(2) TMA confusion and I am satisfied that the same evidence leads me to the conclusion that a substantial proportion of attentive consumers for whom the Marks are reputed will link them to (and indeed confuse them with) the D-ROBE Sign. The existence of a link in the mind of such consumers requires me to assess it globally, taking account of all relevant factors including those set out at [41] and [42] of *Intel Corporation Inc v CPM UK Ltd* (Case C-252/07), [2009] Bus LR 1079, but those are all factors which I have already addressed.
195. I am also satisfied that there is the requisite likelihood of a change in economic behaviour (and, in fact, an actual change in economic behaviour) because of the confusion which damages the distinctiveness of the mark giving rise to the risk that consumers will buy the Defendant's goods believing they are those of the Claimant (as I have found has happened). The evidence of actual confusion, which is sufficient to show that a transfer of image as required has actually occurred, amounts to unfair advantage as it appears clear from that evidence that consumers have bought the Defendant's goods believing them to be those of the Claimant. That amounts to an exploitation by the Defendant of the Claimant's marketing efforts. Per *Lidl v Tesco*, I am satisfied that cannot be use with due cause.
196. The Defendant's written submissions that there would be no link, and no change in economic behaviour, is based on findings about weakness in similarity

between Marks and Signs, lack of reputation of the Marks, weak distinctive character of the Marks, and lack of likelihood of confusion, and I have made none of these findings.

197. For those reasons I am satisfied that use by the Defendant of the D-ROBE Sign and Shield Sign complained of amounts to infringement of the Marks under section 10(3) TMA.

J. Passing off.

198. Neither party contends that the claim in passing off could lead to any different outcome than the infringement claim. Accordingly it seems to me it is sufficient to say that I am also satisfied that the three elements of passing off have been made out: the trade which has made the Marks acquire distinctive character has generated sufficient goodwill; the application of the D-ROBE Sign to clothing which lead ordinary purchasers purchasing with ordinary caution to believe that its goods were associated or connected with the Claimant or an economically linked undertaking constitutes a misrepresentation, and damage is made out because of the actual change in economic behaviour of consumers I have found pursuant to 10(3) TMA infringement. I am satisfied that the Defendant has passed off its goods as those of the Claimant.

K. IP Enforcement Regs. Has there been knowing infringement by the Defendant?

199. The question is whether the Defendant knew or had reasonable grounds to know that it was engaged in infringing activity, and if so, whether the Claimant should be entitled to additional damages pursuant to Regulation 3 of the IP Enforcement Regs.
200. The Claimant submits that the Defendant did, because:
- i) Ms Russell was warned by her graphic designer in early 2021 that there may be a risk of the D-Robe name being too similar to DRYROBE before the brand had been developed;

- ii) the Defendant was sent letters warning it about the Marks in April 2022, very shortly after it had begun trading the previous month, which Ms Russell in cross-examination confirmed that she had seen;
 - iii) the Defendant knew, or should have known that there were confused customers from September 2023 as that is when examples began to present themselves to the Defendant's customer services;
 - iv) Mr Bright's evidence was that the Claimant reached out to the Defendant to discuss their use of the D-ROBE Sign but the Defendant declined to speak to them;
 - v) Despite all of these warning flags, the Defendant pressed on with selling its goods by reference to the D-ROBE Sign and Shield Sign and continues to do so, selling down its existing stock branded with those Signs, despite the fact that it has now rebranded to Delta Roam.
201. The Defendant submits that Ms Russell has provided an explanation with how the Defendant came up with the D-ROBE Sign, supported by contemporaneous evidence, and that she was conscious to differentiate the Defendant from other brands operating in the same space.
202. I accept Ms Russell was conscious to differentiate the Defendant from other leading brands in the outdoor garment market by its placement in the competitive landscape, and that she was conscious to differentiate the Defendant's brand from DUNLOP, but she did not satisfy me that she paid any proper attention to the warning provided by Mr Long about a potential problem with the brand of a well-known competitor in the market the Defendant was proposing to enter, and I accept the Claimant's other submissions that the Defendant failed to act on the other opportunities it had to avoid or limit infringement, set out above, in relation to which the Defendant has really given no answers.
203. I find that the Defendant knew or had reasonable grounds to know that it was engaged in infringing activity, for the purposes of Regulation 3 of the IP Enforcement Regs, from at least September 2023 when confused customers

were presenting themselves, by which time it knew of the Claimant's concerns pursuant to the letters of April 2022. Whether or not additional damages are payable is a matter for assessment at a later date of the actual prejudice suffered by the Claimant, if any.

L. Should the specification of the '428 mark only be reduced for non-use.

Law

204. S46(1)(a) provides that the registration of a trade mark may be revoked on ground that “*within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use.*”. That means non-token use as an origin identifying sign per *Ansul BV v Ajax*.

Pleaded case

205. The Defendant seeks revocation of the '428 Mark in part pursuant to section 46(1)(a). The Claimant admitted in the Reply and Defence to Counterclaim non-use within the 5-year period in respect of the following, which it has since removed from the registration of the '428 Mark:

- i) Class 16: Plastic bags for general use;
- ii) Class 25: Sandals;
- iii) Class 26: Heat adhesive patches; ornamental cloth patches; and
- iv) Class 35: Retail, wholesale and online retail services in relation to the sale of the goods at (i)-(iii) above

206. That leaves the following goods and services in the '428 Mark registration challenged by the Claimant for non-use:

Class 14: *Charms for key chains; Charms for key rings; Key rings and key chains, and charms therefor; Key chains.*

Class 16: *Gift cards; Cardboard gift boxes; Gift boxes made of cardboard; Printed matter; Gift bags; Paper bags; Newsletters; Stickers; Decals; Stationery.*

Class 25: *Beach shoes.*

Class 26: *Accessories for apparel, sewing articles and decorative textile articles; Patches for clothing; Patches (Heat adhesive -) for decoration of textile articles [haberdashery]; Embroidered patches for clothing; Embroidered patches; Decoration of textile articles (Heat adhesive patches for -) [haberdashery]; Cloth patches for clothing; Lanyards for wear; Lanyards [cords] for wear.*

Class 35: *Retail, wholesale and online retail services in relation to the sale of Charms for key chains, Charms for key rings, Key rings and key chains, and charms therefor, Key chains, Gift cards, Cardboard gift boxes, Gift boxes made of cardboard, Printed matter, Gift bags, Paper bags, Newsletters, Stickers, Decals, Stationery, beach shoes, Accessories for apparel, sewing articles and decorative textile articles, Patches for clothing, Patches (Heat adhesive -) for decoration of textile articles [haberdashery], Embroidered patches for clothing, Embroidered patches, Decoration of textile articles (Heat adhesive patches for -) [haberdashery], Cloth patches for clothing, Lanyards for wear, Lanyards [cords] for wear.*

Evidence

207. The Claimant has produced evidence in the form of invoices that show sales of the following:
- i) A number of key straps which I am satisfied is non-token use in Class 14 and related services in Class 35;
 - ii) A number of fabric patches, lanyards and a decorative textile article (cushion) which I am satisfied amounts to non-token use in Class 26 and related services in Class 35.
208. I have seen no evidence of genuine use in the relevant period of *Gift cards; Cardboard gift boxes; Gift boxes made of cardboard; Printed matter; Gift bags; Paper bags; Newsletters; Stickers; Decals; Stationery* in Class 16 or of *Beach Shoes* in Class 25, or related services in Class 35 and the ‘428 Mark. The specification of the ‘428 Mark will be reduced accordingly.

L. Summary

- 209. The Marks are validly registered (save that the specification of the '428 Mark will be reduced as set out in the paragraph above for non-use).
- 210. The counterclaim for revocation pursuant to section 46(1)(a) is dismissed.
- 211. The Marks are infringed by the Defendant's use of the D-ROBE Sign and the Shield Sign complained of.
- 212. The Defendant knew or had reasonable grounds to know that it was engaged in infringing activity pursuant to Regulation 3 of the IP Enforcement Regs.
- 213. The Defendant has passed off its goods as those of the Claimant.
- 214. I wish to pay tribute to the very high quality of the oral and written submissions of Mr Barclay for the Claimant and Ms Knott for the Defendant, for which I am very grateful.

ISSUES

The validity of the Marks pursuant to -

- i) Section 46(1)(c) TMA and/or
- ii) Section 47(1) TMA

Infringement of the Marks -

- iii) Whether the Marks have a reputation (and/or an enhanced reputation) in the UK
- iv) Whether the Defendant's use of the D-Robe Sign is similar to the Marks
- v) Whether the Defendant's use of the D-Robe Sign gives rise to a likelihood of confusion on the part of the average consumer
- vi) Whether the Defendant's use of the D-Robe Sign causes detriment to, or takes unfair advantage of, the distinctive character or repute of the Marks
- vii) Whether the Defendant's use of the D-Robe Sign is without due cause

Passing Off -

- viii) Whether the Claimant owns goodwill in the Marks
- ix) Whether the Defendant's use of the D-Robe Sign is liable to deceive members of the public into believing that its goods are authorised by the Claimant or connected with the Claimant's business
- x) If so, whether such misrepresentation has caused the Claimant damage

Relief -

- xi) Whether any infringing acts committed by the Defendant have been knowing and deliberate.