

O-161-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3101106
BY
ROARCUSS PERFORMANCE MOTORSPORT LTD
TO REGISTER THE MARK**



IN CLASS 9

**AND OPPOSITION 404685 THERETO BY
G-STAR RAW C.V.**

Background and pleadings

1. Roarcuss Performance Motorsport Ltd (the applicant) applied to register the trade mark below in the UK on 25 March 2015. It was accepted and published in the Trade Marks Journal on 10 April 2015 in respect of Software in class 9.



2. G-Staw Raw C.V. (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier Community Trade Mark 11493103 “RAW”, which was filed on 16 January 2013 and registered on 23 June 2013. The following goods and/or services are relied upon in this opposition:

Class 9: Data processing equipment, computers; computer software

Class 42: Design and development of computer hardware and software

3. The opponent argues that the respective goods are identical or similar and that the marks are similar. Given its date of registration the opponent’s mark is not subject to the proof of use requirements.
4. The applicant denies the claims made, arguing that the marks are not similar, and that theirs are such niche goods from a specialist field that the average consumer would not be confused.
5. Neither party filed evidence, and only the opponent filed written submissions, which are not summarised but are referred to where appropriate. No hearing was requested and so this decision is made on the basis of the papers before me.

DECISION

Section 5(2)(b)

6. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

7. The following principles 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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

8. With regard to the goods, the applicant's case is as follows:

“As our software, RawTune is purely for motor vehicle tuning, we see no way why this would cause any likelihood of confusion as we have a very select customer base due to the niche nature of the market/business.”

And

“We cannot see how any customer or member of the public looking to purchase our product will have any confusion that it may be in any way connected to the opposing company because of our ‘specialist’ field...”

9. I understand the points, however, as a matter of law, the opponent is entitled to protect its earlier mark for the goods for which it is registered which includes software at large. It is not limited to any particular type of software. The application is also for ‘software’ as a whole, not for the motor-vehicle tuning product described by the applicant in its pleadings. Even if the applicant had limited its software to the niche product to which it refers, this would not help given the opponent's specification.

10. The opponent's specification covers ‘computer software’ in class 9 whilst the applicant has applied to register its mark for ‘software’ also in class 9. As such the goods for which the two marks, if registered, would be entitled to protection, are identical and, as already stated, this would still be the case even if the applicant restricted its specification. I need not go on to consider the other goods.

Comparison of marks

11. 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.”

12. 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.

13. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
RAW	

14. The overall impression of the opponent's mark is based upon the single word of which it is comprised.

15. The applicant's mark features the words 'RawTune' in a stylised serif font and in the colour red. The colour is broken up by a filter of some sort giving the letters a 'roughness'. The words are presented on a black background. The stylisation makes a contribution to the overall impression of the marks, though the words themselves carry the greater weight, with 'Raw' having slightly greater weight than 'Tune'.

16. In terms of aural similarity, the opponent's mark 'RAW' and the first syllable of the applicant's mark when articulated will be pronounced identically. The second syllable 'Tune' is not present in the earlier mark, though I also note that the first parts of marks normally carries the greater significance (see for example *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02). I assess the aural similarity as medium.

17. In terms of visual similarity the applicant's mark is four letters longer than the opponent's mark, and presented with a great deal more stylisation, however the first three letters are shared. However, the colours and capitalisation of the applied for mark should not feature in the comparison because the opponent is not restricted from using its mark in a range of fonts and colours. I assess the visual similarity as medium.

18. In terms of conceptual similarity, the marks share the word 'raw' and its conceptual associations, however the applicant's mark is qualified by the word 'tune'. The two elements of the applicant's mark 'raw' and 'tune' qualify one another such that the phrase hangs together as a unit and contributes to the marks conceptual identity of either 'a tune' which is 'raw' or something raw which is to be tuned. Whilst these may be rather abstract concepts, they are absent from the opponent's mark which conceptually is based only upon the word 'raw'. I assess the conceptual similarity as below medium.

Average consumer and the purchasing act

19. Software can be a general consumer item and therefore the average consumer of software is the general public, who make a primarily visual selection with an average degree of care and attention which may vary slightly higher or lower according to the nature of the software to be purchased. Some software will be for business use and will be selected through a much more stringent screening process using tenders or other commissioning process, where a much higher degree of care and attention will be paid, whereas general consumers selecting apps for their phone will pay a much lower degree of care and attention. I take these variances into account

Distinctive character of the earlier trade mark

20. In Case C-342/97 *Lloyd Schuhfabrik Meyer*, 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).

21. The earlier mark consists solely of the word 'RAW'. The opponent contends that 'Raw is not a term that would normally be used to describe software, or indeed technological products in general, as technology is by its very nature not "raw" or "natural" but is in fact invented and constructed / processed.' By contrast the applicant states in its counterstatement that "'Raw' in our mark is used as the descriptive part of the word 'RawTune', and merely describes that the software will allow the user to 'tune' a 'raw' file.

22. I note the decision in *Formula One Licensing BV v OHIM*, Case C-196/11P, in which the Court of Justice of the European Union found that:

41. [...] it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and

Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

23. I am inclined to agree with the applicant that in the word ‘Raw’ when applied to software there may be some allusive qualities relating to unprocessed computer files, but without evidence to explain the relevance of this in any greater detail, the earlier mark is at least moderately distinctive.

Conclusions on Likelihood of Confusion.

24. In assessing the likelihood of confusion, I must adopt the global approach set out in case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

25. I have found that the goods are identical and will be selected by the average consumer, who is a member of the general public, via a primarily visual selection process and with an average degree of care and attention. The earlier mark is possessed of a low distinctive character, and the respective marks are aurally and visually similar to a medium degree and conceptually similar to a below medium degree.

26. I also bear in mind that a mark with a higher distinctive character carries a greater likelihood of confusion, though I note also that a weak distinctive character does not preclude a likelihood of confusion, as in *L’Oréal SA v OHIM*, Case C-235/05 P where it was said:

45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance.

The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders”.

27. Notwithstanding the only moderately distinctive character of the earlier mark, having regard to all the relevant factors and considering the case law above, I find that there is a likelihood of confusion in the present case.

28. I find that the average consumer when faced with the competing marks would believe that the differences reflected the variety of the goods or a marketing alteration, and that the goods originated from linked economic undertakings. I therefore find that there is a likelihood of indirect confusion in the present case. Even when considered in terms only of the specific goods to which the applicant refers, the confusion is magnified given that ‘Tune’ is wholly descriptive of ‘tuning’ software.

Conclusion

29. The opposition succeeds under section 5(2)(b). The application is refused.

COSTS

30. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £600 as a contribution towards the cost of the proceedings. Bearing in mind that the Opponent withdrew its 5(3) claim, I make no award in respect of the official fee paid for the ground which was not pleaded. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement	£200
Preparing submissions	£300
Official fees	£100
Total:	£600

31. I therefore order Roarcuss Performance Motorsport Ltd to pay G-Star Raw C.V. the sum of £600. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of March 2016

**Andrew Wall
For the Registrar**