

O-012-18

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3167837
BY RAWPIXEL LTD
TO REGISTER**

RAWPIXEL

**AS A TRADE MARK
IN CLASSES 16, 38, 41, 42 & 45
AND OPPOSITION THERETO (UNDER NO. 407233)
BY
G-STAR RAW C.V.**

BACKGROUND & PLEADINGS

1. Rawpixel Ltd ('the applicant') applied to register the trade mark **RAWPIXEL** on 3 June 2016. It was accepted and published in the Trade Marks Journal on 24 June 2016 in respect of goods and services in classes 16, 35, 38, 41, 42 and 45.

However class 35 has been subsequently deleted from the application and class 45 does not form part of these proceedings. The remaining contested goods and services of this application are:

Class 16	Photographs; Photographs [printed]; Photographic prints.
Class 38	Photo uploading services; Blogging services; Communication services for the electronic transmission of images; Communication services, namely, electronic transmission of data and documents among users of computers; Communications services provided over the Internet; Computer aided transmission of messages, data and images; Electronic transmission of images, photographs, graphic images and illustrations over a global computer network; Electronic transmission of voice, data and images by television and video broadcasting; Photo uploading services; Providing online forums; Provision of telecommunication access to video content provided via the Internet; Transmission of digital files; Transmission of messages and images; Transmission of multimedia content via the Internet; Video uploading services.
Class 41	Photographic library services; Photography; Photographic composition for others; Electronic library services for the supply of electronic information, including archive information, in the form of electronic texts, audio and/or video information and data, games and amusements; Film distribution; Film production services; Photograph library searching services; Photographer services; Photographic composition for others; Photographic library services; Photography; Photography services; Production and distribution of motion pictures; Production of animation; Production of video and audio recordings;

	Production of video films; Video library services; Video production services.
Class 42	Animation and special-effects design for others; Art work design; Cloud computing; Commercial art design; Commercial design services; Computer graphics design services; Computer graphics services; Computer-aided design of video graphics; Consultancy services relating to design; Corporate image design services; Custom design services; Design and development of multimedia products; Design and graphic arts design for the creation of web pages on the Internet; Design consultancy; Design of audio-visual creative works; Design of marketing material; Design services; Digital asset management; Electronic storage of digital video files; Electronic storage of images; Electronic storage of photographs; Graphic art services; Graphic design; Graphic illustration services for others; Hosting a website for the electronic storage of digital photographs and videos; Hosting of digital content; Illustration services (design).

2. G-Star Raw C.V. ('the opponent') opposes this application under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of these specified goods and services of their two EU trade marks set out below:

<p>EU TM 14993356</p> <p>RAW</p> <p>Filing date: 12 January 2016</p> <p>Registration date: 24 August 2016</p>	<p>Goods and services relied on:</p> <p>Class 9: Downloadable software applications for wireless mobile devices, computers and tablets for the distribution of multimedia content containing text, graphics, images, audio and video; apparatus for reproduction of images.</p> <p>Class 16: Paper; paintings (pictures); posters; photographs; stationery; photograph stands.</p>
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	Class 41: Photography; photographic reporting; providing online videos, not downloadable.
EU TM 11493103 RAW Filing Date: 16 January 2013 Registration date: 23 June 2013	Class 9: Apparatus for recording, reproduction of images; data processing equipment. Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; design of fashion articles; product development; interior design and decoration.

3. The applicant filed a counterstatement in which it denied that the marks at issue were similar. It also denied that the contested goods and services were similar. However in its written submissions dated 4 August 2017, the applicant has conceded that some goods and services are identical. I will refer to these concessions when I come to compare the goods and services.

4. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act but, as neither has been registered for five years or more at the publication date of the applicant's mark, they are not subject to the proof of use requirements, as per section 6A of the Act.

5. Neither party filed evidence in this matter. Both parties filed written submissions in lieu of a hearing in this case. I make this decision on the basis of the papers before me.

6. The applicant is represented by Burges Salmon LLP in these proceedings and the opponent by HGF Limited.

DECISION

7. Section 5(2)(b) of the Act is as follows:

“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.

8. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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

9. I note from the opponent's submission that they are comparing goods and services from their earlier marks that were not stated in the Notice of Opposition. For the avoidance of doubt, I intend to compare the goods and services that were stated in the Notice of Opposition against the goods and services of the applicant's mark.

10. The goods and services to be compared are:

Opponent's Goods & Services	Applicant's Goods & Services
<p><u>EU TM 14993356</u></p> <p>Class 9: Downloadable software applications for wireless mobile devices, computers and tablets for the distribution of multimedia content containing text, graphics, images, audio and video; apparatus for reproduction of images.</p> <p>Class 16: Paper; paintings (pictures); posters; photographs; stationery; photograph stands.</p> <p>Class 41: Photography; photographic reporting; providing online videos, not downloadable.</p>	<p>Class 16: Photographs; Photographs [printed]; Photographic prints.</p> <p>Class 38: Photo uploading services; Blogging services; Communication services for the electronic transmission of images; Communication services, namely, electronic transmission of data and documents among users of computers; Communications services provided over the Internet; Computer aided transmission of messages, data and images; Electronic transmission of images, photographs, graphic images and illustrations over a global computer network; Electronic transmission of voice, data and images by television and video broadcasting; Photo uploading services; Providing online forums; Provision of telecommunication access to video content provided via the Internet; Transmission of digital files;</p>

EU TM 11493103

Class 9: Apparatus for recording, reproduction of images; data processing equipment.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; design of fashion articles; product development; interior design and decoration.

Transmission of messages and images; Transmission of multimedia content via the Internet; Video uploading services.

Class 41: Photographic library services; Photography; Photographic composition for others; Electronic library services for the supply of electronic information, including archive information, in the form of electronic texts, audio and/or video information and data, games and amusements; Film distribution; Film production services; Photograph library searching services; Photographer services; Photographic composition for others; Photographic library services; Photography; Photography services; Production and distribution of motion pictures; Production of animation; Production of video and audio recordings; Production of video films; Video library services; Video production services.

Class 42: Animation and special-effects design for others; Art work design; Cloud computing; Commercial art design; Commercial design services; Computer graphics design services; Computer graphics services; Computer-aided design of video graphics; Consultancy services relating to design; Corporate image design services;

	<p>Custom design services; Design and development of multimedia products; Design and graphic arts design for the creation of web pages on the Internet; Design consultancy; Design of audio-visual creative works; Design of marketing material; Design services; Digital asset management; Electronic storage of digital video files; Electronic storage of images; Electronic storage of photographs; Graphic art services; Graphic design; Graphic illustration services for others; Hosting a website for the electronic storage of digital photographs and videos; Hosting of digital content; Illustration services (design).</p>
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11. With regard to the comparison of goods and services, in *Canon*, the CJEU stated at paragraph 23 of its judgment that:

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

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services

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

13. In its written submissions, the applicant conceded that all of its class 16 goods were identical to *photographs* in the opponent's class 16 specification for EU TM 14993356¹. In addition they further conceded that *photography* in their class 41 specification was identical to the same term in the earlier mark EU TM 14993356².

14. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, the General Court ('GC') held:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

¹ Paragraph 3.1

² Paragraph 3.7

15. With regard to *photographic composition for others, photographer services, photographic library services, photography services* in the applicant's class 41 specification, these will be covered by the opponent's *photography* services at large. Under the *Meric* principle outlined above, these are therefore considered identical.

16. Having dealt with the identical goods in class 16 and services in class 41 conceded by the applicant, I must now consider the remaining goods and services. I am guided by the following case law concerning the interpretation of specifications:

In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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) (IP TRANSLATOR)* [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."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. I will now address each of the applicant’s remaining classes in turn and, where appropriate, will group terms together.³

Class 38: Blogging services; Providing online forums; Photo uploading services; Communication services for the electronic transmission of images; Communication services, namely, electronic transmission of data and documents among users of computers; Communications services provided over the Internet; Computer aided transmission of messages, data and images; Electronic transmission of images, photographs, graphic images and illustrations over a global computer network; Electronic transmission of voice, data and images by television and video broadcasting; Photo uploading services; Provision of telecommunication access to video content provided via the Internet; Transmission of digital files; Transmission of messages and images; Transmission of multimedia content via the Internet; Video uploading services.

18. The applicant’s services in this class are all essentially forms of telecommunications. Whilst the opponent’s earlier trade marks are not registered in this class, the class 9 specifications includes *Downloadable software applications for wireless mobile devices, computers and tablets for the distribution of multimedia content containing text, graphics, images, audio and video; apparatus for reproduction of images and Apparatus for recording, reproduction of images; data processing equipment*. In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for*

³ *Separode Trade Mark* BL O-399-10

Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court stated that “complementary” means:

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

19. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.

20. As the case law explains, the purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings.

21. The class 38 services allow the consumer to transmit, upload and send multimedia information (being data, text, images and other audio-visual matter) to a computer network. Such services will be enabled by means of software and hardware. The opponent's goods in class 9 are '*downloadable software applications which enable the distribution of multimedia content containing text, graphics, images, audio and video*'. In other words, the applicant's services require software of the type provided by the opponent in order to operate. I find that the respective users and uses of the goods and the services are likely to be the same. The respective trade channels could also be the same. It is not uncommon for companies to provide both the software and/or hardware (e.g. routers) and the telecommunications services (e.g. broadband). Nor is it uncommon for a photo-sharing site or forum to provide its own application software that the user can download to their specific device in order to interact with it. Taking this in to account I find the applicant's class 38 services to be complementary to the class 9. The goods and services are not in competition, since both are necessary in order to access the applicant's services. When reviewing all of these factors, I find the contested goods and services to be highly similar.

22. In relation to class 41, the applicant concedes in its submission that

“Earlier mark 14993356 also covers *movies studios; rental of motion pictures* which may be considered somewhat similar (but not identical) to *production and distribution of motion pictures*”

23. Although the earlier mark 1493356 does contain *movies studios; rental of motion pictures*, these services were not stated as being relied on by the opponent in its Notice of Opposition. However the services the opponent stated it was relying on in class 41 include *providing online videos, not downloadable* which I consider to be similar to a medium degree to *video library services; film distribution; distribution of motion pictures* in the applicant's class 41 specification. This is due to the users of these services being the same as are the nature of the services, being the provision of video or film content. In terms of trade channels, although the opponent's services are provided online, the applicant's services are broader terms which will cover online services.

24. With regard to the following services in the applicant's class 41 specification, namely; *Electronic library services for the supply of electronic information, including archive information, in the form of electronic texts, audio and/or video information and data, games and amusements; Photograph library searching services*, these appear to be information resource services. The opponent submits that these services are similar to their own goods and services but does not provide an explanation for that submission. In terms of the opponent's stated class 41 services, namely *Photography; photographic reporting*, I do not find these to be similar to the applicant's services outlined in the paragraph above as the nature of the services are different, the users are not the same and the services are unlikely to originate from the same undertaking and in the absence of submissions from the parties, I can find no meaningful areas of coincidence between them.

25. Turning to the remaining services in class 41, namely *production of video and audio recordings; production of video films; video production services; film production services; production of motion pictures; production of animation*, I do not find these services to be similar to *providing online videos, not downloadable* in the opponent's class 41 specification as the core meaning of the services is different. They are different in nature, one being the process of creating, filming and recording the end product and the other relating to than the provision and distribution of it. The same reasoning would apply to the users of the respective services being the creators of the process rather than the distributors of it and to the trade channels through which the services reach the market.

26. Finally I turn to class 42. The applicant's specification contains *design services* at large which, on the *Meric* principle, will include the following services of the opponent's earlier mark namely, *design relating to scientific and technological services; design and development of computer hardware and software; design of fashion articles; product development; interior design and decoration* and must therefore be considered identical.

27. For those services remaining in the applicant's class 42 specification which are not specifically design related, namely *Cloud computing; Digital asset management; Electronic storage of digital video files; Electronic storage of images; Electronic*

storage of photographs; Hosting a website for the electronic storage of digital photographs and videos; Hosting of digital content, I consider these services to fall under the broader term *technological services* in the opponent's specification, and are also identical in accordance with the principle outlined in *Meric*.

AVERAGE CONSUMER AND THE PURCHASING ACT

28. I must now consider the nature of the average consumer and how the goods and services are purchased. 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*.

29. 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.”

30. The parties' respective specifications include a wide range of goods and services, for which the average consumer is both the general public and businesses. The level of attention paid to the purchase will vary according to the nature of the goods and services. Commissioning the production of a film will demand a higher level of attention to be paid than sending a text message. In terms of the purchasing process, it is evident that goods such as photographs and photographic prints will be purchased visually either from a traditional bricks and mortar retail outlet or from an online retailer. Likewise for the selection of hardware and software goods. The purchasing process

for services I consider to be primarily a visual act as consumers are likely to search the internet to find a suitable provider or chose from brochures or other advertising material but I do not rule out an aural element whereby advice may be sought prior to purchase.

COMPARISON OF MARKS

31. The marks to be compared are:

Opponent's marks (same mark for both)	Applicant's mark
RAW	RAWPIXEL

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

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

33. 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.

34. The opponent's trade marks consist of a single word RAW in plain block capital letters. The overall impression of the mark and its distinctiveness rests solely on that word.

35. The applicant's trade mark consists of RAWPIXEL in plain block capital letters. The mark is clearly made up of two separately understood words, however in my view, it hangs together as a unit. Neither element dominates the other and the overall impression is rests in the mark as a whole.

36. In a visual comparison, the marks share the common word RAW which is the only element of the opponent's marks and the first element of the applicant's mark. The applicant's mark contains the additional element PIXEL which follows the word RAW and is joined to it. Overall I find there is a medium degree of visual similarity between the marks.

37. In an aural comparison, the opponent's mark is a known English word and will be accorded its usual pronunciation. The first element of the applicant's mark will be pronounced in the same way, as a single syllable, but will be vocalised in full to include the PIXEL element, resulting in a mark which is two syllables longer than the opponent's marks. Aurally, the conjoining of the words will have no impact on the average consumer's pronunciation. Both words will be pronounced individually. Taking all these factors into account, I find there is a medium degree of aural similarity between the marks.

38. In a conceptual comparison, the applicant states in their submission that:

“For the goods and services at issue, RAW (the earlier mark) is somewhat vague or opaque. It may be seen as alluding to an “unvarnished” product or service. In contrast RAWPIXEL, when used in conjunction with the opposed goods and services, most of which relate to photography, immediately evokes a far more concrete concept of digital pixels and an image of “back to basics” or “raw photography”. ”

39. I disagree with the applicant's submission that the meaning of RAW is vague or opaque. In terms of photography, RAW has a well-known and clear meaning being a digital file format that captures all image data recorded by the sensor when a photograph is taken. Taking the applicant's mark RAWPIXEL in relation to photographic goods and services, the concept of the first element RAW will be identical. Factoring in the PIXEL element and given my finding above, the mostly likely concept is that of a pixel in a RAW photography format. Where the goods and services relate to photography, I find these marks to be conceptually similar to a high degree. For non-photographic goods and services then RAW will be given its plain meaning as a known English word, i.e. meaning uncooked or unfinished. This will also be the case for the common element in the applicant's mark in relation to non-photographic goods and services. The additional word PIXEL in the applicant's mark may bring to mind a digital image which is in some way 'unfinished'. Overall I find there to be a medium degree of conceptual similarity for non-photographic goods and services.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

40. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

41. No claim has been made for enhanced distinctive character, nor has any evidence been filed, so I have only the inherent distinctiveness of the earlier marks to consider.

42. The earlier marks consist of an ordinary English language word. As outlined above RAW has a clear and distinct meaning in relation to photography. However in *Formula One Licensing BV v OHIM*, Case C-196/11P, the Court of Justice of the European Union found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

43. Therefore I must proceed on the basis that the earlier registered trade marks must have at least some distinctive character. In relation to photography related goods and services, I would categorise this as a low level of distinctive character. In relation to non-photographic goods and services then I find the marks to be of average distinctiveness.

LIKELIHOOD OF CONFUSION

44. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

45. I also keep in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on

the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

46. I note the applicant's email dated 8 September 2017 in which they direct me to a Tribunal decision (O/403/16) concerning an opposition brought by the same opponent and submit that I should follow the same reasoning as per that case. I decline to do so as in that referenced decision the contested goods and services and the marks are different to the case before me. Each case must be judged on its own merits. I have to take account of the specific circumstances of this case and the matters presented before me.

47. So far I have found that some of the contested goods and services are identical and some of the applicant's services are similar to the opponent's goods and services. I have found that the average consumer is a member of the general public or a business user who will select the goods and services by primarily visual means whilst paying a varying degree of attention during the purchasing process.

48. In terms of comparison of the marks, I found they had a medium degree of aural and visual similarity but a high degree of conceptual similarity, in the common element RAW. With regard to the distinctiveness of the earlier marks, I concluded this to be average for non-photographic goods and services but low for photographic goods and services.

49. In considering the factors outlined in paragraph 45, I do not find that the average consumer will mistake one mark for the other. . However, if the average consumer sees either mark and then they encounter the other mark used on the same or similar goods and services they are likely to see it as a brand variant or extension of

the type described by the Appointed Person in LA Sugar, due to the common element RAW. As a consequence of this, there is a significant likelihood that the applicant's identical and similar goods and services would be considered by the average consumer, at the very least, to come from the same or linked undertakings and they would be indirectly confused.

CONCLUSION

50. The opposition succeeds under section 5(2)(b) for the following goods and services:

Class 16: Photographs; Photographs [printed]; Photographic prints.

Class 38: Photo uploading services; Blogging services; Communication services for the electronic transmission of images; Communication services, namely, electronic transmission of data and documents among users of computers; Communications services provided over the Internet; Computer aided transmission of messages, data and images; Electronic transmission of images, photographs, graphic images and illustrations over a global computer network; Electronic transmission of voice, data and images by television and video broadcasting; Photo uploading services; Providing online forums; Provision of telecommunication access to video content provided via the Internet; Transmission of digital files; Transmission of messages and images; Transmission of multimedia content via the Internet; Video uploading services.

Class 41: Photography; Photographic composition for others; Film distribution; Photographer services; Photographic composition for others; Photography; Photography services; Photographic library services; distribution of motion pictures; Video library services;

Class 42: Animation and special-effects design for others; Art work design; Cloud computing; Commercial art design; Commercial design services; Computer graphics design services; Computer graphics services; Computer-aided design of video graphics; Consultancy services relating to design; Corporate image design services;

Custom design services; Design and development of multimedia products; Design and graphic arts design for the creation of web pages on the Internet; Design consultancy; Design of audio-visual creative works; Design of marketing material; Design services; Digital asset management; Electronic storage of digital video files; Electronic storage of images; Electronic storage of photographs; Graphic art services; Graphic design; Graphic illustration services for others; Hosting a website for the electronic storage of digital photographs and videos; Hosting of digital content; Illustration services (design).

51. The opposition fails under section 5(2)(b) for the following services:

Class 41: Electronic library services for the supply of electronic information, including archive information, in the form of electronic texts, audio and/or video information and data, games and amusements; Photograph library searching services; Production of video and audio recordings; Production of video films; Video production services; Film production services; Production of motion pictures; Production of animation.

COSTS

52. As the opponent has been largely successful, it is entitled to a contribution of the costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the opponent as follows:

£300 Notice of Opposition and official fee.

£300 Considering written submissions.

53. I order Rawpixel Ltd to pay G-Star Raw C.V the sum of £600. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 05th day of January 2018

**June Ralph
For the Registrar
The Comptroller-General**