

World Trademark Review *Daily*

**Evidence from Google AdWords assists in securing interim injunction
United Kingdom - McDermott Will & Emery UK LLP**

**Confusion
Passing off**

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In *Wasabi Frog Ltd v Miss Boo Ltd* ([2009] EWHC 2767 (Ch), November 4 2009), the Chancery Division of the High Court of England and Wales has granted an interim injunction to [Wasabi Frog Ltd](#).

Wasabi Frog, an online retailer of women's fashion, trades through the website 'boohoo.com' and by reference to the mark BOOHOO since November 2006. It targets the market of young women aged 17 to 25, and has built a reputation as a vibrant, glamorous, but affordable brand. The website has been a success since inception; evidence shows that, to date, it generates £30,000 to £60,000 in revenue per day. Wasabi Frog has made significant investment in marketing, advertising and customer service. It has won a number of industry awards as an online retailer.

Wasabi Frog owns the registered Community trademarks (CTM) BOO, BOOHOO and BOOHOO.COM in respect of cosmetics, clothing, accessories and footwear. It also owns a number of domain names, including 'boohoo.co.uk', 'missboohoo.com', 'missboohoo.co.uk' and 'missboohoo.eu', all of which point to the main website, 'boohoo.com'. The website 'boohoo.com' sells 80% of the clothing and 30% of the footwear under the mark BOOHOO.COM.

On September 1 2009 [Miss Boo Ltd](#) launched its website at 'missboo.co.uk', selling women's clothing and in direct competition with Wasabi Frog. Miss Boo's director gave evidence that the name was chosen to include 'miss' as the range targets young women, and 'boo' because this is a word for loved ones in popular culture.

Wasabi Frog sought an interim injunction against Miss Boo based on trademark infringement and passing off.

In making its decision, the court applied the classic principles to determine whether an interim injunction should be granted. Wasabi Frog had to prove that:

- there was a triable issue;
- damages alone would not represent an adequate compensation; and
- the balance of convenience was in favour of an injunction.

The court accepted Wasabi Frog's submission that Miss Boo had been aware of the 'boohoo.com' website when it launched its business. However, Miss Boo's conduct had to be judged objectively. Therefore, the court had to determine whether it was a reasonably foreseeable consequence that Miss Boo's actions would be to pass off its goods as those of Wasabi Frog.

The court admitted that Wasabi Frog had goodwill and reputation in the marks BOOHOO and BOOHOO.COM, but held that the same could not be said of its BOO mark, although it acknowledged that it is a registered CTM.

The court recognized that the target market of the two websites are young girls who are "very, very savvy" when it comes to fashion. However, the issue of confusion need not be determined at the interim stage; the issue was merely whether there was a triable issue. The court took into consideration evidence of an incident which pointed to actual confusion. Wasabi Frog was contacted by an events promoter in an effort to sell advertising space and, in doing so, twice referred to Wasabi Frog as Miss Boo. The court considered that if someone within the fashion industry could be confused, then even a "very, very savvy" young woman might also be confused.

In addition, the evidence relating to the Miss Boo [AdWord](#) gave rise to an arguable case. Wasabi Frog, as part of its effort to limit any damage caused to its brand by Miss Boo, purchased the words 'Miss Boo' as a [Google AdWord](#). It then used the [Google Analytics](#) reports to show that 15% of the traffic to the 'boohoo.com' website was redirected from users who had searched for 'Miss Boo'. This represented the fourth largest source of traffic to its site.

The court held that damages would not be an adequate remedy for Wasabi Frog, since Miss Boo was a new and impecunious business. On the other hand, it considered that although damages would not be a complete remedy for Miss Boo, they would prove adequate if it transpired that an interim injunction had been wrongly granted. Miss Boo had not been trading for long enough to build up significant reputation in the

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name, and could change it with a loss only of the investment that it had made to date in advertising. Significantly, its stock, which was not branded, could still be sold, whatever the outcome of the dispute.

The court held that there was a triable issue as to a likelihood of confusion. It went on to say that Wasabi Frog had a strongly arguable case on trademark infringement. The balance of convenience was in favour of granting the injunctive relief sought, provided that an adequate cross-undertaking could be given.

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