

O-608-17

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3190058
BY RAWKUS LTD TO REGISTER:



AND

THE OPPOSITION THERETO UNDER NO 408400 BY
G-STAR RAW C.V.

BACKGROUND

1. On 8 October 2016, Rawkus Ltd (the applicant) applied to register the above trade mark in the following class:¹

Class 41

Live entertainment production services; Live entertainment; Live entertainment services; Club entertainment services; Festivals (Organisation of -) for entertainment purposes; Festivals (Organisation of -) for recreational purposes; Festivals (Organisation of -) for cultural purposes; Festivals (Organisation of -) for educational purposes.

2. The application was published on 28 October 2016, following which G-Star Raw C.V. (the opponent) filed notice of opposition against all of the services in the application.

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon the following European Union Trade Marks (EUTMs):

Mark details and relevant dates	Services relied upon
EUTM14993356 RAW Filed: 12 January 2016 Registered: 24 August 2016	Class 41 Education; Providing of training; Entertainment; Sporting and cultural activities; Academies [education]; Educational examination; Entertainment; Amusement park services; Vocational guidance; Casino facilities [gambling] (Providing -); Circuses; Club services [entertainment or education]; Coaching [training]; Music composition services; Electronic desktop publishing; Amusement arcade services; Zoological garden services; Disc jockey services; Entertainer services; Recording studios; News reporters services; Services of schools [education]; Language interpreter services; Animal training; Discotheque services; Tuition; Videotaping; Film production, other than advertising films; Movie studios; Rental of motion pictures; Conducting fitness classes; Photography; Photographic reporting; Health club services [health and fitness training]; Religious education; Gambling; Gymnastic instruction; Arranging and conducting of colloquiums; Arranging and conducting of conferences; Arranging and conducting of congresses; Arranging and

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>conducting of seminars; Arranging and conducting of symposiums; Workshops (Arranging and conducting of -) [training]; Scriptwriting services; Entertainment information; Education information; Information services relating to recreation; Sign language interpretation; Calligraphy services; Nursery schools; Boarding schools; Layout services, other than for advertising purposes; Physical education; Tutoring; Microfilming; Mobile library services; Modelling for artists; Organisation of fashion shows for entertainment purposes; Videotape editing; Museum facilities (Providing -) [presentation, exhibitions]; Music-halls; Production of music; Night clubs; Dubbing; Vocational retraining; Subtitling; Publication of electronic books and journals on-line; Radio entertainment; Television entertainment; Writing of texts, other than publicity texts; Organization of balls; Operating of lotteries; Arranging of beauty contests; Organisation of sports competitions; Organization of exhibitions for cultural or educational purposes; Organization of shows [impresario services]; Organisation of competitions [education or entertainment]; Arranging and conducting of concerts; Orchestra services; Personal trainer services [fitness training]; Ticket agency services [entertainment]; Booking of seats for shows; Training (Practical -) [demonstration]; Production of shows; Planning (Party -) [entertainment]; Production of television and radio programs; Correspondence courses; Sport camp services; Publication of texts, other than publicity texts; Golf facilities (Providing -); Recreation facilities (Providing -); Providing karaoke services; Providing non-downloadable electronic publications online; Providing on-line music, not downloadable; Providing on-line videos, not downloadable; Game services provided on-line from a computer network; Providing sports facilities; Theater productions; Timing of sports events; Performances (Presentation of live -); Publication of books; Library services; Camp services (Holiday -) [entertainment]; Rental of audio equipment; Rental of stage scenery; Rental of skin diving equipment; Rental of movie projectors and accessories; Rental of sound recordings; Rental of radio and television sets; Rental of toys; Games equipment rental; Rental of sports grounds; Rental of sports equipment, except vehicles; Rental of stadium facilities; Rental of tennis courts; Rental of stage scenery; Rental of lighting apparatus for theatrical sets or television studios; Rental of videotapes; Rental of video cameras; Rental of video recorders; Translation and interpretation; Cinema presentations; None of the aforesaid services relating to wrestling, wrestling event or wrestlers.</p>
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<p>EUTM9702184²</p> <p style="text-align: center;">RAW</p> <p>Filed: 1 February 2011 Registered: 5 July 2011</p>	<p>Class 41 Entertainment; record company services, including music publishing services; production and publishing of images, video's and DVD's; 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.</p>
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4. The opponent submits the following in respect of both earlier marks relied upon:

“The marks are closely similar visually, aurally and conceptually and the parties’ marks are identical in their distinctive elements as they both comprise RAW. ‘RAW’ is the distinctive element of the applied for mark. The services are identical and similar.”

5. The applicant filed a counterstatement in which it denied the ground raised by the opponent. The opponent's marks are earlier marks, the second of which is, in principle, subject to proof of use. This is because, at the date of publication of the application, it had been registered for five years.³ However, at section 7 of its counter statement the applicant answered “NO” when asked if it required the opponent to provide proof of use. Consequently, the opponent is entitled to rely on its full specification in class 41.

6. Neither party filed evidence or requested to be heard. The opponent filed submissions in lieu of a hearing.

² The opponent relies on all of the services for which this earlier mark is registered. The annex provided with the opponent’s statement of grounds is a duplication of the specification for EUTM14993356. I have proceed on the basis of the specification of the mark as it stands on the trade marks register.

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

Preliminary issue

The opponent's earlier rights

7. Both of the opponent's earlier marks are the plain English word RAW. For the remainder of the decision I will refer to the earlier RAW mark by which I mean to include both earlier rights.

Other registered marks

8. In section 8 of its counterstatement the applicant makes reference to:

"[the] three letters ('RAW') historically used by a multitude of other businesses and their brands (for example; the wrestling brand WWE Raw, which has until now managed to cohabit despite being, in our opinion, a much closer match to G Star Raw)."

9. The applicant has not provided any examples of RAW marks used by other businesses beyond its reference to WWE Raw. It has not indicated which goods and/or services the mark referred to stands registered for, whether the mark is used and if it is, how it is used. The mark referred to is not on all fours with any of the marks at issue in these proceedings. Furthermore, the opponent is not relying on G Star Raw, but on two RAW solus marks and it is on that basis that this decision must be made. Consequently, I will say no more about this submission.

DECISION

10. Section 5(2)(b) of the Act states:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

Section 5(2)(b) case law

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 services

12. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴ the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

⁴ Case T- 133/05

13. Whilst *Meric* deals specifically with goods, its findings are analogous to specifications which relate to services.

14. The specification of the mark applied for is:

Live entertainment production services; Live entertainment; Live entertainment services; Club entertainment services; Festivals (Organisation of -) for entertainment purposes; Festivals (Organisation of -) for recreational purposes; Festivals (Organisation of -) for cultural purposes; Festivals (Organisation of -) for educational purposes.

15. The opponent's second mark includes the terms, 'Entertainment' and 'Organisation of entertainment and educational events, such as concerts, festivals, parties and workshops'. Clearly, as the services included in the applicant's specification are included within these broad terms they are identical in accordance with the decision in *Meric*.

16. Having found these services to be identical the specification of the first mark relied upon by the opponent puts it in no better position.

The average consumer and the nature of the purchasing act

17. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

18. 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*⁵, 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

⁵ [2014] EWHC 439 (Ch)


court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

19. Entertainment services are normal everyday services provided to members of the general public. A member of the public is likely to pay at least an average degree of attention to the purchase, as they will need to consider location, entry cost, content and so on. The purchase is likely to be primarily visual, the consumer encountering such events online or through more traditional print media and advertising such as magazines, newspapers, leaflets and posters. Tickets for festivals and entertainment events are likely to be primarily made available online, meaning that they will be visual purchases. However, I do not rule out an aural element to the purchase, particularly as, in my experience, it is not unusual to for an event to also provide a telephone number for information and ticket ordering. However, I bear in mind that prior to ticket purchase the consumer is likely to have already encountered event information visually.

20. The average consumer for services relating to organisation of entertainment and festivals are likely to be businesses or professionals who are likely to pay an above average level of attention to what is not a casual purchase. They may need to consider, inter alia, the nature of the event, cost of staging the event, licencing and venue hire. The purchase is likely to be primarily visual being accessed online, at trade fairs or through advertising, though I do not rule out an aural element where advice may be sought prior to purchase.

Comparison of marks

21. The marks to be compared are as follows:

Opponent	Applicant
<p>RAW</p>	 <p>The logo for 'RAWKUS!' features the word 'RAWKUS!' in a large, stylized, blue font with a pink outline and a drop shadow. Below it, the words 'POP PUNK / HARDCORE' and 'METAL / ALTERNATIVE' are written in a smaller, white, blocky font with black outlines.</p>

22. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁶, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

23. With regard to the comparison to be made between the respective marks, the opponent states:

10. RAWKUS is an invented term. It does however comprise the known English language word 'RAW' which is immediately perceived when viewing the mark RAWKUS. Because RAW is an immediately recognizable English language word, it stands out within the overall RAWKUS. The contested RAWKUS mark can immediately be perceived as being formed of two separate elements, namely, 'RAW' and 'KUS!'. The opponent submits that the second portion of the mark 'KUS!' will go unnoticed by consumers.

24. The opponent submits that the graphic element in the contested mark amounts to 'no more than stylised lettering' and concludes that RAW is the dominant and distinctive element of the opposed mark.

25. The applicant's mark is the word RAWKUS! presented in a graffiti style typeface with a torn effect at the termination of each character. The text is smaller at the beginning of the word getting larger towards the final 'S!'. The letters are blue surrounded by a black outline and an additional pink outline. Below the work RAWKUS! are the smaller words POP PUNK/HARDCORE and below those words, METAL/ALTERNATIVE presented in the same typeface. These additional words are white with the forward slashes coloured blue.

26. I do not agree with the opponent that the average consumer will divide the applicant's mark into RAW and KUS! Nor do I agree that the average consumer will pay no attention to the 'KUS!' part of the mark. The RAWKUS! element will either be seen as a misspelling of the English word RAUCOUS or will be seen as an invented word, the former being the more

⁶ *Sabel v Puma AG, para.23*

likely. There is nothing about the presentation of RAWKUS! which would indicate that the first three letters should be considered separately and I can see no reason to conclude that they will take on an independent significance of their own.

27. The additional words POP PUNK / HARDCORE and METAL / ALTERNATIVE are smaller and will be considered, in the context of the services, to relate to the type of music, style or content of the services being provided. It is the larger word RAWKUS! which is both distinctive and dominates the overall impression of the mark.

28. The opponent's mark is the word RAW presented in upper case and in plain black type with no additional stylisation. The overall impression of the opponent's mark rests in that word.

Visual similarity

29. Visual similarity rests in the fact that the entirety of the opponent's mark, RAW, makes up the first three letters of the application.

30. Differences include the additional letters and exclamation mark after the letters RAW, to form a single element RAWKUS! in the application. The presentation of the marks is quite different. I note that the opponent submits that the presentation of the applicant's mark is 'no more than stylised lettering'. Whilst notional and fair use of the opponent's mark means that the mark may be presented in any number of typefaces, the stylisation of the application goes beyond a standard typeface. The nature of its colouring, additional outline, and the torn effect applied to the termination of each character result in a presentation that goes beyond the simple selection of a fairly standard typeface. The additional words POP PUNK/HARDCORE and METAL/ALTERNATIVE are not visually de minimis and will be noticed by the average consumer. They provide an additional point of difference between the marks.

31. I find these marks in their totalities to be visually similar to a fairly low degree.

Aural similarity

32. The opponent's mark RAW is easily understood by the average consumer and will be pronounced accordingly.

33. The only part of the applicant's mark which will be articulated by the average consumer is 'RAWKUS' which will be pronounced as spelled, to sound the same as the word 'raucous'. Similarity rests in the fact that the first syllable of the application is the same as the opponent's mark in its entirety. The obvious difference is the second syllable 'KUS' in the application, which has no equivalent in the earlier mark. Overall, I find these marks to have a medium degree of aural similarity.

Conceptual similarity

34. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁷ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.⁸

35. As I have already found, earlier in this decision, RAWKUS! in the applicant's mark will either be seen as a misspelling of the English word RAUCOUS or will be seen as an invented word, though I think the former more likely. The additional words in the mark are likely to be seen as an indication of the music styles or content of the festivals to which the mark relates. The opponent's mark RAW will be given its plain ordinary meaning, namely, unfinished or uncooked by the average UK consumer who will readily understand the word.

36. If the consumer sees the application as a misspelling of raucous, then it will be given its plain meaning of loud or dissonant noise. This is clearly conceptually different to the opponent's mark which will be seen as meaning unfinished or uncooked. If the consumer gives the application no meaning (which is less likely) then again it is dissimilar to the opponent's mark which has a clearly understood meaning. Taking all of these factors into account, I find the marks to be conceptually dissimilar.

⁷ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁸ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O/048/08, paragraphs 36 and 37.

Distinctive character of the earlier marks

37. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.⁹

38. The opponent submits that:

“...the particularly distinctive character of its RAW mark serves to increase the likelihood of confusion with the contested mark, because the likelihood of association between the marks is greater”.

39. It is not clear to me the basis on which the opponent claims that RAW is ‘particularly distinctive’. No evidence has been filed to support such a claim with regard to the mark’s distinctiveness for the services in class 41.

40. In terms of inherent distinctiveness RAW will be seen by the average consumer as a common English word with a clearly understood meaning which makes no descriptive or allusive reference to the services. Consequently, it is a normal trade mark possessed of a medium degree of inherent distinctive character.

Likelihood of confusion

41. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁰ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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

⁹ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

¹⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27*

respective services and vice versa.

42. I have made the following findings:

- The average consumer is a member of the general public or a professional.
- The level of attention paid to the purchase will vary. That said, the services will require at least an average degree of attention to be paid.
- The purchase will be primarily a visual one, though I do not discount an aural element.
- The respective marks possess a fairly low degree of visual similarity, are aurally similar to a medium degree and are conceptually dissimilar.
- The earlier mark RAW has a medium degree of inherent distinctive character.

43. The opponent draws my attention to the general rule that the average consumer pays more attention to the beginnings of marks submitting that the three letters RAW appear at the beginning of the applicant's mark so that their dominance is increased. This principle has been established in a number of cases, including, *El Corte Inglés, SA v OHIM*¹¹ and is a general rule which does not replace the principle that each case must be decided on its merits.

44. In this case the letters of the word RAW do not appear as a word in their own right in the mark applied for, nor are they separated from the remainder by presentation, colour or size. Rather, they are the first three letters of a six letter word. Nothing in the opponent's submissions persuades me that the average consumer will, in assessing the application, separate the first three letters from the front of the applicant's mark and consider them independently of the rest of the word.

¹¹ Cases T-183/02 and T-184/02. See also: GC cases: *Castellani SpA v OHIM, Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*,¹¹ (similar beginnings important or decisive), *CureVac GmbH v OHIM*,¹¹ (similar beginnings not necessarily important or decisive) and *Enercon GmbH v OHIM*,¹¹ (the latter for the application of the principle to a two word mark).

45. The opponent also draws my attention to a decision of the EUIPO Board of Appeal for the mark CLICK FASHION.¹² It is not clear from its submissions why this case has been referenced, but in any event the decision concerns marks which include known words, clearly visible in the marks and are not on all fours with the matters before me.

46. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The respective marks have a fairly low degree of visual similarity and are conceptually different. Bearing in mind the nature of the purchase and taking account of the level of attention paid (even where it is the level of attention paid by the member of the public and not the higher level paid by businesses and professionals), I find the differences between the opponent's marks and the application are too great to give rise to a likelihood of confusion, either directly, where one mark is mistaken for the other, or indirectly, by virtue of a belief that the marks originate from economically linked undertakings.

CONCLUSION

47. The opposition fails under section 5(2)(b).

¹² R1396/2014-2

COSTS

48. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. The applicant has been successful and would normally be entitled to a contribution towards its costs. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited it to indicate whether it intended to make a request for the award of costs. The applicant was informed that, if so, it should complete a pro-forma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the prosecution of the opposition. It was advised that ‘no costs will be awarded’ if the pro-forma was not completed. The applicant did not file a completed pro-forma. That being the case, I direct that the parties bear their own costs.

Dated this 30th day of November 2017

**Ms AI Skilton
For the Registrar,
The Comptroller-General**