

**IN THE MATTER OF APPLICATION NUMBER 2164280  
IN THE NAME OF RICHARD JAMES WILLAN  
TO REGISTER A TRADE MARK IN CLASS 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 50068 BY  
ARJO WIGGINS FINE PAPERS LIMITED**

**IN THE MATTER OF application number 2164280  
in the name of Richard James Willan  
to register a trade mark in Class 42**

**And**

**In the matter of opposition thereto under number 50068  
by Arjo Wiggins Fine Papers Limited**

### **Background**

On 17 April 1998, Richard James Willan filed an application to register the trade mark RAW DESIGN in Class 42 in respect of the following services:

Graphic design, print design, corporate identity design; design of advertising materials, promotional materials, packaging, wrapping, wrapping materials and containers; services in artwork and digital artwork namely artwork design, artwork printing and artwork reproduction.

On 12 August 1999, Arjo Wiggins Fine Papers Limited filed notice of opposition to this application in which they say they are the proprietors of trade mark registration number 2136537 for the mark RAW MATERIAL which is registered in Class 16 in respect of printed publications relating to print, design and production of printed matter. The grounds of opposition are in summary:

- 1. Under Section 5(2)** because the mark applied for is similar to the opponent's earlier trade mark and there exists a likelihood of confusion on the part of the public.
- 2. Under Section 5(4)** by virtue of the laws of passing off.

The applicants filed a counterstatement in which they refer to other "RAW" prefixed marks on the trade marks register. They deny the grounds on which the opposition is based.

Both the applicants and the opponents requests that an award of costs be made in their favour. Both sides filed evidence in these proceedings. The matter came to be heard on 25 June 2001, when the applicants were represented by Mr Richard Hill of Wilson Gunn McCaw, their trade mark attorneys, Mr James Graham of Counsel, instructed by Wildbore & Gibbons represented the opponents.

## **Opponent's evidence**

This consists of two Statutory Declarations. The first is dated 25 January 2000, and comes from Camilla Frances Sexton, a trainee trade mark attorney with Messrs Wildbore & Gibbons, the opponent's representatives in these proceedings.

Ms Sexton refers to a searches that she carried out between 7 and 24 January 2000, relating to the use of the RAW trade marks referred to in the counterstatement, the results of which she sets out in exhibits CSF1 to CSF4.

The second Statutory Declaration is dated 24 March 2000 and comes from David Harris, the Editor of RAW MATERIAL, a publication of Arjo Wiggins Fine Papers Limited. Mr Harris confirms that the information set out in his Declaration comes from his own personal knowledge or from the opponent's records.

Mr Harris describes RAW MATERIAL as a publication for print, design and production which is circulated on the following ratios to printers (44%), designers (38%), advertising agencies and stationery companies (14%), paper merchants (3%), the remaining 1% being distributed internally. He says it was first produced in February 1995 when approximately 12,500 copies were distributed, and has been published three times each year since then, with the current distribution standing at approximately 25,000.

A copy of the RAW MATERIAL publications from the period June 1996 through to November 1998 is shown as exhibit DH1, and includes a letter sent with the June 1995 and November 1998 editions. The exhibit shows the publication to have the title RAW MATERIAL placed above the description "The publication of print, design & production" which describes the focus of most of the articles covered by the publication, some of which cover related if not identical areas to those specified in the application. The publication uses the word RAW as the heading for various sections such as "Raw Feature", "Raw Interview" "Raw Style"; in connection with promotions under "Raw Offer" and in the name of a training course provided under the name "Raw Skills" which is described as being for designers and printers.

Mr Harris refers to the use of RAW "as a shorthand identifying prefix for the publication as a whole", and to the use of RAW in the names of various sections of the publication, with the word appearing on virtually every page. He notes in particular the section entitled "Raw Style" which he says illustrates the use made of his company's products by a graphic design company for a particular client. Mr Harris refers to a survey letter (exhibit DH2) sent out with the November 1999 edition of RAW MATERIAL, and goes on to give a breakdown of the business activity of the respondents. The survey was carried out well after the relevant date and although it is likely that the figures would be representative of the position prior to the relevant date, this cannot be certain, and consequently, this information can be given little weight on its own. The exhibit does, however, confirm that RAW MATERIAL came into being five years previously.

### **Applicant's evidence**

This consists of a Witness Statement dated 17 July 2000 from Richard Hill, an Attorney employed by Wilson Gunn McCaw, the applicant's representatives in these proceedings.

Mr Hill comments that the evidence of use of RAW prefixed marks given by Ms Sexton, inter alia, saying that it is of no relevance because it post dates the relevant date in these proceedings. He goes on to say that the use of RAW in the opponent's publication (other than as part of RAW MATERIAL) is in such small type as to be insignificant and almost unnoticeable compared to the adjacent text.

### **Opponent's evidence in reply**

This consists of a Witness Statement dated 9 October 2000 from David Harris.

Mr Harris refers to Mr Hill's comments regarding the use of RAW within the RAW MATERIAL publication. He refers to exhibit DH1 which consists of copies of the publication dating from May 1995, September 1995 and February 1996, and the promotional inserts from these editions, Mr Harris highlighting the prominence of the word RAW. The publications have sections with headings similar to those referred to earlier, but in larger text and a more prominent position.

Mr Harris says that he has worked in the paper industry in the United Kingdom and elsewhere for some thirty years. He says that this has principally been in connection with printing papers and for the last five years he has had responsibility for the opponent's Text & Covers range of printing papers which he says are extensively promoted to designers, specifiers and others involved in the graphics industry. Mr Harris says that he is not aware of any descriptive meaning to the word RAW within that industry; it is a fanciful term.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

### **Decision**

At the hearing Mr Graham indicated that the opposition should be considered as being under Section 5(2) alone. The marks are clearly not identical so the matter falls to be considered under subsection (b) of Section 5(2) which reads 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.

An earlier trade mark is defined in Section 6 of the Act as follows:

**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,

In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) 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; *Sabel BV v Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

The mark applied for covers a range of services that mirror, or at the very least, are closely associated with the subject matter covered by the opponent's publications. Whilst the evidence shows that the opponent's magazine is intended for (although not exclusively) those operating in the print and design industry, the opponent's registration is not limited in any way and would notionally include persons who may have call to use such services amongst the potential readership. I do not, therefore, see that there is any difference in the relevant consumer of the respective goods and services.

The opponent's publication does not appear to reach its readership by the usual "news stand" routes, but instead is said to be "distributed" which I take to mean that it is sent without any request or decision on the part of the relevant consumer. I have no evidence as to how the services provided by the applicants come to the attention or may be selected by the consumer, but it seems to me that this is likely to be a visual act through the usual advertisements, mail shots, credits on samples of work or commissions, etc, and perhaps to a lesser extent, through recommendations by word of mouth. I would therefore see any similarities in the look of respective marks as being of primary importance, closely followed by the sound when spoken.

Insofar as both marks have the word RAW as the first element, there is some visual and aural similarity, and being at the beginning of the mark (which is generally accepted to be the most significant element of a mark) this word has more of an impact than the following word. That said, the opponent's mark RAW MATERIAL hangs together as a phrase commonly used to describe the basic material from which something is derived and which in my view takes away some of the individual significance of the individual words. The applicant's mark, RAW DESIGN is not a commonplace phrase, but nonetheless, the use of RAW in combination with DESIGN conveys an idea of a rough or basic outline of a design. To the extent that both marks incorporate the word RAW, and that the use of this word indicates the state of something being unfinished or basic, there is some conceptual similarity.

As I have already mentioned, the opponent's mark RAW MATERIAL has a meaning, but it is not one that, as far as I am aware (and there is no evidence that shows otherwise) has any relevance in relation to their publication, and must be considered to be a distinctive mark.

The opponents have used the mark RAW MATERIAL since February 1995 in relation to a printed publication, in part as a vehicle to promote themselves to industries connected to their own, but also to inform about developments in the print, design and related industries and also wider issues affecting business in general.

The relevant consumer of the publication is stated as being those engaged in print design and production, which Mr Harris describes as being designers, printers, advertising agencies, stationery companies, paper merchants, and also their clients. This includes those that would use, or may provide the services covered by the application. The stated circulation is said to be between 12,500 and 25,000 copies, issued three times yearly. I have no evidence of how this circulation relates to the combined number of designers, printers, etc, forming the potential market, but on the face of it I would say that the figures are such that I would say that the publication is likely to have been seen by a significant proportion of these businesses, but I am not prepared to go so far as to say that the use made of the mark by the opponents is such that it has established a reputation such that it warrants exceptional protection.

On the question of whether the respective goods and services are similar, I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 and the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C- 39/97. With these cases in mind I propose to consider the question of similarity by a reference to the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the 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) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

The application is for the provision of services and the opponent's earlier mark is registered in respect of an item of goods, and I do not see how they could be regarded as

being of the same nature. Although the actual provision of print and design services would, in my view, be for a different purpose to the publication of a magazine (even if it habitually covered the same field) or reference works relating to such topics, I would consider the provision of advice, information and consultancy (which would be covered by the application) to be for the same purpose and could be argued as being complementary but not in competition. I see no reason why a trader engaged in the provision of print and design services could not also provide publications relating to the service they provide, and vice versa. I have already commented on the manner in which the respective goods and services are likely to reach, and the potential for overlap in, the respective consumers. I have also accepted the earlier mark to be distinctive per se, but that the use made by the opponents appears to be insufficient to be able to say that it has acquired a reputation warranting exceptional protection. With all of this in mind, I come to the position that publications relating to print and design and those actually engaged in the provision of such services could be said to be trading in close proximity, particularly in the case of the provision of advice, guidance and consultancy, but that this is not sufficient to conclude that they are similar.

The opponent's case appears to rely upon the likelihood of confusion through imperfect recollection, presumably because of the publication covers topics related to the services that the applicants intend to provide under the mark, and that a consumer will pick out the word RAW from the applicant's mark and will draw a connection with the name of the publication. The publication RAW MATERIAL uses the word RAW as the name for various sections within, for example, Raw Feature, Raw Interview, Raw Style, in connection with promotions under Raw Offer, and in respect of a training course for designers and printers under the name Raw Skills. This use would, in my view, have taken the opponent's reputation beyond that of the name of the publication RAW MATERIAL to include RAW as a prefix.

The opponent's publication appears to be circulated to businesses likely to use, or be interested in the opponent's products, and it seems to me that the recipients would be well aware of the nature of their business, which from the evidence appears to be that of a fine paper merchant. Beyond the features that appear in the publication, there is no evidence that the opponents, nor indeed any other paper merchants also provide print and design services. What the evidence does show is that the opponents have provided a series of training events related to design and printing, and it seems to me that taken with the fact that features on these and other subjects have appeared in their publication, in the minds of the consumer this may well have established a connection with print and design, and the concept that the opponents (or an economically linked undertaking) may actually provide such services.

Taking into account the above, and in particular, the significance of the word RAW in both marks, the use made of this word by the opponents, the parallels in, and limited extent of the area of trade and consumer, and adopting the "global" view advocated, I come to the view that the relevant consumer, on seeing the mark RAW DESIGN, will most likely be

confused or deceived into believing it to be another venture by, or connected with the opponents. The ground under Section 5(2)(b) therefore succeeds.

The opposition having been successful, I order the applicants to pay the opponents the sum of £835 as a contribution towards their costs. 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 15<sup>th</sup> day of January 2002**

**Mike Foley  
for the Registrar  
The Comptroller General**