

O-535-18

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION No. 3202894

BY MOHAMMED WASEEM KHAN

**TO REGISTER THE FOLLOWING TRADE MARK AS A SERIES OF
TWO**

IN CLASSES 25 & 28:

**GYM RAW
GYMRAW**

AND

**OPPOSITION THERETO (No. 409502)
BY G-STAR RAW C.V. & TM25 HOLDING B.V.**

Background and pleadings

1) On 19 December 2016, Mohammed Waseem Khan ('the applicant') applied to register the trade mark GYM RAW and GYMRAW as a series of two in the UK. It was accepted and published in the Trade Marks Journal on 10 March 2017 in respect of the following goods:

Class 25: Clothing, bodybuilding clothing, fitness clothing, gym clothing, T-shirts, vests, tank tops, hoody jackets and jumpers, jumpers, lifting fitness and gym accessory clothing, bodybuilding and weightlifting clothing straps, merchandise in the form of clothing, footwear and head gear, shorts, trousers, tracksuits, tracksuit bottoms, jogger bottoms, hats.

Class 28: Gymnastic and sporting articles; Games and playthings; Apparatus, articles and equipment for use in relation to boxing, martial arts body-building and weight-training; sporting articles [padding] for protective purposes for use in relation to boxing and martial arts; shaped padding for protecting parts of the body [specially made for use in sporting activities]; punch bags; shields for use in martial arts; parts, accessories and fittings for all the aforesaid.

2) On 12 June 2017, G-Star Raw C.V. and TM25 Holding B.V. jointly opposed (I shall refer to them collectively as 'the opponent') the trade mark on the basis of Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) The section 5(2)(b) claim is based on six earlier European Union (formerly Community) Trade Marks (EUTMs), some of which have been designated via the international registration system. Pertinent details of the earlier relied registrations are below:

Mark: RAW

Number: 11493103

Filing date: 16 January 2013

Date of entry in register: 23 June 2013

Goods relied upon:

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Mark: RAW

Number: 12849774

Filing date: 6 May 2014

Date of entry in register: 30 September 2014

Goods:

Class 25: Clothing, footwear and headgear for young people and young adults, including jeans, clothing made of denim, urban wear and street wear.

Mark: RAW

Number: 1131972¹

Date of Designation of the EU: 21 January 2013

Date protection granted in EU: 4 May 2015

Goods and services relied upon:

Class 18: Goods of leather or imitations of leather included in this class; trunks and traveling bags; rucksacks; bags; wallets; umbrellas; parasols and walking sticks.

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

Class 35: Retail store services in the field of soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses and spectacles, spectacle frames, spectacle glasses, spectacle cases, sound-, image and data carriers, such as CD's and DVD's, jewelry, bijoux, horological and chronometric instruments, including watches, goods of leather or imitations of leather, trunks and traveling bags, rucksacks, bags, wallets, umbrellas, parasols and walking sticks, clothing, footwear, headgear, belts (clothing) and fashion

¹ International registration designating the European Union

accessories; business intermediary services relating to the purchase and sale of soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses and spectacles, spectacle frames, spectacle glasses, spectacle cases, sound-, image and data carriers, such as CD's and DVD's, jewelry, bijoux, horological and chronometric instruments, including watches, goods of leather or imitations of leather, trunks and traveling bags, rucksacks, bags, wallets, umbrellas, parasols and walking sticks, clothing, footwear, headgear, belts (clothing) and fashion accessories.

Mark: G-RAW

Number: 4017356

Filing date: 10 September 2004

Date of entry in register: 2 March 2006

Goods relied upon:

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks.

Class 25: Clothing, footwear, headgear.

4) The opponent argues that the respective goods are identical or similar and that the marks are similar.

5) For the opponent's section 5(3) claim it is relying upon all of the goods and services listed above for EUTMs 12849774, 1131972 and 4017356 for the marks RAW and G-RAW, which it claims have a reputation. In particular the opponent argues that (the applicant) will benefit from (the opponent's) investment in advertising, leading to advantage. Further that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark(s). The opponent also claims that the later use will be out of its control and that poor quality or offensive goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks. Finally, the opponent claims that there is no due cause for adoption of the opposed mark.

6) The opponent's section 5(4)(a) claim is on the basis of its alleged earlier rights in RAW and G-RAW. It claims to have been selling goods and providing services under the signs since the beginning of 2001 throughout the UK and has acquired goodwill under each of the signs. It claims that use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

7) The applicant filed a counterstatement denying all of the claims made. The applicant also requested that the opponent provides proof of use of its earlier EUTM no 4017356 for the classes 25 and 28 it relies upon.

8) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

9) The opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following careful consideration of the papers.

Preliminary issues

10) In the applicant's counterstatement and evidence² it seeks to rely upon a number of arguments which it claims are reasons why there is no likelihood of confusion. These are summarised as follows:

- a) The opponent's use of the word RAW is part of the mark G-STAR RAW DENIM. Therefore, they are offering denim items whereas the applicant is not offering such goods since 'you quite clearly cannot wear denim to the gym or for fitness'.
- b) 'Our brand name will not bear the word RAW on its own our brand name encompasses two important words GYM RAW. One will not be used without the other. Where a company in our field uses the brand name

² Witness statement filed by Mr Khan and exhibits LK1 – LK13

GYMSHARK/GYM SHARK one word is not used without the other and both as equally important’.

- c) The trade mark application will not feature visibly on the face on all its intended garments.
- d) The opponent claims to have used the mark RAW solus but the evidence clearly shows that it is always used in conjunction with a logo.
- e) The opponent refers to third party use of the mark RAW on clothing. These examples include the use of RAW by World Wrestling Entertainment Inc.
- f) There are number of existing UK trade mark registrations including the word RAW. For example, RAW, RAW EDGE, RAW BLUE and RAW POWER.

11) Some of these are familiar arguments in trade mark oppositions. Before going further into the merits of this opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

12) A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods and/or services if there is a likelihood of confusion. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods/services for which it is registered.

13) Only one of the earlier relied upon trade mark registrations (no. 4017356) is old enough for the proof of use provisions to apply. The applicant has exercised its right to request that the opponent provides proof of use of that registration. However, since the remaining registrations are too young for proof of use to bite, it may rely upon all of the goods that they are registered for. In other words, the earlier mark is entitled to protection against a likelihood of confusion with the applicant’s mark based on the ‘notional’ use of the earlier mark for all the goods listed in the register. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22.It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

14) The assessment based on notional use also means that the opponent does not need to provide evidence of confusion in the marketplace or that there are existing marks currently co-existing (e.g. the existing use made by World Wrestling Entertainment., Inc is not relevant). Further, evidence on how the mark is currently being used (i.e. with a logo, with G-STAR, inside the garments or outside) are not relevant and I am unable to take these into consideration when considering a likelihood of confusion. In essence, it is an assessment made in the abstract based on the application as applied for against the earlier existing trade mark registrations.

15) As the comparison is made only between the applied-for and earlier marks, and their respective specifications, the existence of other trade marks on the register is not relevant to the judgment I must make (see the judgment of the General Court ("GC") in *Zero Industry Srl v OHIM*, Case T-400/06).

DECISION - Section 5(2)(b)

16) Five of the earlier relied upon trade mark registrations are not the subject of proof of use. Therefore, I shall begin my assessment based on Nos. 1131972 and 11493103 (both for the mark RAW), which are not the subject the proof of use and appear to represent the opponent's best case.

The law

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

The case law

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

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

19) In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

- (a) The respective 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.

21) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

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

22) The respective goods are as follows:

Applicant's goods	Opponent's goods
<p>Class 25: <i>Clothing, bodybuilding clothing, fitness clothing, gym clothing, T-shirts, vests, tank tops, hoody jackets and jumpers, jumpers, lifting fitness and gym accessory clothing, bodybuilding and weightlifting clothing straps, merchandise in the form of clothing, footwear and head gear, shorts, trousers, tracksuits, tracksuit bottoms, jogger bottoms, hats.</i></p>	<p>Class 25³: <i>Clothing; footwear; headgear; belts (clothing).</i></p>
<p>Class 28: <i>Gymnastic and sporting articles; Games and playthings; Apparatus, articles and equipment for use in relation to boxing, martial arts body-building and weight-training; sporting articles [padding] for protective purposes for use in relation to boxing and martial arts; shaped padding for protecting parts of the body [specially made for use in sporting activities]; punch bags; shields for use in</i></p>	<p>Class 28⁴: <i>Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.</i></p>

³ These goods are covered by international trade mark registration no 1131972 designating the EU

⁴ These goods are covered by EUTM no 11493103

<i>martial arts; parts, accessories and fittings for all the aforesaid.</i>	
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Class 25

23) The term *clothing* is identically included in the respective lists of goods.

24) Applying the principle set out in *Meric*, I consider the *bodybuilding clothing, fitness clothing, gym clothing, T-shirts, vests, tank tops, hoody jackets and jumpers, jumpers, lifting fitness and gym accessory clothing, bodybuilding and weightlifting clothing straps, merchandise in the form of clothing, shorts, trousers, tracksuits, tracksuit bottoms, jogger bottoms* to be included, and therefore identical, to the opponent's broad term, *clothing*.

25) Applying the same principle, I consider the applied for *merchandise in the form of footwear* to be identical to the opponent's *footwear* and *merchandise in the form head gear, hats* to be included and therefore identical to the opponent's *headgear*.

Class 28

26) The terms *Gymnastic and sporting articles; Games and playthings* are identically included in both lists of goods.

27) All of the remaining class 28 goods are various types of goods which are used in sporting activities. Therefore, they are all encompassed in the opponent's broad term *sporting articles*. They are identical.

Comparison of marks

28) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall

impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

29) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30) The respective trade marks are shown below:

Applicant's mark	Opponent's mark
GYMRAW GYM RAW	RAW

31) The opponent's mark comprises of just one word and so this is the only thing which contributes to the mark's distinctive character.

32) The applicant's mark is a series of two word marks with one being conjoined (GYMRAW) and the other two separate words (GYM RAW). Whilst the conjoined mark consists of two easily distinguishable words (GYM and RAW) which do not form anything meaningful as a whole, the average consumer is likely to dissect the mark into two words. With regard to the other mark in the series, they are presented as two words. The applicant argues that:

'...the word GYM is equally as important as the word RAW and will be used as one and not without the other. It is incorrect for the opposition to allude that the word GYM in our trademark application is non-distinctive. The opposing party states the word gym is merely identifies the goods or the place where the goods are to be used. We disagree that the word GYM is merely a description this is not correct whatsoever. Our application is very specific on the types of goods we will be selling and they are specifically in this field OF FITNESS AND GYM LIFESTYLE & FITNESS ACCESSORIES. Our trademark is NOT the word RAW, it is two words GYM RAW with the word GYM being as vital a word as raw in our application. The word GYM is wholly sufficient to distinguish the marks.'

33) I agree with the applicant that its application is for GYM RAW/GYMRAW and not RAW solus and I cannot disregard GYM. However, I do consider that the word 'GYM' has little or no distinctiveness in relation to the goods. By its own admission, the applied for mark will be used on gym and fitness related goods. When consumers are faced with trade marks that include a descriptive or non-distinctive element this does not contribute to the essential function of the trade mark which is to guarantee its trade origin. Accordingly, whilst I do not consider GYM to be distinctive *solus* for gym related articles, the mark in question is GYM RAW/GYMRAW and I do find that this combination is unusual and the overall impression rests in the mark as a whole.

34) Visually, both marks coincide with the word RAW which is the only element of the earlier mark and the second word of the application. Bearing in mind my assessment of the overall impression of the marks, I consider that the marks are visually similar to a medium degree.

35) Aurally, the marks will be articulated as GYM RAW (regardless of it being conjoined or not) and RAW respectively. Clearly the RAW element will be pronounced in the same way. Bearing in mind that the first word in the application is GYM, but this is of little or no distinctive character for the goods in question, I consider there to be an medium degree of aural similarity.

36) Conceptually, the word RAW, in relation to the goods, would be understood as being made of natural or unrefined matter. With regard to the applied for GYMRAW/GYM RAW mark, it has no overall meaning but the words individually would be understood. Therefore, since the respective marks include the word RAW there is (at best) a low degree of conceptual similarity.

Average consumer and the purchasing act

37) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

38) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39) The average consumer of the goods at issue, which are general consumer goods, is a member of the general public. The average consumer will wish to ensure that the goods are, for example, the desired fit, colour or style. Consequently, an average degree of attention will be paid to their selection. The goods at issue are generally sold through bricks and mortar retail premises (such as shops on the high street, or in supermarkets) and online. The goods will normally be chosen via self-selection from a shelf or a website, or perhaps from a catalogue. In *New Look*

Limited v OHIM, joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) stated that:

“50. [...] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion”.

40) Consequently, whilst I do not rule out that there may be an aural component (for example, advice may be sought from a shop assistant), when considered overall, the selection process will be mainly visual.

41) In respect of the class 28 goods, these are various sporting articles. These too will be purchased following a visual inspection of the goods in question (I do not discount aural considerations) and I find that there will be an average degree of care and attention paid when purchasing such goods.

Distinctive character of the earlier trade mark

42) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

43) The opponent has filed evidence to support its claim to an enhanced degree of distinctive character. However, for the sake of procedural economy I shall proceed based solely on the inherent distinctive character.

44) The earlier mark is for the word RAW. It is an ordinary dictionary word which, in relation to the goods, may be understood to mean that they are made of natural materials or are in an unprocessed condition. Since it is a suggestive word I consider the inherent distinctive character to be moderate.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

45) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

46) Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the

Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

47) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

48) In the present case I have found that the respective goods are identical and they will be purchased following a visual inspection (though aural considerations are not dismissed) with an average degree of care and attention. I have also found that the earlier mark has a moderate degree of distinctive character. With regard to the comparison of marks I have found them to be visually and aurally similar to an medium degree and there is little (if any) conceptual similarity. Taking all of these factors into consideration, I do not consider it likely that the average consumer (for any of the goods) will mistake one mark for the other, even when identical goods are considered, and even taking into account imperfect recollection.

49) I do, however, find that there is a likelihood of indirect confusion since the average consumer is likely to believe that the respective goods come from the same or economically linked undertakings, particularly since the goods are identical⁵. Whilst the list of examples provided in the *L.A. Sugar* is not exhaustive, I do consider that the present case fits firmly in example (b), i.e. the applicant's mark simply adds a non-distinctive element to the earlier mark so it would be viewed as a sub-brand suitable for wear in the gym or whilst carrying out fitness activities.

Conclusion

50) The opposition under section 5(2)(b) of the Act succeeds in its entirety. The application shall, subject to appeal, be refused registration.

51) As the two earlier trade marks listed above lead to the opposition being successful in its entirety, there is no need to consider the remaining trade marks

⁵ A lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97

upon which the opposition is based. Further, there is no need to consider the remaining grounds as they do not materially improve the opponent's position.

COSTS

52) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering and commenting on the other side's evidence	£600
Official fee	£200
Total	£1100

53) I therefore order Mohammed Waseem Khan to pay G-Star Raw C.V. and TM25 Holding B.V. the sum of £1100. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 28th day of August 2018

**Mark King
For the Registrar
The Comptroller-General**