

O/234/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2561127
BY
MOHAMMAD TARIQ MAHMOOD
TO REGISTER THE TRADE MARK**



IN CLASSES 25 AND 41

AND

**THE OPPOSITION THERETO
UNDER NO 101521
BY
G-STAR RAW C.V.
AND
FACTON LIMITED**

Trade Marks Act 1994
In the matter of application no. 2561127
by Mohammad Tariq Mahmood
to register the trade mark:



in classes 25 and 41
and the opposition thereto
under no. 101521
by G-Star Raw C.V.
and
Facton Limited

BACKGROUND

1. On 11 October 2010, Mohammad Tariq Mahmood (the applicant) applied to register the above trade mark in classes 25 and 41 of the Nice Classification system.¹ Only class 25 has been opposed, the specification for which is as follows:

General Clothing, headgear and footwear.

2. Following publication of the application in the *Trade Marks Journal* on 5 November 2010, G-Star Raw C.V. and Facton Limited (the opponents) filed a joint notice of opposition against the application.

3. The grounds of opposition were brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed against all of the applicant's goods in class 25 and is based upon the trade marks shown below. Under sections 5(2)(b) and 5(3) of the Act the opponents rely upon all of its goods and services as follows:

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

MARK DETAILS AND RELEVANT DATES	GOODS
<p>TM: 2491837</p> <p>Mark:</p>  <p>Date of application: 4 July 2008</p> <p>Priority date: 25 January 2008</p> <p>Date of registration: 27 February 2009</p>	<p>Class 18: Leatherware, made of leather, imitation of leather and goods made of these materials not included in other classes including bags and wallets; travelling trunks; umbrellas.</p> <p>Class 25: Clothing, footwear, headgear; leather belts (clothing)</p> <p>Class 35: Business advertising services relating to franchising, business advice relating to franchising, business assistance relating to franchising, business consultancy relating to franchising, business consultancy relating to franchising, franchising consultancy services, management advisory services related to franchising; Retail services in the field of soaps, perfumery, essential oils, cosmetics, suntan oils, hair lotions, glasses, sunglasses, head straps/cords for glasses, cases for glasses, cases for sunglasses, image sound and data cassettes, records, compact discs, DVD's, CD rom's, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, ornaments, precious stones, horological and chronometric instruments, watches and clocks, leather and imitations of leather, and goods made of these materials, bags, rucksacks and wallets, trunks and travelling bags, umbrellas, furniture, clothing, footwear, headgear, belts (clothing) and fashion accessories; business management; advertising and promotion services; aforementioned services also provided via the Internet.</p>
<p>CTM: 5429931</p> <p>Mark: RAW FOOTWEAR</p> <p>Date of application: 31 October 2006</p> <p>Date of registration: 15 October 2008</p>	<p>Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes, including bags and pocket wallets; trunks and travelling bags; umbrellas; except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 25: Clothing, footwear, headgear; belts</p>

	<p>[clothing]; except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 35: Advertising; business administration; office functions; business management, including retailing and franchising relating to leather and imitations of leather, and goods made of these materials, not included in other classes including bags and wallets, trunks, travelling bags, umbrellas, clothing, footwear, headgear, and belts [clothing]; except services relating to wrestling, wrestling entertainment and wrestlers.</p>
<p>CTM: 4743225</p> <p>Mark: RAW</p> <p>Date of application: 24 November 2005</p> <p>Date of registration: 15 October 2008</p>	<p>Class 03: Soaps; perfumery, essential oils, cosmetics, hair lotions; except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 25: Clothing, footwear, headgear; belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 35: Advertising; business management, including franchise services; business administration; office functions; except services relating to wrestling, wrestling entertainment and wrestlers.</p>
<p>CTM: 4017356</p> <p>Mark: G-RAW</p> <p>Date of application: 10 September 2004</p> <p>Priority date: 19 March 2004</p> <p>Date of registration: 2 March 2006</p>	<p>Class 03: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>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.</p> <p>Class 25: Clothing, footwear, headgear.</p>
<p>IR: 1010026</p> <p>Mark:</p>	<p>Class 03: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 09: Optical instruments and apparatus; including spectacles, spectacles frames,</p>

<h1>GS Raw</h1> <p>Date of International registration: 27 July 2009</p>	<p>spectacle lenses, spectacle cases; recording discs.</p> <p>Class 14: Jewellery, horological and chronometric instruments.</p> <p>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; backpacks, bags, umbrellas, parasols and walking sticks.</p> <p>Class 25: Clothing, footwear, headgear.</p>
<p>CTM: 5429956</p> <p>Mark: RAW SHOES</p> <p>Date of application: 31 October 2006</p> <p>Date of registration: 15 October 2008</p>	<p>Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes, including bags and pocket wallets; trunks and travelling bags; umbrellas, except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 25: Clothing, footwear, headgear; belts (clothing), except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 35: Advertising; business administration; office functions; business management, including retailing and franchising relating to leather and imitations of leather, and goods made of these materials, not included in other classes including bags and wallets, trunks, travelling bags, umbrellas, clothing, footwear, headgear, and belts (clothing), except services relating to wrestling, wrestling entertainment and wrestlers.</p>
<p>IR: 1000949</p> <p>Mark:</p>  <p>Date of International registration:</p>	<p>Class 18: Leatherware, imitation leather and goods made of these materials not included in other classes, including bags and wallets; traveling trunks; umbrellas.</p> <p>Class 25: Clothing, footwear, headgear; leather belts (clothing).</p> <p>Class 35: Retail and franchising services, namely</p>

<p>26 September 2008</p> <p>Priority date: 27 March 2008</p>	<p>consultation and assistance in business management; organization and promotion services; advertising and promotion services; aforementioned services also provided via Internet.</p>
<p>IR: 986572</p> <p>Mark:</p> <p>G-RAW</p> <p>Date of International registration: 26 September 2008</p> <p>Priority date: 27 March 2008</p>	<p>Class 35: Retail and franchising services, namely business management; advertising and promotion services; aforementioned services also provided via Internet.</p>

5. In their submissions the opponents argue that the applicant's goods in class 25 are identical to the goods of their own registrations in class 25 and are similar to their own goods and services in classes 18 and 35. In respect of the marks they state:

"16. In so far as the Opponent's earlier Registration Numbers 4743225 RAW, 5429956 RAW SHOES and 5429931 RAW FOOTWEAR are concerned the respective marks are identical in their distinctive verbal, conceptual and phonetical [sic] elements. The additional matter is not sufficient to distinguish the marks phonetically."

6. Under section 5(3) of the Act the opponents claim a reputation for all of the goods for which the earlier marks are registered.

7. In relation to section 5(3) the opponents state in their notice of opposition:

"4. The applicant will benefit from the Opponent's investment in its advertising and promotion of its brand leading to advantage to the Applicant without any investment by the Applicant.

5. The Applicant's use will be out of the control of the Opponent; any poor quality goods provided under the mark by the Applicant will reflect upon the Opponent's business and goods leading to detriment to the Opponent's valuable reputation and business.

6. There will be detriment to the distinctive character of the opponent's mark because the Opponent's mark will no longer signify origin. Furthermore, the economic behaviour of the relevant public will be affected as they will buy the Applicant's goods in place of those of the Opponent. If such goods are unsatisfactory the public may cease purchasing the Opponent's goods also."

8. Under 5(4)(a) of the Act the opponents state that they have a goodwill in relation to the following goods and services:

“Belts, bags, wallets, key cases; clothing, footwear and retail services.”

9. In relation to section 5(4)(a) they state in their notice of opposition:

“The Opponent has established goodwill resulting from its use of the mark relied upon. Use of the opposed mark is a misrepresentation likely to lead the public to believe that the applicant’s goods are those of the opponent. The opponent will suffer damage by reason of the public’s erroneous belief that the applicant’s goods are those of the opponent.”

10. On 14 April 2011, the applicant filed a counter statement which denies the grounds upon which the opposition is based.

11. The opponents’ marks are earlier marks which are not subject to proof of use because, at the date of publication of the application, none of them had been registered for five years.²

12. Both parties filed evidence in the proceedings, only the opponents filed written submissions in lieu of a hearing. I will refer to these as necessary below.

EVIDENCE

13. The opponents’ evidence consists of a witness statement, dated 30 July 2011, by Johannes Christian de Bil who is the managing director of Facton Ltd. Attached to the witness statement are 15 exhibits. For reasons which will become apparent below, I will not detail the evidence here but will discuss the relevant exhibits when considering the distinctive character of the opponents’ earlier mark.

14. The applicant’s evidence consists of a witness statement, dated 28 October 2011, by Mohammad Tariq Mahmood, who is the director of Raw Fitness Limited. Attached to the witness statement are 5 exhibits which consist of, inter alia, pictures of merchandise, hand written receipts for membership and merchandise sales, marketing leaflets and plan drawings for expansion of the applicant’s business. In his witness statement the applicant says:

“2. The trade mark RAW FITNESS was first used in May 2011 in the United Kingdom by the applicant.”

15. The date of first use in the United Kingdom is after the material date. Where the exhibited material is dated it is also all after the material date and is, therefore, of no assistance to the applicant.

DECISION

16. I shall deal first with the ground of objection under section 5(2)(b). 5(2)(b) of the

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

Trade Marks Act 1994, states:

“(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.”

17. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) 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 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 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.”

The average consumer and the nature of the purchasing act

18. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

19. In their submissions the opponents state:

“8. The Class 25 goods of the opposed mark are general consumer goods; the relevant consumer for the goods is the UK public as a whole...

9. It is established in the case law that the clothing sector comprises a wide array of goods of variable quality and price and although a consumer may be more attentive when purchasing an expensive article of clothing, an above average level of attention cannot be presumed without evidence in that regard (Case T-434/10 Václav Hrbek v OHIM, para. 29).”

20. I agree: the average consumer for these goods is a member of the general public who buys clothing. In considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the General Court’s (GC) decision in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 in which

it commented:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

...

53. 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.”

21. Whilst the opponents’ mark excludes goods essentially related to wrestling, neither are limited in any way, they will therefore include goods across all price spectrums. Given the nature of the goods at issue which are (broadly speaking) clothing items of one sort or another, the average consumer will, in my view, pay at least a reasonable degree of attention to their purchase, to the extent that they will need to consider, inter alia, size, material and colour; in accordance with the decision in *New Look*, the visual aspect of the competing marks is likely to be of more importance than aural considerations.

The opponents’ best case

22. In their written submissions the opponents state:

“12The Opponents’ strongest position is in relation to the earlier Community Trade Mark Registration Number 4743225 for the mark RAW per se, and in relation to Registration Numbers 5429931 RAW FOOTWEAR and 5429956 RAW SHOES, each of which comprises RAW accompanied by non-distinctive matter.”

23. In his counter statement the applicant states:

“5. Whilst it is denied that any of the Opponents’ marks are confusingly similar to that of the Applicant, it is submitted that the most similar is Community Trade Mark Registration No. 4743225 RAW...If the Opponents’ RAW mark is not similar to the mark applied for, none of the other marks cited in this Opposition can be said to be similar to it either.”

I agree. The opponents' best case rests in the mark RAW and it is this mark which will form the basis of my decision under 5(2)(b) of the Act.

Comparison of goods

24. In their submissions the opponents state:

“11. The Class 25 goods of the respective marks are identical as each of the Opponents' earlier trade marks extend to clothing, footwear and headgear in Class 25.”

25. In his counter statement the applicant draws my attention to the fact that the opponents' earlier right G-RAW is only registered in class 35. And continues:

“15. It is admitted that the goods protected in class 25 of the other marks on which the Opponents rely are identical to those for which the Applicant is currently seeking registration in that class, namely 'General clothing, headgear and footwear’”.

I agree. This opposition is directed at class 25 of the application, the specification of which contains identical goods to the class 25 specification of the opponents' earlier mark.

Comparison of marks

26. The marks to be compared are:

Opponent's mark	Applicant's mark
RAW	

27. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components³, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Dominant and distinctive components

28. The opponents' mark, 'RAW' does not split into separate distinctive and dominant

³ Sabel v Puma AG, para.23

components. It will be viewed as the single word 'RAW' which is its only constituent part.

29. In their written submissions the opponents state:

“13...The word RAW prominently features in the opposed mark with RAW comprising one third of the mark as a whole. The word 'FITNESS' is diminutive and the overall impression of the mark is the word RAW which dominates the image. Accordingly, the term RAW is visually dominant in the opposed mark.”

30. In his counter statement the applicant states:

“9.Visually, the dominant and distinctive part of the Applicant's mark is the stylised device of a muscular man raising a dumbbell. This image encompasses well over 50% of the mark, and would be the part that registers with consumers most strongly, as its bold, striking stencilling rises above and dominates the words beneath.”

31. The applicant's mark consists of a stylised figure which he describes as *'the stylised device of a muscular man raising a dumbbell'*. The figure makes up the upper two thirds of the mark. The degree of stylisation and the positioning of the figure in the applicant's mark results in it being both a dominant and distinctive element.

32. Presented below the figure is a black rectangle which makes up the remaining third of the mark. Within the rectangle is the word 'RAW' in a stylised, though not remarkable, font. The word "RAW" is, in my view, equally as dominant and distinctive as the stylised figure. Beneath the letters 'A' and 'W' of the word 'RAW' appears the word 'FITNESS' presented in block capitals, but considerably smaller than the word 'RAW'. In their submissions the opponents state:

“15. ...the term FITNESS per se is descriptive of goods in class 25 as it refers to the intended purpose of the clothing articles i.e. clothing, footwear and headgear which is suitable for, or intended to be used in relation to fitness related activities. Accordingly, the relevant public is likely to disregard the FITNESS element of the opposed mark or to accord it less weight especially if the public does not have the opportunity to make a direct comparison between the marks”.

33. I agree. In the context of the goods this will be seen as nothing more than a reference to the kind of goods. Consequently, this and the fact that the mark is dominated by the stylised device of a muscular man and the word 'RAW', means that the word FITNESS is unlikely to be afforded any origin significance by the average consumer.

34. Consequently, I find the stylised figure and the word 'RAW' to be equally dominant and distinctive elements within the applicant's mark.

Visual similarities

35. In his counter statement the applicant states:

“9. The image reinforces the fact that this mark relates to physical health and exercise, clearly being the sign used by a gymnasium. No such elements appear in the Opponents' marks, which give no visual reference to health or fitness.

10. Further, the word RAW appears in highly stylised, pointed angular typeface not replicated in the Opponents' RAW registration...The words RAW FITNESS appear within a large black rectangle also absent from the Opponents' marks and are written in white...In short, none of the Opponents' registrations are visually similar to the Applicants mark.”

36. Any visual similarity between the marks rests in the word 'RAW'. In the applicant's mark the word is presented in a black rectangle and makes up a third of the mark. As discussed above, the word FITNESS is unlikely to be afforded any origin significance by the average consumer. Taking all of these factors into account I find there to be a moderate degree of visual similarity between the marks.

Aural similarities

37. The opponents submit:

“14. Words are the primary means by which a consumer identifies a mark or orders goods...The subject mark will be identified as RAW by the public. Even to the extent that “fitness” may be articulated or read by the consumer, this term will be perceived as non-distinctive.”

38. The applicant submits:

11. Phonetically, the Applicant's mark would be pronounced 'RAW FITNESS'. The most similar of the Opponents' marks would be pronounced 'RAW'. Two of the three syllables in the Applicant's mark are not replicated in those of the Opponents'.

39. I agree with the opponents that the applicant's mark will be articulated, primarily, as the word 'RAW'. For the reasons mentioned above, the word FITNESS is likely to be given little or no weight by the average consumer. However, I cannot rule out that the average consumer may also articulate the word 'FITNESS' in the applicant's mark.

40. Consequently, if FITNESS is articulated, I find the marks to be at least aurally highly similar as both contain the word RAW, spoken as the first or only word within them. If as I expect, the word RAW is not articulated then the marks are aurally identical.

Conceptual similarities

41. For a conceptual meaning to be relevant it must be one capable of immediate grasp by the average consumer.⁴

42. The opponents conclude that both marks will be seen as the word RAW and as such:

“16...the respective marks are identical in their distinctive verbal, conceptual and phonetical elements’.

43. The applicant states:

“7. Conceptually the Opponents’ RAW mark would be seen as referring to a rough, unfinished or uncooked quality (i.e. a raw quality). RAW FITNESS, when accompanied with the device in the Applicant’s mark, would be seen as referring to harsh, demanding physical exercise for the purpose of improving health. Such a meaning is not present in any of the marks relied upon by the Opponents. Fitness and health are not alluded to in any of their registrations. As such, the Applicant’s mark is conceptually dissimilar from those of the Opponents.”

44. I agree with the applicant that RAW is a well known word with which the average consumer will be familiar. There is no evidence to show that it would be seen as referring to ‘*harsh, demanding physical exercise*’, in my view, the most likely conceptual meaning of the word would, in my view, be something unfinished or uncooked and I do not agree that the marks are conceptually dissimilar. As both contain the word RAW, both will convey the same conceptual message in relation to that word. In the applicant’s mark the additional elements, namely, the stylised device at the top of the mark and word FITNESS, cannot be ignored and will provide the average consumer with an allusion to fitness. That said, the overall impression of both marks is dominated by the word RAW; in the case of the opponents’ mark this is the only message. The applicant’s mark provides a similar message albeit in the context of fitness.

45. Consequently, I find the marks to have a high degree of conceptual similarity.

Distinctive character

46. I must now assess the distinctive character of the opponents’ earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall

⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

47. I have to consider whether the opponents' mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it.

48. The word 'RAW' is neither descriptive of nor non-distinctive for the goods at issue. I find it to be a trade mark with a normal level of distinctiveness.

49. In order to determine whether the trade mark RAW has acquired enhanced distinctive character through the use made of it, I must turn to the evidence filed by the opponents. This consisted of 15 exhibits which amounted to several thousand pages. It is clear from these exhibits that the vast majority of use relates to the marks G Star Raw and GS RAW, G STAR RAW DENIM and the following device mark:



50. Mr de Bil submits in his witness statement:

"3. The exact date when we first used RAW on its own is not certain as our use of RAW has moved through various stages."

51. As far as I can see there is little or no use of the word RAW alone. Exhibit 5 includes catalogues showing the opponents' goods. At pages 47-50 the images show clothing which features the word 'RAW' in large letters on the front. But the images are not clear and there is other wording included on the garments which I suspect to be the words 'G STAR'.

52. In addition, Mr de Bil has provided turnover figures which culminate in turnover of £37.4 million for the year 2006-2007. This is a substantial turnover, however, it relates to all of the marks on which the opponents rely and is not broken down.

53. Given that I have little or no evidence of use of the mark 'RAW' being used alone, I cannot conclude that there has been use of it sufficient to enhance the inherent distinctive character of the mark.

54. Therefore, the mark which the parties agree represents the opponents' strongest case is not, in my view, entitled to enhanced distinctive character through use.

Likelihood of confusion

55. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept

in his mind.⁵ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

56. I have found that the marks share a moderate degree of visual similarity, are aurally highly similar (or identical) and share a high degree of conceptual similarity. I have identified a normal level of inherent distinctive character in the opponent's earlier mark and have concluded that the parties' goods are identical. I have identified the average consumer, namely a member of the general public who buys clothing. I have concluded that the purchasing act will, generally, be visual and that the purchase will involve a reasonable degree of care and attention, given that the goods will be selected according to size, colour, etc.

57. Taking all the above factors into account and considering the marks as a whole, I have no difficulty concluding that while the differences between the respective marks are sufficient to avoid direct confusion, i.e. where one mark is mistaken for the other, the similarities between the respective marks arising from the commonality of the word RAW is sufficient that where used on goods which are identical, there is a likelihood that consumers will be confused into believing that the goods provided by the applicant are those of the opponents or provided by some undertaking linked to them i.e. there will be indirect confusion. Accordingly, **in respect of the goods in class 25 the opposition is successful.**

58. Given what I consider to be a very clear finding under section 5(2)(b) of the Act, I need not go on to consider the opposition under sections 5(3) and 5(4)(a).

CONCLUSION

59. The opposition succeeds. This was a partial opposition to all of the applicant's goods in class 25. The applicant's services in class 41 can proceed to registration.

Costs

60. The opposition having succeeded, the opponents, are entitled to a contribution towards their costs. I have taken into account that no hearing has taken place, but that the opponents filed evidence and written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side's statement:	£ 300
Preparing evidence and considering the other side's evidence:	£ 500
Written submissions:	£ 300
Official fee:	£ 200

⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

Total:

£ 1300

61. I order Mohammad Tariq Mahmood to pay G-Star Raw C.V. and Factor Ltd the sum of £1300. This sum is 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 14th day of June 2012

**Ms Al Skilton
For the Registrar,**