

O-002-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3143259

BY BENJAMIN AMANNA LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 5, 18, 25, 28, 35 &

41:

BOXRAW

AND

OPPOSITION THERETO (NO. 406530) BY G-STAR RAW C.V.

Background and pleadings

1. This dispute concerns whether the following trade mark should be registered for the goods and services shown below:

BOXRAW

Class 5: Pharmaceutical preparations; dietetic food and substances adapted for medical use, dietary supplements for humans; vitamin, mineral and protein supplements; bodybuilding food supplements; weight gain supplements; energy supplements; weight loss supplements; medical kits; filled first aid boxes and kits; carbohydrates in liquid form; plant compounds and extracts for use as dietary supplements; bandages and dressings; disinfectants for hygiene purposes; weight loss supplements.

Class 18: Articles of leather and imitation leather not included in other classes, namely, wallets, gym bags, sports bags and draw string bags; trunks and travelling bags; handbags; travel bags; gym bags; sports bags; briefcases; shopping bags; satchels; backpacks; rucksacks; travelling sets; drawstring bags; bags for sport, gymnasium, boxing and mma; duffle bags.

Class 25: Clothing; boxing clothing; fitness clothing; bodybuilding clothing; gym clothing; T-shirts; vests; tanks; hoodies; sweatshirts, jumpers; straps; shorts; trousers; tracksuits; tracksuit bottoms; joggers; hats; headwear; footwear; base layer clothing; compression wear clothing; hats, caps; beanie hats; shoes; trainers; track shoes; boots; sandals; flip flops; socks; boxing boots; mma shorts; boxing shorts; socks; underwear; boxer shorts; boxer briefs; wristbands; robes; sleepwear; boxing jerseys; exercise suits; sauna suits; gloves; ski gloves; head gear; weatherproof clothing; thermal clothing; sports clothing, footwear and headgear; athletic clothing, footwear and headgear; clothing, footwear and headgear for football, rugby, golf, running, cricket, tennis, basketball, fitness, field hockey, ice hockey, training, handball, American football, baseball, boxing and MMA; polo shirts; headbands; sweat bands; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; sleeveless jerseys; undergarments; undergarment skins; brassieres; thongs; baselayer bottoms; baselayer tops; undershirts; unitards; girdles; ankle socks; men's socks; men's

dress socks; leggings; long sleeve shirts [turtle necks]; mock turtle necks; jackets; sweat pants; pullovers; fleece pullovers; knitwear; capri trousers; hooded pullovers; hooded sweatshirts; knit shirts; long-sleeved shirts; coats; dresses; skirts; children's clothing, footwear and headwear; sports bras; sports jackets; sports jerseys; sports trousers; jogging trousers; sports shirts; baseball shoes; baseball caps; baseball uniforms; basketball sneakers; swimwear; beachwear; bikinis; beach footwear; bib overalls; camouflage gloves; camouflage jackets; camouflage trousers; camouflage shirts; camouflage vests; hunting jackets; hunting trousers; bib overalls for hunting; hunting shirts; hunting vests; cleats for attachment to sports shoes; fishing shirts; sports shoes; sneakers; training shoes; running shoes; football shoes; soccer boots; golf shorts; golf shirts; golf caps; golf trousers; martial arts uniforms; mixed martial arts suits; volleyball jerseys; yoga trousers; yoga shirts; athletic uniforms; foul weather gear; rainwear; moisture-wicking sports bras; moisture-wicking sports trousers; moisture-wicking sports shirts; rain suits; rain jackets; rain trousers; rainproof jackets; waterproof jackets and pants; waterproof trousers; windproof trousers; wind resistant jackets; windproof shirts; splash tops; ski bibs; ski gloves; ski jackets; ski pants; ski trousers; ski wear; snow trousers; shorts; snowboard gloves; snowboard mittens; snowboard pants; snowboard trousers; tennis wear; visors; padded shirts; padded trousers; padded shorts; padded elbow compression sleeves; belts; parts, fittings and accessories for all the aforesaid goods.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; gymnasium, sport and training equipment; balls; sport and game balls; footballs; rugby balls, american footballs; golf balls; boxing gloves; table tennis balls; basketballs; bats; table tennis bats, golf clubs, cricket bats, baseball bats, lacrosse sticks; skis; snowboards; basketball rings; table tennis tables; athletic exercise cones; sporting protective items; weight lifting belts, athletic knee and wrist supports, boxing gloves; punch bags; lifting weights; exercise balls; treadmills; exercise machines; cardio-vascular exercise machines; exercise bicycles; cross-trainer exercise machines; stepping exercise machines; boxing bags; boxing rings; boxing balls; boxing wraps; ear and eyebrow protectors for boxers; boxing masks; striking bags; fighting gloves;

training dummies; striking-bag platforms; dumbbells; guards and protectors for football players; rowing machines; chest weights; spring exercisers; grip developers; medicine balls; punching bags; training bags; skipping ropes; wrestling and boxing trunks; supporters; shoe guards; wrestling rings; parallel bars; climbing ropes; bicycle trainers; weight benches; step machines; weightlifting gloves; equipment bags; trampolines; exercise equipment; weight lifting equipment; weight lifting belts; jumping ropes; free weights; aerobic equipment, namely, aerobic fitness belts, stationery cycles, elastic exercise bands, ankle weights, wrist weights, treadmills, exercise bikes; martial arts equipment, namely, kicks, shin guards, punch gloves, body shields, target paddles, punch and kick boards; sporting equipment; sporting articles and equipment for football, rugby, golf, running, cricket, tennis, basketball, fitness, field hockey, ice hockey, training, handball, American football and baseball; bags adapted for sporting articles and sporting equipment; leg and arm guards for sport; protective padded articles for use in sport; apparatus for use in training in sport [sporting equipment]; lip guards for sport; chin pads for athletic use; football girdles; protective athletic cups; jock straps; baseball and softball equipment for catchers, namely, face masks, chest protectors, leg guards, knee supports; toys; parts, fittings and accessories for all the aforesaid goods

Class 35: Business and management advice; business consultancy and business information services; compilation and provision of trade, business, price and statistical information and databases; preparation and compilation of reports; advertising services, business administration, marketing and marketing planning; advisory and consultancy services relating to marketing, marketing assessment services; business planning and development; stock control services; setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes and advice, consultancy and information services relating to such services; business management, including assistance and advising for the establishment and management of retail stores; office functions; provision of space on websites for advertising goods and services; business advisory services, promotional services and information services relating thereto; direct mail advertising; distribution of samples and promotional items; marketing services;

business advisory and information services provided on-line from a computer database or the Internet; retail store services connected with the sale of apparel and sporting goods

Class 41: Training, entertainment, sporting and cultural activities; providing sports facilities; providing recreation facilities; health club services; arranging and conducting of conferences and congresses; presentation of live performances; arranging and conducting of seminars and symposiums; rental of sports equipment; organising of sporting competitions; video tape film production; arranging of sporting events; arranging of sports competitions; educational services relating to sports; hire and rental of equipment for sports; information services relating to sport; instruction courses relating to sporting activities; instruction in sporting activities; organisation of sporting competitions; organisation of sporting events; provision of sport facilities; sports coaching; timing of sports events

2. The mark was filed on 7 January 2016 by Benjamin Amanna Ltd (“the applicant”) and was published for opposition purposes on 29 January 2016.

3. G-Star Raw C.V. (“the opponent”) opposes the registration of the mark under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). It is the owner of various marks which comprise the word **RAW**. I will set out the specifications of the various marks (to the extent necessary) later in this decision, but, for the time being, the following is sufficient to outline the opponent’s case and what marks it relies upon under each ground:

- European Union Trade Mark (“EUTM”) 4743225 which was filed on 24 November 2005 and registered on 15 October 2008. Under section 5(2)(b), the opponent relies upon its goods/services in classes 25 & 35 to oppose the applicant’s goods/services in classes 18, 25 & 35. Under section 5(3) the opponent claims a reputation in classes 25 & 35 to oppose all of the applicant’s goods/services. Given its date of registration, this mark is subject to the proof of use provisions contained in section 6A of the Act. To this extent, the opponent made a statement of use corresponding to the goods/services on which it relies.

- UK trade mark 2650539 which was filed on 1 February 2013 and registered on 5 July 2013. Under section 5(2)(b), the opponent relies on all of its goods/services (in classes 18, 25 & 35) to oppose the applicant's goods/services in classes 18, 25 & 35. Under section 5(3), the opponent claims a reputation for all of its goods/services to oppose all of the applicant's goods/services (with the exception of those in class 5). Given its date of registration, this mark is not subject to the proof of use provisions and may be relied upon without having to establish genuine use.
- EUTM 11493103 which was filed on 16 January 2013 and registered on 23 June 2013. Under section 5(2)(b), the opponent relies on its goods in class 28 to oppose all of the goods in classes 25 & 28 and, additionally, "gym bags, sports bags; bags for sport, gymnasium, boxing and mma" in class 18. This mark is not relied upon under section 5(3). Given its date of registration, this mark is not subject to the proof of use provisions and may be relied upon without having to establish genuine use.
- EUTM 9702184 which was filed on 1 February 2011 and registered on 5 July 2011. Under section 5(2), the opponent relies on all its services in class 41 to oppose the applicant's services in class 41. Under section 5(3), the opponent claims a reputation in relation to its class 41 services with the exception of "sporting activities" and "development of television and radio programs" to oppose all the applicant's services in class 41. Given its date of registration, this mark is not subject to the proof of use provisions and may be relied upon without having to establish genuine use.
- International Registration ("IR") 1131972 which designated the EU for protection on 21 January 2013 with protection being conferred on 4 May 2015. Under section 5(2), the opponent relies upon all of its goods/services in classes 3, 9, 14, 18, 25 & 35 to oppose the goods/services in classes 18, 25 and 35. Under section 5(3), the opponent claims a reputation for all its goods/services to oppose the applicant's goods/services in classes 18, 25, 28 & 35. Given its date of registration, this mark is not subject to the proof of use provisions and may be relied upon without having to establish genuine use.

- The use of the sign **RAW** (which is claimed to have been used since 2001) is relied upon under section 5(4)(a) of the Act to oppose all of the applicant's goods/services.

4. In relation to the section 5(2)(b) claims, the opponent states that the applicant's mark comprises its earlier mark together with the non-distinctive word BOX. It states that the word BOX qualifies the word RAW and is, therefore, not a distinguishing element. It is stated that the majority of the opposed goods/services are directed at the field of boxing and BOX will be given little weight by the consumer.

5. In relation to section 5(3), the opponent considers the marks to be closely similar, as are the respective goods/services, and that the opponent's reputation in RAW will increase the likelihood of the consumer linking the marks and assuming that they are economically connected. The opponent's claims are made on the basis of unfair advantage, dilution and tarnishing.

6. Under section 5(4)(a), the opponent considers that on account of its use of the sign RAW, the applicant's mark misrepresents its goods as those of the opponent, which will result in a loss of sales and which will damage its goodwill. This claim relates to the law of passing-off.

7. The applicant filed a counterstatement denying the claims. It put the opponent to proof of use in respect of the earlier mark which is the subject of those provisions, albeit, specifying the following goods/services on which it required proof:

Class 25: Clothing, footwear, headgear; belts (clothing)

Class 35: Advertising; business management, including franchise services; business administration; office functions.

8. A number of points are made in the counterstatement, including that:

- The marks are not similar even if RAW is included within them.
- There are other marks on the register including the word RAW.

- It disagrees that BOX is descriptive and that it is the RAW element that is distinctive – it, instead, considers the mark as a whole to be distinguishable and that “if anything, the addition of the element BOX actually serves to highlight the fact that the goods/services are boxing related and, therefore, differentiates them from the Opponent’s goods/services”.
- It disagrees that the opponent’s marks have a reputation given that i) the mark is commonly used with other elements and not RAW alone and ii) some of the goods for which a reputation is claimed have not even been used.
- Similar points regarding the mark, goods and use (not used alone) are made in relation to the passing-off claim.

9. Both sides are professionally represented, the applicant by Vault IP Ltd, the opponent by HGF Limited. Both sides filed evidence (the applicant’s evidence was accompanied by a set of written submissions). Neither side requested a hearing, but both filed written submissions in lieu. It should be noted that in the opponent’s submissions filed in lieu of a hearing, reference was made to the opposition being against classes 18, 25 and 35 of the application. I therefore wrote to the opponent seeking clarification as to whether it was reducing the extent of the opposition given that it had been pleaded against all of the goods/services of the application. The opponent responded stating that the reference to classes 18, 25 and 35 was an error and that it still pursued its opposition in full. It also provided some brief additional submissions in respect of class 41, however, as they are so brief, and as they largely repeat what it has said previously, I have taken them into account.

The evidence

10. Rather than provide an evidence summary on a statement by statement basis, I will refer to it with respect to the various relevant and pertinent issues. However, I will set out here who has given evidence and, generally speaking, what the evidence is about.

11. The opponent’s primary evidence comes from its general counsel, Mr Johannes Christian de Bil. He gives evidence about various G STAR companies that were the

predecessors in title to the opponent. He gives evidence about the use and reputation of the mark RAW in trade and the opponent's business more generally. He also gives evidence, although more akin to submissions, about the word BOX in the applicant's mark and why he feels the addition of this word does not help to distinguish between the trade marks at issue.

12. The applicant's primary evidence comes from its director, Benjamin James Amanna. He gives evidence (albeit briefly) about the applicant's business and the meaning of the words BOX and RAW in relation to its boxing orientated brand and contrasts this to the image associated with the opponent's mark. He gives evidence about the distinctiveness of the word RAW by way of state of the register evidence, use in trade and, also, evidence of claimed descriptive use and use as part of slogans.

13. The opponent's reply evidence comes, again, from Mr de Bil in which he i) provides evidence about the breadth of use of RAW by the opponent in order to respond to the comments by the applicant that it is limited to denim goods, ii) disagrees with the applicant that there will be no confusion and, iii) highlights that the opponent polices misuse of the word RAW by other traders and that potential infringements of its marks should not be considered as co-existence.

Section 5(2)(b)

14. I begin with this ground of opposition and will focus, initially, on the marks which are not subject to proof of use. After determining how far (if anywhere) this gets the opponent, I will return to the other marks/grounds to the extent necessary. All of the earlier marks are for the plain word mark **RAW**, however, the specifications of the earlier marks, whilst there is some overlap, are not the same. It is therefore difficult to identify one earlier mark which represents the opponent's best case. In a case such of this, and whilst I will of course bear in mind that the earlier marks are separate registered rights, I will treat them as a homogenous whole, but will highlight in the goods/services comparison which terms in which earlier mark presents the best case. One final point to note is that the opponent's pleading under section 5(2)(b) does not extend to the applicant's class 5 goods; as such, no comparison will be made.

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

“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,

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

16. The following principles are gleaned from the judgments 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 greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods/services

17. Goods and services may be considered identical if they fall within the ambit of a term in the competing specification (or vice versa), as per the guidance provided by the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

“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”.

18. In terms of similarity, when making a comparison, all relevant factors relating to the goods/services in question should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

19. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.”

20. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

21. I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13, *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

22. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

narrow meaning². I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

The applicant's class 18 goods

23. The applicant's class 18 goods are as follows:

Articles of leather and imitation leather not included in other classes, namely, wallets, gym bags, sports bags and draw string bags; trunks and travelling bags; handbags; travel bags; gym bags; sports bags; briefcases; shopping bags; satchels; backpacks; rucksacks; travelling sets; drawstring bags; bags for sport, gymnasium, boxing and mma; duffle bags.

24. The opponent relies on, inter alia, earlier marks: UK 2650539 and IR 1131972. The first of these marks covers the following class 18 goods:

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

Goods of leather or imitations of leather not included in other classes; bags, handbags; rucksacks; purses; wallets; trunks and traveling bags; umbrellas; parasols and walking sticks.

25. The second earlier mark, although worded differently, gives no broader scope of protection. The opponent's specification covers bags, without limit on their type. As such, all of the applicant goods which have been identified as a bag of some form will fall within the ambit of the opponent's bags and must be considered identical. That then leaves wallets, trunks, briefcases, satchels, backpacks, rucksacks and travelling sets. All of these goods, with the exception of briefcases, have identical counterparts in the opponent's specification, or there are terms which essentially mean the same thing. Such goods are, therefore, identical. In relation to briefcases, these are highly similar in nature, purpose and channels of trade to goods such as messenger style bags which are used to carry documents. These goods are highly similar. None of the opponent's other goods/marks (including those in other classes) put it in any better position.

Class 25

26. The applicant's class 25 goods are as follows:

Clothing; boxing clothing; fitness clothing; bodybuilding clothing; gym clothing; T-shirts; vests; tanks; hoodies; sweatshirts, jumpers; straps; shorts; trousers; tracksuits; tracksuit bottoms; joggers; hats; headwear; footwear; base layer clothing; compression wear clothing; hats, caps; beanie hats; shoes; trainers; track shoes; boots; sandals; flip flops; socks; boxing boots; mma shorts; boxing shorts; socks; underwear; boxer shorts; boxer briefs; wristbands; robes; sleepwear; boxing jerseys; exercise suits; sauna suits; gloves; ski gloves; head gear; weatherproof clothing; thermal clothing; sports clothing, footwear and headgear; athletic clothing, footwear and headgear; clothing, footwear and headgear for football, rugby, golf, running, cricket, tennis, basketball, fitness, field hockey, ice hockey, training, handball, American football, baseball, boxing and MMA; polo shirts; headbands; sweat bands; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; sleeveless jerseys;

undergarments; undergarment skins; brassieres; thongs; baselayer bottoms; baselayer tops; undershirts; unitards; girdles; ankle socks; men's socks; men's dress socks; leggings; long sleeve shirts [turtle necks]; mock turtle necks; jackets; sweat pants; pullovers; fleece pullovers; knitwear; capri trousers; hooded pullovers; hooded sweatshirts; knit shirts; long-sleeved shirts; coats; dresses; skirts; children's clothing, footwear and headwear; sports bras; sports jackets; sports jerseys; sports trousers; jogging trousers; sports shirts; baseball shoes; baseball caps; baseball uniforms; basketball sneakers; swimwear; beachwear; bikinis; beach footwear; bib overalls; camouflage gloves; camouflage jackets; camouflage trousers; camouflage shirts; camouflage vests; hunting jackets; hunting trousers; bib overalls for hunting; hunting shirts; hunting vests; cleats for attachment to sports shoes; fishing shirts; sports shoes; sneakers; training shoes; running shoes; football shoes; soccer boots; golf shorts; golf shirts; golf caps; golf trousers; martial arts uniforms; mixed martial arts suits; volleyball jerseys; yoga trousers; yoga shirts; athletic uniforms; foul weather gear; rainwear; moisture-wicking sports bras; moisture-wicking sports trousers; moisture-wicking sports shirts; rain suits; rain jackets; rain trousers; rainproof jackets; waterproof jackets and pants; waterproof trousers; windproof trousers; wind resistant jackets; windproof shirts; splash tops; ski bibs; ski gloves; ski jackets; ski pants; ski trousers; ski wear; snow trousers; shorts; snowboard gloves; snowboard mittens; snowboard pants; snowboard trousers; tennis wear; visors; padded shirts; padded trousers; padded shorts; padded elbow compression sleeves; belts; parts, fittings and accessories for all the aforesaid goods.

27. The opponent relies on earlier marks: UK 2650539, EUTM 11493103 and IR 1131972. The first of these marks is registered for the following goods in class 25:

Clothing; footwear; headgear; belts (clothing).

28. All of the goods applied for are types of clothing, footwear or headgear, or, indeed, belts, they are encompassed by the opponent's specification and must be considered identical.

29. The applicant's class 28 goods read as follows:

Games and playthings; gymnastic and sporting articles not included in other classes; gymnasium, sport and training equipment; balls; sport and game balls; footballs; rugby balls, american footballs; golf balls; boxing gloves; table tennis balls; basketballs; bats; table tennis bats, golf clubs, cricket bats, baseball bats, lacrosse sticks; skis; snowboards; basketball rings; table tennis tables; athletic exercise cones; sporting protective items; weight lifting belts, athletic knee and wrist supports, boxing gloves; punch bags; lifting weights; exercise balls; treadmills; exercise machines; cardio-vascular exercise machines; exercise bicycles; cross-trainer exercise machines; stepping exercise machines; boxing bags; boxing rings; boxing balls; boxing wraps; ear and eyebrow protectors for boxers; boxing masks; striking bags; fighting gloves; training dummies; striking-bag platforms; dumbbells; guards and protectors for football players; rowing machines; chest weights; spring exercisers; grip developers; medicine balls; punching bags; training bags; skipping ropes; wrestling and boxing trunks; supporters; shoe guards; wrestling rings; parallel bars; climbing ropes; bicycle trainers; weight benches; step machines; weightlifting gloves; equipment bags; trampolines; exercise equipment; weight lifting equipment; weight lifting belts; jumping ropes; free weights; aerobic equipment, namely, aerobic fitness belts, stationery cycles, elastic exercise bands, ankle weights, wrist weights, treadmills, exercise bikes; martial arts equipment, namely, kicks, shin guards, punch gloves, body shields, target paddles, punch and kick boards; sporting equipment; sporting articles and equipment for football, rugby, golf, running, cricket, tennis, basketball, fitness, field hockey, ice hockey, training, handball, American football and baseball; bags adapted for sporting articles and sporting equipment; leg and arm guards for sport; protective padded articles for use in sport; apparatus for use in training in sport [sporting equipment]; lip guards for sport; chin pads for athletic use; football girdles; protective athletic cups; jock straps; baseball and softball equipment for catchers, namely, face masks, chest protectors, leg guards, knee supports; toys; parts, fittings and accessories for all the aforesaid goods

30. The opponent relies on earlier mark: EUTM 11493103, which is registered for the following goods in class 28:

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

31. The applied for “games and playthings” correspond to the opponent’s “games and playthings” and are, therefore, identical. The remainder of the applied for specification covers various articles used for various sports. Given that the opponent’s specification covers “gymnastic and sporting articles” at large, all of the applied for goods are encompassed by the opponent’s specification and are, therefore, identical.

Class 35

32. The applicant’s class 35 services read as follows:

Business and management advice; business consultancy and business information services; compilation and provision of trade, business, price and statistical information and databases; preparation and compilation of reports; advertising services, business administration, marketing and marketing planning; advisory and consultancy services relating to marketing, marketing assessment services; business planning and development; stock control services; setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes and advice, consultancy and information services relating to such services; business management, including assistance and advising for the establishment and management of retail stores; office functions; provision of space on websites for advertising goods and services; business advisory services, promotional services and information services relating thereto; direct mail advertising; distribution of samples and promotional items; marketing services; business advisory and information services provided on-line from a computer database or the Internet; retail store services connected with the sale of apparel and sporting goods

33. The opponent primarily relies on earlier marks: UK 2650539 and IR 1131972. The first of these marks covers the following class 35 services:

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; sales promotion; commercial business and administrative services in the field of franchising and exploitation of retail businesses

34. Unlike the other classes assessed already, there is no easy way of going through the specification other than term by term (albeit grouping the terms where possible) and comparing those goods/services to those that represent what appears to be the best case(s) in the opponent's specification. To that extent, it seems to me that the following applied for services clearly fall within the opponent's terms "business management; business administration and administrative services" and are to be regarded as identical:

Business and management advice; business management, including assistance and advising for the establishment and management of retail stores; business administration

35. Further, in respect of the following applied for terms, if they are not identical, there must be a high degree of similarity (with the opponent's "business management; business administration and administrative services") having regard to their nature, purpose and trade channels, and a strong complementary link:

Business consultancy and business information services; business planning and development; business advisory and information services provided on-line from a computer database or the Internet; business advisory services.....and information services relating thereto; compilation and provision of trade, business, price and statistical information and databases; preparation and compilation of reports

36. I also consider that the applied for "office functions" and "stock control services" are identical (or if not highly similar) to the opponent's business administrative services.

37. The earlier mark's specification covers "sales promotion" which I consider to be identical to the opponent's "promotional services" and, also, highly similar to:

"marketing and marketing planning; advertising services; direct mail advertising; distribution of samples and promotional items; marketing services; advisory and consultancy services relating to marketing, marketing assessment services"

38. The opponent's retail services covers clothing and is, therefore, identical to the applied for "retail store services connected with the sale of apparel". Given that sporting goods are often sold in conjunction with clothing, I consider that the retail of clothing has a reasonably high degree of similarity with "retail store services connected with the sale of sporting goods". There would also be at least a medium degree of similarity between the retail of sporting goods and the various sporting goods covered by class 28 of the earlier mark (no. 1149103).

39. In respect of "setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes and advice,

consultancy and information services relating to such services”, although different in nature, purpose and methods of use, such services are clearly complementary to the opponent’s retail services given the relationship between them and the likelihood that the average consumer would understand the same undertaking to be responsible for both. I consider there to be a medium degree of similarity. That leaves “provision of space on websites for advertising goods and services”. That a business may advertise itself does not mean that it offers an advertising service. The nature, purpose and methods of use differ. The services do not compete. Nor do I consider this to be the type of complementary relationship described by the case-law. These services are not similar, nor are they similar to any of the other goods/services of the earlier marks.

Class 41

40. The applicant’s class 41 services read as follows:

Training, entertainment, sporting and cultural activities; providing sports facilities; providing recreation facilities; health club services; arranging and conducting of conferences and congresses; presentation of live performances; arranging and conducting of seminars and symposiums; rental of sports equipment; organising of sporting competitions; video tape film production; arranging of sporting events; arranging of sports competitions; educational services relating to sports; hire and rental of equipment for sports; information services relating to sport; instruction courses relating to sporting activities; instruction in sporting activities; organisation of sporting competitions; organisation of sporting events; provision of sport facilities; sports coaching; timing of sports events

41. The opponent relies on earlier mark: EUTM 9702184, which is registered for the following services in 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.

42. Given that the opponent's specification covers entertainment, sporting activities, cultural activities and organisation of educational events (albeit none relating to wrestling), I consider that the vast majority of the applied for services fall within the ambit of the opponent's specification and are to be considered identical. Some, though, require slightly more thought:

"Video tape film production" falls within the ambit of "production and publishing of ...video's and DVD's" and is, therefore, identical.

"Rental of sports equipment; hire and rental of equipment for sports", "Information services relating to sport" and "timing of sports events" although not sporting activities per se, are highly similar to sporting activities given the purpose, trade channels and what I regard as a key complementary relationship.

Average consumer and the purchasing act

43. 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. 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.”

44. The goods and services are varied but none (subject to what I say below) are of the type where a materially higher or lower than average degree of care will be deployed by the average consumer who will, generally speaking, be a member of the general public, including those who have an interest in some of the sporting goods covered by the specifications. The goods and services are likely to be selected by predominantly visual means, through self-selection, websites and brochures/catalogues. I will not, though, ignore the aural impacts of the marks completely. The one main area of difference could be in relation to business type services in class 35 where the average consumer will be a business person as opposed to a member of the general public and where there may be a (slightly) higher than average level of care.

Distinctiveness of the earlier mark(s)

45. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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).”

46. I should say upfront that the earlier mark **RAW** must be considered as a distinctive trade mark for the goods and services for which it is registered (see Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*). The question that arises, though, is how distinctive it is, with such distinctiveness coming from either the inherent characteristics of the mark, and/or from the use made of it. The answer to this question may differ depending on what goods and services are being considered. At this point I turn to the evidence. The applicant’s evidence attempts to establish that the word RAW has a very limited amount of distinctive character. First, it provides a large amount of state of the register evidence of marks which include (or in a small number of cases consist of) the word RAW. However, what is more important to consider is the actual use of such marks, which the applicant has also provided, as follows:

- A website with UK prices selling sweatshirts and t-shirts under the brand RAW APPAREL.
- A website with UK prices selling t-shirts, vest, hoodies and caps under the brand RAW THREADS (the mark is presented in a stylised form).
- A website with UK prices selling clothing under the brand RAW-COUTURE
- A website with UK prices selling t-shirts and hoodies under the brand EX RAW STATE. The words are most often in logo form, with RAW having slightly more prominence than the other elements. There are also some eBay prints showing products such as sweatshirts, jeans, jackets and gilets sold under this brand.

- A website with UK prices selling hoodies under the brand RAW ELEMENTS.
- Webpages relating to a shop called RAW VINTAGE which sells vintage clothing in Glasgow.
- A website with UK prices showing t-shirts, jackets, jeans and shoes. The primary brand on the page is YUKKA STREET FASHION, but there is use of what appears to be a sub-brand consisting of the words RAW BLUE.
- A website with UK prices showing tracksuits, jackets and hats. The primary brand on the page is GLOBAL STREETWEAR, but there is use of what appears to be a sub-brand consisting of the words Raw Blue. There are also some prints from Amazon of Raw Blue caps and jeans and RAW STATE jeans.
- A website with UK prices selling t-shirts and hoodies under the brand FUNKY RAW.
- A website with UK prices showing jackets, shorts and shirts under the mark SURPLUS RAW VINTAGE. There are also two third party sites selling such items.
- Prints from amazon showing t-shirts and boxer shorts branded under the name EXPLICIT, but with a sub-brand of RAW TO THE CORE. There is also a print from a third party website, and also from eBay, selling such products.
- Webpages with UK prices from the Wrestling company WWW showing a WWW Team Raw t-shirt, a Have a nice Raw t-shirt, a Raw logo t-shirt, a Raw line-up t-shirt and a WWW Hulk Hogan Raw Impact t-shirt.
- The website of a company called RAW SPORTS, with UK prices, showing a range of motorcycling clothing and, also, t-shirts and hoodies, caps and socks.
- The website of a company called IRON RAW, with UK prices, showing t-shirts, vest and hoodies.
- Facebook pages about a company called RAW STATE CLOTHING, with a third party website showing a RAW STATE t-shirt for sale.
- The website of a company called RAW TRAINING with a t-shirt listed in UK prices.

- The website of a company called RAW INSTINCT showing t-shirts and hoodies.
- The website of a company called RAW TENNIS, showing polo shirts and caps.
- The website of a company called RAW STRENGTH showing a gentleman in a short sleeve hoodie.
- The website of a company called REPRAW showing leggings, t-shirts and hoodies.
- There are a number of pages of overseas companies which, apparently, ship to the UK. I do not consider it necessary to summarise this evidence.
- There are a number of pages showing various companies using RAW in relation to class 5 goods. I do not consider it necessary to summarise this evidence.
- Similar evidence is provided as per the class 25 goods in relation to class 18 uses of RAW, as follows: MARIEL RAW (bags), RAW LEATHER WORKSHOP (leather accessories), RAWPIECE (bags), a bag depicting the words I LIKE IT RAW, another depicting EAT RAW, another I SHOOT RAW, another RAW FOOD, another I LOVE RAW FOOD.
- In relation to class 28, RAW MMA FIGHTWEAR (boxing gloves, wraps, protective items), BARABI RAW (boxing gloves), Slazenger Raw distance golf balls, Rawlings (various sporting items), RAWFIT (kettlebells and skipping ropes), Fox Pro Raw Scooters, Raw Stunt Scooter, Raw & Black Predator Scooter, Rebel Strength Raw dumbbell.
- In relation to class 35, RAW MEDIA LTD (marketing), RAW CREATIVE (advertising/marketing), RAW BUSINESS (consulting), RAW BUSINESS LTD (business networks), RAW JAM (product/website building), RAW TALENT (talent management), EIT RAW MATERIALS (networking), raw professional building materials (sale of building materials), RAW WINE (wine fair), THE RAW FOOD COACH, Raw Business Consulting Services Ltd, THE RAW CHOCOLATE COMPANY (sale of chocolate), RAW ORGANIC (sale of organic products), RAWWW (creative agency).

- In relation to class 41, RAW FITNESS, RAW HEALTH & FITNESS, RAWFIT, WWE RAW, RAW FITNESSBOX, RAW ANATOMY, RAW INSTINCT (personal training), RAW PERFORMANCE (strength and conditioning), RAW INC (personal training), RAW FITNESS UK, RAW STRENGTH AND FITNESS, RAW STRENGTH, RAW BOOTCAMP, RAW TENNIS, RAW ANATOMY, WWE RAW BOXING PHOTOS, RAW MOTION FITNESS, RAW FITNESS STUDIO, RAW GOLF COURSE DESIGN, RUGBY LEAGUE RAW, THE RAW FOOD COACH, EIT RAW MATERIALS (training), RAW NEWS, RAW LISA (training in fermentation), RAW WINE (some form of event), RAWHIDE (gaming), RAWR (a video game), UPRAWR (nightclubbing), RAWLPLUG (a marketing service offered in connection with this well-known product), WWW LATE NIGHT RAW, RAWHIDE COMEDY CLUB, DELICIOUSLY RAW CULINARY SCHOOL, RAW LIVING (sale of raw food and associated events), RAWFORLIFE (online blog), StRaW (an acronym for sustaining resilience at work), RAW DIGITAL TRAINING, HAPILLAY RAW (yoga), RAW HORIZONS (a retreat) and RAW RETREAT.
- There is also evidence of claimed descriptive use including of the words RAW EDGE (a dictionary definition defines this as an unfinished edge) and use of this phrase in relation to a jumper and sweatshirt by Paul Smith, a turtle neck by Sea Saw, a shirt by Zulu and a kimono by Free People. There is also use of the phrase raw silk in three products, raw hem in seven clothing products and raw riveter in two Superdry products. There are prints from the website of Tellason which defines RAW DENIM as denim in its purest form and a number of products from that site using the term descriptively and three other uses of RAW in connection with jeans and trousers. There is a further use of a raw style scarf. There are some uses, but not from the UK, of raw in relation to fabrics. There are also a number of uses in relation to bags and wallets of RAW/RAW EDGE. Finally, there are a number of pages showing various t-shirts where RAW is used as a part of a slogan, including phrases such as “I like it Raw”, “Raw in Life”, “Raw Power” and “EAT RAW”.

47. The opponent’s evidence shows that it is a successful business in the clothing field. Its UK wholesale figures have risen from £1.4 million in 2000/1 to greater than

£185 million in the period 2010-2015. Marketing expenditure has risen from £115k in 2000/1 to greater than £7.1 million in 2010/15. The goods are sold through third party retail stores and department stores (including some which I accept are well-known on the high street) and, also, through a reasonably large number of own stores.

48. It is clear from the evidence that the primary brand of the business began as GSTAR RAW (as opposed to RAW alone) and it is still used in that manner today. However, Mr de Bil's evidence is that RAW has been given greater emphasis especially since 2012. He refers to the use of various forms of RAW on the goods of the opponent, including various RAW logos. In written submissions that accompanied the applicant's evidence, various points were made about the examples of use exhibited by Mr de Bil including that RAW was used as part of GSTAR RAW, that it was used in close proximity to GSTAR or it was likely that there would be some reference to GSTAR on the product, that some uses of RAW were accompanied by a particular logo and that although some of the goods (such as t-shirts) had RAW printed upon them, this could be seen as use of a slogan. Save for the slogan point, I do not disagree with the applicant's characterisation of the use put forward. However, this does not mean that the capacity of such use to enhance the distinctiveness of the mark is wholly diminished. The various exhibits show use of RAW used alone (albeit often with some form of accompanying logo) which supports Mr de Bil's statement that the word RAW has at least been given greater emphasis. I take the view that even if the relevant public know that the use of RAW is associated with the GSTAR brand, I still consider that they will see the word RAW as, effectively, a sub-mark/brand of the opponent. In relation to the claimed slogan use, I do not agree that the average consumer will simply see this is a slogan, it will function, in my view, as an indicator of origin.

49. I must now consider where all of this leaves the distinctiveness of the opponent's mark. It is clear that the word RAW is a common English word. It has, though, a number of meanings, but the two main ones which are likely to be known by the average consumer will be i) of an uncooked or natural state, unprocessed or unrefined etc) and, ii) something or someone that is tender or pained. In isolation, the first of these meanings is the one most likely to be perceived. Indeed, having considered the applicant's evidence that seems to me to be the suggestive meaning that many of the

traders are attempting to get over to their customers. However, the strength of the allusion will depend on the goods/services concerned. For the goods in class 18, there may be some mild allusion to goods which are simple or roughly made, but, notwithstanding the applicant's evidence, I still consider that the mark has a moderate (between low and medium) level of inherent distinctive character. In class 28, for sporting goods etc, again, I consider the allusion to be mild, particularly when the mark has no other words to make a stronger more specific allusion - there is a moderate degree of inherent distinctiveness. Any allusion in relation to class 35 services is weak with the consequence that there is an average level of inherent distinctiveness. In class 41, for certain sporting services, I consider that there is a mild allusion, so meaning that the distinctiveness is moderate, but for entertainment and cultural activities and training (non-sporting) activities, a medium degree of distinctiveness.

50. That then leaves class 25. I consider that this is where the allusion is strongest, and, inherently, the mark is low in distinctiveness. However, the evidence shows that in relation to a range of casual clothing items the distinctiveness is enhanced through use to what I would say is a medium degree.

51. The fact that there are a large number of retailers who have used the word RAW in their marks does not in my view alter the assessments that have been made. First, simply because a word is a popular trade mark (or popular word to use in a trade mark) does not, in and of itself, reduce the distinctiveness of the word. Further, if the argument is that the relevant public has seen numerous traders using the word, I am conscious that there is no evidence showing the degree to which consumers have encountered such multiple uses. The evidence is mainly internet use, so it is not as though consumers would have passed by multiple traders on the high street. Further, it is not clear how significant, or how longstanding, such use has been.

Comparison of marks

52. 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 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.”

53. 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. The marks to be compared are:

RAW v **BOXRAW**

54. In terms of overall impression, the opponent’s mark comprises just one word which, therefore, is the only thing which contributes to the mark’s distinctive character. The applicant’s mark comprises two words, BOX and RAW, which have been conjoined to form one word. Whilst there is much discussion between the parties as to the distinctiveness of the words, it suffices simply to observe that neither word materially dominates the other in terms of the overall impression of the mark. Further, and I will return to this point later, RAW does not stand out as an independent element of the mark as it is presented – it is a single word, albeit one which is made up of two known words.

55. Visually, there is some similarity because the word RAW is present in both marks. However, the applicant’s mark has the additional word BOX, positioned at the front of the mark, and the two words are conjoined which means that RAW does not stand out. I consider the degree of visual similarity to be low.

56. Aurally, the marks will be articulated as RAW v BOX-RAW. There is marginally more aural similarity than visual. I consider the degree of aural similarity to be moderate, between low and medium.

57. Conceptually, the word RAW will be taken as a reference to something that is unprocessed, unrefined etc. In terms of BOXRAW, the applicant contends that it will be perceived as a reference to boxing (the sport) conducted in a certain way - in submission it refers to boxing hard/fast. The opponent considers that whilst the boxing reference may be perceived, the word RAW will be prescribed the same meaning in both marks.

58. One of the difficulties in this assessment relates to the broad range of goods and services applied for. I accept that for goods/services relating to boxing, the word "box" will signify the sport. However, I am doubtful whether the average consumer will analyse the mark in such a way that an immediate conceptual picture will spring to mind for the mark as a whole. The mark is BOXRAW as a whole. It creates, in my view, an odd mark, with no specific meaning. The average consumer will not dissect the mark into BOX and RAW and conceptualise the mark on the basis of the separate meanings of those words. In view of this, in the context of boxing related goods/services, there is no conceptual similarity with the word RAW alone. Even if I am wrong on that, and even if I were to accept that an overall evocative meaning would flow from BOXRAW, it would relate to some form of boxing, perhaps conducted in a rough unsophisticated manner. Although the meaning of RAW in that context stems from the meaning of the word more generally, the qualifying effect on the word BOX gives it a specific evocative meaning as a whole, one which differs from RAW alone. RAW alone is unlikely to be seen as a reference to a form or type of boxing. Therefore, there would still be no material conceptual similarity.

59. For goods and services unconnected with boxing, I am doubtful that the boxing message will be seen. From this perspective, it is unlikely that the average consumer will see any form of evocative whole and will see the mark simply as a quirky word which happens to be made up of the words BOX and RAW without ascribing any particular meaning to the mark. This can be contrasted with RAW alone which has a meaning. Again, there is not, in my view, any material conceptual similarity.

Likelihood of confusion

60. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods and services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he 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).”

61. The majority of the goods and services are identical, highly similar or similar to a medium degree. The evidence of other traders using RAW is put forward by the applicant as showing co-existence and that consumers are used to differentiating between various RAW based marks. However, for the reasons given earlier when discussing the distinctiveness of the earlier marks, I do not accept that the average consumer has necessarily been exposed to multiple traders using the word RAW.

62. Even for goods/services which relate to boxing or combat sports, I do not consider that there is a likelihood of direct confusion. Notwithstanding the concept of imperfect recollection, the average consumer is unlikely to overlook or miss-recall the fact that the applied for mark consists of the whole word BOXRAW and the slightly odd impression that this gives. Thus, if there is a likelihood of confusion, it must be of an indirect nature.

63. Even accepting, as I have done earlier, that there is some visual and aural similarity between the marks, in none of the scenarios I have put forward do I consider it likely that RAW will be seen as an independent distinctive element of the BOXRAW mark. To suggest otherwise would, in my view, stem from an approach which artificially dissects the mark. Given this, the scenarios outlined in cases such as *Bimbo* and *Medion* etc are not applicable. That, of course, does not rule out indirect confusion. However, I think it unlikely, when all things are considered, that the average consumer will believe that the common presence of the word RAW signifies that a common (or related) undertaking is responsible for the goods and services. The conceptual

differences between RAW alone and BOXRAW (with the latter's meaningless or specific whole - depending on what is perceived) contributes to this view. Further, RAW does not stand out in anyway in the context of BOXRAW. The commonality does not leap out. Further again, it is not as though RAW is a particularly unusual word. Even for its goods in class 25, I have only assessed its level of overall distinctiveness as medium.

64. Whilst appreciating that the examples given in the *L.A. Sugar* case are just illustrative, BOXRAW will not, in my view, be seen as a logical or consistent brand extension, neither is RAW so strikingly distinctive that its use as part of BOWRAW would result in the average consumer believing that no-one else other than the opponent would be using it. I appreciate that at least BOX (for certain goods and services) would be regarded as a non-distinctive term alone, but the nature of the word BOXRAW is not suggestive of a sub-brand or brand extension, even if it is notionally possible that the opponent's goods could be used in the field of boxing. There is no likelihood of confusion, be it direct or indirect. I extend this finding to areas outside boxing/combat sport – the position is even clearer here. The grounds under section 5(2)(b) are dismissed.

Other marks/grounds

65. I do not consider it necessary to deal with the ground under section 5(4)(a) in any real detail. This is because as I have found no confusion and I see no reason why there would be a relevant misrepresentation. The opponent's submissions do not advance a materially different case and the ground under section 5(4)(a) is dismissed accordingly.

66. In relation to section 5(3), this reads:

“5-(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 Kingdom (or, in the case of Community trade mark, 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.”

67. The leading cases are the following CJEU judgments: 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 Case 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 later mark would cause an average consumer to bring 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 likelihood 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 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*).

Reputation

68. I accept that the opponent's earlier mark has a reputation (at least for casual clothing), although, given what I have said earlier about the distinctiveness of the mark, and that it is often used with other insignia, its reputation cannot be considered as strong.

The required link

69. In addition to having a reputation, a link must be made between the subject trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

70. In *Intel* the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

71. Put simply, weighing all the relevant factors, and even considering the BOXRAW mark used in relation to the type of clothing where RAW has a reputation, I do not consider that a link will be made. The mark BOXRAW will not bring the opponent's brand to mind for much the same reasons as I have given under section 5(2)(b). The ground under section 5(3) is dismissed.

Conclusion

72. The opposition fails. Subject to appeal, the applied for mark may proceed to registration for all of its goods and services.

Costs

73. The applicant has been successful and is, therefore, entitled to a contribution towards its costs. My assessment, based upon the published scale, is set out below:

Reviewing the Notice of opposition and preparing the counterstatement - £300

Filing and considering evidence - £800

Written submissions - £400

Total - £1500

74. I order G-Star Raw C.V. to pay Benjamin Amanna Ltd the sum of £1500 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 2nd day of January 2018

Oliver Morris

For the Registrar,

The Comptroller-General