

O-265-15

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3017524
BY NOSH DETOX DELIVERY LIMITED
TO REGISTER THE TRADE MARK**

raw
fruity
N  S H

**& APPLICATION No. 3017834
BY NOSH DETOX DELIVERY LIMITED
TO REGISTER THE TRADE MARK**

raw
smoothie
N  S H

BOTH IN CLASS 32

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos. 401310 & 401461 BY
G-STAR RAW C.V**

BACKGROUND

1) On 9 August 2013 (3017524) and 13 August 2013 (3017834) Nosh Detox Delivery Limited (hereinafter the applicant), applied to register the two trade marks shown above. The goods applied for were as follows:

3017524: Class 32: Aerated juices; Aloe vera juices; Aperitifs, non-alcoholic; Beverages consisting principally of fruit juices; Beverages enriched with added minerals; Beverages enriched with added trace elements; Beverages enriched with added vitamins; Cocktails, non-alcoholic; Concentrated fruit juice; Energy drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit juice; Fruit juice for use as a beverages; Fruit juices; Fruit-based beverages; Fruit-flavoured beverages; Honey-based beverages (Non-alcoholic -); Smoothies; Soft drinks; Sorbets in the nature of beverages; Vegetable juice.

3017834: Class 32: Aerated juices; Aloe vera juices; Aperitifs, non-alcoholic; Beverages consisting principally of fruit juices; Beverages enriched with added minerals; Beverages enriched with added trace elements; Beverages enriched with added vitamins; Cocktails, non-alcoholic; Concentrated fruit juice; Energy drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit juice; Fruit juice for use as a beverages; Fruit juices; Fruit-based beverages; Honey-based beverages (Non-alcoholic -); Smoothies; Soft drinks; Sorbets in the nature of beverages.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 6 September 2013 in Trade Marks Journal No. 2013/036 and 04 October 2013 in Trade Marks Journal No. 2013/040 respectively.

3) On 5 December 2013 G-Star Raw C.V. (hereinafter the opponent) filed a notice of opposition (subsequently amended) in respect of application 3017524. On 3 January 2014, G-Star Raw C.V. filed a notice of opposition (subsequently amended) in respect of application 3017834. On 16 May 2014 the two cases were consolidated. The grounds of the oppositions are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of filing / Registration	Class	Goods /services relied upon:
RAW	CTM 9702184	01.02.11 05.07.11	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.
RAW	CTM 11493103	16.01.13 23.06.13	31	Grains and agricultural, horticultural and forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals; malt.
			43	Services for providing food and drink; temporary accommodation.
RAW	CTM 11493012	16.01.13 12.01.14	32	Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; energy drinks.
			33	Alcoholic beverages (except beers).
RAW	CTM 4743225	24.11.05 15.10.08	3	Soaps; perfumery, essential oils, cosmetics, hair lotions; except products relating to wrestling, wrestling entertainment and wrestlers.
			25	Clothing, footwear, headgear; belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers.
			35	Advertising; business management, including franchise services; business administration; office functions; except services relating to wrestling, wrestling entertainment and wrestlers.

b) The opponent relies upon CTMs 9702184, 11493103 and 11493012 in respect of the section 5(2)(b) grounds in relation to both applications. In both cases the opponent contends that the goods and services covered by its marks are similar to the goods applied for and that the marks of the two parties are similar which will lead to a likelihood of confusion.

c) The opponent relies solely upon its reputation for goods in Class 25 in respect of CTM 4743225 and contends that the marks in suit offend against Section 5(3) as the applicant will benefit from the opponent's advertising and promotion of its brand and that the applicant is likely to gain sales, goodwill or enhanced status because of its association with the opponent's mark. The applicant may supply poor quality goods which would be detrimental to the opponent's mark. There will also be detriment to the distinctive character of the opponent's mark as the opponent's mark will be used on goods which do not originate from it. The opponent also contends that there was no due cause for the adoption of the marks in suit.

4) On 10 April 2014 (401310) and 9 May 2014 (401461) the applicant filed counterstatements. These put the opponent to strict proof of use of its trade marks,

whilst also contending that there is no likelihood of confusion due to the differences in the marks and the goods and services.

5) Both sides filed evidence. Both seek an award of costs in their favour. The matter came to be heard on 18 May 2015 when the opponent was represented by Ms Hutchinson of Messrs HGF Limited; the applicant was represented by Dr Randle of Messrs Tacit Fusion on the telephone and by Ms Sidhu-Robb in London.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 15 July 2014, by Johannes Christian de Bil the Managing Director of Facton Ltd a position he has held since July 2009. From 2000-2011 he was also General Counsel of G-Star International B.V. He states that on 19 April 2011 G-Star Raw C.V. acquired all of the assets of G-Star International B.V. He states that the entire undertaking of G-Star International B.V. was transferred to G-Star Raw C.V. including the employment of staff and he continued in his role as General Counsel, hence he is now a General Counsel for G-Star Raw C.V. He points out that Facton Ltd and G-Star Raw C.V. are affiliated companies. As a result he states that he has knowledge of all three businesses. He also states that the “benefit of use by G-Star International B.V. has now transferred to G-Star Raw C.V. together with all other assets of the business”.

7) Mr de Bil states that the first use of RAW was as part of the mark “G-Star Raw Denim” in 1985. He states that from approximately 2000 his company began using the word Raw independently from the G-Star Raw brand, often in combination with other elements (exhibit JCB3). He states that the opponent’s different clothing lines such as “Correct Line”; “Laundry Army”; Sports Originals”; Raw Sustainable” and “Raw Essentials” have been rebranded as of 2013 to “Raw Sports”; Raw Cargo line”; “Raw Correct” and “Raw Essentials”. He states:

“Since its inception, G-Star has been known for its innovative and cutting edge style in the world of denim. Continuous experimentation with new ways of using fabrics and product development and the rough rudimentary characteristics of the brand have enabled the G-Star business to maintain its distinct and unorthodox style.”

And:

“The concurrent use of our brands means that I am not able to provide isolated sales figures for each one of our brands. I can however confirm that at least 90% of the sales shown in the tables below will have included the trade mark RAW either independently or in combination with our other brands. The trade mark RAW can be found at least two or three times on each of our products. The extensive use of RAW can be seen from the exhibits to my witness statement.”

8) Mr de Bil provides the following figures for the G-Star business in the UK:

Period	Turnover	Marketing £
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	£million	
2002-2003	4.0	182,000
2003-2004	7.8	302,000
2004-2005	12.1	334,000
2005-2006	21.9	777,000
2006-2007	37.4	1,160,000
2008-2009	>37.0	>1,160,000
2009-2010	>37.0	>1,160,000
2010-2011	>37.0	>1,160,000

9) He states that the advertising and promotion includes clothing trade fairs, none of which have taken place in the UK but which are said to be attended by UK clothing buyers. The company also hosts events to promote its brands. These are referred to as “Raw nights” which are described as “exclusive party events which take place in various types of venue, including hotels, where guests (including celebrities) from the fashion, entertainment and other creative industries can sample champagne, cocktails and canapés whilst enjoying music performances and other entertainment”. He states that the company also advertise in magazines and newspapers such as *FHM*, *The Guardian*, *Maxim*, *GQ* and the *Observer*. Mr de Bil also states that since 2009 the opponent has, two or three times per annum, issued its own RAW magazine. In the UK this is issued via the *Observer* newspaper, as well as being available on-line and in shops. He estimates that the number of copies provided in Europe exceeds two million copies per publication. The opponent also embarks on worldwide campaigns to promote its goods and brands. These feature people whom he refers to as “celebrities” and which, he claims get media attention. He states that the opponent’s goods are sold through a range of retail outlets throughout the UK. Some of these stores are owned by the opponent, others are well known names such as *John Lewis*, *House of Fraser*, *Selfridges* and *ASOS*. The opponent has its own website which sells its goods and other retailers such as those named also sell the opponent’s goods online. He states that the same situation applies in France, Germany, Italy, Spain, Sweden, Portugal, Poland, The Netherlands and Greece. He also provides the following exhibits:

- JCB3: Pictures of clothing with various marks upon them, dating from 2004 to 2012. These vary enormously with a highly stylised letter “G” and the word “raw”; “G.S.RAW” a device and “BY G-Star”; “G.S.RAW”; “G-STAR RAW”. There is a copy of the “G-Star Raw look book for spring summer 2011” which lists “RAW ESSENTIALS” on 13 of 52 items, the other items do not feature the word “raw” at all. A number of T-shirts have the term “raw” emblazoned upon the chest but also have highly visible labels also on the front of the garment which states “G.S” or in some cases is printed underneath the word “raw”.
- JCB4: Pictures of labels, tags, zippers, rivets etc used on clothing as brand identifiers and which are not always visible in catalogues. Some of the illustrations are so badly copied that they are unreadable. For the most part the labels have “G-STAR” or the large device in the shape of a letter “G”, some have

the letters “G.S.” and a number also have the word “raw” or “raw denim” upon them.

- JCB5: Copies of clothing trade fair literature. These all show use of “G-Star Raw”.
- JCB6: Copies of press releases and photographs of “Raw nights”. The press releases all have the “G” logo with the words “G-Star Raw” at the top and are headed “G-Star presents...”. The pictures show various, mainly scruffily dressed, individuals at a party, none of whom are immediately recognisable.
- JCB8: Copies of advertisements in magazines and publications in the UK. These are dated from 2002 to October 2012. They show use of G-Star Raw and G-Star in relation to clothing.
- JCB9: Copies of advertisements in magazines and publications in Germany. These are dated from 1995 to August 2012. They show use of G-Star Raw in relation to clothing.
- JCB10: Copies of advertisements in magazines and publications in Sweden. These are dated from April 2007 to September 2012. They show use of G-Star Raw, G (logo) Raw and G-Star in relation to clothing.
- JCB11: Copies of advertisements in magazines and publications in Italy. These are dated from 2000 to April 2012. They show use of G-Star Raw, G (logo) Raw and G-Star in relation to clothing.
- JCB12: Copies of advertisements in magazines and publications in Belgium. These are dated from Winter 2004 to September 2012. They show use of G-Star Raw and G (logo) Raw in relation to clothing. This exhibit also, inexplicably, includes part of a statutory declaration in relation to the mark QUINTIQ in Malaysia (page 38) and a change to the WIPO register (page 33).
- JCB13: Copies of advertisements in magazines and publications in France. These are dated from September 2000 to September 2012. They show use of G-Star Raw and G (logo) Raw in relation to clothing.
- JCB14: Copies of advertisements in magazines and publications in the Netherlands. These are dated from October 1997 to September 2012. They show use of G-Star Raw, G-Star, G (logo) Star Raw and G (logo) Raw in relation to clothing. This exhibit includes an invoice from Novagraaf Nederland BV (page 57) addressed to an individual seemingly unconnected with this case; another Novagraaf invoice to a company can be found at page 108.

- JCB15: Copies of advertisements in magazines and publications in Spain. These are dated from October 2000 to September 2012. They show use of G-Star Raw, G-Star, G (logo) Star Raw and G (logo) Raw in relation to clothing.
- JCB16: Copies of advertisements in magazines and publications in Denmark. These are dated from October 2000 to September 2012. They show use of G-Star Raw, G-Star, G (logo) Star Raw and G (logo) Raw in relation to clothing.
- JCB17: Examples of outdoor usage on taxis, billboards, buses, London underground, bus shelters and G-Star Raw stores. The use is said to be in the UK and Europe, although photographs are not identified or dated. It is clear that some are in the UK. All show use of G-Star Raw in relation to clothing.
- JCB18: Copies of the RAW magazine for the period Autumn 2009 to Autumn 2012.
- JCB19 & 20: Copies of press releases and online articles regarding the 2010 advertising campaigns featuring an actress and a chess champion. In 2011 another actress was used along with an actor. The press release refers to clothing under the G-Star Raw brand.
- JCB 21: Screen prints from the website g-star.com which shows where its stores in the UK are located on maps.
- JCB 22: Extracts from the websites of *Next*, *Very*, *Amazon* & *ASOS* showing garments carrying the mark G Star Raw.

APPLICANT'S EVIDENCE

10) The applicant filed a witness statement, dated 22 September 2014, by Geeta Sidhu-Robb the CEO of the applicant company a position she has held since 2008 when she was a sole trader and then since incorporation on 30 July 2009. She states that the "raw" smoothie was conceived in the first half of 2012 and launched in the UK on 1 July 2012. She states that the marks in suit were first used in January 2013. She provides a number of definitions but does not state where they come from. These are "Beverage: brewed; mixture of drinks" and "Drink: portable liquids". She then states:

"6. ...The goods represented in our applications UK 00003017524 and UK 00003017834 in Class 32 are described as drinks "meaning not brewed, not cooked, not boiled or not fermented) and also as beverages (meaning mixtures, but not meaning brewed). In Class 32 these drinks and beverages are exclusively non-alcoholic. The term "raw" when used in our products relates specifically to the "raw food movement" that broadly categorises food products that have not been heated above 104-115^oF (40-46^oC)."

11) She provides a large amount of evidence regarding pasteurisation and high pressure processing. She states that her company's products have been marketed in the UK through selected channels to reach our target customers with no overlap with the opponent's. She provides examples of the advertising and marketing which included a range of articles in newspapers and magazines, including, inter alia, the *Daily Mail*, *Redonline*, *The Grocer*, *FoodBev*, *The Sunday Telegraph*, *Hello*, *Woman*, *The Scotsman*, *Mother and Baby Health and Fitness*, *The Times*, *The People*, and *BBC Good Food Magazine*. Examples are provided as exhibits, somewhat bizarrely numbered. She provides the following sales figures:

Period	UK sales £
August 2012 – December 2012	10,439
January 2013 – December 2013	104,744
January 2014 – August 2014	61,760

12) Ms Sidhu-Robb states that the marks in suit were chosen to maintain a direct association with the applicant's earlier UK mark No. 3017520 "PURIFY AND NUTRIFY NOSH". She provides the following exhibit:

- GSR1: Launch of "raw" smoothie. This shows use of a mark where the main word is "NOSH" below a device mark similar to that in the marks applied for, shown on the front cover of this decision.

13) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

14) The first ground of opposition is based on section 5(2)(b) of the Act which reads:

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

-
- 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, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

16) The opponent is relying upon its trade marks listed in paragraph 3 above. It is clear that all four of the opponent’s trade marks are earlier trade marks. With regard to proof of use, the applications were advertised on 6 September 2013 (3017524) and 4 October 2013 (3017834) at which points as none of the opponent’s trade marks had been registered for five years; as a consequence they are not subject to The Trade Marks (Proof of Use, etc) Regulations 2004. In its skeleton argument the opponent states that its strongest case under section 5(2)(b) resides in CTM 11493012. At the hearing it confirmed that if it failed under this mark then it could not succeed under its other marks under section 5(2)(b).

17) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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

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

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

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

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

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

The average consumer and the nature of the purchasing process

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

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

19) The opponent has confirmed its strongest case lies under its CTM 11493012 and in particular its class 32 goods which it contends are identical to those of the applicant. Quite clearly the majority of the goods in class 32 are standard non-alcoholic drinks, which include drinks which verge on being foods such as smoothies. However, the term “beverages” in class 32 must also include “beer”. Drinks are widely available on the market in the UK, via a wide selection of suppliers and are purchased as everyday items by all members of society, albeit alcoholic drinks can only be legally purchased by

those over 18 years of age. Despite being a frequent purchase I do not accept that such items are chosen with a low level of consideration. For instance, someone who is teetotal would be careful to avoid alcoholic beverages. Anyone with a gluten allergy would be very careful to avoid drinks made from barley or wheat and instead seek out drinks made from rice or corn. A number of consumers have issues with fruits such as tomatoes and would avoid fruit drinks which include these. To my mind, the average consumer is far more aware of the contents of beverages that they consume, and everyday one is assailed in the media by new stories outlining health issues such as the levels of sugar in fruit drinks. I therefore believe that the average consumer will be careful in their selection of beverage of whatever kind. Most beverages will be purchased in retail outlets by self selection, or if in a public house or cafeteria the product will still normally be visible or have a label on the tap to denote the contents and point of origin. The selection is likely to be by eye, therefore it is the visual aspect of the competing trade marks that will dominate the selection process although aural considerations must not be overlooked because of word of mouth recommendations etc.

Comparison of goods

20) The opponent has identified CTM 11493012 as its strongest case. The specifications of the applicant's two marks are identical, except that 3017524 also includes "Fruit-flavoured beverages" and "Vegetable juice". I shall therefore use 3017524 only for the comparison test. For ease of reference the specifications of the two parties are:

Applicant's specification	Opponent's specification
3017524: Class 32: Aerated juices; Aloe vera juices; Aperitifs, non-alcoholic; Beverages consisting principally of fruit juices; Beverages enriched with added minerals; Beverages enriched with added trace elements; Beverages enriched with added vitamins; Cocktails, non-alcoholic; Concentrated fruit juice; Energy drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit juice; Fruit juice for use as a beverages; Fruit juices; Fruit-based beverages; Fruit-flavoured beverages; Honey-based beverages (Non-alcoholic -); Smoothies; Soft drinks; Sorbets in the nature of beverages; Vegetable juice.	CTM 11493012: Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; energy drinks.

21) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose

and their method of use and whether they are in competition with each other or are complementary”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

23) I take into account the following guidance of the General Court (GC) in *Gérard Meric v OHIM*, T-133/05:

“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) [2004] ECR II-719, paragraphs 41 and 42).”

24) Clearly the terms “non-alcoholic beverages” and “beers” within the opponent’s specification encompasses the whole of the applicant’s specification. **The goods of the two parties must therefore be regarded as being identical.**




Comparison of trade marks

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

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

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

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

Applicant's marks	Opponent's mark
<p>3017524</p> 	
<p>3017834</p> 	

Distinctiveness of earlier marks and dominant components of both parties marks

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

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

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

28) The opponent has only provided evidence of use of its mark RAW in the UK in relation to clothing. As such the opponent cannot benefit from enhanced distinctiveness in relation to the goods relied upon in the opposition under section 5(2)(b). As the opponent’s marks are registered they are deemed to have at least a degree of inherent distinctiveness.

29) The applicant contended:

“The words in our trade mark applications were specifically chosen to ensure that there was a direct association with our company brand and registered trade mark. UK00003017520 PURIFY AND NUTRIFY NOSH. In addition, this combination of words was selected specifically to avoid confusion with any existing products, goods, services, brands or trade marks upon the date on which we filed our UK trade mark applications. Moreover, the “raw fruity NOSH PURIFY AND NUTRIFY” and “raw smoothie NOSH PURIFY and NUTRIFY” products have always been used and associated with the NOSH PURIFY AND NUTRIFY company brand to ensure a direct connection is made between our company’s brand and each of the products we have developed in this category that fall within class 32.”

30) The opponent contends:

“17. The distinctive and dominant component of the respective marks is the word RAW. The use of powerful larger size lettering for the word RAW emphasises that this is the part of the mark to which attention should be paid. The visual impression influences the way the consumer will note and use the mark i.e. the consumer will refer to the product as "RAW". RAW is a distinctive element for the goods. The additional words appearing in the opposed marks do not detract from the conceptual meaning of the word RAW, nor do they result in an alternative meaning in relation to the goods of the opposed marks.

18. It is well accepted that the first part of a mark is the part to which the consumer attaches most importance (see CFI Decision *T-146/06 Sanofi-Aventis/OHIM - GD Searle* at paragraph 49). This is especially relevant when the remaining elements are descriptive eg "Fruity" and "Smoothie" or are a house mark.

19. Given that the distinctive and dominant components of the respective marks are identical the marks must be deemed to be visually, conceptually and aurally closely similar to a high degree.”

31) I accept that the word “RAW” is a common English word with a well known meaning of “not cooked; in an unfinished or natural state; not treated by manufacturing or other processes”. Therefore for the goods in question (beverages) the term “RAW” has a descriptive element, which will be recognised by UK consumers. In the case of fruit or vegetable drinks it can also be seen as meaning “fresh” as the ingredients have not been cooked or processed. The opponent’s mark consists solely of the term “RAW” which has a relatively low level of distinctiveness for beverages but nevertheless the distinctiveness of the opponent’s mark is in the single word.

32) Moving onto the applicant’s marks the term “raw” when used on beverages has, as mentioned previously, a descriptive element. When “raw” is used with the words “fruity / smoothie” and “Nosh” following them the whole forms a descriptive phrase, effectively “raw fruity food” or “raw smoothie food”. In my opinion such phrases do not really hang together. I also take into consideration the sheer size of the term “raw” in the applicant’s mark and its stylisation compared to the rest of the mark. I do not accept the applicant’s contention that the term “Nosh purify and nutrify” will lead to a connection with its reputation under this mark. I reject the contention on the simple basis that the words “purify and nutrify” referred to are very difficult to be read unless the consumer is using a magnifying glass, or makes an extremely close study of the label, something which I do not believe is common. The device element in the applicant’s mark is deliberately formed to suggest the letter “o” to form the word “NOSH” in the mark, otherwise they would simply have the letters “N”, “S” and “H” and a device element. The device element does have a degree of distinctiveness. Consumers are used to labels providing a brand or trade mark signifying the source of the goods. In the instant case the size and stylisation of the word “raw”, and its position as the first word in the applicant’s mark combined with other descriptive elements means that it will be viewed by the average consumer as the distinctive and dominant element despite it being inherently weak. It was mooted that the average consumer might identify the word “NOSH” as the house mark of the applicant but that it would regard the term “Raw” as a trade mark because

of its size and positioning. I am not convinced that this would be the case but even if it were it would not affect the fact that the dominant distinctive element of the applicant's mark is the term "raw".

Visual / Aural and Conceptual similarity

33) The marks of the two parties both have the term RAW as their distinctive and dominant element. The marks of both parties are inherently weak. The only difference is that the applicant's marks also have other descriptive elements in the words "fruity Nosh" and a device or "smoothie Nosh" and a device. Although there are differences between the marks of the two parties I believe that visually, aurally and conceptually they have at least a medium degree of similarity.

Likelihood of confusion

34) I must now take all the above into account and consider the matter globally taking into account the interdependency principle - a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence shows that the opponent has an enhanced distinctiveness for clothing which does not assist it under this ground of opposition.

35) In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

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

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

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

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

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

36) Earlier in this decision I found that:

- The class 32 goods of both parties are identical.
- The average consumer will be relatively careful in their selection, and that as selection is likely to be by eye, it is the visual aspect of the competing trade marks that will dominate the selection process although aural considerations must not be overlooked because of word of mouth recommendations etc.
- The term “RAW” has a relatively low level of distinctiveness for beverages and the opponent cannot benefit from enhanced distinctiveness.
- Although there are differences between the marks of the two parties I believe that visually, aurally and conceptually they have at least a medium degree of similarity.

37) To my mind in respect of both of the applicant’s marks, when considering the opponent’s mark CTM 11493102 there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to both marks in respect of this mark of the opponent.**

38) I now turn to consider the ground of opposition under Section 5(3) which 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 3 the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) 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.

39) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation,

the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

40) The onus is upon the opponent to prove that its earlier trade marks enjoy a reputation or public recognition and it needs to furnish the evidence to support this claim. In the pleadings the opponent relies solely upon its mark CTM 4743225 RAW which is registered for, broadly, clothing. The opponent contends:

“24....The evidence filed by the opponent demonstrates extensive reputation in relation to Class 25 goods and Class 35 services. There has been extensive use of RAW by the opponent. In order to find for the Opponent under 5(3) it is not necessary that the public is confused. It is merely necessary that the public will establish a link between the respective goods and that the earlier mark will be called to mind by the public. It is possible for the public to make a connection between two distinct areas of trade where the reputation is very extensive such that reputation extends beyond the public targeted by the earlier mark.

25. When considering the matter under 5(3) there are a number of factors to be taken in to account including the geographic distribution of use, sales value, promotion, duration of use and investment in promotion of the brand (see, for example, ECJ case C-301/07). Reputation requires a certain degree of knowledge by the public. As registration number 474325 is a community trade mark, knowledge and reputation in the community must be demonstrated. The Opponent's reputation has been amply demonstrated in the evidence and confirms that the RAW mark of the Opponent is the subject of significant reputation throughout the community.

26. Should the matter fall to be considered under Section 5(3) we submit that unfair advantage will arise in several areas. The public will link the respective marks as a result of the public's extensive knowledge of RAW as the brand of the Opponent. The Opponent's extensive reputation in relation to fashion goods and retail will be linked with the Applicant's use on a highly fashionable product. The Opponent's goods are the subject of celebrity endorsement and the Applicant has provided evidence that it pursues similar endorsement. The Opponent has invested heavily in promotion of RAW and the applicant will benefit from the extensive advertising of the opponent. The reputation associated with the opponent's mark will reflect upon the opposed mark. This constitutes unfair advantage to the Applicant as a result of the Opponent's reputation in its mark. The applicant's advertising is more likely to obtain traction and attract the public's attention as a result of the public's knowledge of the RAW mark.”

41) Firstly, whilst the opponent's mark CTM4743225 is registered for class 3 & 25 goods and class 35 services it has only shown reputation under clothing in class 25 and so the submissions regarding class 35 services must be ignored. This was accepted at the hearing. Somewhat reluctantly I am willing to accept that the opponent has provided evidence that this mark does enjoy a significant reputation for clothing. This is despite the absence of turnover figures specifically for the mark RAW. The opponent therefore overcomes the first hurdle.

42) Once the matter of reputation is settled any opponent must then show how the earlier trade mark would be affected by the registration of the later trade mark. The opponent contends that its mark will be linked to those of the applicant and its business damaged as it has no control over the quality of the applicant's goods. The opponent also contends that the applicant will benefit from the opponent's advertising.

43) Earlier in this decision I found that the applicant's marks had a medium degree of similarity to the opponent's mark RAW. The opponent's mark RAW is inherently highly distinctive for clothing. The applicant's marks both relate to beverages whereas the opponent's mark is in relation to clothing. Despite the opponent's claim that the average consumer would form a link between the marks they have not provided any evidence or even compelling submissions as to why they would be linked by the average consumer in the marketplace. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is no advantage for the applicant to derive. As far as detriment is concerned, the opponent suggested that this would subsist in a reduction in the distinctiveness of their marks and also in loss of sales due to poor quality goods being offered by the applicant. I do not accept that registration of the marks in suit could have an impact in this respect, be it to the distinctiveness of the earlier mark or the reputation it enjoys. **The opposition under Section 5(3) therefore fails.**

COSTS

44) The opponent opposed each of the two marks applied for under two grounds. The opponent has succeeded under Section 5(2)(b) but failed under the ground of opposition under Section 5(3). As the opponent has succeeded it is entitled to a contribution to its costs.

Preparing statements and considering the other side's statements x 2	£400
Preparing evidence and considering the evidence of the other side	£800
Expenses	£200
Preparing for and attending the final hearing	£600
TOTAL	£2,000

45) I order Nosh Detox Delivery Limited to pay G-Star Raw C.V. the sum of £2,000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of June 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**