

O-082-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2578156
IN THE NAME OF FRO KNOWS PHOTO LLC

AND

JOINT OPPOSITION THERETO UNDER NO 102271
BY G-STAR RAW C.V. AND FACTON LTD

Background

1. Application no 2578156 has a filing date of 11 April 2011 and stands in the name of Fro Knows Photo LLC (“the applicant”). The applicant seeks registration of the trade mark I SHOOT RAW for the following goods in Classes 9 and 25:


Class 9:
Glasses, sunglasses

Class 25:
Shirts, shirts for men, shirts for women, shirts for children, jackets, jackets for men, jackets for women, jackets for children, jumpers, jumpers for men, jumpers for women, jumpers for children, golf shirts, polo shirts.


2. Following publication of the application in the *Trade Marks Journal* on 13 May 2011, notice of opposition was filed by G-Star Raw C.V and Facton Ltd, jointly (“the opponents”). The grounds on which the opponents rely are as follows:

- Under section 5(2)(b) of the Act on the basis that the application is in respect of a mark which is similar to eight earlier marks and is made in respect of identical or similar goods;
- Under section 5(3) of the Act because the same eight earlier marks enjoy a reputation in the UK and the applicant would benefit from the opponents’ investment in advertising, leading to an advantage, without any investment, to the applicant; that any poor quality goods provided under the applicant’s mark would reflect upon the opponents’ business leading to detriment to their reputation and that there would be detriment to the distinctive character of the opponents’ marks because their marks would no longer signify origin;
- Under section 5(4)(a) of the Act because the opponents have established goodwill in seven signs (the notice of opposition sets out nine signs but two of them appear to be duplicated) in respect of belts, bags, wallets, key cases, clothing, footwear and retail services.


3. As far as the objections founded on section 5(2) and 5(3) of the Act are concerned, the opponents rely on the following earlier marks:

Mark and relevant dates	List of goods and services
<p>2491837</p> 	<p>Class 18: <i>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.</i></p> <p>Class 25: <i>Clothing, footwear, headgear; leather belts (clothing)</i></p> <p>Class 35: <i>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,</i></p>

<p>Filing date: 4 July 2008</p> <p>Registration date: 27 February 2009</p>	<p><i>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.</i></p>
<p>Community trade mark (CTM) 5429931</p> <p>RAW FOOTWEAR</p> <p>Filing date: 31 October 2006</p> <p>Registration date: 15 October 2008</p>	<p>Class 18: <i>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.</i></p> <p>Class 25: <i>Clothing, footwear, headgear; belts [clothing]; except products relating to wrestling, wrestling entertainment and wrestlers.</i></p> <p>Class 35: <i>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.</i></p>
<p>CTM 4743225</p> <p>RAW</p> <p>Filing date: 24 November 2005</p> <p>Registration date: 15 October 2008</p>	<p>Class 3: <i>Soaps; perfumery, essential oils, cosmetics, hair lotions; except products relating to wrestling, wrestling entertainment and wrestlers.</i></p> <p>Class 25: <i>Clothing, footwear, headgear; belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers.</i></p> <p>Class 35: <i>Advertising; business management, including franchise services; business administration; office functions; except services relating to wrestling, wrestling entertainment and wrestlers.</i></p>
<p>CTM 4017356</p> <p>G-RAW</p> <p>Filing date: 10 September 2004</p> <p>Registration date: 2 March 2006</p>	<p>Class 3: <i>Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</i></p> <p>Class 18: <i>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.</i></p> <p>Class 25: <i>Clothing, footwear, headgear</i></p>
<p>International Registration (EU)(IR EU) 1010026</p> <p>GS Raw</p> <p>Date of International registration:</p>	<p>Class 3: <i>Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices</i></p> <p>Class 9: <i>Optical instruments and apparatus; including spectacles, spectacle frames, spectacle lenses, spectacle cases; recording discs</i></p> <p>Class 14: <i>Jewellery, horological and chronometric instruments</i></p> <p>Class 18: <i>Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides;</i></p>

<p>27 July 2009</p> <p>Date of protection in the EU: 15 July 2010</p>	<p><i>trunks and travelling bags; backpacks, bags, umbrellas, parasols and walking sticks</i></p> <p>Class 25: <i>Clothing, footwear, headgear</i></p>
<p>CTM 5429956</p> <p>RAW SHOES</p> <p>Filing date: 31 October 2006</p> <p>Registration date: 15 October 2008</p>	<p>Class 18: <i>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.</i></p> <p>Class 25: <i>Clothing, footwear, headgear; belts (clothing), except products relating to wrestling, wrestling entertainment and wrestlers.</i></p> <p>Class 35: <i>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.</i></p>
<p>IR EU 986572</p> <p>G-RAW</p> <p>Date of International registration: 26 September 2008</p> <p>Date of protection in the EU: 9 December 2009</p>	<p>Class 35: <i>Retail and franchising services, namely business management; advertising and promotion services; aforementioned services also provided via Internet</i></p>
<p>IR EU 1000949</p>  <p>Date of International registration: 26 September 2008</p> <p>Date of protection in the EU: 28 April 2010</p>	<p>Class 18: <i>Leatherware, imitation leather and goods made of these materials not included in other classes, including bags and wallets; travelling trunks; umbrellas</i></p> <p>Class 25: <i>Clothing, footwear, headgear; leather belts (clothing)</i></p> <p>Class 35: <i>Retail and franchising services, namely consultation and assistance in business management; organization and promotion services; advertising and promotion services; aforementioned services also provided via Internet</i></p>

4. In relation to the objection founded upon section 5(4) of the Act, the opponents rely on the following signs:

Sign	Date of claimed first use
	1995
RAW FOOTWEAR	At least 2003
RAW	2001
G-RAW	At least 1995
GS Raw	At least 2007
RAW SHOES	At least 2003
G-RAW	1995

5. The applicant filed a counterstatement in which, essentially, it denied the claims made. Only the opponents filed evidence. They also filed written submissions in lieu of a hearing. I have carefully reviewed all of this material in reaching my decision.

Opponents' evidence

6. This takes the form of a witness statement by Johannes Christian de Bil, managing director of Facton Ltd. He states that G-Star Raw C.V. (the first opponent) is a licensee of Facton Ltd (the second opponent) and both are part of the G-Star group of companies.

7. Mr de Bil states that the first use of any mark that included the word RAW was in 1995 when G-STAR RAW DENIM was first used. Since that time, other marks incorporating the word RAW are said to have been used including use of the word RAW on its own. Mr de Bil states that he cannot provide the exact date of first use of the word RAW on its own as it "is not certain as our use of RAW has moved through various stages".

8. Mr de Bil states that the opponents' marks have become established in many markets around the world with offices in more than twenty countries and with over five and a half thousand points of sale in more than eighty countries.

9. Mr de Bil provides the following details of total turnover under the marks relied on in this opposition:

Year	UK turnover in £millions
2000-2001	1.4
2001-2002	2.3
2002-2003	4.0
2003-2004	7.8

2004-2005	12.1
2005-2006	21.9
2006-2007	37.4
2007-2008	>37.0
2008-2009	>37.0
2009-2010	>37.0

10. Mr de Bil states that most products sold bear all of the brands and that product packaging, marketing material and products themselves bear multiple trade marks simultaneously. He states that the nature of this use means that he is not able to isolate figures relating to any one mark though he confirms that at least 90% of the figures in the above table relate to sales where the mark RAW was used either alone or in combination with another mark.

11. Mr de Bil lists various overseas trade fairs which took place in 2004-2006 and states that they are attended by UK buyers for the explicit purpose of viewing products to be sold in the UK. At JCdeB1 he exhibits sample invitations sent out to buyers and traders which show use of the marks G-STAR RAW, G-STAR, and G-STAR RAW DENIM and logo.

12. Mr de Bil states that the opponents' goods are sold in a wide range of retail outlets in the UK including *House of Frasier* (sic), *Selfridges*, *Republic*, *Mesh Menswear*, *Colours*, *Cult*, *Urban Outfitters*, *Aspecto*, *Hayes and USC* and provides a list of some other UK outlets in Exhibit JCdeB2. At JCdeB3 he provides a list of towns and cities in the UK where the opponents' products are sold and says that there is a presence in every county. At JCdeB6-15 he exhibits numerous documents listing the marks relied on, brochures and leaflets showing the various marks and examples of their use in various EU countries.

13. That concludes my summary of the evidence filed to the extent I consider it necessary.

The objection under section 5(2)(b) of the Act

14. Section 5(2)(b) of the Act states:

“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.”

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. Under this ground of objection, the opponents rely on the eight marks shown above (each joint opponent being the registered proprietor of four of them). All of them are earlier marks as defined by section 6 of the Act given that they each have a date of application prior to that of the application in suit and each has achieved registration/protection. CTM 4017356 completed its registration process more than five years prior to the publication date of the application now before me and would be subject to the proof of use provisions set down in section 6A of the Act if the applicant had requested it in its counterstatement. No such request was made.

17. Whilst the opponents rely on eight earlier marks under this ground of opposition, I intend to consider the matter only in relation to one earlier mark: that is CTM 4743225 as it represents their strongest case. If the opponents cannot succeed under this ground based on this earlier mark, they will be in no stronger position in respect of their other earlier marks. For the same reasons, whilst this CTM is registered in respect of various goods and services, I intend to consider it insofar as it is registered for goods in class 25 only.

18. 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.”

Comparison of the respective goods

19. For ease of reference, the goods to be compared are as follows:

Earlier mark	Application
Class 25: <i>Clothing, footwear, headgear; belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers</i>	Class 9: <i>Glasses, sunglasses</i> Class 25: <i>Shirts, shirts for men, shirts for women, shirts for children, jackets, jackets for men, jackets for women, jackets for children, jumpers, jumpers for men, jumpers for women, jumpers for children, golf shirts, polo shirts</i>

20. In its counterstatement, the applicant submits:

“To clarify: [The applicant] owns a photography education and consumer review website. His daily activities include; commenting on photo submissions, offering advice and tips on theory and practice and making instructional videos for entertainment and educational purposes to photographers.

The merchandise sold to complement the website is all branded “I SHOOT RAW” with reference to the digital photographic file format “RAW” used by all professional photographers, and many enthusiasts and amateurs. This format existed several years prior to the creation of G Star Raw.

To suggest that G-Star Raw has any goodwill in the industry in which [the applicant] trades is misleading, and incorrect. [The applicant] can prove that every single purchase made of his branded “I SHOOT RAW” shirts has come from subscribers to his website, i.e. clientele whose interest in the brand stems from the public proclamation that they “SHOOT RAW”, and enjoy the educational and photographic services offered by the website.

Consumers looking to purchase G-Star’s products, would need to search high street stores and department stores, and fashion retail websites in order to make any such purchase.

The route[s] taken to obtain either “I SHOOT RAW” or “G-STAR RAW” products are diametrically opposed.”

21. I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

“67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the

methods by which the goods covered by the earlier mark are likely to be marketed.”

22. I am also mindful of the findings of the Court of First Instance (now General Court) in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

23. In accordance with the above cases, I have to make the comparison on the basis of the specification of goods as currently registered by the opponents’ earlier mark and that for which registration is applied by the applicant regardless of where the respective goods may have been sold in the past.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

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

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

26. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 the General Court (GC) stated:

“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-214/05P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05, *Saint-Gobain Pam v OHIM –Promamsa (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-1-0000, paragraph 48).”

27. Finally, I take note of the comments of the General Court in *Gérard Meric v OHIM*, Case T-133/05, where it was stated:

“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)*.”

28. Each of the goods as set out in class 25 of the application is an item of clothing. They are included within the term *clothing* as appears in the earlier mark’s specification and therefore, in line with *Meric*, identical goods are involved.

29. As to the goods as set out in class 9 of the application, whilst the nature of *glasses* and *sunglasses* differ to that of *clothing*, they are each articles to be worn. The same manufacturers will produce and market such eyewear to complement their range of clothing and the same consumer will purchase them as an accessory to clothing and to coordinate with them. Furthermore, the respective goods are found in

the same retail outlets and in the same area of e.g. a department store or supermarket. There is a degree of similarity between the respective goods.

Average consumer and nature of the purchasing process

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

31. In respect of clothing, in *React trade mark* [2000] R.P.C. 285, Mr Simon Thorley, sitting as the appointed person, said:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing order by word of mouth. Nevertheless, my own experience tells me it is true of most casual clothing. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent orders usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

32. 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 the General Court considered the level of attention paid by the average consumer when purchasing goods in the clothing sector:

“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.”

33. As the *New Look* case acknowledges, the cost of clothing can vary considerably and the same applies to glasses and sunglasses, however, I must keep in mind goods across the whole price spectrum. While the average consumer’s level of attention is likely to vary considerably given the cost and nature of the particular item being bought, I consider that, even when selecting routine items, the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned, its suitability for purpose and, where applicable, ease

of being laundered. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of all the goods at issue.

Comparison of the respective marks

34. 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, the average consumer rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he may have kept in 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 to compare the respective trade marks from the visual, aural and conceptual perspectives.

35. For ease of reference, I set out below the marks to be compared:

Earlier mark	Application
RAW	I SHOOT RAW

36. The opponents' mark consists of the single word RAW. As a single word, it has no dominant components: its distinctiveness rests in its whole. The applicant's mark is made up of three words which make up a phrase. In my view the word RAW is the dominant element of the mark as it is the object of that phrase. Whilst the words I SHOOT appear only in the application, the fact that both marks consist of or contain the word RAW leads to there being a reasonably high degree of similarity between them from both the visual and aural perspectives.

37. The word RAW is an ordinary everyday word which has a number of meanings including „not cooked' (of food), „red and sore' (of the body) or „in an unfinished or natural state'. The verb shoot also has a number of meanings including „to fire or discharge' (a gun), „to photograph' or „to fasten' (a bolt). As I set out above at paragraph 20, the applicant states I SHOOT RAW is a reference “to the digital photographic file format “RAW” used by all professional photographers, and many enthusiasts and amateurs”. Whilst this may be the applicant's intention, the goods at issue here are glasses and items of clothing and it is not clear to me why the average consumer of such goods would bring such a file format to mind. In my view the mark will bring to mind something „raw' being „shot' though in the context of the goods, there is no particular image being brought to mind. I consider the marks are conceptually neutral.

The distinctive character of the earlier mark

38. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *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 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 (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

39. The earlier mark consists of the single word RAW. It is, as set out above, an ordinary English word which has a number of meanings though no particular meaning in respect of the goods at issue. Whilst, in his evidence, Mr de Bil has provided turnover etc. figures, he has explained that he cannot separate those figures so that they relate to any particular mark used. Despite fairly weighty evidence showing use of the opponents' marks, there is very limited evidence of the word RAW being used alone: it is far more commonly used, as Mr de Bil acknowledges, in conjunction with other marks including logos. Consequently, I am unable to conclude that the mark RAW alone has an enhanced distinctive character through the use made of it. It is a mark with an average level of distinctive character.

Likelihood of confusion

40. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he has retained in mind.

41. Earlier in this decision I found:

- the respective marks to have a reasonably high degree of both visual and aural similarity;
- the position from the conceptual perspective to be neutral;
- the applicant's goods in class 9 to be similar to the opponents' goods;
- the applicant's goods in class 25 to be identical to the opponents' goods;
- the distinctive character of the earlier mark to be of an average level and which had not been enhanced through its use;
- the purchase of the goods at issue to be primarily visual.

42. Taking all relevant factors into account, I find that there is a likelihood of confusion between the respective marks in respect of all goods of the application. Given the inclusion of the words I SHOOT within the application which is absent from the earlier mark, I do not consider the marks will be directly confused with each other. Rather, I consider that the average consumer will believe that the respective goods will originate from the same or a linked undertaking and will therefore confuse them indirectly. The opposition based on section 5(2)(b) of the Act succeeds.

The objections under 5(3) and 5(4) of the Act

43. In view of my findings in respect of the objection under section 5(2)(b) of the Act, I do not consider it to be necessary to go on to consider the grounds of opposition founded on section 5(3) and 5(4) of the Act and I decline to do so.

Costs

44. The opposition having succeeded, the opponents are entitled to an award of costs in their favour. In making the award, I take into account the fact that the applicant did not file any evidence and that no hearing took place. I also take into account that whilst the opponents filed a weighty volume of evidence, it was not particularly well directed in terms of the individual marks on which they sought to rely. I award costs on the following basis:

Preparing a statement and considering the applicant's counterstatement:	£300
Fee:	£200
Preparing and filing evidence:	£500
Filing written submissions:	£200
Total:	£1200

45. I order Fro Knows Photo LLC to pay G-Star Raw C.V. and Facton Ltd the sum of £1200. 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 21st day of February 2013

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