

O-585-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3075415
STANDING IN THE NAME OF RAW AUTOS LTD
FOR REGISTRATION OF THE MARK

The logo for RAW AUTOMOTIVE features the word "RAW" in a large, bold, italicized sans-serif font. The letter "A" is stylized with a white gear-like shape inside it. To the right of "RAW", the word "AUTOMOTIVE" is written in a smaller, bold, italicized sans-serif font. A horizontal line runs underneath the entire "RAW AUTOMOTIVE" text.

AND

OPPOSITION THERETO UNDER NO 403690
BY G-STAR RAW C.V.

Background

1. Application No 3075415 has a filing date of 3 October 2014 and seeks registration of the trade mark shown on the front cover of this decision. It stands in the name of RAW Autos Ltd (“the applicant”) and seeks registration for the following services:

Class 37

Vehicle maintenance, vehicle repairs, automotive servicing

2. Following publication of the application in *Trade Marks Journal* 2014/045 on 31 October 2014, notice of opposition was filed by G-Star Raw C.V. (“the opponent”). The opposition was originally based on grounds under sections 5(2), 5(3) and 5(4) of the Trade Marks Act 1994 (“the Act”) but the opponent later indicated it no longer sought to rely on the latter two grounds. The single remaining ground is one founded on section 5(2)(b) of the Act. In support of this objection the opponent relies on the following Community Trade Mark (“CTM”) insofar as it is registered for the following goods:

Mark	Relevant dates	Specification relied upon
CTM 1149103 RAW	Filing date: 16 January 2013 Date of entry in register: 23 June 2013	Vehicles; apparatus for locomotion by land, air or water

3. The applicant filed a counterstatement in which, essentially, it denies there is any likelihood of confusion.

4. Only the applicant filed evidence which I will refer to as necessary in this decision. Neither party requested a hearing but both filed written submissions in lieu of attendance at the hearing. I give this decision after a careful review of all the papers before me.

Decision

5. Sections 5(2)(b) of the Act states:

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

(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”.

6. Given the filing dates of the respective marks as set out above, the mark relied on by the opponent is an earlier mark within the meaning of the Act. As it had not been registered for five years at the date of filing of the application, there is no requirement that the opponent prove use of its mark. This means that it is entitled to rely on each of the goods as claimed whether or not it has made use of the mark on such goods.

7. In determining whether there is a likelihood of confusion, I take into account the following principles which 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;
- (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 the respective goods and services

8. The comparison I have to make is a notional one based on the specifications of goods and services as registered and applied for regardless of what use, if any, may have been made of them. The respective specifications are as follows:

The earlier mark	The application
Class 12 Vehicles; apparatus for locomotion by land, air or water	Class 37 Vehicle maintenance, vehicle repairs, automotive servicing

9. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

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

11. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (GC) stated that “complementary” means:

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

12. The opponent's goods are, broadly speaking, vehicles or apparatus for locomotion. The services for which registration is sought are for the maintenance, repair and servicing of vehicles (automotives). Whilst they are clearly not identical, the users of the respective goods and services are the same in that the purchaser of a vehicle will need to maintain, repair and/or service it. Such services are commonly carried out by the manufacturer of vehicles and are complementary. I consider the respective goods and services are similar to a reasonable degree.

The average consumer and the nature of the purchasing process

13. 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 and/or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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

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

15. Vehicles may be bought by the general (driving) public and may also be bought by businesses, particularly when the vehicle is for a particular purpose such as a lorry, a hearse or a minibus. Whoever the purchaser, they are goods that will be bought on an irregular basis with a high degree of care being taken not only to ensure that the goods meet the specific needs of the purchaser but also because of the likely cost involved. Maintenance and repair services are likely to be bought on a more regular basis and at a lesser cost but, given the importance of maintaining a vehicle in good order, a reasonably high degree of care will still be taken. Both the visual and aural considerations are likely to underpin the purchasing process given that the purchase of the respective goods and services is likely to involve e.g. reviewing brochures (whether online or not), the completion of paperwork and discussion with the provider.

Comparison of marks


16. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

18. The marks to be compared are as follows:

The earlier mark	The applicant's mark
RAW	

19. The earlier mark consists of the ordinary dictionary word RAW. As no part of the mark is highlighted in any way, its distinctiveness rests in its whole.

20. The applicant's mark consists of a number of elements. To the left hand side of the mark there are letters which the applicant says are RAW, the initials of one of the directors of the company. This may be true, however, the derivation of the mark is not something which I can take into account in the comparison. The letter A within the word is partially obscured by the device of a spark plug which extends to almost the full height of the letter, however, there is a sufficient portion of the letter visible to show that it is intended to be a letter A and I agree with the applicant that this element will be seen as the word/letters RAW. To the right hand side of the mark is the word AUTOMOTIVE. This word is presented in smaller letters, roughly half the height of the other element of the mark. The word AUTOMOTIVE is bordered above and below by a line, the lower line extending the full width of the mark. Each of the letters within the mark is presented in a stylised and italicised upper case typeface. Neither the device of a spark plug nor the word AUTOMOTIVE is distinctive in relation to services for the maintenance, repair or servicing of vehicles. The RAW element is distinctive and has a degree of dominance given its size and position within the mark and despite it being partially obscured.

21. On a visual comparison, there is a degree of similarity between the respective marks given that both contain the word RAW as their only or first element. There are also visual differences between the marks in that the device of a spark plug and the word AUTOMOTIVE have no equivalents in the earlier mark. In its written

submissions, the applicant refers to the stylisation of the letters within its mark and submits that this distinguishes it from the opponent's mark, however, as normal and fair use of the opponent's mark would include use in a variety of fonts, the apparent visual differences between the respective marks would be reduced. I say "apparent" because insignificant differences between the two might go unnoticed by the average consumer (see: *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00, [2003] ETMR 83). Taking all matters into account, the respective marks are similar to a reasonable degree.

22. From an aural consideration, the similarity is somewhat higher. This is because the device element will not be articulated and, given its descriptiveness, the word AUTOMOTIVE may not be either. The aural similarity is one of a reasonably high degree.

23. The word RAW is an ordinary dictionary word with a range of meanings such as uncooked or inexperienced but is also used in the vernacular to mean hard-core in the sense of being serious or committed. Whichever image is brought to mind by the average consumer, it is likely to be the same in respect of both marks.

The distinctive character of the earlier mark

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

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

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

25. The opponent has filed no evidence and therefore I have only the inherent distinctiveness of the earlier mark to consider. Whilst the word RAW is an ordinary dictionary word, it has no particular meaning in relation to the goods for which it is registered. The earlier mark has an average degree of inherent distinctive character.

Likelihood of confusion

26. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

27. In its submissions the applicant states it carried out a number of searches prior to the setting up of its business including searches of the "automotive industry for any similar names and trademarks in the IPO register specifically in class 37 and related classes as well as on Companies House". It gives no further information about what searches of the "automotive industry" it made and I cannot comment on them. In respect of the search for other trade marks, it says its searches were directed only to class 37 and, if that is the case, it may not have identified other trade marks for goods and services in other classes which could be regarded as having a degree of similarity with its own services. Lastly, the registration of company names is an entirely separate regime to the registration of trade marks.

28. As I have explained above, I have to consider the likelihood of confusion between the earlier mark and the mark applied for on a notional basis, bearing in mind the guidance provided by the case law which I have set out.

29. Earlier in this decision I found:

- The respective goods and services are similar to a reasonable degree;
- The goods and services will be bought by the general public as well as those in business. The goods are such as will be bought on an irregular basis, at high cost and a high degree of care will be taken over that purchase. The services are such as will be bought on a more regular basis but still be a reasonably high degree of care;
- The purchasing process of the respective goods and services will be underpinned by both visual and aural considerations;
- The respective marks have a reasonable degree of visual similarity, a reasonably high degree of aural similarity and are conceptually the same;
- The earlier mark has an average degree of inherent distinctive character which has not been shown to have been enhanced through use.

30. There is a rule of thumb that the beginnings of mark are of greater impact than the endings (the comments of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 refer). In this case, the word which makes up the earlier mark is the first element of the application and it is the dominant and distinctive element of that mark. Taking all matters into account, I find that there is a likelihood of confusion between the respective marks. Even if the average consumer does not directly confuse them (i.e. mistake one mark for the other) there will be indirect confusion (i.e. the average consumer will consider that the respective goods and services come from businesses which are economically connected. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

31. I have already found that the device of a spark plug and word AUTOMOTIVE are non distinctive elements within the mark. In view of my findings, the opposition brought on grounds under section 5(2)(b) of the Act succeeds in full.

Summary

32. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

33. The opponent, having succeeded, is entitled to an award of costs in its favour. I note that although originally based on three grounds, it sought to proceed in respect of a single ground under 5(2)(b) only. I also note that it did not file evidence though did file written submissions. The evidence filed by the applicant was not extensive. Neither party requested to be heard so the decision has been taken after reviewing the papers. Taking all matters into account, I make the award on the following basis:

For filing a notice of opposition and reviewing the applicant's statement of grounds:	£300
Fee for 5(2)(b) objection:	£100
For reviewing evidence:	£100
For preparation of written submissions;	£200
Total:	£700

34. I order RAW Autos Ltd to pay G-Star Raw C.V. the sum of £700. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of December 2015

**Ann Corbett
For the Registrar
The Comptroller-General**