

O-100-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2621390
IN THE NAME OF BERTRAND & MARIE LTD

AND

OPPOSITION THERETO UNDER NO 103878
BY G-STAR RAW C.V. AND FACTON LTD

Background

1. Application No 2621390 has a filing date of 18 May 2012, stands in the name of Bertrand & Marie Ltd (“the applicant”) and seeks registration of the trade mark **rawness** in respect of the following services:


Class 35:
organisation of exhibitions fairs and events


Class 41:
Organisation of forums


Class 42:
Hosting of websites

2. Following publication of the application in the *Trade Marks Journal* on 29 June 2012, Notice of Opposition was filed by G-Star Raw C.V. and Facton Ltd, jointly (“the opponents”).

3. The opponents found their opposition on grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and rely on the following UK, Community (“CTM”) and International (“IR”) trade mark registrations:

Mark	Dates	Specification of goods/services relied upon
CTM 9702184 RAW	Filing date: 1 February 2011 Date of entry in register: 5 July 2011	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.
2491837 	Filing date: 4 July 2008 Priority date: 25 January 2008 Date of entry in register: 27 February 2009	Class 18: Leatherware, made of leather, imitation of leather and goods made of these materials not included in other classes including bags and wallets; travelling trunks; umbrellas. Class 25: Clothing, footwear, headgear; leather belts (clothing) Class 35: Business advertising services relating to

		<p>franchising, business advice relating to franchising, business assistance relating to franchising, business consultancy relating to franchising, business consultancy relating to franchising, franchising consultancy services, management advisory services related to franchising; Retail services in the field of soaps, perfumery, essential oils, cosmetics, suntan oils, hair lotions, glasses, sunglasses, head straps/cords for glasses, cases for glasses, cases for sunglasses, image sound and data cassettes, records, compact discs, DVD's, CD rom's, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, ornaments, precious stones, horological and chronometric instruments, watches and clocks, leather and imitations of leather, and goods made of these materials, bags, rucksacks and wallets, trunks and travelling bags, umbrellas, furniture, clothing, footwear, headgear, belts (clothing) and fashion accessories; business management; advertising and promotion services; aforementioned services also provided via the Internet.</p>
<p>IR 1000949</p> 	<p>International registration date: 26 September 2008</p> <p>Priority date: 27 March 2008</p> <p>Date protection granted: 28 April 2010</p>	<p>Class 18: Leatherware, imitation leather and goods made of these materials not included in other classes, including bags and wallets; traveling trunks; umbrellas.</p> <p>Class 25: Clothing, footwear, headgear; leather belts (clothing).</p> <p>Class 35: Retail and franchising services, namely consultation and assistance in business management; organization and promotion services; advertising and promotion services; aforementioned services also provided via Internet.</p>
<p>IR 986572</p> <p>G-RAW</p>	<p>International registration date: 26 September 2008</p> <p>Priority date: 27 March 2008</p> <p>Date protection granted: 9 December 2009</p>	<p>Class 35: Retail and franchising services, namely business management; advertising and promotion services; aforementioned services also provided via Internet.</p>

<p>CTM 4743225</p> <p>RAW</p>	<p>Filing date: 24 November 2005</p> <p>Date of entry in register: 15 October 2008</p>	<p>Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 25: Clothing, footwear, headgear; belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 35: Advertising; business management, including franchise services; business administration; office functions; except services relating to wrestling, wrestling entertainment and wrestlers.</p>
<p>CTM 3612801</p> 	<p>Filing date: 15 January 2004</p> <p>Date of entry in register: 22 June 2005</p>	<p>Class 41: Entertainment; cultural activities.</p>

4. The applicant filed a counterstatement in which it stated:

“RAW is a word of common language and is widely used as everyday wording or branding. It is already used by various companies across the EU for branding and registered trade marks in almost every EU country in various trade mark classes and more specifically in classes 35, 41 and 42.

rawness is a parent common word of RAW but not similar to G G STAR RAW, GG STAR RAW DENIM, G STAR RAW, G-DESIGN RAW GD 9901, G-RAW, G-STAR ORIGINAL RAW DENIM, G-STAR RAW, G-STAR RAW 1, G-STAR RAW DENIM, G-STAR. RAW, G-STORE RAW, neither visually (logos are clearly distinguishable) nor phonetically or conceptually. Neither the word nor the brand name *rawness* can therefore be associated with the opponent’s marks.

G-STAR RAW are clothing, jeans and leather goods manufacturer, well known for their activity and commonly known as G STAR. This is clearly ingrained in the popular consuming culture (please see http://en.wikipedia.org/wiki/G-STAR_Raw)

rawness’s activity is collaborative and non-commercial and is not meant for selling anything. *rawness* doesn’t produce any goods nor provide any paying services. It is a free think-tank cloud aiming at creating educational knowledge and professional relationships instead of transactions. (please see our website manifesto on www.rawness.org/what-is-rawness).

The Trade Mark classifications we applied for are therefore not meant for establishing a business, nor raise any commercial activity. By registering our mark, we want to establish *rawness* as a reference as social and economic sustainability think-tank and protect our work and investments in working time and financial expenses.

rawness is a professional network acting in economic and social sustainable development. It cannot benefit from, nor take advantage of investments or the reputation, nor ride on the coat tails of a clothing, leather goods and jeans manufacturer. This is the main activity of the Opponent as per their Trademark classifications registrations and as it is known in the popular consuming culture.

rawness.org website's contributors act as free volunteers and no remuneration nor financial reward is attributed. It is a community and collaborative website aiming at reflecting a community and collaborative intellectual work."

5. Neither party filed evidence nor did they request to be heard though the opponents filed written submissions in lieu of attendance at a hearing.

Decision

6. The grounds of opposition are based on section 5(2)(b) of the Act which reads:

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

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

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

7. An "earlier trade mark" is defined in section 6, the relevant part of which states:

"6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

8. As can be seen from the information above, each of the marks relied on by the opponents is an earlier mark within the meaning of section 6 of the Act. Only CTM 3612801 would be subject to the proof of use provisions of section 6A of the Act but I note that in its counterstatement the applicant has indicated it does not require the opponents to provide proof of use of its marks.

9. In considering the objection under section 5(2)(b) and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs Q.C., acting as the Appointed Person, set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch):

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

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the respective services

10. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how similarity should be assessed. He identified the following factors to be taken into account:

- (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.”

11. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the CJEU stated:

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

12. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM). The court commented that:

“...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...”

By analogy the same is true in respect of services.

13. In comparing the respective services, I take account of the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, where he stated:

“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 meaning attributable to the rather general phrase.”

14. Whilst, in the notice of opposition, the opponents rely on all goods and services for which their six earlier marks are registered and they object to the application in its entirety, in their written submissions their objection is more limited. It is this limited objection that I will take into account. Based on the written submissions, the services to be compared are as follows:

Opponents' services	Applicant's services
CTM 4743225 Class 35: Advertising; business management; business administration; office functions	Class 35: Organisation of exhibitions fairs and events
CTM 9702184 Class 41: Entertainment; organisation of entertainment and educational events; cultural activities	Class 41: Organisation of forums

15. The opponents submit:

“...the Opponents' advertising; business management; business administration; office functions are similar to organisation of exhibitions, fairs and events...particularly since any exhibitions, fairs and events which are proper to Class 35 will be business related; and all exhibitions, fairs and events, being promotional to some extent will include an element of advertising.

...the Opponents' advertising; business management; business administration; office functions are similar to organisation of forums...since any forums will be business related and involve advertising and promotional activities to some extent.

...the Opponents' entertainment; organisation of entertainment and educational events; cultural activities...are also identical and/or similar to organisation of exhibitions, fairs and events and organisation of forums....There is a strong relationship between the Opponents' educational events and organisation of exhibitions, fairs and events; since the term exhibitions, fairs and event (particularly events) would encompass and therefore be identical to the Opponents' educational events. There is also a strong relationship between the Opponents' entertainment; cultural activities and the applied for organisation of exhibitions, fairs and events because all types of exhibition/events include an element of entertainment and culture. There is also identity and/or similarity between the Opponents' organisation of entertainment and educational events; cultural activities and the organisation

of forums...as forums by their very nature will involve some form of educational information.”

16. They also submit:

“The Applicant’s business is communications and events design services, which extend across a range of topics which include arts, crafts, music, culture, fashion and gastronomy. The Opponents earlier RAW brands extend to services in a wide range of sectors which include fashion, entertainment, cuisine, gastronomy, sport and culture. It is clear that there is scope for confusion where there is use of RAWNESS in relation to, in particular, fashion, art and photography projects, exhibitions and shows, or in relation to online forums which discuss and bring together information in relation to such events, because it is easily conceivable that RAWNESS would be taken by consumers to refer to G-Star’s RAW brand, for example some form of creative offshoot of the brand. This association is particularly likely in light of the philosophies of creativity and edginess that are common to both businesses.”

17. As I set out above, in its counterstatement, the applicant states its opinion that “G-STAR RAW are clothing, jeans and leather goods manufacturer, well-known for their activity and commonly known as G STAR” whereas it “is a free think-tank cloud aiming at creating educational knowledge and professional relationships instead of transactions”. Neither parties’ specifications are limited in any way, and as marketing considerations may vary over time (the decision of the CJEU in *Devinlec Développement Innovation Leclerc SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – case C-171/06P refers), I have to consider the issue on the basis of the specifications as applied for and as registered and not on the basis of how the parties currently, or intend to, use their marks.

18. The term *advertising* as appears in the opponents’ specification is a term which refers to the promotion or advertisement of something and covers a wide range of activities which will include advertising by way of exhibitions, fairs and other events. On the basis of *Meric*, I find the opponents’ advertising services to be identical to the applicant’s *organisation of exhibitions fairs and events*.

19. A forum is an event in the form of a meeting or assembly of people for open discussion on a particular topic or topics and which may be for e.g. general interest, educational or entertainment purposes. I find the applicant’s *Organisation of forums* to be included within, and therefore identical to, the opponents’ *organisation of entertainment and educational events; cultural activities*.

The average consumer and the nature of the purchasing process

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

21. Each of the respective services in class 35 is such as is most likely to be used by professionals in business who will seek to use them to manage or in some way

promote its area(s) of interest. Each of the respective services in class 41 may also be used by businesses or organisations but may also be used by members of the general public. The respective services cover a wide range of activities and the cost of those activities is likely to vary greatly but given their importance to whichever user and, where applicable, its business and the need to ensure they deliver the aims intended, they are each services which are likely to involve some, though not the highest, amount of consideration in their purchase.

Comparison of the respective marks

22. As I indicated earlier, in their submissions the opponents have essentially limited the earlier rights on which they rely. The two CTMs are each for the word RAW, both in plain block capitals and, for the purposes of this comparison, I intend to refer to them as a single mark.

23. On that basis, the marks to be compared are:

Opponents' mark	Applicant's mark
RAW	rawness

24. The opponents' mark consists of the word RAW in plain block capitals. As no part of the mark is emphasised or highlighted in any way, it has no dominant elements, the distinctiveness of the mark resting in the whole. The applicant's mark is for the word rawness presented in lower case. Again, no part of the mark is emphasised or highlighted in any way so it has no dominant elements and the distinctiveness of the mark rests in the whole.

25. There are clear visual and aural similarities between the respective marks in that both consist of or begin with the same three letters forming the word RAW. As I set out earlier in this decision, in its counterstatement the applicant states that "rawness is a parent common word of RAW" which I take to be an acknowledgement that both words have a common etymological background. As rawness is the state of being raw, there is a clear conceptual similarity between the respective marks.

26. The respective marks are highly similar.

The distinctiveness of the earlier mark

27. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

28. The opponents have filed no evidence of any use of the earlier mark and therefore I have only its inherent distinctiveness to consider. The earlier mark is an ordinary dictionary word but has no meaning in relation to the services for which it is registered and therefore has an average degree of inherent distinctive character.

The likelihood of confusion

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

30. Earlier in my decision I found that:

- the respective services are identical and will be bought with some, though not the highest degree of care;
- the respective marks are highly similar;
- the earlier mark has an average degree of inherent distinctive character which has not been shown to have been enhanced through its use.

31. Taking all matters into account, I find that there is a likelihood of direct confusion between the respective marks. Even if I am wrong in this, the similarities are such that I consider there would be a likelihood of indirect confusion where the average consumer will consider that the respective services come from the same or an economically linked entity. The opposition based on section 5(2)(b) of the Act succeeds.

Summary

32. The opposition succeeds insofar as it relates to the services as applied for in classes 35 and 41. The application may proceed to registration for those services for which the opposition was not pursued i.e. *Hosting of websites* in Class 42.

Costs

33. The opponents having succeeded are entitled to an award of costs in their favour to reflect that success. In making the award, I take note that no evidence was filed by either party and that no hearing has taken place though the opponents did file written submissions in lieu of a hearing and in which they reduced the extent of their opposition.

34. I make the award on the following basis:

For filing a statement and reviewing the other side's statement:	£300
Fee:	£200
Preparing written submissions:	£300
Total:	£800

35. I order Bertrand & Marie Ltd to pay G-Star Raw C.V. and Facton Ltd, jointly, the sum of £800 as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of March 2014

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