

O-403-16

TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION BY  
VIOLA WOOLCOTT  
UNDER NO 3121384 FOR THE TRADE MARK

*Raw Passion*  
— Organic & Vegan Skin Food —

AND

IN THE MATTER OF OPPOSITION NO. 405593 THERETO BY  
G-STAR RAW C.V.

## THE BACKGROUND AND THE PLEADINGS

1) On 21 August 2015 Ms Viola Woolcott filed application no. 3121384 to register the following mark:



After deletion of some goods by Ms Woolcott during the course of these proceedings, and the addition of the limitation *all being or containing raw ingredients*, the goods for which registration is still sought are as follows:

**Class 3:** *After sun moisturisers;Aftershave moisturising cream;Almond oil;Aloe vera;Aromatic essential oils;Aromatic oils for the bath;Aromatic potpourris;Babies' creams [non-medicated];Baby oil;Baby oils;Balms (non-medicated-);Barrier creams for the skin; Almond milk for cosmetic purposes;Almond oil;Aloe vera;Aloe vera gel for cosmetic purposes;Bath oil;Bath oils;Bath salts;Bath soap;Beauty balm creams;Beauty creams;Beauty creams for body care;Beauty lotions;Beauty serums;Beauty soap;Bergamot oil;Body butter;Body cream;Body cream soap;Body lotions;Body moisturisers;Body oil;Body oil spray;Body scrub;Body shampoos;Bubble bath;Cedarwood (Essential oils of -);Citron (Essential oils of -);Cocoa butter for cosmetic purposes;Conditioning balsam;Conditioning creams;Distilled oils for beauty care;Essences (Ethereal -);Essences for skin care;Essential oils;Essential oils for the care of the skin;Ethereic oils;Extracts of flowers;Eye cream;Face creams;Facial cream;Geraniol;Hand barrier creams;Hand cream;Hand lotion (non-medicated-);Hand oils (non-medicated-);Lavender oil;Lavender water;Lemon (Essential oils of -);Lip balm;Lip balm [non-medicated];Lip conditioners;Lip cream;Liquid bath soaps;Liquid soap used in foot bath;Liquid soaps for hands and face;Lotions for face and body care;Massage creams, not medicated;Massage oil;Massage oils, not medicated;Massage waxes;Mint essence [essential*

*oil];Moisturiser;Moisturisers [cosmetics];Moisturising body lotion [cosmetic];Moisturising skin creams [cosmetic];Moisturising skin lotions [cosmetic];Natural oils for cosmetic purposes;Night cream;Night creams [cosmetics];Non medicated skin toners;Non-medicated bath oils;Non-medicated bath salts;Non-medicated beauty preparations;Non-medicated cleansing creams;Non-medicated cosmetics;Non-medicated creams;Non-medicated foot cream;Non-medicated lotions;Non-medicated moisturisers;Non-medicated oils;Non-medicated skin care preparations;Non-medicated skin lotions;Non-medicated soaps;Nutritional creams (non-medicated-);Oils for cosmetic purposes;Oils for the body [cosmetics];Pets (Shampoos for -);Rose oil;Rose oil for cosmetic purposes;Scented water;Shampoo for animals;Shampoos for pets;Shower and bath gel;Shower creams;Shower gel;Skin balms [cosmetic];Skin balms (non-medicated-);Skin care creams [cosmetic];Skin care creams, other than for medical use;Skin care lotions [cosmetic];Skin care oils [non-medicated];Skin cleaners [non-medicated];Skin cleansers [cosmetic];Skin cleansers [non-medicated];Skin cleansing cream;Skin cleansing cream [non-medicated];Skin cleansing lotion;Skin conditioners;Skin conditioning creams for cosmetic purposes;Skin cream;Skin creams [cosmetic];Skin creams [non-medicated];Skin emollients;Skin emollients [non-medicated];Skin fresheners;Skin lotion;Skin moisturizers;Skin toners;Soap;Soaps;Soaps in liquid form;Soapy gels;Tea-tree oil;Day creams; all the aforesaid goods being organic and vegan friendly and all being or containing raw ingredients.*

The application was published for opposition purposes on 4 September 2015.

2) On grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) G-Star Raw C.V. (“the Opponent”) opposes the registration of the Applicant’s mark for all the goods for which the Applicant seeks registration. A further claim under section 5(3) of the Act was withdrawn during the course of the proceedings.

3) For the purposes of its claim, the Opponent relies on international trade mark (EU) no. 2631672 (“the earlier mark”), which designated the EU for protection on 21

January 2013 with protection being conferred on 4 May 2015 for the mark shown below:

## **RAW**

The following goods, which are among those for which the earlier mark is protected, are relied on:

**Class 3:** *Soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices.*

**Class 35:** *Retail store services in the field of soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.*

4) The significance of the above dates is that (1) the earlier mark constitutes an “earlier mark” for the purposes of section 5(2)(b) of the Act, and (2) the proof of use provisions in section 6A of the Act do not apply in respect of it.

5) Ms Woolcott is represented by Schlich. The Opponent is represented by HGF Ltd. Ms Woolcott filed a notice of defence and counterstatement, denying the grounds of opposition. Ms Woolcott’s counterstatement also contains what amount to written submissions. Neither party filed evidence. Neither side requested a hearing. The Opponent filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

### **SECTION 5(2)(b)**

#### **The law**

6) Section 5(2)(b) of the Act reads 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) I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments. The following principles are gleaned from the decisions 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.

### **Comparison of the goods and services**

8) 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”.

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.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, (“*Meric*”) the General Court (“the GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

10) In her counterstatement Ms Woolcott submits, in essence, that her goods differ from those of the Opponent in that they are all explicitly specified to be organic and vegan-friendly, and to be, or contain, “raw” products. As such, she maintains, they would not generally be sold through supermarkets and chemist stores, but through specialist health store outlets. I shall have more to say about the significance to be attached to the word “raw” when I come later in my decision to consider the issues of distinctiveness of the earlier mark, conceptual similarity and likelihood of confusion. For the present purposes of comparison of the competing goods, the argument is misconceived. The point is that the Opponent’s specification, as it stands, does not limit the Opponent’s protection to goods which are *not* organic and vegan-friendly, or do *not* contain “raw” products; on the contrary, the Opponent’s broad specification would entitle it to supply such goods under its mark and distribute them through appropriate channels of trade. I shall therefore make my comparison on this basis. I shall do so by reference to Ms Woolcott’s goods, going through them term by term (but grouping them when it is useful and reasonable to do so – see the comments of the Appointed Person in *Separode* BL O-399-10).

11)The opponent’s *cosmetics* refers to a range of preparations intended to beautify the hair, skin and complexion; in my view the following goods of Ms Woolcott’s specification fall within the ambit of this term, and are therefore identical: *After sun moisturisers;Aftershave moisturising cream;Almond oil;Aloe vera; Aromatic oils for the bath;Aromatic potpourris; Balms (non-medicated-); Barrier creams for the skin; Almond milk for cosmetic purposes;Almond oil;Aloe vera;Aloe vera gel for cosmetic purposes;Bath oil;Bath oils; Beauty balm creams;Beauty creams;Beauty creams for body care;Beauty lotions;Beauty serums;Beauty soap;Bergamot oil;Body butter;Body cream;Body cream soap;Body lotions;Body moisturisers;Body oil;Body oil spray; Cocoa butter for cosmetic purposes;Conditioning balsam;Conditioning creams;Distilled oils for beauty care;Essences (Ethereal -);Essences for skin care; Etheric oils;Extracts of flowers;Eye cream;Face creams;Facial cream;Geraniol;Hand barrier creams;Hand cream;Hand lotion (non-medicated-);Hand oils (non-medicated-); Lip balm;Lip balm [non-medicated];Lip conditioners;Lip cream; Lotions for face and*



*body care; Moisturiser;Moisturisers [cosmetics];Moisturising body lotion [cosmetic];Moisturising skin creams [cosmetic];Moisturising skin lotions [cosmetic];Natural oils for cosmetic purposes;Night cream;Night creams [cosmetics];Non medicated skin toners;Non-medicated bath oils;Non-medicated bath salts;Non-medicated beauty preparations;Non-medicated cleansing creams;Non-medicated cosmetics;Non-medicated creams;Non-medicated foot cream;Non-medicated lotions;Non-medicated moisturisers;Non-medicated oils;Non-medicated skin care preparations;Non-medicated skin lotions; Nutritional creams (non-medicated-);Oils for cosmetic purposes;Oils for the body [cosmetics]; Rose oil for cosmetic purposes; Skin balms [cosmetic];Skin balms (non-medicated-);Skin care creams [cosmetic];Skin care creams, other than for medical use;Skin care lotions [cosmetic];Skin care oils [non-medicated]; Skin conditioners;Skin conditioning creams for cosmetic purposes;Skin cream;Skin creams [cosmetic];Skin creams [non-medicated];Skin emollients;Skin emollients [non-medicated];Skin fresheners;Skin lotion;Skin moisturizers;Skin toners; Tea-tree oil;Day creams; all the aforesaid goods being organic and vegan friendly and all being or containing raw ingredients.*

12) Though the purpose of grooming may predominate in the case of the Opponent's *cosmetics* and the purpose of hygiene and comfort may predominate in the case of *babies' creams [non-medicated]; baby oil; baby oils*, there is a strong overlap of these purposes in both cases; use, users (carers in the case of babies) and trade channels are also the same. Moreover, these goods are often also used for cosmetic purposes. They are very similar.

13) Ms Woolcott's *Aromatic essential oils; Cedarwood (Essential oils of -);Citron (Essential oils of -); Essential oils; Essential oils for the care of the skin; Lavender oil; Lemon (Essential oils of -); Mint essence [essential oil]; Rose oil* all fall within the ambit of the Opponent's essential oils, and are thus identical.

14) The Opponent's *essential oils* can be used for massaging purposes, and are thus very similar to Ms Woolcott's *Massage creams, not medicated; Massage oil; Massage oils, not medicated; Massage waxes;*

15) Ms Woolcott's *Bath soap; Liquid bath soaps; Liquid soap used in foot bath; Liquid soaps for hands and face; Non-medicated soaps; Soap; Soaps; Soaps in liquid form; Soapy gels*; all fall within the ambit of the Opponent's *Soaps*, and are thus identical. Ms Woolcott's *Body scrub; Body shampoos; Pets (Shampoos for -); Shampoo for animals; Shampoos for pets; Shower and bath gel; Shower creams; Shower gel* perform a similar purpose, have a degree of complementarity and share users and channels of trade with the Opponent's *Soaps*, and are very similar.

16) Ms Woolcott's *Skin cleaners [non-medicated]; Skin cleansers [cosmetic]; Skin cleansers [non-medicated]; Skin cleansing cream; Skin cleansing cream [non-medicated]; Skin cleansing lotion* both compete with, and complement, the Opponent's *Soaps*, and are very similar. Ms Woolcott's *Bath salts* are strongly complementary with the Opponent's *Soaps*, sharing users and channels of trade, and are very similar.

17) Ms Woolcott's *Lavender water; Scented water* fall within the ambit of the Opponent's *perfumery*, and are thus identical.

18) The General Court in *Oakley Inc v OHIM*, Case T-116/06, decided that the retail of specific goods can, potentially, create a link with the goods themselves by virtue of the complementary relationship between them. However, given the inherent difference in nature between a good and a service, there cannot be greater similarity between the Opponent's services in class 35 and Ms Woolcott's goods in class 3 than I have already found to exist between those goods and the Opponent's goods in class 3. A comparison with the Opponent's services in class 35 would therefore take the Opponent's case no further forward.

### **The average consumer and the purchasing process**

19) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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.”

20) The parties’ competing goods are cosmetics or similar items. The average consumer will be a member of the general public. The purchasing act is likely to be primarily a visual one, as the goods will most often be self-selected from a shelf (or the online or catalogue equivalent) and the marks may be exposed visually in advertising and websites etc. However, aural considerations will not be ignored in my assessment, as it is not unusual to find sales assistants and advisors involved in the purchasing process. I accept that where consumers seek specific characteristics in goods – such as “organic” ingredients and method of preparation – they may be prepared to pay a higher price for them. Cosmetics and similar goods generally, however, are likely to be available in a broad range of prices – though, as a general rule, they are relatively low value, fairly frequent purchases, and are unlikely to demand a higher level of attention to be paid in their selection than that necessary to establish suitable skin type, particular ingredients, perfume, and so on. The purchasing process will be a normal, reasonably considered one.

### **The distinctiveness of the earlier mark**

21) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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).”

22) The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

23) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctive character. In her counterstatement Ms Woolcott states (at paragraph 12) that “*within the natural products and cosmetics industry an ingredient is considered to be ‘raw’ if it fulfils certain conditions.* She further states (at paragraph 29) that “*Products that can be described as ‘raw’ are considered to be premium and specialist products*” and that they would “*attract a premium price and the consumers would pay particular attention to them*”. On this basis she argues that the word “raw” is descriptive when used in relation to cosmetic and similar goods which consist of, or contain, ingredients which are “raw” in this sense. She submits

no evidence, however, to support her assertion that “raw” is understood in a specific technical sense either among producers or among a specific class of consumers of cosmetics and similar products.

24) The Opponent (at paragraph 17 of its written submissions) submits as follows:

*“The Applicant has argued that the word “RAW” within the contested mark is descriptive of the ingredients and properties of the contested goods, being “uncooked” or being “in a natural condition”. The Opponent submits that “RAW” is meaningless in relation to Class 3 products. “RAW” is not a normal way to refer to skin care products or any personal care products, being a term which is synonymous with “rough” and “crude”. Cosmetic products which boast an absence of processed or artificial ingredients are more commonly described as “natural”. The word “raw” is not synonymous with “natural”. The term “raw” is at odds with the usual qualities possessed by personal care products, which are nurturing, comforting and healing. The Opponent does not accept that “RAW” is a term which is commonly used to describe Class 3 products. The Opponent refutes the Applicant’s assertion that the Opponent’s mark RAW is either descriptive of Class 3 goods (if the products have “raw” qualities), or is deceptive (if they do not). The Opponent submits that its mark RAW has no meaning in relation to the goods and services for which the mark is registered, and it can therefore be neither descriptive nor deceptive. The Opponent has successfully registered the mark RAW on its own in the UK, the EU and elsewhere. As RAW is registered for Class 3 goods, it is indisputably a distinctive term.”*

25) With reference to the Opponent’s last point, I must begin by recognising that, since the mark is registered, it is prima facie valid<sup>1</sup>, and is therefore to be treated as having at least a minimum level of distinctive character<sup>2</sup>. In the absence of evidence from either party my duty is to use my own common knowledge of the world (excluding idiosyncratic knowledge) – including, for example, how well-known a meaning given in a dictionary is – to determine whether and how the possible

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<sup>1</sup> See section 72 of the Act.

<sup>2</sup> See by analogy *Formula One Licensing v OHIM*, Case C-196/11P

meanings of the word “raw” might influence the perception of the mark for the relevant goods or services by the reasonably well-informed and reasonably observant and circumspect consumer I have identified<sup>3</sup>.

26) A number of definitions are given in the “*Oxford Dictionary of English*” (3<sup>rd</sup> edition, 2010) for the word “raw”. The first, and potentially most relevant, are as follows:

1. **(of food) not cooked:** *raw eggs | salsify can be eaten raw in salads.*  
**(of a material or substance) in its natural state; unprocessed:** *raw silk | raw sewage.*  
**(of data) not analysed, evaluated, or processed for use:** *there were a number of errors in the raw data.*
  
2. **(of a part of the body) red and painful, especially as the result of skin abrasion:** *he scrubbed his hands until they were raw.*  
**(of a person's nerves) very sensitive:** *Fran's nerves were raw.*
  
3. **(of an emotion or quality) strong and undisguised:** *he exuded an air of raw, vibrant masculinity.*  
**frank and realistic in the depiction of unpleasant situations:** *a raw, uncompromising portrait.*  
**US informal (of language) coarse or crude, typically in relation to sexual matters:** *his wife has led a campaign against raw lyrics in rock music.*

It would be wrong to assume, of course, that simply because a particular meaning is given for a word in a dictionary, that meaning is necessarily widely known. Similarly, where a word has a number of definitions, it cannot be assumed that all such definitions are equally well-known. I am satisfied, however, that the general public which I have found to constitute the average consumer for the parties’ competing products would be familiar with all of the following meanings of the word “raw”: *not*

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<sup>3</sup> See on this the observations of Mr Geoffrey Hobbs, QC, sitting as the Appointed Person in *FOREX*, O/100/09, at paragraphs 14-15.

*cooked; in its natural state; unprocessed; red and painful; very sensitive; strong and undisguised.*

27) The Opponent submits: that “raw”, being synonymous with “rough” and “crude”, is not a normal way to refer to skin care products or any personal care products; that its mark RAW has no meaning in relation to the goods and services for which the mark is registered; and that it cannot therefore be descriptive. On the other hand, it does not explicitly suggest that the average consumer of these products would attach any particular conceptual hook to the word “raw” when used simply on its own. This is understandable. It is, I find, difficult to pin down what particular resonances the word “raw” used in isolation might evoke in the mind of the average consumer of these products – sensitivity, strength, or a certain rugged glamour, perhaps? . In the absence of some kind of cue or prompt, however, I do not think that the word “raw” will evoke – at least in any concrete sense – the concepts “in its natural state” or “unprocessed” in the mind of the average consumer of skincare products in general. For such “unprompted” consumers I consider that the earlier mark has a normal degree of distinctiveness.

28) Nevertheless, I have already observed (at paragraph 10) that the Opponent’s specification does not limit the Opponent’s protection to goods which do not contain “raw” products; on the contrary, the Opponent’s broad specification would entitle it to supply under its mark cosmetics produced with “organic” or “natural” ingredients and minimal processing, and to market them as such, if it saw fit. The Opponent’s assertion that “*cosmetic products which boast an absence of processed or artificial ingredients are more commonly described as ‘natural’*” agrees with my own impression in this regard. However, in the specific context of the marketing of cosmetics designed to appeal to consumers seeking “organic” or “natural” products, as opposed to more highly processed ones, or ones containing artificial chemical ingredients, I consider that the word “raw”, while not specifically descriptive in concrete terms, would nevertheless be perceived by such consumers as carrying a strong implication or suggestion that the goods are produced with “natural” ingredients or with a minimum of processing. The meanings “*in its natural state*” and “*unprocessed*” given in the dictionary for the word “raw” tend to confirm me in this view. In this case, I consider that the distinctive character of the word “raw” would

be significantly reduced; it would be of not more than moderate (between low and medium) distinctiveness in respect of such goods.

### **Comparison of the marks**

29) 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 CJEU 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.”

It would be wrong, therefore, to dissect the trade marks artificially, 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.

30) The marks to be compared are shown below:



The contested mark	The earlier mark
	<p data-bbox="1114 456 1225 501"><b>RAW</b></p>

31) The earlier mark consists exclusively of the word RAW, which is thus its sole element. As the earlier mark is a word mark not limited to colour, the colours in which the contested mark appears are not relevant. For the purposes of comparison of the respective marks, therefore, the contested mark will be drained of colour, in accordance with the observations of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch). I also bear in mind that notional and fair use of the earlier mark would include use in a variety of scripts, thus potentially reducing apparent visual difference between the respective marks<sup>4</sup>.

32) The contested mark consists of the visually prominent word RAW, presented in a typeface resembling that of an old-fashioned typewriter, followed by the equally prominent word PASSION, presented in a cursive script. Beneath these words, and rendered in white against a ragged banner background, again in a typeface reminiscent of an old-fashioned typewriter, are the words ORGANIC & VEGAN SKIN FOOD. The latter are presented in substantially smaller lettering than the prominent words RAW PASSION, but they are perfectly clear. Though they constitute an obvious product description, they nevertheless, together with their banner background and the general graphical presentation of the mark, make a definite contribution to its overall visual impression.

33) The Opponent submits at paragraph 15 of its written submissions:

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<sup>4</sup> See *Peek & Cloppenburg v OHIM*, T-386/07 at paragraph 38.

*“The Opponent disagrees with the Applicant’s assertion that in the term ‘RAW PASSION’, the emphasis is generally placed on the second word “PASSION”. The Opponent submits that it is the word RAW which has the most impact, due to its position at the beginning of the contested mark. It was held by the General Court in Body Shop International p/c v Spa Monopole [2016] EUECJ T-201/14 (16 March 2016) (SPA / SPA WISDOM) that although the mark applied for (SPA WISDOM) consisted of two terms which were distinctive with regard to cosmetic products, the term “spa” in the light of its position at the beginning of the mark, would be more likely to attract the relevant public’s attention”.*

34) There is a rough rule of thumb that the consumer normally attaches more importance to the beginnings of word marks. However, this is no more than a rule of thumb. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks<sup>5</sup>. I consider that the graphically preponderant words RAW PASSION together jointly form the dominant and distinctive element of the mark. Despite the two words being presented in different type, RAW qualifies PASSION to create a complete phrase which hangs together as a unit. Neither of these two words dominates the other. The other elements, whilst not negligible, play a weaker role.

35) Visually, the common initial element RAW constitutes an element of similarity between the competing marks, but the addition to Ms Woolcott’s mark of the longer word PASSION contributes a strong element of difference. The visually subordinate product description and banner also make some contribution to the difference in visual impression as a whole. Overall there is a moderate (between low and medium) degree of visual similarity between the marks.

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<sup>5</sup> Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-438/07*:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

36) The contested mark will generally be referred to orally as RAW PASSION. The descriptive words “Organic and Vegan Skin Foods” will not normally be spoken by consumers when, for example, they ask for the brand in the course of trade. The initial RAW is common to both competing marks, but the further two syllables of the quite differently sounding word PASSION add a strong element of difference. Overall, there is a medium degree of aural similarity between them.

37) I have already pointed out in paragraph 27 that it is difficult to pin down from among its various layers of meaning what particular associations the adjective “raw” may evoke in the mind of the average consumer of skincare products in general where it appears simply in isolation. I suggested possible connotations of sensitivity, strength or rugged glamour. As soon as “raw” is used to qualify a noun its meaning becomes more concrete and clear. A passion is a strong desire or intense enthusiasm. “Raw” qualifies “passion” to produce a phrase indicating an intense desire or strong enthusiasm. This is a much more concrete concept than the vague connotations of the word “raw” when used in isolation, and has a meaning quite distinct from them; it creates a significant overall conceptual difference from the earlier mark.

### **Likelihood of confusion**

38) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), 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.

39) Taking into account my findings on visual, aural and conceptual similarity, the average consumer and the purchasing process, and the distinctiveness of the earlier mark, and bearing in mind the effects of imperfect recollection, I do not consider that there is a likelihood that the competing marks will be directly confused with one another. I have made clear that I do not consider that the words “Organic & Vegan Skin Food” and the figurative elements of the contested mark can be regarded as

negligible. Even if one were to discount them, however, I consider that the overall visual, aural and conceptual differences between RAW PASSION and RAW would alone be sufficient to mean that there will be no likelihood of direct confusion of the marks, even for identical goods. I must still, however, consider whether there is a possibility of indirect confusion. In this connection it is helpful to bear in mind the observations of Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 (“*L.A. Sugar*”), where he noted that:

“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).”

40) The Opponent submits at paragraph 16 of its written submission:

*“..... the word RAW is of at least equal dominance with the word PASSION within the contested mark, and has an independent character within the contested mark, even if it forms part of an overall recognised term RAW PASSION. This is particularly clear, given that the stylisation of the lettering in which the word RAW is displayed is individual to the word RAW, giving the word its own separate identity within the contested mark. RAW is clearly intended to be separate from PASSION, which appears in a different script. The ECJ in its decision in Case C-120/04 Medion AG v Thomson Multimedia Sales Germany & Austria GmbH (THOMSON LIFE) confirmed that a sign composed of an earlier mark in combination with an additional distinctive element could be regarded as similar with the earlier mark if the earlier mark has an independent distinctive role in the composite sign without necessarily constituting the dominant element. The High Court in its decision of 13 March 2013 in Aveda Corporation v Dabur (India) Limited, further confirmed that there is no requirement that the common element between the marks in question even be dominant”.*

41) The words “Organic & Vegan Skin Food” play a subordinate role graphically in the contested mark. The distinctive weight of the mark is clearly borne by the dominant phrase RAW PASSION, in which RAW qualifies PASSION to create a recognisably complete phrase which hangs together as a whole, and might be paraphrased as “undisguised emotion” or “intense love” or “strong enthusiasm”. I can agree in part with the Opponent, to the extent that I consider that the use of two different scripts could invite consumers to consider the two words individually at the same time as they recognise the complete phrase, with its own meaning distinct from that of its component words. I do not agree, however, that the effect of the different scripts is to emphasise an independent distinctive role for RAW. The phrase will be

seen as it is, a phrase that hangs together which has simply been created with different scripts.

42) When the word RAW is used on its own as a mark for goods explicitly marketed as organic or natural or minimally processed, I have found that it would be of no more than moderate distinctiveness. I do not think that the average consumer who had, for example, come across the earlier mark used in connection with such goods would, on encountering the contested mark, attribute to the word RAW in that mark a *distinctive* significance independent of the composite phrase RAW PASSION. I think that the most natural reaction would be for the consumer simply to assume that two different producers had chosen to exploit the allusive quality of the word RAW in respect of such goods in their different marks. Nor is PASSION the kind of non-distinctive element one would expect to find in a sub-brand. On the contrary, it contributes very substantially to the distinctive nature of the composite phrase RAW PASSION, which forms a distinctive unit. Nor does the earlier mark comprise a number of elements such that a change of one element appears logical and consistent with a brand extension. Even for identical goods, there will not be a risk that the consumer will believe that the respective goods come from the same or economically linked undertakings. Even if I am wrong on my assessment as to the distinctive character of the earlier mark (for organic etc goods) and that there is instead a medium level of distinctiveness (as there would be for “mainstream” cosmetic products), I still consider that there would be no likelihood of confusion. The conceptual differences that exist between the mark, together with the fact that RAW does not play an independent and distinctive role within the contested mark, is sufficient to mean that any similarity will be put down to co-incidence and not economic connection.

## **Outcome**

44) I have found that, even for the goods which I have found identical, there will not be a likelihood of either direct or indirect confusion between the competing marks. It follows that there can be no likelihood of confusion in respect of any of the goods of Ms Woolcott’s specification. Accordingly, **the opposition fails in its entirety.**

## **Costs**

45) Ms Woolcott has been successful and is entitled to a contribution towards her costs. I hereby order G-Star Raw C.V. to pay Ms Viola Woolcott the sum of £500. This sum is calculated as follows (I have taken into account the fact that Ms Woolcott's counterstatement contained what were in effect detailed submissions):

*Preparing a statement and considering the other side's statement*      £500

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 18th day of August 2016**

**Martin Boyle**

**For the Registrar,**

**The Comptroller-General**