

O-387-14

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION
Nos. 2654158, 2646285 & 3002300
BY VEGESSENTIALS LIMITED
TO REGISTER THE TRADE MARKS**

&

IN CLASS 32

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERETO UNDER Nos. 400497, 400162 & 400849 BY
G-STAR RAW C.V**

BACKGROUND


1) On the dates shown below Vegesentials Limited (hereinafter the applicant), applied to register the following trade marks:

Number	Mark	Filing Date	Class	Goods
2654158 (opp 400497)	Deliciously Raw	26.02.13	32	Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.
2646285 (opp 400162)	The Raw Generation	19.12.12	32	Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines
3002300 (opp 400849)	Refreshingly Raw	17.04.13	32	Beverages (Non-alcoholic); Fruit juice beverages (Non-alcoholic); Non-alcoholic beverages; Non-alcoholic fruit juice beverages; Smoothies; Smoothies [non-alcoholic fruit beverages]; Vegetable juice; Vegetable juices [beverages].

2) The applications were examined and accepted, and subsequently published for opposition purposes on 5 April 2013 in Trade Marks Journal No. 2013/014, 25 January 2013 in Trade Marks Journal No.6976 and 14 June 2013 in Trade Marks Journal No. 2013/024 respectively.

3) On 4 July 2013, G-Star Raw C.V. filed a notice of opposition (subsequently amended) in respect of application 2654158. On 25 April 2013, G-Star Raw C.V. and Facton Limited acting as joint opponents filed a notice of opposition (subsequently amended) in respect of application 2646285. On 28 May 2013 Facton Ltd was deleted as an opponent with G-Star Raw C.V. continuing as the sole opponent. On 13 September 2013, G-Star Raw C.V. filed a notice of opposition in respect of application 3002300. On 10 December 2013 the three cases were consolidated. As G-Star Raw C.V. is the sole opponent I shall hereinafter refer to it as the opponent. The grounds of the oppositions are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of filing / Registration	Class	Relevant Goods /services
	CTM 5939947	25.05.07 28.08.08	43	Providing of food and drink.
RAWSECCO	CTM 5006887	07.04.06 13.02.07	33	Alcoholic beverages (except beers).
RAW	CTM 9702184	01.02.11 05.07.11	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.
RAW	CTM 11493103	16.01.13 23.06.13	31	Grains and agricultural, horticultural and forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals; malt.
			43	Services for providing food and drink; temporary accommodation.
LEGENDARY RAW	CTM 4846598	19.01.06 20.11.09	3	Soaps; perfumery, essential oils, cosmetics, hair lotions.

			25	Clothing, footwear, headgear; belts [clothing].
			35	Advertising; business management, including franchise services; business administration; office functions.
RAW	IR 1131972	IR date 27.06.12 Priority date 31.05.12 Benelux	25	Clothing; footwear; headgear; belts (clothing). Additional goods and/or services have been added as a result of a subsequent designation received on 2014-04-15: Clothing; footwear; headgear; belts (clothing). Goods and services limited to: Clothing; footwear; headgear; belts (clothing).
RAW	CTM 11493012	16.01.13 12.01.14	32	Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; energy drinks.
			33	Alcoholic beverages (except beers).
RAW	CTM 4743225	24.11.05 15.10.08	25	Clothing, footwear, headgear; belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers.

- b) The opponent relies upon CTMs 5939947, 5006887, 9702184, 11493103, 4846598, 11493012 and International Registration 1131972 in respect of the section 5(2)(b) grounds in relation to applications 2654158 and 3002300. In respect of the ground of opposition under section 5(2)(b) in respect of application 2646285 the opponent relies upon CTMs 5939947, 5006887, 9702184 only. In all the cases the opponent contends that the goods and services covered by its marks are similar to the goods applied for and that the marks of the two parties are similar which will lead to a likelihood of confusion.
- c) The opponent relies solely upon its reputation for goods in Class 25 in respect of CTM 4743225 and contends that the marks in suit offend against Section 5(3) as the applicant will benefit from the opponent's advertising and promotion of its brand and that the applicant is likely to gain sales, goodwill or enhanced status

because of its association with the opponent's mark. The applicant may supply poor quality goods which would be detrimental to the opponent's mark. There will also be detriment to the distinctive character of the opponent's mark as the opponent's mark will be used on goods which do not originate from it. The opponent also contends that there was no due cause for the adoption of the marks in suit.

4) On 4 July 2013 (400497), 1 September 2013 (400162) and 24 November 2013 (400849) the applicant filed counterstatements. These put the opponent to strict proof of use of its CTM 5006887, whilst also contending that there is no likelihood of confusion due to the differences in the marks and the goods and services. The applicant also points out that there are a large number of marks upon the UKIPO and OHIM registers which have the word RAW within them. They also contend that the opponent has no reputation in respect of the word RAW *solus*, they state that the word is always used with other words.

5) Only the opponent filed evidence. Both seek an award of costs in their favour. Neither side wished to be heard in the matter although the opponent provided written submissions.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 7 March 2014, by Johannes Christian de Bil the Managing Director of Facton Ltd a position he has held since July 2009. From 2000-2011 he was also General Counsel of G-Star International B.V. He states that on 19 April 2011 G-Star Raw C.V. acquired all of the assets of G-Star International B.V. He states that the entire undertaking of G-Star International B.V. was transferred to G-Star Raw C.V. including the employment of staff and he continued in his role as General Counsel, hence he is now a General Counsel for G-Star Raw C.V. He points out that Facton Ltd and G-Star Raw C.V. are affiliated companies. As a result he states that he has knowledge of all three businesses. He also states that the "benefit of use by G-Star International B.V. has now transferred to G-Star Raw C.V. together with all other assets of the business".

7) Mr de Bil states that the first use of RAW was as part of the mark "G-Star Raw Denim" in 1985. He states that from approximately 2000 his company began using the word Raw independently from the G-Star Raw brand, often in combination with other elements (exhibit JCB3). He states that the opponent's different clothing lines such as "Correct Line"; "Laundry Army"; Sports Originals"; Raw Sustainable" and "raw Essentials" have been rebranded as of 2013 to "Raw Sports"; Raw Cargo line"; "Raw Correct" and "Raw Essentials". He states:

"Since its inception, G-Star has been known for its innovative and cutting edge style in the world of denim. Continuous experimentation with new ways of using fabrics and product development and the rough rudimentary characteristics of the

brand have enabled the G-Star business to maintain its distinct and unorthodox style.”

And:

“The concurrent use of our brands means that I am not able to provide isolated sales figures for each one of our brands. I can however confirm that at least 90% of the sales shown in the tables below will have included the trade mark RAW either independently or in combination with our other brands. The trade mark RAW can be found at least two or three times on each of our products. The extensive use of RAW can be seen from the exhibits to my witness statement.

8) Mr de Bil provides the following figures for the G-Star business in the UK:

Period	Turnover £million	Marketing £
2002-2003	4.0	182,000
2003-2004	7.8	302,000
2004-2005	12.1	334,000
2005-2006	21.9	777,000
2006-2007	37.4	1,160,000
2008-2009	>37.0	>1,160,000
2009-2010	>37.0	>1,160,000
2010-2011	>37.0	>1,160,000

9) He states that the advertising and promotion includes clothing trade fairs, none of which have taken place in the UK but which are said to be attended by UK clothing buyers. The company also hosts events to promote its brands. These are referred to as “Raw nights” which are described as “exclusive party events which take place in various types of venue, including hotels, where guests (including celebrities) from the fashion, entertainment and other creative industries can sample champagne, cocktails and canapés whilst enjoying music performances and other entertainment”. He states that the company also advertise in magazines and newspapers such as *FHM*, *The Guardian*, *Maxim*, *GQ* and the *Observer*. Mr de Bil also states that since 2009 the opponent has, two or three times per annum, issued its own RAW magazine. In the UK this is issued via the *Observer* newspaper, as well as being available on-line and in shops. He estimates that the number of copies provided in Europe exceeds two million copies per publication. The opponent also embarks on worldwide campaigns to promote its goods and brands. These feature people whom he refers to as “celebrities” and which, he claims get media attention. He states that the opponent’s goods are sold through a range of retail outlets throughout the UK. Some of these stores are owned by the opponent, others are well known names such as *John Lewis*, *House of Fraser*, *Selfridges* and *ASOS*. The opponent has its own website which sells its goods and other retailers such as those named also sell the opponent’s goods online. He states that the same situation applies in France, Germany, Italy, Spain, Sweden, Portugal, Poland, The Netherlands and Greece. He also provides the following exhibits, many of which are very poorly photocopied and are extremely hard if not impossible to read:

- JCB3: Pictures of clothing with various marks upon them, dating from 2004 to 2012. These vary enormously with a highly stylised letter “G” and the word “raw”; “G.S.RAW” a device and “BY G-Star”; “G.S.RAW”; “G-STAR RAW”. There is a copy of the “G-Star Raw look book for spring summer 2011” which lists “RAW ESSENTIALS” on 13 of 52 items, the other items do not feature the word “raw” at all. A number of T-shirts have the term “raw” emblazoned upon the chest but also have highly visible labels also on the front of the garment which states “G.S” or in some cases is printed underneath the word “raw”.
- JCB4: Pictures of labels, tags, zippers, rivets etc used on clothing as brand identifiers and which are not always visible in catalogues. Some of the illustrations are so badly copied that they are unreadable. For the most part the labels have “G-STAR” or the large device in the shape of a letter “G”, some have the letters “G.S.” and a number also have the word “raw” or “raw denim” upon them.
- JCB5: Copies of clothing trade fair literature. These all show use of “G-Star Raw”.
- JCB6: Copies of press releases and photographs of “Raw nights”. The press releases all have the “G” logo with the words “G-Star Raw” at the top and are headed “G-Star presents...”. The pictures show various, mainly scruffily dressed, individuals at a party, none of whom are immediately recognisable.
- JCB8: Copies of advertisements in magazines and publications in the UK. These are dated from 2002 to October 2012. They show use of G-Star Raw and G-Star in relation to clothing.
- JCB9: Copies of advertisements in magazines and publications in Germany. These are dated from 1995 to August 2012. They show use of G-Star Raw in relation to clothing.
- JCB10: Copies of advertisements in magazines and publications in Sweden. These are dated from April 2007 to September 2012. They show use of G-Star Raw, G (logo) Raw and G-Star in relation to clothing.
- JCB11: Copies of advertisements in magazines and publications in Italy. These are dated from 2000 to April 2012. They show use of G-Star Raw, G (logo) Raw and G-Star in relation to clothing.
- JCB12: Copies of advertisements in magazines and publications in Belgium. These are dated from Winter 2004 to September 2012. They show use of G-Star Raw and G (logo) Raw in relation to clothing. This exhibit also, inexplicably, includes part of a statutory declaration in relation to the mark QUINTIQ in Malaysia (page 38) and a change to the WIPO register (page 33).

- JCB13: Copies of advertisements in magazines and publications in France. These are dated from September 2000 to September 2012. They show use of G-Star Raw and G (logo) Raw in relation to clothing.
- JCB14: Copies of advertisements in magazines and publications in the Netherlands. These are dated from October 1997 to September 2012. They show use of G-Star Raw, G-Star, G (logo) Star Raw and G (logo) Raw in relation to clothing. This exhibit includes an invoice from Novafgraaf Nederland BV (page 57) addressed to an individual seemingly unconnected with this case; another Novagraaf invoice to a company (page 108); an advertisement for PME Bare Metal jeans (page 68); images of watched marks which have nothing to do with this case (pages 109 & 110).
- JCB15: Copies of advertisements in magazines and publications in Spain. These are dated from October 2000 to September 2012. They show use of G-Star Raw, G-Star, G (logo) Star Raw and G (logo) Raw in relation to clothing.
- JCB16: Copies of advertisements in magazines and publications in Denmark. These are dated from October 2000 to September 2012. They show use of G-Star Raw, G-Star, G (logo) Star Raw and G (logo) Raw in relation to clothing.
- JCB17: Examples of outdoor usage on taxis, billboards, buses, London underground, bus shelters and G-Star Raw stores. The use is said to be in the UK and Europe, although photographs are not identified or dated. It is clear that some are in the UK. All show use of G-Star Raw in relation to clothing.
- JCB18: Copies of the RAW magazine for the period Autumn 2009 to Autumn 2012.
- JCB19 & 20: Copies of press releases and online articles regarding the 2010 advertising campaigns featuring an actress and a chess champion. In 2011 another actress was used along with an actor. The press release refers to clothing under the G-Star Raw brand.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

11) The first ground of opposition is 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.”

12) 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.”

13) The opponent is relying upon its trade marks listed in paragraph 3 above. It is clear that in respect of applications 2654158 and 3002300 all those relied upon for the section 5(2)(b) ground (CTMs 5939947, 5006887, 9702184, 11493103, 4846598, 11493012 and International Registration 1131972) are clearly earlier trade marks. However, in respect of application 2646285 the opponent relies upon CTMs 5939947, 5006887, 9702184 only, all of which are earlier trade marks. Of the marks relied upon only 5006887 has been put to strict proof of use by the applicant. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the

United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

14) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the marks has been made. In the instant case the publication dates of the applications were 5 April 2013, 25 January 2013 and 14 June 2013 respectively. Therefore, the relevant periods for the proof of use are 6 April 2008-5 April 2013, 26 January 2008-25 January 2013 and 15 June 2008-14 June 2013 respectively. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

“(a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

15) Trade mark 5006887 is registered for the following goods in class 33 “alcoholic beverages (except beers)”. In its evidence the opponent has not shown use of the mark RAWSECCO in relation to anything. The opponent cannot rely upon this mark in its

opposition. I note that in the opponent's written submission it does not mention this mark as part of its comparison.

16) When considering the issues under Section 5(2) and the likelihood of confusion, 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 *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC 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.

17) The opponent's submissions are very unclear on what it regards as its strongest case. It refers to the marks "Raw Cuisine", "Raw" and "Legendary Raw" in its comparison of marks. However, when it comes to goods and services these are all lumped together in one column with no indication of which of the marks it refers to. For example, although "Legendary Raw" is compared to each of the marks in suit, none of the goods or services form part of the comparison test in the written submissions. I have therefore considered the goods and services listed and extrapolated the marks that they refer to, and have added in LEGENDARY RAW for completeness.

Mark	Number	Specification
	CTM 5939947	Class 43: Providing of food and drink.
RAW	*CTM 11493103	Class 31: Grains and agricultural, horticultural and forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals; malt.
		Class 43: Services for providing food and drink; temporary accommodation.
RAW	9702184	Class 41: Entertainment; organisation of entertainment and educational events, such as concerts, festivals, parties and workshops; sporting activities, including the organisation of sports competitions; cultural activities.
LEGENDARY RAW	*CTM 4846598	Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions.
		Class 25: Clothing, footwear, headgear; belts [clothing].
		Class 35: Advertising; business management, including franchise services; business administration; office functions.
RAW	*CTM	Class 32: Beers; mineral and aerated waters and other

	11493012	non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; energy drinks.
		Class 33: Alcoholic beverages (except beers).

*denotes marks not included in the opposition case against 2646285

The average consumer and the nature of the purchasing process

18) The opponent states that the goods applied for “are generally everyday food/drink products addressed to the general public in the United Kingdom. The goods in question are widely available on the market in the UK, via a wide selection of suppliers. As a result of the wide availability, it is submitted that the level of attention of the general public when purchasing the goods is likely to be low.” They also comment that the applicant has not produced evidence to the contrary. Whilst I agree that there are a large number of suppliers of beverages (both alcoholic and non-alcoholic) and they are widely available, I do not see why this equates to the average consumer paying a low level of attention. For instance, someone who is teetotal would be careful to avoid alcoholic beverages. Anyone with a gluten allergy would be very careful to avoid beers made from barley or wheat and instead seek out beers made from rice or corn. A number of consumers have issues with fruits such as tomatoes and would avoid fruit drinks which include these. To my mind, the average consumer is far more aware of the contents of beverages that they consume, and everyday one is assailed in the media by new stories outlining health issues such as the levels of sugar in fruit drinks. I therefore believe that the average consumer will be careful in their selection of beverage of whatever kind. Most beverages will be purchased in retail outlets by self selection, or if in a public house or cafeteria the product will still normally be visible or have a label on the tap to denote the contents and point of origin. The selection is likely to be by eye, therefore it is the visual aspect of the competing trade marks that will dominate the selection process although aural considerations must not be overlooked because of word of mouth recommendations etc.

Comparison of goods

19) The specifications of applications 2654158 and 2646285 are identical. The specification of application 3002300 differs slightly in its wording but covers ostensibly the same goods as the two earlier applications. Making the best I can from the opponent’s submissions it appears that it believes its strongest case resides under the marks and specifications set out in paragraph 17 above. The accepted test for comparing goods and services is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the CJEU in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods and services;
- b) The respective users of the respective goods and services;
- c) The physical nature of the goods and services;

- d) The respective trade channels through which the goods and 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 and 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 in the same or different sectors.

20) I take into account the following guidance of the General Court (GC) in *Gérard Meric v OHIM*, T-133/05:

“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).”

21) I take on board the class in which the goods are placed is relevant in determining the nature of the goods (see *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34. Goods in one class cannot be identical to those in another, although they may be similar to a high degree. Also I look to the comments of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 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 particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

22) The question of complementary goods/services has been considered by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 where it 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).”

23) However, in the cases of *Sandra Amalia Mary Elliott v LRC Products Limited* (and cross opposition) [BL O-255-13] in respect of the marks LUV and LOVE respectively Mr Alexander Q.C. acting as the Appointed Person said:

“15 A formulation of the law by the same Hearing Officer in very similar terms was accepted without criticism by either party or by Floyd J (as he then was) *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and the Hearing Officer's statement of the law cannot be faulted.

16. However, because of the particular grounds of appeal in this case, which did not arise in the *Youview* case, it is necessary to make three observations about that summary as it applies to the present case.

17. First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in Canon, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in Boston).

18 Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in Boston as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. 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.

19 Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per Boston, is that the goods must be “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”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

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 .

21 Moreover, it is necessary to view the quotation from Boston in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (Sunrider v OHIM , paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 Eurodrive Services and Distribution v OHIM — Gómez Frías (euroMASTER) , paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fibre oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81. In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82. 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).

83. It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fibre oxygenators with detachable hard-shell reservoir.

84. However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85. It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86. Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (PiraÑAM diseño original Juan Bolaños , paragraph 82 above, paragraph 37; see also, to that effect, SISSI ROSSI , paragraph 82 above, paragraph 65; and PAM PLUVIAL , paragraph 82 above, paragraph 95).

87. Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, *Case T-388/00 Institut für Lernsysteme v OHIM — Educational Services (ELS)* [2002] ECR II-4301 , paragraph 56).

22 The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.”

24) Taking first the class 31 goods under CTM 11493103 the opponent contends merely that these “are identical and/or similar” to the applicant’s goods but gives no reason why it believes this is the case. To my mind this is clearly not the case. Certainly some of the applicant’s goods may include fresh fruits and vegetables and certain grains but this does not make them similar goods. Fresh fruit and vegetables have a multitude of uses not beverages alone. The physical nature is different, they would not be found together in a shop, nor are they in competition. **The goods in class 31 of CTM 11493103 are not similar or complementary to the applicant’s goods.**

25) Moving to the Class 43 services of CTM 11493103 the opponent contends that “providing of food and drink in class 43 are also closely similar to the applicant’s goods being beverage products”. The opponent does not offer any rational explanation for this statement. Clearly, the “providing of drink” could include the applicant’s products but the question that needs to be raised is whether the average consumer will think that responsibility for the goods lies with the same undertaking. To my mind this will not occur. I accept that tied public houses will sell beer from a single source and that source name will also appear upon the public house. However, in my experience, this always follows the form that the mark used on the public house i.e. Courage will then be used as the house mark on the beer pump along with a secondary mark indicating the beer itself i.e. Courage Best/Directors. For the most part purveyors of drinks will not also be responsible for their manufacture. In my opinion the applicant’s goods are not similar to the opponent’s services nor does it make them complementary. **The Class 43 services of CTM 11493103 are not similar or complementary to the goods of the applicant.**

26) **The same conclusion would also apply to the, effectively, identical class 43 services in CTM 5939947.**

27) Moving onto the class 41 services registered under the opponent's mark CTM 9702184 the opponent contends:

“29. The class 41 services of the opponent's earlier trade marks are entertainment, cultural and sporting related and include festivals, parties and events which give rise to interdependence between the services provided by the opponent and the goods of the applicant. The applicant asserts in its counterstatements that the channels through which its goods and the opponents class 41 services are provided are so different that consumers are unlikely to believe that the two undertakings are the same or economically linked. The opponent submits that on the contrary food and drink will often be advertised and available at these events, and it is also common for such events to be sponsored by companies who provide such products.”


28) The fact that drinks may be sold at festivals etc or that drink manufacturers may sponsor such events does not make the goods of the applicant similar or even complementary to the opponent's services. **The opponent's Class 41 services under CTM 9702184 are not similar or complementary to the applicant's goods.**


29) Moving onto the class 3 and 25 goods and class 35 services registered under the opponent's CTM 4846598, and the effectively identical class 25 goods under IR1131972 and CTM 4743225 the opponent has not provided any comment on whether these should be regarded as similar to the goods of the applicant. **To my mind it is clear that the goods and services of CTM 4846598, and the goods of IR1131972 and CTM 4743225 are not similar or complementary to the applicant's goods.**

30) Lastly I turn to the class 32 and 33 goods registered in respect of the opponent's CTM 11493012. **The class 32 goods clearly encompass those of the applicant with the exception of “wines” in 2654158, and “vegetable juice; vegetable juices (beverages)” in 3002300 which nevertheless must be regarded as highly similar to the class 32 goods of the opponent. In addition “wines” must also be very similar to the opponent's class 33 goods.**

Comparison of trade marks

31) The marks to be compared are:

Applicant's marks	Opponent's marks
2654158: Deliciously Raw 2646285: The Raw Generation	5939947:  4846598: Legendary Raw

	9702184: Raw 11493103: Raw 11493012: Raw 4743225: Raw 1131972: Raw
3002300: Refreshingly Raw	5939947:  9702184: Raw

32) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctiveness of earlier marks and dominant components of both parties marks

33) The opponent has only provided evidence of use of its mark RAW in the UK in relation to clothing. As such the opponent cannot benefit from enhanced distinctiveness in relation to the goods and services relied upon in the opposition under section 5(2)(b). As the opponent's marks are registered they are deemed to have at least a degree of inherent distinctiveness. The applicant points out that the word "RAW" is a common English word with a well known meaning of "not cooked; in an unfinished or natural state; not treated by manufacturing or other processes". Therefore for certain of the goods and services of the opponent the term "RAW" has a descriptive element. The applicant also listed in its submissions a number of other CTM and UK marks which have the word "RAW" as part of the mark. The applicant contends that this shows that the word "RAW" is not particularly distinctive. No evidence of any use of any of these marks was provided and it seems to me that this is usually termed state of the register evidence. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 28 Jacob J. said:

"It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME* Trade Mark [1966] RPC 541 and the same must be true under the 1994 Act."

34) In *Digipos Store Solutions v Digit International* [2008] RPC 24 Mr Alexander Q.C acting as a Deputy Judge of the High Court commented:

“63 That was said in the context of a case where absolute grounds were relied on as the basis for refusing registration. However, in the present case, this material is not relied on in support of an argument that a mark which shares characteristics with those already registered should, for that reason, also be registered: the register is not relied on for its precedent value, in my judgment, rightly so. The register is not in this case deployed to show actual use of the marks recorded there either: for that purpose too, it would be of limited, if any, evidential value. Instead, the register is relied upon to show that, as a matter of fact, a significant number of traders have expressed the intention of using (and *may* be using) the prefix DIGI- as part of a mark in relation to class 9 goods which (one is invited to infer, in the absence of detailed specifications) involve a digital or computer-related element. It does not seem to me to be illegitimate, as a matter of principle, to deploy material of this kind for that limited purpose and, for that purpose, it is of some value as part of a larger body of material.”

35) However, in *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 the GC stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

36) This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-400/06.) In *Digipos* Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues. Just as in the *GfK* case mentioned above, the applicant has not provided evidence that the marks are in use.

37) Clearly, the word RAW will be familiar to UK consumers as it is an ordinary dictionary word in everyday use. In the opponent’s mark 5939947 the words “RAW” and “Cuisine” clearly combine to create a descriptive term for the food services offered. As such in this mark the word “RAW” has no inherent distinctiveness. The obvious badge of origin is the term “G-Star”, which is also the dominant element despite its diminutive size within the mark. The mark LEGENDARY RAW for class 3 and 25 goods and class 35 services is highly inherently distinctive. In relation to the types of entertainment services offered under

Class 41 the term “RAW” could be taken to mean unprocessed similar to the use of the term “unplugged” but the mark would still be moderately inherently distinctive. The term “legendary” in entertainment services is also highly descriptive. The mark has no dominant element and its distinctiveness rests in its whole. In respect of class 31 goods by definition fresh fruits and vegetables are “raw” and so the mark is highly descriptive as it is for all the other goods included in the opponent’s specification for this class. Originally beer was not cooked and it is still possible to purchase raw beer, therefore the term “raw” has a low level of distinctiveness in relation to beer. Similarly, when considering other beverages the term “raw” denotes uncooked or unprocessed and so has a low level of distinctiveness. Clearly the majority of the opponent’s marks consist solely of the word “RAW” and so that is the dominant element. I have already commented upon the opponent’s other marks.

38) Moving onto the applicant’s marks the term “raw” when used on beverages has, as mentioned previously, a descriptive element. When “raw” is used with the words “deliciously” and “refreshingly” in front of it then the whole forms a descriptive phrase which indicates how the consumer will regard the beverage. The mark “the Raw Generation” hangs together as a whole with the term “raw” being used to describe the consumer or generation. It is an indication that today’s consumer is getting back to natural unprocessed products. The mark has no dominant element and its distinctiveness rests in its whole.

Visual / Aural and Conceptual similarity

39) The marks “Deliciously Raw” and “Refreshingly Raw” are visually, aurally and conceptually highly similar to the mark RAW. The marks of both parties are inherently weak and both are relatively descriptive. The only difference is that the opponent’s mark is prefaced by an adjective. The applicant’s two marks are also obviously highly similar to the mark “Legendary Raw”. Turning to the opponent’s “Raw Cuisine G-Star” mark there are a number of obvious visual and aural differences. The term “raw Cuisine” hangs together, and to my mind the differences including the conceptual ones far outweigh the fact that both the opponent’s mark and those of the applicant include the word “raw”.

40) Moving onto the applicant’s mark “The Raw Generation”, this creates a conceptual image of a group of people, a generation, who are concerned about maintaining the goodness in items they consume by having them raw. This is conceptually similar to 5939947. There are clear visual and aural differences between the applicant’s mark and the two opponent’s marks, 9702184 and 5939947, such that the differences far outweigh any minor similarity by the inclusion of the same short word, “raw”.

Likelihood of confusion

41) The opponent makes the following comments:

“31. It is submitted that there is a very clear overlap or relationship between the opposed goods and services [sic] of the opposed mark [sic] and the earlier goods and services of the opponent such that there is a likelihood of confusion.

32. The applicant's business is drink products, including fruit juices and smoothies. The opponent's 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 the applicant's marks in relation to drink products, because it is easily conceivable that the marks DELICIOUSLY RAW, REFRESHINGLY RAW and THE RAW GENERATION would be taken by consumers to refer to the opponent's RAW brand, for example some form of promotional offshoot of the brand".

42) The opponent has not adduced any evidence that the average consumer expects the food and drink provided by such service providers to emanate from the service provider. I must now take all the above into account and consider the matter globally taking into account the interdependency principle - a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence shows that the opponent has an enhanced distinctiveness for clothing which does not assist it under this ground of opposition.

43) Earlier in this decision I found that in respect of 2654158 Deliciously Raw and 3002300 Refreshingly Raw:

- The class 31 goods and class 43 services of CTM 11493103 are not similar or complementary to the applicant's goods, although the marks were highly similar.
- The opponent's Class 41 services under CTM 9702184 are not similar or complementary to the applicant's goods, although the marks were highly similar.
- The class 43 services of CTM 5939947 are not similar or complementary to the goods of the applicant, also the differences in the marks outweigh any similarities.
- The Class 3 and 25 goods and class 35 services of CTM 4846598, and the class 25 goods of IR 1131972 and CTM 4743225 are not similar or complementary to the applicant's goods, although the marks were highly similar.
- The class 32 goods of CTM 11493012 clearly encompass those of the applicant with the exception of "wines" in 2654158, and "vegetable juice; vegetable juices (beverages)" in 3002300 which nevertheless must be regarded as highly similar to the class 32 goods of the opponent. In addition "wines" must also be very similar to the opponent's class 33 goods under the same mark. I also found that the marks were highly similar.

44) To my mind in respect of both of the applicant's marks, when considering the opponent's marks CTM 11493103, CTM 9702184, CTM 5939947, CTM 4846598, CTM 4743225 and IR 1131972 there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided

by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in relation to both marks in respect of these marks of the opponent.**

45) To my mind in respect of both of the applicant's marks, when considering the opponent's mark CTM 11493012 there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to both marks in respect of this mark of the opponent.**

46) Earlier in this decision I found that in respect of 2646285 The Raw Generation

- The class 43 services of CTM 5939947 are not similar or complementary to the goods of the applicant and the differences in the marks outweigh any similarities.
- The opponent's Class 41 services under CTM 9702184 are not similar or complementary to the applicant's goods and the differences in the marks outweigh any similarities.

47) To my mind in respect of this mark of the applicant, when considering the opponent's marks CTM 9702184 and CTM 5939947 there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in relation to this mark in respect of these marks of the opponent.**

48) I now turn to consider the ground of opposition under Section 5(3) which 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 3 the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) 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.

49) The scope of the section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7. Guidance in relation to reputation under Section 5(3) has been set out in *General Motors Corporation v Yplon SA* in paragraphs 23 to 27. Paragraphs 26 & 27 indicate the standard that must be reached:-

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

50) The onus is upon the opponent to prove that its earlier trade marks enjoy a reputation or public recognition and it needs to furnish the evidence to support this claim. In the pleadings the opponent relies solely upon its mark CTM 4743225 RAW which is registered for clothing. The opponent contends that because it uses events to launch its clothing ranges that somehow it has a reputation in entertainment services including the provision of food and drink. Having a party where music is played and food and drink provided free for those who have come along to view a new range of clothing does not provide such a reputation. In any event the pleadings did not include such a claim. Somewhat reluctantly I am willing to accept that the opponent has provided evidence that this mark does enjoy such a reputation for clothing. This is despite the absence of turnover figures specifically for the mark RAW. The opponent therefore overcomes the first hurdle.

51) Once the matter of reputation is settled any opponent must then show how the earlier trade mark would be affected by the registration of the later trade mark. The opponent contends that its mark will be linked to those of the applicant and its business damaged as it has no control over the quality of the applicant’s goods. The opponent also contends that the applicant will benefit from the opponent’s advertising. The opponent contends that the goods of the two parties are identical, which I have already stated is not the case as it can only rely upon the goods pleaded and for which it has a reputation in the UK. In *Inlima S.L’s* application [2000] RPC 61 Mr Simon Thorley Q.C., sitting as the Appointed Person, said:

“The word ‘similar’ is a relative term. One has to ask the question ‘similar for what purpose’. The question of similarity accordingly can only be answered within the context of a particular set of facts, once one has identified both the facts and the purpose for which similarity is required. In the case of section 5(3), the purpose of requiring similarity is so that the possibility of detriment or unfair advantage might arise. In any particular case, a conclusion as to whether it does arise must depend not only upon the degree of similarity but on all the other factors of the case, not least, the extent of the reputation. I therefore conclude that the same global appreciation as is required for confusion under section 5(2) is likewise to be applied to the changed circumstances of section 5(3).”

52) This matter was considered by Mr Daniel Alexander Q.C. sitting as the Appointed Person in BL O/307/10 where he stated:

“37. The Decision in this case was handed down on 18th May 2009. On 18th June 2009, the ECJ handed down judgment in *L'Oréal v. Bellure*, Case C-487/07 in which it gave guidance on the proper approach to interpretation of Article 5(2) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), (the “Trade Marks Directive”).

38. The ECJ said the following as regards Article 5(2) of the Trade Marks Directive and the requirement to show detriment or unfair advantage.”

"40. As regards detriment to the repute of the mark, also referred to as 'tarnishment' or 'degradation', such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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 coattails of the mark with a reputation.

42 Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply (see, to that effect, *Intel Corporation*, paragraph 28).

43 It follows that an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor.

44 In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the

current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, Intel Corporation, paragraphs 67 to 69).

45 In addition, it must be stated that any such global assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark.

46 In the present case, it is a matter of agreement that Malaika and Starion use packaging and bottles similar to the marks with a reputation registered by L'Oréal and Others in order to market perfumes which constitute 'downmarket' imitations of the luxury fragrances for which those marks are registered and used.

47 In that regard, the referring court has held that there is a link between certain packaging used by Malaika and Starion, on the one hand, and certain marks relating to packaging and bottles belonging to L'Oréal and Others, on the other. In addition, it is apparent from the order for reference that that link confers a commercial advantage on the defendants in the main proceedings. It is also apparent from the order for reference that the similarity between those marks and the products marketed by Malaika and Starion was created intentionally in order to create an association in the mind of the public between fine fragrances and their imitations, with the aim of facilitating the marketing of those imitations.

48 In the general assessment which the referring court will have to undertake in order to determine whether, in those circumstances, it can be held that unfair advantage is being taken of the distinctive character or the repute of the mark, that court will, in particular, have to take account of the fact that the use of packaging and bottles similar to those of the fragrances that are being imitated is intended to take advantage, for promotional purposes, of the distinctive character and the repute of the marks under which those fragrances are marketed.

49 In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third

party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation 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."

53) Earlier in this decision I found that the applicant's marks 2654158 Deliciously Raw and 3002300 Refreshingly Raw were highly similar to the opponent's mark RAW. I also found that in relation to the applicant's mark 2646285 The Raw Generation the differences in this mark to the opponent's RAW mark outweighed any similarities. The opponent's mark RAW is inherently highly distinctive for clothing. The applicant's marks all relate to beverages whereas the opponent's mark is in relation to clothing. Despite the opponent's claim that the goods are identical it has provided no submissions as to why these goods should be considered similar (although they do not need to be) or why they would be linked by the average consumer in the marketplace. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is no advantage for the applicants to derive. As far as detriment is concerned, the opponent suggested that this would subsist in a reduction in the distinctiveness of their marks and also in loss of sales due to poor quality goods being offered by the applicant. I do not accept that registration of the marks in suit could have an impact in this respect, be it to the distinctiveness of the earlier marks or the reputation they enjoy. **The opposition under Section 5(3) therefore fails in relation to all three of the applicant's marks.**

COSTS

54) The opponent opposed each of the three marks applied for under two grounds. Under Section 5(2)(b) it pleaded seven marks against two of the application and three marks against the other. It succeeded under section 5(2)(b) under only one mark in the case of two of the applications, it failed in respect of all the other marks pleaded. The opponent also failed in respect of all three applications under the ground of opposition under Section 5(3). The opponent therefore lost more grounds than it pleaded. I also take into account the filing of documents as part of the evidence which clearly had no part in this case. The applicant is entitled to a contribution towards its costs despite only one of its three marks actually surviving the opposition.

Preparing statements and considering the other side's statements	£600
Considering the evidence of the other side	£400
Preparing written submissions	£600
TOTAL	£1,600

55) I order G-Star Raw C.V. to pay Vegesentials Limited the sum of £1,600. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of September 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**