TRADE MARKS ACT 1994

BL O/1222/24

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

AGAINST DECISION NO O/0256/24

AND IN THE MATTER OF APPLICATION NO. UK00003789861 BY RASE LTD TO REGISTER THE TRADE MARK "RASE" IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 436489: BY RABE MODEN GMBH

DECISION

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1. This is an appeal from the decision of Ms. L. Fayter (the "**Hearing Officer**") dated 26 March 2024 (the "**Decision**").

2. The Appellant was represented before me, as it was before the Hearing Officer, by Ms. Randa Gowiely (the wife of the director of the Applicant). Ms. Gowiely is not legally qualified. Nonetheless, Ms. Gowiely presented the Applicant's case clearly and with admirable focus and brevity. I was greatly assisted by her written and oral submissions as I also was by those of Mr. Lewis Jones (of Dummett Copp LLP) who appeared on behalf of the Respondent.

Background

3. On 19 May 2022, RASE LTD ("the **Appellant**") applied to register the word mark RASE (the "**Trade Mark**") in relation to the following goods in class 25:

Articles of clothing, footwear, headwear, underwear and outerwear, all parts

and fittings thereof, for men, women, children and infants.

4. The application was opposed by Rabe Moden GmbH ("the **Opponent**") under section 5(2)(b) of the Trade Marks Act 1994 ("the **Act**"). It was also initially opposed under other grounds that were later dropped and formed no relevant part of the Decision.

5. The Opponent relied upon the earlier trade mark trade mark "**RABE**' in relation to the following goods in Class 25: "*Clothing; Hats; Footwear*" (the "**Earlier Mark**"). The Earlier Mark was registered on 15 October 2015. The TM7 filed by the Respondent asserts that the Earlier Mark was used in the UK in the 5-year period ending on the date of the application for the Trade Mark. The TM8 filed by the Appellant states that it did not require such use to be proved.

6. The Hearing Officer:

    a. refused registration in respect of "*Articles of clothing, footwear, headwear, underwear and outerwear for men, women, children and infants"* (the **"Article"** goods);

    b. allowed registration in respect of: *"All parts and fittings of articles of clothing, footwear, headwear, underwear and outerwear for men, women, children and infants"* (the **"Parts"** goods), and

    c. made no order as to costs on the basis that both parties had obtained a *"roughly equal measure of success"*.

7. In reaching those conclusions the Hearing Officer also found that:

    a. the average consumer was a member of the general public who would select the goods in issue primarily by visual means, but who would also select them by reference to aural means;

    b. the average consumer would exercise a medium degree of attention when purchasing such goods;

c. the Trade Mark and the Earlier Mark (jointly hereafter the "**Marks**") were visually similar to a high degree;

d. the Marks were aurally similar to between a medium and high degree;

e. neither of the Marks evoked a meaning to the average consumer, and therefore they were both conceptually neutral, and

f. the Earlier Mark was inherently distinctive to a high degree.

g. the Article Goods and the goods of the Earlier Mark were identical. This led, together with the other findings set out above, to a conclusion that there was a likelihood of confusion.

h. the Parts Goods and the goods of the Earlier Mark were dissimilar and therefore section 5(2)(b) was not engaged.

Appeal

8. The Appellant appeals the Decision in relation to the Article Goods. The Respondent does not appeal the decision in relation to the Parts Goods.

9. There was no dispute as to the approach I must adopt on this appeal. That approach is as set out in *Axogen v Aviv* [2022] EWHC 95 (Ch). For present purposes it is sufficient to adopt the convenient summary provided by Mr. Hobbs KC (sitting as an Appointed Person) in BUILDXACT Trade Mark BL O/0934/23:

> *"The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that he or she has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in equation or that the Hearing Officer was wrong".*

I note only in addition, that a Hearing Officer will generally only have been *"wrong"* if he/she reached a decision that was outside the range of views that could reasonably have been taken on the established facts.

Grounds of Appeal

Inherent Distinctiveness of the Earlier Trade Mark: RABE

10. The Appellant submitted (primarily in its oral submissions) that Hearing Officer erred by finding that the Earlier Trade Mark (i.e. RABE) was inherently highly distinctive. It submitted that the error arose because the Hearing Officer should have found that RABE was not an invented word with no meaning to the relevant average consumer but instead was a word which had a meaning that was understood by the average UK consumer.

11. It was common ground that "RABE" is a word with, as a matter of fact, a meaning in German (i.e. "raven"). It is also the name of a particular type of broccoli ("broccoli rabe"). The evidence for such meanings was provided by the Appellant and is derived from the Meriam Webster dictionary. There was no other evidence before the Hearing Officer pertinent to how the average consumer in the UK would understand the word RABE.

12. The Hearing Officer found as follows:

> *46. Firstly, I do not consider that the UK average consumer for clothing goods would know that RABE is a type of broccoli. Secondly, as my assessment is from the perspective of the UK average consumer, the translation of RABE from German to English is redundant. Thirdly, I consider that the other conceptual meanings which have been proposed by the applicant, such as to tear down and a razor, would not be assigned to the conceptual meaning of RASE, especially because of the spelling of this word (using the letter S instead of Z). For those average consumers that pronounce the applicant's mark as RACE, the concept of a race may be assigned to the mark. However, I consider that a significant proportion of average consumers will see the applicant's mark, RASE, as an invented word with no conceptual meaning. On this basis, both marks evoke no meaning and thus the marks are conceptually neutral.*

13. The Hearing Officer went on to find that as the RABE was an invented word with no conceptual meaning, it was inherently distinctive to a high degree (Decision, para 49).

14. The Appellant sought to challenge these findings on, effectively, the basis of the same submissions it made to the Hearing Officer: that is to say by reference to submissions about the meaning RABE would have to an average UK consumer that were not supported by evidence (beyond the dictionary definition referred to above).

15. I reject those submissions for the following reasons:

    a. it was not suggested that the Hearing Officer erred in law.

    b. likewise, it was not suggested that the Hearing Officer had failed to take into account evidence before her that she ought to have done, or taken into account evidence she should not have done, and

    c. RABE is not a commonly used word in English. Given that, the Hearing Officer was fully entitled to find that, without evidence to the contrary, a substantial number of average UK consumers would view RABE as an invented word.

16. I therefore dismiss this ground of appeal.

17. I note here that in its skeleton of argument for the Appeal, the Appellant under the heading *"Distinctiveness of the marks"* makes submissions about the visual, aural and conceptual comparison of the Trade Mark and the Earlier Mark. I have taken those submissions in to account when considering those comparisons.

The Application of the decision in BL O/080/22 SLEEPIO v SLEEPIO

18. This Ground relates to the correct approach to comparing the Marks.

19. The Appellant submitted that the Hearing Officer erred in principle in reaching a decision which, it was submitted, was clearly inconsistent with the earlier decision in BL 0/080/22 SLEEPPRO v SLEEPIO ("SLEEPPRO").

20. In SLEEPPRO, the Hearing Officer in that case found that the marks SLEEPPRO and

SLEEPIO were:

a. were visually similar to an average degree,

b. aurally similar to below an average degree,

c. conceptually similar to a lower degree, and

d. there was no likelihood of confusion.

These findings are materially different from the equivalent findings in this case (see paragraph 7 above). A further significant difference between the findings in SLEEPPRO and the present case is that in SLEEPPRO the Hearing Officer found that the earlier mark was had a *"low level of distinctive character"*. I shall come back to that finding below.

21. The Appellant submitted that given the similarity in nature of the marks compared in SLEEPPRO and the marks compared in this case (e.g. as to length and letter positioning etc.), the Hearing Officer was wrong to reach materially different conclusions on visual, aural and conceptual similarity. Its reasons (which mirror those which were advanced before, and considered in detail by, the Hearing Officer) are set out below. However, in reading these submissions it must however be noted that the Appellant incorrectly writes "SLEEPRO", whereas the mark in question was "SLEEPPRO" and therefore had two Ps not one:

a. *"On analysis of both letters the word 'SLEEP' and 'O' in both marks SLEEPRO v SLEEPIO appear in the exact same order and positioning as within the marks RABE and RASE"*

b. *"As with RABE vs RASE, the point of difference is one letter. SLEEPRO and SLEEPIO with the R and I being one letter of difference in comparison with the B and S in this case"* [I note that as there are two Ps in SLEEPPRO, this is submission is not accurate]

c. *"Both marks of the exact same length as is the case with RABE v RASE"* [Again, this is not accurate]*;*

d. *Conceptually there is clearly a high association between both marks given the universally renowned word "SLEEP" at the front of the marks;*

e. *Both marks in the case of SLEEPRO and SLEEPIO were in the exact same class registration and it is clear that both marks had identical product or service offerings with the word SLEEP in both marks and the same category.*

22. The Appellant also submitted, that decisions from different Hearing Officer's ought to be consistent with each other.

23. I reject this ground of appeal for the following reasons:

a. SLEEPPRO is not a binding precedent. More importantly it sets out no new principle of general application. Nor does it purport to do so. It follows a well charted path, based on well-established principles (which apply equally in this case), and therefore turns entirely on its own particular facts. Finally, I note that if SLEEPPRO had purported to raise a new principle of general application I would, of course, have had to consider whether that principle was correct in law before following it in this case (as SLEEPPRO is not binding on me).

b. the Hearing Officer must decide the case on the facts before him/her. That decision making process necessarily has built into a margin of appreciation and one, as set out above in relation to *Axogen*, I should not interfere with without proper reason. It necessarily follows that two cases with similar, possibly very similar, facts may lead to two different conclusions. It therefore also follows that the existence of differing conclusions in and of itself cannot in my view be a reason in and of itself to interfere with an otherwise properly reasoned decision.

c. the Appellant's submissions proceed on the basis that the facts in the two cases are effectively identical. They clearly are not. Whilst there are some similarities (as the Appellant has pointed out), the pairs of marks being compared, the context in which those pairs of marks exist and the evidence available to the Hearing Officer all differ. Furthermore, even if I accepted that the four submissions set out in paragraph 20 above mean that the result of the comparison analysis of the marks

in SLEEPPRO and this case must be the same (which I do not), it remains the case that in SLEEPPRO the earlier mark had a low level of distinctiveness whereas in this case, RABE was found to have a high-level distinctiveness.

The Hearing Officer's analysis of the visual, aural and conceptual differences

24. The Appellant's arguments as to why the Marks are visually, aurally and conceptually different were ably advanced by Ms. Gowiely. However, those arguments were effectively the same as were advanced before the Hearing Officer. In my view they identify no error of principle (independent of the other matters raised on appeal), nor can it be said that the Hearing Officer was wrong based on the material before her. In those circumstances I dismiss these grounds of appeal.

The Original Decision of the IPO

25. The Appellant submitted that neither a) the IPO examiner who originally examined the Application for the Trade Mark nor b) the Trade Mark Attorneys who filed that Application on the Appellant's behalf, identified the Earlier Mark as a potentially conflicting trade mark.

26. For the purposes of this appeal, it is irrelevant whether an IPO Examiner or a Trade Mark Attorney failed to identify the Earlier Mark as potentially conflicting or indeed reached any decision different from that of the Hearing Officer. The question is not, as cases such as *Axogen* make clear, whether a different tribunal could have reached a different decision. What matters is whether the Hearing Officer reached a decision she was not entitled to reach.

27. I therefore dismiss this ground of appeal.

Comparison of Goods

28. The Appellant's arguments on appeal largely elided the issues relevant to the comparison of goods with those relevant to a likelihood of confusion. Nonetheless, it is clear that the Appellant did challenge the finding that the Article Goods were identical.

29. The Hearing Officer carefully recited the relevant principles for the comparison she had to make by reference to a) "*Canon"* C-39/97, *"Treat"* [1996] RPC 281 and "*Meric"* T-133/05. The Appellant did not directly criticize this analysis. In my view, the Hearing Officer's the analysis was entirely correct.

30. For present purposes I need only highlight two points relating to the correct approach in law:

    a. *"goods can be considered as identical when the goods designated in the earlier mark are included in a more general category, designated by the trade mark application, or where the goods designated by the trade mark application are included in a more general category designate by the earlier mark"* (per *Meric*);

    b. the comparison relates to the goods specified for the marks. The assessment is notional – i.e. the question relates to how the goods within those specifications could be used and sold (see *O2 Holdings & Anor v Hutchinson 3G UK Limited*, C-533/06 paragraph 66).

31. The Hearing Officer found that the following goods were identical:

Trade Mark	**Earlier Mark**
Articles of clothing for men, women, children and infants Underwear and outerwear for men, women, children and infants	Clothing
Footwear for men, women, children and infants	Footwear
Headwear for men, women, children and infants	Hats

32. The Appellant sought to criticize this finding on the basis of submissions it made about the alleged use made of the RABE mark by the Opponent. In this respect it submitted that the Opponent had no presence in the UK, did not compete with the Appellant's brand, served different market, and was brought to market via different channels. However, as the Hearing Officer found correctly, none of this is relevant to a notional comparison of

the Marks (noting that there was no challenge in relation to non-use of the Earlier Mark). I should also note that (as stated in paragraph 5 above) there was no "non-use" challenge to the Earlier Mark and the assertions about the lack of market presence of RABE in the UK were not supported by evidence from the Appellant.

33. In my view the Hearing Officer's assessment that the goods set out above are identical is clearly correct.

34. I therefore dismiss this ground of appeal.

Likelihood of Confusion

35. For the reasons set out above, I have upheld Hearing Officer in relation to the precursors to her decision on the likelihood of confusion that were challenged on appeal: i.e. the distinctiveness of the Opponent's mark, the comparison of the Marks, and the comparison of goods and comparison of services.

36. As to the Hearing Officer's analysis of the likelihood of confusion itself I find as follows. The Appellant has identified no error of principle which would, in my view, entitle me to interfere with the Hearing Officer's analysis of the likelihood of confusion. That analysis:

    a. recites and seeks to apply the relevant legal principles;

    b. provides a summary of the evidence that was not (beyond the matters I have already addressed) materially criticized on appeal, and

    c. draws what is in my view a perfect reasonable conclusion on the likelihood of confusion based upon that evidence.

I note here that in reaching this conclusion I have taken into account the Appellants submissions I have grouped and discussed below under *"Other Matters Raised on Appeal"*.

Other Matters Raised on Appeal

37. The Appellant made a number of additional submissions grouped under the heading *"Legal Grounds to register RASE under Class 25, Articles of Clothing"*. Whilst these submissions were raised in detail under eight different sub-headings, they all seek to justify the same fundamental point: - i.e. that the most appropriate specification in relation to the use of the Trade Mark on the Appellants goods, being clothing/fashion items, must include the Article Goods. The nub of this argument appears to be that Appellant should be allowed to register the Trade Mark for the Article Goods due to its need to use the trade mark in relation to Article Goods, and the facts that others in the industry have used their marks for Article Goods.

38. The trouble with all these submissions is that none of them bite on the considerations relevant to the Hearing Officer's decision under s. 5(2)(b). They do not bite because they all proceed in a vacuum in which the consideration of the Earlier Mark does not take place at all. I therefore dismiss these grounds of appeal.

CONCLUSION AND COSTS

39. For the reasons given above I dismiss this appeal. The Trade Mark will proceed to registration only the basis of the Parts Goods.

40. The Respondent has been the successful party. I therefore order that the Appellant should pay the Respondent £1,200 by way of costs of this appeal within 28 days of the date of this decision, comprising:

    a. preparation of skeleton argument: £600, and
    b. attendance at hearing: £600.

GEOFFREY PRITCHARD