

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 2 594 952

IN THE NAME OF RAW SNOW MEDIA LIMITED

TO REGISTER IN CLASSES 09, 35, 39, 41, 42 AND 43 THE TRADE MARK: RAW SNOW

AND

OPPOSITION THERETO UNDER NO 102 939

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The Background and Pleadings

1. Raw Snow Media Limited (RSM) applied to register the trade mark RAW SNOW on 19/09/2011. The application was published in the Trade Marks Journal on 28/10/2011 in respect of the following goods and services:

Class 09:

Recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; mobile software applications, downloadable electronic publications; digital music; computer games equipment adapted for use with an external display screen or monitor.

Class 35:

Advertising; business management; business administration; office functions; electronic data storage; advertising services provided via the Internet; trade fairs; opinion polling; data processing; provision of business information.

Class 39:

Transport; travel arrangement; travel information; destination information.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; winter sports information.


Class 42:


Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.

Class 43:


Temporary accommodation; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation.

2. Falcon Ltd (FL) oppose the registration on the basis of Section 5(2)(b) and 5(3) of the Trade Marks Act 1994 based upon the following earlier trade marks :

Earlier trade marks	Filing Date	Date of Registration	Goods and services
1. CTM 9 702 184 RAW	1/2/2011	5/7/2011	Class 41: Entertainment; record company services, including music publishing services; production and publishing of images, video's and DVD's; organisation of entertainment and educational events, such as concerts, festivals, parties and workshops; development and production of television and radio programs and publication of printed matter, including books, magazines and newspapers and electronic publications; sporting activities, including the organisation of sports competitions; cultural activities; except services relating to wrestling, wrestling entertainment and wrestlers.
2. UK 2 491 837 	4/7/2008	27/2/2009	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. Class 25: Clothing, footwear, headgear; leather belts (clothing) Class 35: Business advertising services relating to franchising, business

			<p>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>3. IR (designating EU) 1000949</p> 	26/9/2008	28/4/2010	<p>Class 18:</p> <p>Leatherware, imitation leather and goods made of these materials not included in other classes, including bags and</p>

			<p>wallets; traveling trunks; umbrellas.</p> <p>Class 25: Clothing, footwear, headgear; leather belts (clothing).</p> <p>Class 35: 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.</p>
4. IR (designating EU) 986572 G-RAW	26/9/2008	9/12/2009	<p>Class 35: Retail and franchising services, namely business management; advertising and promotion services; aforementioned services also provided via Internet</p>
5. CTM 4 743 225: RAW	24/11/2005	15/10/2008	<p>Class 3: 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</p>



			wrestling, wrestling entertainment and wrestlers.
6. CTM 3 612 801 	15/1/2004	22/6/2005	Class 41: Entertainment; sporting and cultural activities.
7. CTM 9 914 284 RAW	21/4/2011	27/9/2011	<p>Class 9: Spectacles; sunglasses, sunglass products, namely, headstraps, sunglass retainers, eyeglass cases, and sunglasses cases.</p> <p>Class 14: Watches; bijoux and jewellery.</p> <p>Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; plastic materials for packaging (not included in other classes).</p> <p>Class 18: Goods made of leather and imitations of leather not included in other classes; trunks and travelling bags, rucksacks, bags, pocket wallets, umbrellas, parasols and walking sticks.</p> <p>Class 20:</p>

			<p>Furniture, mirrors, picture frames.</p> <p>Class 24:</p> <p>Textile goods, not included in other classes; bed and table covers</p>
8. CTM 5 429 931 RAW FOOTWEAR	31/10/2006	15/10/2008	<p>Class 18:</p> <p>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:</p> <p>Clothing, footwear, headgear; belts [clothing]; except products relating to wrestling, wrestling entertainment and wrestlers.</p> <p>Class 35:</p> <p>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>9. CTM 5 429 956 RAW SHOES</p>	<p>31/10/2006</p>	<p>15/10/2008</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>

3. FL also oppose on the basis of the following earlier common law rights:

<p>Earlier sign</p>	<p>Goods and services used</p>
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1. Raw	Belts, bags, wallets, key cases; clothing, headgear, footwear, fashion accessories; printed matter; entertainment; electronic applications for mobile devices; online publications; fashion shows; retail services; film production; film presentation; film publishing services.
 2. RAW	Belts, bags, wallets, key cases; clothing, headgear, footwear, fashion accessories; printed matter; entertainment; electronic applications for mobile devices; online publications; fashion shows; retail services; film production; film presentation; film publishing services.
3. G-RAW	Belts, bags, wallets, key cases; clothing, headgear, footwear, fashion accessories; printed matter; entertainment; electronic applications for mobile devices; online publications; fashion shows; retail services; film production; film presentation; film publishing services.
	Belts, bags, wallets, key cases; clothing, headgear, footwear, fashion accessories; printed matter; entertainment; electronic applications for mobile devices; online publications; fashion shows; retail services; film production; film presentation; film publishing services.
RAW FOOTWEAR	Belts, bags, wallets, key cases; clothing, footwear and retail services
RAW SHOES	Belts, bags, wallets, key cases; clothing, footwear and retail services

4. Under Section 5(2) (b) of the Act, FL claims that the goods and services are identical and/or similar and the respective trade marks are similar. As such, there is a likelihood of confusion. It is noted from the Notice of Opposition that, though this opposition is directed against all the goods and services of the application, under Section 5(2) (b) of the Act, only some of the goods and services are attacked. These are recorded media; downloadable electronic publications; digital music; mobile

software applications in class 09 and classes 35, 39, 41 and 42. The remainder of class 09 and the whole of class 43 are unopposed under Section 5(2) (b) of the Act.

5. In respect of Section 5(3) of the Act, FL claim that RSM will benefit from FL's investment in its advertising and promotion of its brand leading to advantage without any investment; that RSM's use will be out of the control of FL and that any poor quality goods will reflect negatively upon FL's business leading to detriment to FL's valuable reputation and business: detriment to distinctive character will occur as FL's signs will no longer indicate origin; further, that the economic behaviour of the relevant public will be affected as they will buy the RSM's goods in place of FL's. Under Section 5(4)(a) of the Act, FL claim it has established goodwill and that use of RSM's mark is a misrepresentation likely to lead the public to believe that it's goods are those of FL. FL will therefore suffer damage by reason of this erroneous belief.
6. RSM filed a counterstatement denying the grounds of opposition. In particular, it claims that the addition of the word SNOW in its mark enables it to be distinguished from those of FL. Further, RSM claim the goods and services are not identical or similar. The remaining grounds are denied.
7. Neither side requested a hearing and both sides filed evidence. Further, written submissions were received which have been taken into account in reaching this decision.

FL's evidence

8. This is a witness statement, from Mr Robert M.Schuman, managing director of the opponent. The following relevant points are contained therein:
 - First use of any mark comprising the element RAW was of the mark G-STAR RAW DENIM, in 1996. Since then, extensive use of the following marks has been made: G-STAR RAW DENIM, G-STAR RAW DENIM Logo, RAW DENIM Logo, GS RAW, G-RAW and RAW on its own.
 - Mr Schuman asserts that RAW is now a major brand for the opponent's business, though he accepts that the exact date of first use of the RAW element alone is unknown as its use has moved through various stages.
 - The opponent's brands are, according to Mr Schuman, known for being innovative and cutting edge. Further, perfection is of the utmost importance. The G-Star group of marks has become established in markets around the world; the business has offices in more than 20 countries, with 5700 points of sale in over 80 countries.
 - Sales figures under the various trade marks from the years 2000 to 2010 are provided:

Year	United Kingdom turnover in £ millions
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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

9. Mr Schuman draws attention to the fact that the opponent's products commonly bear numerous brands simultaneously. In his view, this is supported by numerous exhibits to the witness statement. As such, the above figures cannot be isolated to any of the brands, though Mr Schuman claims that at least 90% of sales shown above will have included the trade mark RAW either alone or in conjunction with another element.
10. The opponent's brands have been promoted via trade fairs. Further, they have been promoted via a variety of magazines and newspapers. A list of newspapers and magazines are provided together with circulation figures. Marketing and advertising expenditure is provided. I note that this is greater than £1 million from the years 2006 onwards (up to 2010).
11. According to Mr Schuman, goods provided under the earlier trade marks have been sold in a wide range of retail outlets throughout the United Kingdom. A list is provided at Exhibit RS 2 (comment on this list). Further, there are dedicated stores, selling only the opponent's products in 15 UK cities.
12. Mr Schuman explains that the trade marks comprising RAW are used in respect of a wide range of goods. He goes on to list items, all of which are clothing. Exhibit RS6 are brochures and leaflets showing various clothing items bearing the earlier trade marks and also includes extracts from the opponent's website showing the trade marks in use.
13. Exhibits RS8-RS15 are, according to Mr Schuman, examples of use from other European countries. I note that this use is in respect of clothing.
14. As support for use of the earlier trade marks on goods and services other than clothing, Mr Schuman explains that its earlier trade marks have been used on fashion

shows and short films of such shows are also published on the internet or via the opponent's website. Screen shots of one such show, from the internet site YouTube are exhibited at RS16. The opponent also publishes an online magazine which includes short films and information about events of interest. Screen shots and editorials are provided in RS17. The opponent also provides an electronic application for purchase via iTunes as shown in RS18. RS19 shows imagery of a "Raw Ferry", a classic canal boat used in Amsterdam. RS20 shows furniture bearing the earlier trade marks. Finally, a Raw Drinking Flask has been produced, seemingly for fashion shows in New York. Mr Schuman claims that fashion buyers from around the world would attend such an event.

15. In conclusion, Mr Schuman claims that his evidence shows extensive use of the earlier trade marks in respect of the full breadth of clothing articles and as such the marks have attracted considerable goodwill and reputation in the United Kingdom.

CONCLUSIONS ON OPPONENT'S EVIDENCE

16. The first observation is that there are a number of trade marks on display throughout the evidence. Indeed, some of those are in respect of trade marks which are not pleaded and relied upon in these proceedings, such as RAW Essentials + egg timer device, G-Star Originals Raw Denim and G-Star encased in a stylised letter G. As these are not pleaded and relied upon, no further mention will be made of them.



Second, the evidence overwhelmingly features the earlier trade mark. Thirdly, this is almost without exception, in relation to clothing. It is true that there is some use of RAW alone in respect of magazines and also use of other trade marks containing RAW in respect of fashion shows, applications for mobile devices and furniture. However, in respect of these, though they show limited use, it is insufficient to amount to a reputation. Indeed, there is nothing in the evidence which demonstrates the market share in respect of RAW alone, either in respect of clothing or any other goods and services. There is no indication as to the degree of recognition of the trade mark RAW among the relevant public. As a result, the evidence does not show that RAW alone is known by a significant part of the relevant public. It is concluded therefore that the opponent does not have a reputation in the United Kingdom. However, this is overwhelmingly in respect of the earlier



trade mark as it is attached to clothing. Further, it is accepted there is a reputation in respect of this earlier trade mark in respect of the retail of clothing.

RSM's evidence

17. This is a witness statement, from Theresa Castle-Green, Director of the applicant company. The following relevant points are contained therein:

- The term RAW SNOW was originally conceived to provide a shortened description to describe unprocessed snow found on ungroomed pistes. The combination seemed to have paradoxical qualities, which the applicants felt made it a very unique and individual phrase.
- Initial research showed the term to be unconnected with any other business and a search with the IPO did not identify any other marks that would conflict.
- Ms Castle-Green asserts that the applicant has no intention to copy or benefit from the G-Star brand in any way. Though it is aware of the opponent as a clothing brand, the applicant had not conceived any possible connection or relationship between the opponent's brands and RAW SNOW.
- Ms Castle-Green goes on to provide details of the applicant's business which is in respect of building a network of websites providing online content and information. The sites cover a mix of subjects including Travel Destinations, Winter Sports, Honeymoons and Weddings. Exhibit TCG1 shows a complete list of the sites within the network and Exhibit TCG2 shows that the majority of websites are branded as RAW SNOW websites either via a statement or copyright statement on the bottom of every page. Exhibit TCG3 shows the affiliate networks RAW SNOW work with and TCG4 some examples of the brands that the applicant works with and that have advertisements/links on and across the various RAW SNOW websites. TCG5 shows some of the businesses RAW SNOW have built direct working relations with. Since June 2010, the applicant has, according to Ms Castle-Green, provided business services to businesses across the UK and this is fast becoming the applicant's primary activity. The range of services provided include software development, website development, website design, print design, online marketing support and training. Exhibit TCG6 shows some businesses that the applicant has provided services to.
- The applicant has also launched two electronic applications. The first was available on android devices and showcased multi functionality on such devices. The second was an interface to Raw Snow's wedding website and provided users with access to wedding businesses and services. Exhibit TCG7 shows the applications and how they are portrayed under the RAW SNOW brand.
- Ms Castle-Green confirms that the applicant has no intention of entering the fashion or fashion design industry and that the applicant's expertise is within media publishing, software development and online marketing services. Finally, Ms Castle-Green asserts that the applicant's business is growing due to great customer service and thorough provision of high quality products and services.

DECISION

The proof of use provisions

18. In its TM8 and Counterstatement, the applicant, when asked whether or not it wished the opponent to provide proof of use of its earlier trade marks, replied “no”. A notional assessment based on the earlier specification of goods and services as they are registered must therefore be undertaken.

Likelihood of confusion – Section 5(2) (b) of the Act.

Preliminary remarks

19. In response to the arguments of the applicant as regards the nature of the respective businesses in the marketplace, the current, or past, marketing undertaken by the parties is not relevant to the issues to be determined, as the GC stated in *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).”¹

20. The relevant parts of section 5 of the Act read as follows:

(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.

21. The leading authorities which guide me in this ground are from the CJEU: *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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C- 334/05 P (LIMONCELLO)*. 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*,

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

(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*,

(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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) 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*,

(h) 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*,

(i) 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; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

22. Following a thorough perusal of the earlier trade marks, pleadings and evidence filed, it is noted that some of the earlier trade marks relied upon are registered for a broader range of goods and/or services than others. Further it is noted that these earlier trade marks are in respect of the earlier denomination RAW (word only). There is a further earlier trade mark, namely CTM 3 612 801 that attacks an item in the applied for class 09 specification which is not attacked by any other trade mark. It seems therefore that these represent the opponent's best case under Section 5(2) (b) of the Act. If they cannot succeed here, they are unlikely to succeed in respect of the remaining trade marks. As such, these will only be considered if necessary.

The average consumer

23. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). *The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in Inter- Ikea Systems BV v OHIM (Case T-112/06)).*
24. The average consumer in these proceedings will differ according to the wide range of goods and services on offer, from the business sector in respect of, for example, computer consultancy services, to the public at large in respect of, for example, travel, education and digital music. The level of attention likely to be displayed during the purchasing process will vary from relatively low in respect of digital music to high in respect of computer consultancy services which often involve a significant monetary outlay. In any case, the level of attention is unlikely to ever be very low (as is the case with perishable or everyday items) and is therefore likely to be at least reasonably considered.

Comparison of the goods and services

25. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

26. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

27. The following guidance is also taken into account: Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 where he stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

28. The definition of complementary is also borne in mind. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06 GC* explained when goods are complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

29. The earlier goods and services are:

CTM 9 702 184

Class 41

Entertainment; record company services, including music publishing services; production and publishing of images, video's and DVD's; organisation of entertainment and educational events, such as concerts, festivals, parties and workshops; development and production of television and radio programs and publication of printed matter, including books, magazines and newspapers and electronic publications; sporting activities, including the organisation of sports competitions; cultural activities; except services relating to wrestling, wrestling entertainment and wrestlers.

CTM 4 743 225:

Class 3

Soaps; perfumery, essential oils, cosmetics, hair lotions; except products relating to wrestling, wrestling entertainment and wrestlers.

Class 25

Clothing, footwear, headgear; belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers.

Class 35

Advertising; business management, including franchise services; business administration; office functions; except services relating to wrestling, wrestling entertainment and wrestlers.

CTM 3 612 801:

Class 41:

Entertainment; sporting and cultural activities

30. The contested goods and services are:

Class 09:

Recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; mobile software applications, downloadable electronic publications; digital music; computer games equipment adapted for use with an external display screen or monitor.

Class 35:

Advertising; business management; business administration; office functions; electronic data storage; advertising services provided via the Internet; trade fairs; opinion polling; data processing; provision of business information.

Class 39:

Transport; travel arrangement; travel information; destination information.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; winter sports information.

Class 42:

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.

Class 43:

Temporary accommodation; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation.

Contested class 09 goods:

31. Recorded media are, for example, films, television programmes, music, recorded in a tangible form, such as on a video or disc. They are the end product of the earlier services “production of images, videos and DVDs”. Bearing in mind the guidance in Case T325/06 above, it is considered that these goods and services are entirely complementary as there would be little point in providing the services were it not for the end result of the videos, discs etc. They are moderately similar. Likewise the contested “digital music” will be produced and offered by the earlier “record company services”. They are also moderately similar. The contested “downloadable electronic publications” are the end result of the earlier “publication of electronic publications” and are moderately similar. The remaining contested term is “mobile software applications”. The only earlier trade mark opposing this term under Section 5(2) (b) covers the services “entertainment” and “sporting and cultural activities”. Mobile software applications are applications which enable a mobile phone user to access information, be entertained or otherwise interact via a mobile phone device. The earlier services seek to entertain or to provide sporting or cultural enjoyment. This can include for example, gaming. Gaming could also be provided through mobile applications and so these goods and services can be in competition with one another. Bearing this in mind, they would have essentially the same nature, purpose and end user. They are considered to be similar at least to a low to moderate degree.

Contested class 35 services:

32. The contested terms “advertising, business management, business administration, office functions” are included in the earlier trade marks. Notwithstanding the extremely specific limitation placed on the earlier terms (namely none related to wrestling), they are clearly identical. The contested “electronic data storage” and “data processing” are office functions and are included within the earlier wider term office functions. They are identical. The contested “trade fairs” is an activity undertaken by companies to showcase, that is, advertise their business or product. It is included within the earlier “advertising” and so is identical. The contested “opinion polling” is an activity whereby the views of a particular group of people (which can include the general public) are gathered. They are used to inform policies and strategies of a business in order to enable more effective management for the future. It is an activity which is included within the earlier business management. They are identical. The contested “provision of business information” is an activity rightfully included within the earlier business management and so is identical. Finally, the contested “advertising services provided via the internet” is included within the earlier “advertising”. It is identical. In reaching this

conclusion, the content of TPN 1/2012, particularly the following at paragraph 3.2.2 (d) has been taken into account:

“.....it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the opponent's business, as indicated by the evidence”.

33. As regards these contested services, it is considered following perusal of the applicant's evidence that they are in no way interested in the wrestling business or any such related activity. Therefore to suggest that they proceed with a specification positively limited to such activity to avoid a finding of identical services in totality appears disproportionate.

Contested class 39 services:

34. The earlier services “cultural activities” can include activities such as tours and trips to buildings and areas of cultural interest. Such tours could include transportation of people and other aspects of travel arrangement. Information services about the tour are also implicit within such a service in my view. The contested class 39 services are transport, which will necessarily include the transport of people for the purposes of leisure. The contested “travel arrangement” will include the arrangement of travel for people. It is a broad term which could include activities such as the arrangement of a tour or trip to a particular place. There is considered to be an overlap between these services and those of the earlier term. They are at least moderately similar. Further, the contested “travel information” and “destination information” can overlap with the earlier term as such activities are implicit within the term. They are also moderately similar. Again, in reaching this conclusion it is noted that the contested “transport” can also include terms which would not be identical nor similar to any of the earlier terms, for example the transportation of goods. However, there is no indication from the applicant's evidence that they are in any way interested in such an activity. As previously therefore and bearing in mind the contents of TPN 1/2012, a specification limitation in this regard is considered to be disproportionate.

Contested class 41 services:

35. The respective specifications each include “entertainment” and “sporting and cultural activities”. They are identical. Further, the contested “winter sports information” is included within and so is also identical. The earlier term is “organisation of educational events”. This will include a number of activities which will be rightfully included in the wider contested term “education”. They are identical. Finally, the contested “providing of training” is also identical to the earlier term as it is likely to include organisation of training events.

Contested class 42 services:

36. The contested term is industrial analysis and research services. These services are designed to provide a business with information and review economic, political and market factors affecting a particular industry. The earlier business management can include business consultancy, a service likely to be provided by experts who are also aware of such factors and this knowledge is likely to form at least part of the support and expertise provided as part of the business consultancy. Further, analysis and research activities may be implicit within business consultancy, for example, as part of initial scoping activities and to enable advice and support to be placed into the correct context. There is at least therefore a degree of similarity here, albeit at the lower end of the scale. In respect of the contested “computer consultancy services”, it seems feasible that a business consultant may also offer expertise as regards computers, at least in respect of available technologies. There is therefore at least a degree of similarity here, although again at the lower end of the scale. However, a line must be drawn and though a business consultant may be able to offer some advice as regards computers, it is not considered to be on a par with the actual design and delivery (or maintenance) of a computer system. Such services are therefore not considered similar to the earlier class 35 services or indeed any of the earlier goods and services. Likewise, the web site related services and design services are also not similar. Finally, the contested “scientific and technological services and research and design relating thereto” are services which provide, for example, laboratory testing services for businesses. They are entirely different in nature and purpose to any of the earlier terms and so are not similar.
37. The net effect of the above is that the following contested goods and services are deemed to be identical or similar to the earlier terms:

Class 09:

Recorded media, downloadable electronic publications; digital music; mobile software applications.

Class 35:

Advertising; business management; business administration; office functions; electronic data storage; advertising services provided via the Internet; trade fairs; opinion polling; data processing; provision of business information.

Class 39:

Transport; travel arrangement; travel information; destination information.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; winter sports information.

Class 42:

Computer consultancy services.


38. The remaining goods and services are either not similar or (as already stated) are unopposed under Section 5(2) (b).

Comparison of the marks

39. 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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

40. The respective trade marks are shown below:

RAW	RAW SNOW
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Earlier trade marks	Contested trade mark

41. A comparison of RAW and RAW SNOW will be made first of all. As regards dominant and distinctive components, the earlier trade mark has only one component and so the answer is straightforward. In relation to the contested trade mark, neither RAW nor SNOW are presented in a manner which ensures one has dominance over the other. In this regard, the guidance of the ECJ in Case C-3/03P, *Matratzen Concord v OHIM*, paragraph 32 is helpful:

“The Court rightly pointed out, in paragraph 34 of the contested judgment, that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. It also held that that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components”.

42. Bearing in mind the above guidance, it is considered that the correct comparison to be made is between the respective trade marks as wholes.

43. In this regard, it is clear that visually and aurally, the marks coincide in respect of the element RAW and differ in the additional element SNOW which appears in the later trade mark.

44. In terms of conceptual comparison, it is noted that in *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS) (2003) ECR* at paragraph 54, the CFI stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to

be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately....


The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

45. The ECJ reached the same conclusion, expressed in similar terms, in the *Picasso and others v DaimlerChrysler AG Picarro/Picasso case (C- 361/04P)*.

46. Conceptually, the earlier trade mark will be understood as meaning not cooked or otherwise an unfinished, natural or unrefined state. It therefore has a very clear and specific meaning. The contested trade mark RAW SNOW appears conceptually fanciful and does not centre wholly on the word raw. It is a complete phrase and though the idea of raw snow is somewhat odd, it hangs together as a conceptual combination, creating an idea which, overall, seems dissonant from the very specific meaning of the earlier trade mark.

47. Bearing in mind all of the foregoing, it is accepted that there is some similarity between the trade marks, though this is not pitched as being particularly high.



48. In comparing  with RAW SNOW, it is considered that there is no stand out dominant and distinctive element in the earlier trade mark. Rather it will be appreciated as a complete whole. It is noted that visually and aurally, the one common feature between the marks is RAW. The earlier trade mark has a number of other features as shown. There is considered to be a very low degree of visual and aural similarity. Conceptually, as already indicated, RAW SNOW hangs together as a combination. The earlier trade mark has no clear concept, though the numeral 1, the word STAR and the word RAW will be understood as individual components. It does not hang together as a complete phrase. There is no conceptual similarity.

Distinctiveness of the earlier trade marks

49. The degree of distinctiveness to be accorded to the earlier trade mark is important because the more distinctive the earlier marks (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

50. In respect of distinctiveness, it is noted that the opponent has filed a great deal of evidence which, in its view, shows that it has a high reputation in the United Kingdom in respect of the earlier trade marks relied upon, including RAW on its own. At best, the evidence filed demonstrates that the opponent has a reputation only in respect of goods and services (clothing

and the retail of) which are in any case not similar to any of the contested goods and services (or which otherwise do not advance the opponent's case). Further, the evidence overwhelmingly



demonstrates reputation in respect of the earlier trade mark but not in respect of RAW alone. The position must therefore be considered on a prima facie basis, by reference to the goods and services to which it is applied, from the perspective of the consumers of those goods and services¹. It is considered that RAW is not particularly strong in respect of some of the earlier goods relied upon, such as clothing as it may describe an attractive characteristic of the goods, namely those made with materials that are natural and unprocessed. However, as already stated, these are in any case not similar to anything contained within the contested specification. In respect of the earlier goods and services relied upon and found to be identical and/or similar to the contested goods and services, it is considered that RAW and indeed all of the earlier trade marks are distinctive to at least an average degree.

Global Assessment – Conclusions on Section 5(2) (b)

51. In considering the likelihood of confusion therefore, it is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.

52. The likelihood of confusion will be assessed in respect of the earlier RAW trade marks first. In considering this, the guidance in Case C-120/04 Medion is taken into account where it was stated:

“28 The global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, in particular, *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and *Matratzen Concord*, paragraph 29).

29 In the context of consideration of the likelihood of confusion,

¹ *4 Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

53. Applying the above guidance, it is considered that RAW does not play an independent and distinctive role in the contested trade mark. There, the element RAW qualifies the word SNOW.

54. Having said that, the presence of the word RAW in each of the trade marks creates an obvious point of visual and aural similarity and so it is accepted that there is a degree of similarity between the marks. However, it is considered that this similarity is significantly reduced by the presence of the word SNOW which will not go unnoticed and which is considered to have a significant visual and aural impact. Further, as the word RAW in the mark qualifies the word SNOW, this has the effect of the combination hanging together as a complete phrase thus creating a concept dissonant from RAW alone. Though it is true that the relevant public rarely has the opportunity to compare the trade marks side by side and so relies on an imperfect picture of them, the idea created by the combination raw snow, which is different from raw alone, is likely to provide a strong point of recollection. Further, the purchases in question here are always likely to be at least reasonably considered, on occasion highly so. This negates against imperfect recollection, despite the identical nature of some of the services here. Bearing in mind all of the foregoing, it is considered that the trade marks create a different overall impression. As such, the differences between them are clear and noticeable and will enable the relevant public to accurately distinguish between them. Further, the differences are such that the relevant public will not believe them to be economically linked. There is no likelihood of confusion.

55. As regards the earlier G-Star Raw trade mark, it has been found to be even less similar to the contested trade mark. It follows therefore that there is also no likelihood of confusion here. The same conclusion applies to the remaining earlier trade marks, which are also even less similar and/or which are registered in respect of a narrower specification of goods and/or services and so which in any case place the opponent in no better position.

56. The opposition therefore, in so far as it is based upon Section 5(2) (b) of the Act, fails.

For the sake of completeness and as the basis of the grounds differ, the remaining grounds of opposition relied upon will be considered.

Section 5(3) of the Act

57. Section 5(3)² of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

58. In order to succeed under this ground the earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA* (Chevy) [1999] ETMR 122 and [2000] RPC 572 Chevy the CJEU stated:

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

59. As already found, it is considered that some of the opponent’s trade marks have the



requisite reputation. However, this is limited to the trade mark and in respect of clothing and the retail of only.

60. In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1) (b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

² Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“*Addidas-Salomon*”) (C-408/01)).

61. In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“Intel”), the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

62. Bearing in mind the guidance provided above, what must be considered is whether or not the relevant public will make a link between the respective trade marks. It is true that the earlier trade mark G-Star Raw has a strong reputation and contains the element RAW. However, there are clearly a number of other features present which serve, in my view, to distinguish the respective trade marks. Further, they operate in very disparate fields of activity, namely clothing and the retail of on the one hand and computer products (and related services) and accommodation and booking services on the other. Bearing in mind all of the foregoing, it is extremely difficult to see how the relevant public will make any link between the signs. This ground of opposition therefore fails.

Passing Off - Section 5(4) (a)

63. Section 5(4)(a) reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

64. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponent’s goods or services have acquired a goodwill or

reputation in the market and are known by some distinguishing feature;
(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent;
and
(3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

The Relevant Date

65. The relevant date for determining the opponent's claim will be the filing date of the application in suit (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115) . The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). The relevant date in date in these proceedings therefore, is 19/09/2011.

Goodwill

66. In the notice of opposition, the opponent claims that the business attracts a protectable goodwill in respect of the following goods and services: Belts, bags, wallets, key cases; clothing, headgear, footwear, fashion accessories; printed matter; entertainment; electronic applications for mobile devices; online publications; fashion shows; retail services; film production; film presentation; film publishing services.

67. In relation to goodwill, this was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first."

68. It is also worth noting that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature³ However, being a small player does not prevent the law of passing-off from being relied upon as it can be used to protect a more limited goodwill⁴.

69. Conclusions have already been reached as regards the impact of the evidence filed by the opponent in these proceedings and for the most part, these findings are equally applicable here and so will not be repeated in any great depth, save to say that the opponent has clearly established goodwill in its business in respect of clothing and, together with retail services in respect of such items. Further, the public will associate this goodwill with,



overwhelmingly so, its earlier rights in the denomination . It is true that there

³ *Hart v Relentless Records* [2002] E.W.H.C. 1984

⁴ See, for instance, *Stannard v Reay* [1967] F.S.R. 140, *Teleworks v Telework Group* [2002]

R.P.C. and *Stacey v 2020 Communications* [1991] F.S.R. 49).

is some use in respect of other denominations which include the element RAW, but this is considered insufficient to clearly demonstrate a separate protectable goodwill associated solely with it.

70. However, this is not the end of the matter as there is also use in respect of other activities to consider, which although insufficient to demonstrate reputation, may be sufficient to demonstrate goodwill. In exhibit RS16 for example, G-Star Raw has been used in respect of fashion shows and in RS18 in respect of an application for mobile devices. However each of these examples are considered to be mediums through which the core field of activity, namely clothing is promoted and made accessible to the clothing buying customer. It is not sufficient to enable a separate goodwill to be established which is also then protectable. Further, in exhibit RS19 there is use of RAW in respect of canal boats. This trade, however, is not placed into any context and no detail is provided and so cannot lead to a separate protectable goodwill. Exhibit RS20 show some limited use of RAW on furniture, but there is no other context provided, most notably there is no information which enables ascertainment as to when these activities took place and what their impact is.
71. Finally, the trade in RAW magazine. Again, it is considered that this publication is essentially a “house” magazine and is promotional in nature, in respect of the opponent’s core business in clothing. Further, there is a distinct lack of context provided, including dates. There is nothing persuasive in the evidence that there is a separate protectable goodwill here.
72. The sum of all this is that there is found to be goodwill in respect of the earlier denomination




in respect of clothing and also the retail of such items.

Misrepresentation and damage

73. Having decided that there is goodwill in respect of clothing and the retail of such items and



that this goodwill is associated overwhelmingly with the sign , the next step is to consider if there has been a misrepresentation. The following guidance is noted: Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of the opponent’s customers or potential customers would be misled into purchasing the applicant’s products in the belief that it was the opponent’s. Further, In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”

In the same case he went on to state:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

75. In these proceedings, the respective fields of activity are exceptionally disparate. So much so that there can be no real prospect of the opponent’s customers believing it to also be responsible for the goods and services of the application. It is considered therefore that there is no realistic prospect of misrepresentation occurring. The opposition under Section 5(4) (a) of the Act therefore fails.

COSTS

76. The applicant has been successful and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale nor requested a Hearing. In the circumstances the applicant is awarded £1100 as a contribution towards the cost of the proceedings. This is comprised as follows:

Considering Notice of Opposition - £200

Statement of Case in Reply - £300

Considering Evidence and Preparing and Filing Evidence - £600

77. The above sum should 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 13th day of June 2013

Louise White

For the Registrar,

The Comptroller-General