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OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

Cancellation Division

C491B

Alicante, 29/11/2011

**INVALIDITY PROCEEDINGS: NOTIFICATION OF A DECISION TO THE  
CTM PROPRIETOR**

Address of proprietor / representative: HOYING MONEGIER LLP  
Rembrandttoren, 31e  
verdieping  
Amstelplein 1  
NL-1096 HA Amsterdam  
PAÍSES BAJOS

Reference:  
Fax number: 00 31-204637296

Community trade mark concerned: 004743225  
RAW

OHIM reference: **000004159 C**  
Language of the proceedings: English

Please see attached the decision terminating the invalidity proceedings referred to above. It was delivered on 29/11/2011.

Biruté Sataite Gonzalez

Attached: 8 pages including cover page



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

Cancellation Division

**DECISION  
of the Cancellation Division  
of 29/11/2011:**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY**

OHIM reference number: 4159 C

Community trade mark: 4 743 225  
RAW

Language of the proceedings: English

**APPLICANT** **R.B. Europe GmbH**  
Klever Str. 187  
47574 Goch  
Germany

**REPRESENTATIVE** **Markus Kreuzkamp**  
Ludenberg Str. 1a  
40629 Düsseldorf  
Germany

against

**COMMUNITY TRADE MARK  
PROPRIETOR** **G-Star Raw C.V.**  
Keienbergweg 100  
1101 GH Amsterdam (Zuidoost)  
The Netherlands

**REPRESENTATIVE** **Hoyng Monegier LLP**  
Rembrandttoren, 31e verdleping  
Amstelplein 1  
1096 HA Amsterdam  
The Netherlands

### THE CANCELLATION DIVISION

composed of: Gianluigi Mannucci, José Antonio Garrido Otaola and David Leffler has taken the following decision on 29/11/2011:

1. The request for a declaration of invalidity of Community trade mark No 4 743 225 is rejected.
2. The applicant shall bear the fees and costs of the Community trade mark proprietor.
3. The costs are fixed as follows:

The amount of costs to be paid by the applicant to the Community trade mark proprietor shall be 450 EUR, corresponding to representation costs.

### FACTS AND ARGUMENTS

- (1) The Community trade mark No 4 743 225, "RAW" (word mark) ("the CTM"), was filed on 24/11/2005 and registered on 15/10/2008 for goods and services in classes 3, 25 and 35.
- (2) On 28/01/2010, the applicant filed a request for a declaration of invalidity against the CTM on the basis of absolute grounds pursuant to Article 52(1)(a) CTMR, namely that the CTM was registered in breach of Article 7(1)(b) and (c) CTMR.
- (3) The applicant files its request for a declaration of invalidity in respect of part of the goods covered by the CTM, namely *clothing, footwear, headgear, belts (clothing); except products relating to wrestling, wrestling entertainment and wrestlers* in class 25.
- (4) The CTM proprietor was duly notified of the invalidity application and the parties were given ample opportunity to comment upon the observations made by the counterparty in accordance with the relevant provisions of the CTMR and the CTMIR.
- (5) The applicant argues, as regards Article 7(1)(c) CTMR that in English the word "raw" means, *inter alia*, "in an unfinished, natural or unrefined state: not treated by manufacturing or other processes" and that when applied to the goods for which the CTM is registered it is a clear reference to a characteristic of these goods, namely the texture and quality of the material they are made of. It further claims that the term "raw" can also refer to the cut of the clothing, indicating a rough style and that this is also applicable to the other goods concerned, i.e. belts, headgear and footwear. The applicant adds that the term is purely descriptive for all sorts of denim clothes, since it is only an abbreviation of "raw denim" which is one of the major fabrics used for this type of clothes. Finally, it refers to the decision of the Second Board of Appeal of 26/03/1999, R 43/1999-2, 'RAW DENIM', in which the expression "raw denim" was found to be descriptive for goods in classes 24 and 25.

- (6) As regards Article 7(1)(b) CTMR, the applicant argues that the fact that the CTM is composed of a word which is descriptive of a characteristic of the goods also means that it is devoid of distinctive character.
- (7) In support of its arguments, the applicant files the following documents:
- Excerpts from the Collins English Dictionary showing the various meanings of the term "raw".
  - Extracts from Wikipedia, dated 14/09/2009 and 12/01/2010, regarding the terms "cut and sew" and "denim", respectively.
  - Internet print-outs, undated, showing the results of a Google search for expressions such as "raw jeans", "raw shirts" and "raw denim", which appear in various websites in relation to clothing items. The applicant notes that expressions such as "raw design" and "raw colours" are also used in some of these websites in relation to clothing.
- (8) The CTM proprietor claims that, for the average consumer, the term "raw" does not have any meaning in connection with the goods for which the CTM is registered, and therefore that it is not descriptive. It argues that the normal meaning of this English word is "not cooked" or "not processed" and submits copies of the corresponding entries in several dictionaries to support it. It further argues that it is not relevant that on the internet some information can be found where the word "raw" is used in connection with certain textiles, a certain cut, or a certain clothing style or design, since these meanings may be readily known by insiders in the fashion industry but cannot be considered to be the common meanings of the word "raw" according to normal parlance. The CTM proprietor claims that the documents filed by the applicant show that "raw" is an adjective with a variety of meanings and that it has to be used together with a noun (such as raw cut, raw denim or raw cotton) in order for the consumer to determine a specific meaning. Since the average consumer will not understand the meaning of this term in connection with the goods in question without additional information or further thought, the CTM cannot be considered to be merely descriptive of said goods. The CTM proprietor also refers to a judgment of 25/11/2009 of the Community Trade Mark Court in The Hague, on a counterclaim for invalidity of the same CTM by Pepsico Inc., in which it was held that the CTM is "distinctive and not descriptive because clothing, footwear, headgear and belts are, by their nature, always finished and it is not clear to which aspects of these goods the concept "raw" should then refer".
- (9) In the alternative, the CTM proprietor argues that the CTM has acquired a secondary meaning over time as a result of long standing and extensive use and advertising and submits evidence to support this argument, including advertising material, data on advertising expenditure and several market surveys.
- (10) After two further rounds of observations, in which the parties essentially contested each other's claims and reiterated their own arguments, on 18/07/2011 they were informed that the adversarial part of the proceedings was closed and that a decision would be taken in due course.

## GROUNDS FOR THE DECISION

### *On the admissibility*

- (11) The request complies with the formalities prescribed in particular in Article 56(1) CTMR and Rule 37 CTMR and is, therefore, admissible.

### *On the substance*

- (12) The request is not well-founded. The Cancellation Division considers that the CTM has not been registered in breach of Article 7(1)(b) or (c) CTMR.
- (13) Pursuant to Article 52(1)(a) and (3) CTMR a Community trade mark shall be declared invalid on application to the Office where the Community trade mark has been registered contrary to the provisions of Article 7 CTMR. Where the ground for invalidity exists in respect of only some of the goods or services for which the Community trade mark is registered, it shall be declared invalid as regards those goods or services only.
- (14) As regards the assessment of the absolute grounds of refusal pursuant to Article 7 CTMR, which forms part of the *ex officio* examination prior to the registration of the CTM, it should be noted first that the Cancellation Division will not carry out its own research but will confine itself to an examination of the facts and arguments presented by the parties (see OHIM Manual of Trade Mark Practice, Part D, Section: Cancellation Proceedings, Substantive Provisions, Chapter 4.1.).
- (15) These facts and arguments must relate to the time of the application for the CTM. However, facts relating to an immediately subsequent period might constitute an indication also for the time of the application (see order of 23/04/2010, C-332/09 P, 'Flugbörse', at paragraphs 41 and 43).

### *Article 7(1)(c) CTMR*

- (16) Under Article 7(1)(c) CTMR, trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of the goods or services, shall not be registered. Thus Article 7(1)(c) CTMR pursues the aim, which is in the common interest, of ensuring that signs or indications which describe the categories of goods or services in respect of which registration is applied for remain available. Hence, this provision does not permit such signs or indications to be reserved for use by one undertaking as a result of their registration as a trade mark (see judgment of 12/02/2004, C-265/00, 'Biomild', paragraph 31).
- (17) The signs and indications referred to in Article 7(1)(c) CTMR are those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought. Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by a specific intended public.

- (18) In the present case, the goods for which the CTM is registered are directed at the public at large. Taking into account the kind of goods in question (which are not everyday consumption goods but are regularly bought by the average consumer) the degree of attention is deemed to be average.
- (19) As the CTM consists of English terms, the relevant public to be taken into consideration must possess a certain command of the English language. In this respect, it should be noted that according to Article 7(2) CTMR a trade mark shall not be registered even if the grounds of non-registrability only exist in part of the Community. Thus, an obstacle as regards the English-speaking population of the Community is sufficient to declare the CTM invalid.
- (20) In the light of the goods concerned in the present case and of the specific intended public (in particular, the English-speaking part of that public), it is considered that the term "raw" will not be understood, on its own, as having a clear descriptive meaning. As the applicant itself has argued, the adjective "raw" has a variety of meanings depending on the context, and in particular of the noun which follows it. The term "raw" on its own, used in connection with the clothing, footwear, headgear and belts, will just bring to mind its most common meanings, i.e. "uncooked, unprocessed, unfinished", which cannot be considered to be descriptive of the goods in question, which by definition are finished products. At most, the relevant consumer could consider, after some reflection, that the term might be suggestive or allusive to the kind of fabric used to make the goods (e.g. raw denim, raw cotton) or to a "rough" style, but even then it is not clear to which of these two different meanings it refers. In other words, the contested CTM does not enable the relevant public to establish a specific and direct relationship between the sign and the goods in question immediately, and without further thought.
- (21) The internet printouts filed by the applicant in support of its arguments actually tend to confirm the absence of a descriptive character of this adjective on its own for the goods in question since, apart from the fact that a large part of said printouts relate to the use of the term "RAW" as a trade mark (and not as a descriptive term) by the CTM proprietor or by its competitors, in the few instances in which it is used in a descriptive way it qualifies another noun (e.g. raw cut, raw colour, raw textile materials), which gives it a context and clarifies its meaning. Similarly, the decision of the Second Board of Appeal of 26/03/1999, R 43/1999-2, 'RAW DENIM' refers to the descriptiveness of the expression as a whole for goods in class 25, and not that of the word "raw" on its own.
- (22) It follows from the above that the applicant has not proved that the CTM was registered contrary to Article 7(1)(c) CTMR.

*Article 7(1)(b) CTMR*

- (23) For a trade mark to possess a distinctive character within the meaning of Article 7(1)(b) CTMR, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings. It is also apparent from settled case-law that that distinctive character must be assessed, first, by reference to the relevant goods and, second, by reference to the perception of the relevant public (see judgment of 08/05/2008, C-304/06 P, 'Eurohypo', at paragraphs 66 and 67).

- (24) Whilst Articles 7(1)(b) and 7(1)(c) CTMR call for a separate examination on account of the specific public interest pursued by each ground of refusal, both grounds have a certain overlap, in particular as regards descriptive terms, which might not only designate a characteristic of the goods in question pursuant to Article 7(1)(c) CTMR, but for the same reason also do not serve to distinguish the goods as regards their commercial origin pursuant to Article 7(1)(b) CTMR. As follows from the assessment above, the CTM does not fall foul of this provision on account of a descriptive meaning.
- (25) Given that the only argument put forward by the applicant as regards the lack of distinctive character of the CTM is based on its descriptiveness and that it has already been found that the CTM cannot be considered descriptive for the goods it covers, it must be concluded that the applicant has not proved that the CTM was registered contrary to Article 7(1)(b) CTMR.

*Conclusion*

- (26) In conclusion, the applicant has not proved that the CTM was registered contrary to Article 7(1)(b) or (c) CTMR and therefore the request for a declaration for invalidity must be rejected in its entirety.
- (27) Given that it has not been proved that the CTM was registered in breach of Article 7(1)(b) and (c) CTMR, it is not necessary to examine under Article 7(3) CTMR the parties' arguments and evidence on its acquired distinctiveness.

**COSTS**

- (28) Pursuant to Article 85(1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The applicant, as the party losing the cancellation proceedings shall bear the costs of the CTM proprietor.
- (29) The amount of the costs to be paid by the applicant to the CTM proprietor pursuant to Article 85(6) CTMR in conjunction with Rule 94(3) CTMIR shall be: EUR 450, corresponding to representation costs.



## THE CANCELLATION DIVISION

<hr/> Gianluigi Mannucci	<hr/> José A. Garrido Otaola	<hr/> David Leffler
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**Notice on the availability of an appeal:**

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

**Notice on the review of the fixation of costs:**

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94(4) CTMIR such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2 point 30 of the Fees Regulation) has been paid.