

**O-279-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3024045**

**BY**

**MICHAEL CAMPBELL**

**TO REGISTER THE TRADE MARK**

**RawTiD TV**

**IN CLASSES 35 & 41**

**AND**

**AND OPPOSITION THERETO**

**UNDER NO 401579**

**BY G-STAR RAW C.V. & FACTON LTD**

**BACKGROUND AND PLEADINGS**

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1. On 29 September 2013, Michael Campbell (“the applicant”) applied to register the trade mark RawTiD TV (“the application”). It was accepted and published in the Trade Marks Journal on 18 October 2013 in respect of the following services:

Class 35: Advertisement and publicity services by television, radio, mail; Advertisements (placing of-); Advertisements (preparing of-); Advertising; Advertising and advertisement services; Advertising and promotion services; Advertising and publicity services; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising flyer distribution; Advertising services provided via the internet; Production of video recordings for advertising purposes; Production of video recordings for marketing purposes; Production of video recordings for publicity purposes.

Class 41: Post-production services in the field of music videos and film, Production of musical videos, Video editing, Animated musical entertainment services; Entertainment provided via the internet; Entertainment in the nature of on-going television programs in the field of variety; Showing of prerecorded entertainment.

2. On 20 January 2014, G-Star Raw C.V. and Facion Limited (“the opponents”) opposed the application in its entirety. The opposition was based on Section 5(2)(b) and (3) of the Trade Marks Act 1994 (“the Act”). The marks and classes relied upon for this opposition are shown below:

### Section 5(2)(b)

Mark	Number	Classes relied upon
	UK 2491837	35
RAW	CTM 4743225	25
RAW	CTM 11493103	9 & 42
RAW	CTM 4743225	25 & 35 (except for advertising)
RAW	UK 2650539	35
RAW	CTM <sup>1</sup> 1131972	35
RAW	CTM 9702184	41

### Section 5(3)

<sup>1</sup> European Community Trade Mark designated via the International filing system at WIPO

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Mark	Number	Class relied upon
RAW	CTM 4743225	25

3. The opponent argues that the respective goods and services covered by the application are identical or similar to their earlier mark, and that the marks are similar. Therefore, the application should be refused under section 5(2)(b) of the Act.

4. The opponent also claims that their existing registrations have a reputation. In particular the opponent argues that the applicant will benefit from the opponent's investment in advertising, leading to advantage. Further, that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark. The opponent also claims that the later use will be out of its control and that poor quality will cause detriment to its valuable reputation and business. It claims that use of the later mark will tarnish the opponent's mark and result in a change of economic behaviour which will result in consumers to cease purchasing the opponent's goods.

5. The applicant filed a counterstatement strongly disagreeing with the opponent's claim that the respective marks are similar.

6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

7. The opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following careful consideration of the papers filed.

### Evidence

#### Opponent's evidence

##### *Witness statement of Johannes Christian de Bil*

8. The opponent's evidence is a witness statement from Johannes Christian de Bil of Amsterdam, The Netherlands.

9. Mr de Bil is the Managing Director of Facton Ltd, a position he has held since 9 July 2009. He states that he is also the General Counsel for G-Star Raw CV, a position he has held since 2000. Mr de Bil states that on 19 April 2011 G-Star Raw CV acquired assets of G-Star International BV, for whom he was the general counsel. Following the acquisition he became their General Counsel. He also states that Facton Ltd and G-Star Raw CV are "affiliated companies"<sup>2</sup>. Further, "Any use by Facton Ltd is made with permission of G-Star Raw CV"<sup>3</sup>.

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<sup>2</sup> Paragraph 2 of his witness statement

<sup>3</sup> Paragraph 2 of his witness statement

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10. Mr de Bil states that the first use of RAW was as part of G-STAR RAW DENIM in 1995. Then “from around 2000, the G-Star RAW Denim brand was simplified to G-STAR RAW, and several new RAW Logos were introduced”. Further, “as of 2013 the main clothing lines were rebranded to RAW Sports, RAW Cargo Line, RAW Correct and RAW Essentials”.

### Turnover figures

Year	United Kingdom Turnover figures in £ millions
2000 - 2001	1.4
2001 - 2002	2.3
2002 – 2003	4.0
2003 – 2004	7.8
2004 – 2005	12.1
2005 – 2006	21.9
2006 – 2007	37.4
2007 – 2008	>37
2008 – 2009	>37
2009 - 2010	>37

### Marketing figures

Year	Expenditure figures in £
2001 – 2002	115,000
2002 – 2003	182,000
2003 – 2004	302,000
2004 – 2005	334,000
2005 – 2006	777,000
2006 – 2007	1,160,000
2007 – 2008	>1,160,000
2008 – 2009	>1,160,000
2010 – 2011	>1,160,000

11. The opponent states that in view of the above figures, G-Star spends on average more than 3% of its turnover on marketing and promotion. Further, he draws attention to the fact that the opponent’s products commonly bear numerous brands simultaneously. He claims that this is supported by numerous exhibits to the witness statement. As such, the turnover figures cannot be isolated to any of the brands, though Mr de Bil claims that at least 90% of sales shown will have included the trade mark RAW either alone or in conjunction with another element.

12. Mr de Bil states that the opponent frequently organises “RAW nights” events and provides a list of events. None of these are in the UK. The exhibits attached to the witness statement are summarised as follows:

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Exhibit JCdeB1 – these are selection of brochure extracts and pictures of various clothing products. The majority of the clothing shows the mark RAW together with G-STAR.

Exhibit JCdeB2 is an overview table showing G-Star's logos, labels and tags which Mr de Bil claims to appear on their products in brochures. The table is headed "Main G-Star Logos" which, notably, does not include RAW *solus*.

Exhibit JCdeB3 are invitations which have been sent to buyers and traders in the fashion industry. The invitations show the mark G-STAR RAW with and without the device, but not RAW.

Paragraph 8 of the witness statement states: "The concurrent use of our brands means that I am not able to provide isolated sales figures for each one of our brands. I can however confirm that at least 90% of the sales shown in the tables below will have included the RAW trade mark, either independently or in combination with our other brands."

JCdeB4 are a selection of press releases and photographs of various Raw Nights events and parties.

JCdeB5 is an extract from the Audit Bureau of Circulations (ABC) website. They are an industry body who collate statistical information relating to the media. It appears that this has been added to verify the circulation figures provided which relate to various publications where the opponent has promoted their goods.

Exhibit JCdeB5A are facebook web print outs. The page is headed "G-Star Raw Clothing".

Exhibit JCdeB6 are samples of advertisements placed by G-Star in magazines and publications in the UK "over the years".

Exhibit JCdeB7-14 are samples of advertisements placed in Germany, Sweden, Italy, Belgium, France, Netherland, Spain, Denmark respectively. The advertisements relate to the sale of clothing.

Exhibit JCdeB15 are samples of outdoor advertising materials. Mr de Bil states that these are placed on billboards, electronic signage, fashion shows and taxis in places such as London, Birmingham, Manchester and Glasgow). They are not dated and include representations of G-STAR RAW, and not RAW *solus*.

Exhibit JCdeB16 are copies of "RAW" magazines dated Autumn/Winter 2009, Spring/Summer 2010, Autumn/Winter 2010, Autumn/Winter 2011. There is one further magazine but the date is illegible. The magazines include numerous examples of the clothing designed and sold by the opponent.

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Exhibit JCdeB17 are a selection of online articles featuring a number of celebrities including the actresses Liv Tyler and Gemma Arterton. There a number of articles, all of which are dated 2010 and 2011.

Exhibit JCdeB18 are images of the opponent's "Fall (Autumn) 2010 Campaign".

Exhibit JCdeB19 are a number of screen shots of stores throughout the UK which sell the opponent's goods. These stores include House of Fraser, Selfridges, John Lewis, ASOS, Accent, Quest Retail, USC, Shopdirect Group and "many others". Each of the screen shots refer to the stores as "G-STAR".

Exhibit JCdeB20 are further web screen prints which offer for sale the opponent's goods. These websites include next.co.uk, very.co.uk, amazon.co.uk and asos.com.

Mr de Bil states that a number of the opponent's goods are sold via franchised stores. He states that they offer training on the G-Star brand and, evidence in exhibit JCdeB21, are screenshots relating to franchises. The shots are dated 15 December 2014.

Mr de Bil states that the opponent produces a number of short films, some of which are advertisements for their goods. Exhibit JCdeB22 are a selection of screen shots from youtube. They are all prior to the relevant date, except for the first two screen shots which have the video title "Pharrell Williams presents RAW for the Oceans"

### **Proof of use**

#### **Relevant statutory provision: Section 6A:**

13. "Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

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(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14. In the applicant’s counterstatement they requested that the opponent provide proof of use for a number of the earlier relied upon registrations (namely 4743225, 11493103, 1131972, 2650539, 2491837 and 4743225) then stated the following:

“I would like the opponent to provide “proof of use” for all goods and services in class 41 that apply to trade mark application being opposed.”<sup>4</sup>

15. The only earlier registration which includes class 41 is European Community no. 9702184, which completed registration on 5 July 2011. Since this is less than 5 years prior to the date of publication of the application (i.e. five years prior to 18 October 2013) it is not subject to proof of use trade mark.<sup>5</sup>

### **Law and relevant legislation**

#### **Section 5(2)(b)**

16. Sections 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

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<sup>4</sup> Section 7 of the counterstatement headed “Request for proof of use”

<sup>5</sup> Section 6A(3)(b) of the Trade Marks Act 1994 (as amended)

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(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

### The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;



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(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of services

#### Class 35 (emphasis in bold added)

Opponent's services (UK 2650539 and CTM 1131972)	Applicant's services
<p>Retail services in connection with the sale of soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses and spectacles, spectacles frames, spectacles cases, sound-, image and data carriers, such as CD's and DVD's, jewelry, bijoux, horological and chronometric instruments, amongst others watches, handbags, headgear, jewellery, bags, rucksacks, purses, wallets, trunks and traveling bags, umbrellas, parasols and walking sticks, clothing, footwear, headgear, belts (clothing) and fashion accessories; business intermediary services in the purchase and sale of soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses and spectacles, spectacles frames, spectacles cases, sound-, image and data carriers, such as CD's and DVD's, jewelry, bijoux, horological and chronometric instruments, amongst others watches, goods of leather or imitations of leather not included in other classes, bags, rucksacks, purses, wallets, trunks and traveling bags, umbrellas, parasols and walking sticks, clothing footwear headgear, belts (clothing) and fashion accessories; business management; business administration and administrative services; <b>sales promotion</b>; commercial business and administrative services in the field of franchising and exploitation of retail businesses.</p>	<p>Advertisement and publicity services by television, radio, mail; Advertisements (placing of-); Advertisements (preparing of-); Advertising; Advertising and advertisement services; Advertising and promotion services; Advertising and publicity services; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising flyer distribution; Advertising services provided via the internet; Production of video recordings for advertising purposes; Production of video recordings for marketing purposes; Production of video recordings for publicity purposes.</p>

18. The opponent's services include the broad term "sales promotion". Generally speaking this term is the same as "advertising" services insofar that the nature and intended purpose of both is an activity, profession or task which promotes supports and/or encourages the sale of others goods and services. However, I recognise that some advertising services do not focus on sales of goods or services but to generally

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raise the profile thereof. Nevertheless, owing to shared purpose, users, channels of trade and complementarity, I find that “sales promotion” services similar to a higher than average degree to the following services:

Advertisement and publicity services by television, radio, mail; Advertisements (placing of-); Advertisements (preparing of-); Advertising; Advertising and advertisement services; Advertising and promotion services; Advertising and publicity services; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising flyer distribution; Advertising services provided via the internet.

19. With regard to remaining services, namely: “Production of video recordings for advertising purposes; production of video recordings for marketing purposes; production of video recordings for publicity purposes”. I consider these to be services aimed at promoting and attracting new business. Again the intention of these services may not focus on promoting sales, but assessing the services as a whole and they are similar, also to an above average degree.

### **Class 41 (emphasis added in bold)**

<b>Opponent's services (CTM 9702184)</b>	<b>Applicant's services</b>
Class 41 <b>Entertainment</b> ; record company services, including music publishing services; <b>production and publishing of images, video's and DVD's</b> ; organisation of entertainment and educational events, such as concerts, festivals, parties and workshops; development and production of television and radio programs and publication of printed matter, including books, magazines and newspapers and electronic publications; sporting activities, including the organisation of sports competitions; cultural activities; except services relating to wrestling, wrestling entertainment and wrestlers.	Class 41: Post-production services in the field of music videos and film, Production of musical videos, Video editing, Animated musical entertainment services; Entertainment provided via the internet; Entertainment in the nature of on-going television programs in the field of variety; Showing of prerecorded entertainment.

20. Services can be considered as identical when the services of the applied for mark fall within the ambit of broad terms in the earlier mark (see, for example, *Gerard Meric v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) Case T-133/05 – “*Meric*”).

21. Applying the principles set out in *Meric*, I find that the opponent's “production and publishing of images, video's and DVD's” are identical to the applicant's:

“Post-production services in the field of music videos and film, production of musical videos, video editing”.

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22. To clarify, I consider “video editing” to be identical since the “production” and “post-production” of videos must include the adding and excluding of material, i.e. editing.

23. I also find that the opponent’s “entertainment” services are sufficiently broad to be considered identical to:

“Animated musical entertainment services; Entertainment provided via the internet; entertainment in the nature of on-going television programs in the field of variety; Showing of prerecorded entertainment”

### **Average consumer and the purchasing act**

24. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

25. At paragraph 60 of *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

26. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services and then to determine the manner in which these services are likely to be selected.

### **Class 35**

*Class 35 “advertising and promotion”*

27. In the opponent’s submissions they state that “Adverting services are used by the professional public and the general public”. Generally, I agree though I consider businesses more likely to be the average consumer. Businesses seek advertising and promotion services in order to enhance the profile of their business with the intention of generating additional income and/or exposure. Advertising and promotion services can be an expensive purchase for a business and the potential effect can be crucial to their success or failure. Businesses will often budget a dedicated amount for advertising and promotional services. Accordingly, I find that businesses seeking such services will take a greater than average (but not high) degree of care and attention upon selecting advertising and promotion services.

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28. With regard to the general public seeking advertising and promotion services, I consider the level of care and attention is likely to be lower than businesses, i.e. average. They are more likely to be seeking such services for the sale of personal belongings or, possibly, individual services. These services are not as integral to an individual as they would be to a business, and the cost would be significantly lower (with many advertising forums being free of charge). Therefore, the level of attention would be moderate.

29. Businesses seeking advertising and promotion services are likely to conduct internet investigations, peruse business directories or seek word of mouth recommendations. This is likely to be followed by a face to face meeting to further discuss the individual requirements. Therefore, the purchasing act is likely to be following a visual inspection of advertisements posted by the advertisers, followed by an aural meeting.

30. When members of the general public seek to advertise goods or services, they too are likely to search the internet, local newspapers or follow word of mouth recommendations. It is unlikely that the general public will require a face to face meeting. Therefore, the services are more likely to be purchased following a visual inspection (though aural considerations will still be taken into account).

*Class 35 "Production of video recordings for advertising, marketing and publicity purposes"*

31. The average consumers of these types of services are likely to be businesses. As with advertising and promotional services, employing a third party to produce video recordings, etc. for promotional purposes will be carefully considered. This would take place after a visual internet search or perusal of relevant magazines, trade brochures. Therefore, the services are more likely to be purchased following visual inspection, though aural considerations will still be taken into account.

### **Class 41**

32. As outlined in the comparison of services, the respective class 41 services can be split into "entertainment services" and the "production of entertainment services".

*Class 41 "entertainment and production of entertainment services"*

33. The term entertainment services is broad and would cover services which most people seek and enjoy each day (e.g. tv shows, radio programmes, etc.). Therefore, I generally consider that the average consumers of entertainment services are likely to be the general public. However, I also consider businesses to seek such services. For example, schools, clubs, associations or businesses who wish to entertain their employees or clients. Given the broad nature of the services, I do not consider there to be a primary manner in which the services are sought.

34. With regard to "production of entertainment services", these are likely to be sought by businesses rather than individuals. These are relatively niche services, therefore the level of care and attention taken by the average consumer will be higher than the norm. Purchasing these services are likely to take place following a

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visual inspection of the services offered (via internet searches, magazines, brochures, etc). It is then likely that a face to face meeting will be required to finalise details.

35. To summarise, the average consumer of entertainment services is likely to be the general public with no obvious mode of seeking such services. The average consumers of “production of entertainment services” are likely to be businesses, following a visual inspection (though the subsequent aural meeting is also taken into account).

### Comparison of marks

36. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

38. The respective marks are shown below:

Opponent's mark	Applicant's mark
RAW	RawTiD TV

### *Applicant arguments*

39. In the applicant's counterstatement they state as follows:

“The mark belonging to the opponent “RAW” and the mark being opposed “Rawtid TV” both contain three of the same letters from the English alphabet, which are the letters “R”, “A” and “W”. The marks are however, perfectly distinguishable and bear absolutely no conceptual similarity.

As an example, the comparison between the respective marks are clearly distinct as if the mark of the opponent was “MAT” and the mark being opposed was “Matter TV” or if the mark of the opponent was “WIN” and the

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mark being opposed was “Window TV”. The “TID TV” element of the mark being opposed is more than sufficient to distinguish “RAW” and “Rawtid TV”.

40. There are two flaws with the applicant’s argument. Firstly, the “T” within “RawTiD” is a capital rather than a lower case letter as argued by the applicant. The capital “T” separates Raw from the rest of the mark. If the “t” was in lower case as the applicant suggests there would be a degree of merit in this argument. Secondly, the example of “Matter TV” against the subject application is not comparable. “MAT” has no ordinary meaning and is not independently distinctive within MATTER, whereas “Raw” has a meaning and is independent within the application.

### *Comparison*

41. The opponent’s mark consists of the single word RAW. This is the only element. Therefore, the distinctiveness of the mark rests in the whole.

42. The applicant’s mark consists of RawTiD and TV. The dominant and distinctive element of the application is RawTiD, with TV merely being descriptive for Television. It does not add distinctive character to the mark as a whole but its presence is not disregarded. Whilst RawTiD is conjoined, since the T is in the centre and is capitalised it separates the mark. Further, given that Raw is a well known, dictionary defined word it is likely to be viewed independently of TiD.

43. With regard to TiD, these initials do not have an obvious meaning and no evidence on how they would be perceived has been filed. Accordingly, they are likely to be perceived as an acronym, the meaning of which will be unknown and distinctive.

44. To summarise, the overall impression created by the the application is RawTiD, with Raw being independently distinctive.

45. Visually, the opponent’s mark is wholly contained in the application, appearing as the first three letters. The capital letter “T”, followed by “iD”, dissects it from Raw. Therefore, from a visual perspective there is an obvious point of similarity, albeit no more than average.

46. Conceptually, the earlier mark will be known by its ordinary meaning, i.e. something unfinished or uncooked. Since this is the only component of the earlier mark which has a meaning this is the only way in which it will be conceptualised. Given that the application begins with “Raw” and that it is the only element of the mark which will be understood, I find that there be some conceptual similarity. I consider the level of such similarity to be average.

47. Aurally, the earlier mark would be pronounced in its ordinary manner, i.e. RAW. With regard to the application, given the dissection of RAW from TiD (as discussed in paragraph \*\*), it would be pronounced as RAW-T-I-D, TV. Since the first part of the respective marks would be verbalised in the same manner, although there is additional matter, I consider the level of aural similarity to be above average.

**Distinctive character of the earlier trade mark**

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated in paragraphs 22 and 23 that:

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

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

49. The distinctive character of the earlier mark is another important factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24).

50. The opponent has filed turnover and advertising figures and copious examples of use of the G-STAR RAW (with and without the device) mark. The evidence demonstrates that the opponent has a reputation in the UK in respect of the aforementioned marks but not RAW *solus*. Further, the evidence filed proves that the opponent has a reputation in clothing and the retailing thereof rather than the remaining relied upon goods and services.

51. With regard to the mark’s inherent distinctive character, the word RAW is not descriptive of the goods and/or services offered. Further, it is not an invented word and its ordinary meaning would be understood by the average consumer. Since RAW is not an invented word, it cannot be at the top end of the distinctiveness scale. Accordingly, I find that overall the mark RAW has (at least) an average degree of distinctiveness for the services offered.

**Likelihood of confusion**

52. It is necessary to consider the earlier mark to have been used in relation to all the goods/services covered by the registered In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated at paragraph 78 that:

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“.....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

53. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I must also keep in mind the distinctive character of the opponent’s mark as the more distinctive these marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture retained in their mind.

54. In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04 in which the CJEU stated at paragraphs 29 to 36:

“In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.



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The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

55. With regard to assessing the independent and distinctive roles within the respective marks, Anna Carboni sitting as the appointed person in *Julius Sämaan Limited (Bermuda) and Julius Sämaan Limited (Switzerland) v L&D S.A. (“Aire Limpio”)* in BL O/193/15 recently summarised the relevant case law<sup>6</sup>:

“95. I do not think that any of this is revelatory, but it is a useful reminder of the approach that should be taken when assessing the similarity of a later composite mark that incorporates an element that is argued to be the same as or similar to the earlier mark or a dominant or distinctive component of it. In summary, this approach should be:

(1) is the earlier trade mark, or a dominant or distinctive component of it, the dominant element of the composite sign?

(2) if not, does it nevertheless retain a role in the composite sign that is perceived by the average consumer, notwithstanding the fact that another element of the sign may be more prominent?

(3) if so, it must be taken into consideration for the purposes of assessing the similarity between the composite sign and the earlier

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<sup>6</sup> *Medion, Bimbo and Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch)

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trade mark and is therefore relevant for the purposes of assessing the likelihood of confusion;

(4) but it is only one factor in the global assessment and does not mean that a likelihood of confusion will necessarily be found.”

56. Applying the principles set out by Ms Carboni, I do not consider the earlier mark (RAW) to be dominant within the application but it is an independently distinctive component thereof. The word RAW does retain a role within the application which would be recognised and perceived by the average consumer. Accordingly, upon taking a global appreciation of the level of similarity, the independent role of RAW will be taken into account.

57. Other factors to be taken into account are:

- The respective services are highly similar.
- The average consumer of the services are more likely to be businesses rather than the general public, and they will take an above average degree (but not high) degree of care and attention. The general public may also seek these services, but with a lower degree of care. Regardless of the consumer the services are more likely to be acquired following a visual inspection.
- There is no enhanced distinctive character through use of the mark, though the mark RAW has (at least) an average degree of inherent distinctiveness.
- With regard to comparison of the marks, they are similar to the following degrees: conceptually average, visually no more than average and aurally above average.

58. Overall the earlier mark is considered to have an average (at least) degree of distinctive character, it is similar to an average degree to the application and the respective services are highly similar. Therefore, I conclude that there is an overall likelihood of confusion. Further, given that I consider the earlier mark (RAW) to be independently distinctive within the application as a whole, a global appreciation of the relevant factors lead to a likelihood of confusion.

### **Section 5(2)(b) outcome**

**59. The opposition succeeds. The application is refused in its entirety.**

### **Section 5(3)**

60. Whilst the opponent has already succeeded in this opposition, I shall still consider their claim under section 5(3) of the Act, which states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United

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Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

### *General principles to apply when considering 5(3)*

61. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

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

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

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in

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such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

62. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

### Decision

63. ‘Reputation’ for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572).

64. The opponent clearly has substantial sales, invests heavily in promotional activities and has widespread use throughout the UK. However, at paragraph 9 of Mr de Bil's witness statement

“I do not have figures for the total sales value of goods and services offered under our various brands in the UK from the date of first use of RAW but the table below lists turnover of the G-Star business in the UK...”

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65. The evidence shows that the opponent has established a reputation in the UK for clothing and the retailing thereof. However, it is clear that the reputation resides with G-STAR RAW (with and without the device), which was not pleaded, and not RAW *solus*. Therefore, the opponent falls at the reputation hurdle and I do not need to consider this section of the Act any further.

### Section 5(3) outcome

**66. The opposition based on section 5(3) fails in its entirety.**

### COSTS

67. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement of grounds and considering the other side's statement	£400
Official fee	£200
Preparing evidence and submissions	£600
Total	£1200

68. I therefore order Michael Campbell to pay G-STAR RAW C.V. & FACTON LTD the sum of £1200. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15th day of June 2015**

**MARK KING**  
**For the Registrar,**  
**The Comptroller-General**