

O-439-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2539660
BY ANTON HICKS TO REGISTER THE TRADE MARK:**



IN CLASSES 9 & 41

AND:

**OPPOSITION THERETO UNDER NO. 100683
BY UNIVERSAL MUSIC – MGB NA LLC**

BACKGROUND

1. On 19 February 2010, Anton Hicks applied to register the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 9 April 2010 for the following goods and services:

Class 9 - Recorded media, downloadable electronic publications; compact discs; digital music.

Class 41 – Entertainment.

2. On 7 July 2010, Universal Music MGB NA LLC (“the opponent”) filed a notice of opposition directed against all of the goods and services in Mr Hicks’ application. The opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which the opponent relies upon all of the goods and services in:

CTM no. 3811312 for the mark: **KILLER TRACKS** applied for on 30 April 2004 and which completed its registration procedure on 25 July 2005. It stands registered for:

Class 9 - Sound storage media, image storage media and data storage media, all being prerecorded.

Class 16 - Printed materials.

Class 41 - Providing music for use in production of television shows, television advertisements, motion pictures, video recordings, in-house productions, and multimedia applications; music publishing services; providing information about and performances of musical artists by means of a global computer information network.

In its notice of opposition the opponent stated:

“4. It is the view of the opponent that the mark KILLER CHORUS is similar to the mark KILLER TRACKS given the identity of the distinctive and dominant component of each of the respective marks, namely, KILLER. Further, the CHORUS element of the applicant’s mark is conceptually similar to the TRACKS element of the opponent’s mark, both of which possess musical connotations.

5. Moreover, it is the view of the opponent that the respective marks cover identical and similar goods and services...”

3. On 10 September 2010, Mr Hicks filed a counterstatement in which the ground of opposition is denied. The basis of Mr Hicks defence is, inter alia, that the word KILLER has a well known descriptive/laudatory meaning, and, as a consequence, there is no likelihood of confusion between the competing marks.

4. In a decision issued “from the papers” on 2 September 2011, the Trade Marks Registry (“TMR”) determined the opposition in the opponent’s favour; a copy of that decision can be found on the website of the Intellectual Property Office (“IPO”) under BL-O-308-11. In that decision, the hearing officer concluded:

“47. Nonetheless, in all the circumstances, noting in particular the absence of crucial evidence from Mr Hicks, I find that there is likelihood of confusion in relation to all the goods and services specified. Even if the average consumer may not ‘directly’ confuse the marks one for the other, given my analysis of the distinctive and common element, it is likely that he or she may conclude that Mr Hicks’ mark is a another brand of the owner of Universal’s mark” (my emphasis).

5. Mr Hicks appealed to the Appointed Person (“AP”) against that decision. In his decision dated 30 October 2012 (a copy of which can be found under BL-O-431-12), the AP, Mr Geoffrey Hobbs QC, stated:

“38. I am satisfied that the Hearing Officer’s reasoning noted in paragraphs [18] to [23] above led to the distinction between evidence and submissions being over-rigidly applied in the decision under appeal and, as a consequence of that, to an imbalance in the weighing of the factors relevant to the determination of the objection to registration under Section 5(2)(b).

39. With regard to point (1), I am satisfied that the Applicant did not appreciate the distinction between ‘evidence’ and ‘submissions’ and the potentially adverse consequences for him of not adhering to it. That, in combination with the shortcomings I have referred to above in connection with points (2) and (3), rendered the conduct of the proceedings substantially defective.

Conclusion

40. For the reasons I have given the appeal is allowed and the Hearing Officer’s decision and order as to costs are set aside. The opposition is remitted to the Registry for further consideration and further directions as to how it should proceed in accordance with the Act and the Rules. The costs of the proceedings to date (including the costs of this appeal) are reserved to the Registrar upon the basis that the question of how and by whom they are to be borne and paid will be determined at the conclusion of the opposition in accordance with the usual practice. “

6. On its return to the TMR, both parties were given (and availed themselves of) an opportunity to file evidence/further evidence. The matter came to be heard on 10 September 2013. At the hearing, Mr Steven Lane of Lane IP represented the opponent; Mr Hicks represented himself.

EVIDENCE

Evidence & submissions filed at first instance

7. At the hearing, both parties agreed that the hearing officer's summary of the evidence and submissions filed at first instance was accurate. In those circumstances, there is no need for me to repeat them here. I will, of course, keep them in mind when reaching a decision.

Mr Hicks' further evidence & submissions

8. This consists of two witness statements from Mr Hicks. The first, dated 29 January 2013, is accompanied by 12 exhibits and written submission of the same date. The second statement, dated 8 June 2013, is accompanied by 3 exhibits.

The opponent's further evidence & submissions

This consists of a witness statement and 6 exhibits from Mr Lane dated 8 July 2013, accompanied by written submissions of the same date.

9. Whilst I do not propose to summarise the evidence and submissions filed here, as I explained to the parties at the hearing, I have read all of the evidence and submissions filed and will bear them all in mind when reaching a conclusion. I will, however, refer to specific parts of the evidence and submissions later in this decision.

DECISION

10. 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, or

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

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question,

taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published (i.e. 9 April 2010) and the date on which the earlier trade mark completed its registration procedure (i.e. 25 July 2005), the earlier trade mark is not subject to proof of use, as per section 6A of the Act.

Section 5(2)(b) – case law

13. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O-330-10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services and then to determine the manner in which these goods and services will be selected by the average consumer in the course of trade. In their skeleton arguments and at the hearing, the parties stated that they operated: “in exactly the same field” (the opponent) and: “in a similar area of the music business” (Mr Hicks).

15. Insofar as the competing goods in class 9, “entertainment” (in Mr Hicks’ application in class 41), “printed materials” in class 16, “music publishing services” and “providing information about and performances of musical artists by means of a global computer information network” (in class 41 of the earlier mark) are concerned, the average consumer is a member of the general public. In relation to the other services in class 41 of the earlier mark i.e. “providing music for use in production of television shows, television advertisements, motion pictures, video recordings, in-house productions, and multimedia applications”, the average consumer is more likely to be a specialist user selecting music for use in the specific fields identified. As to how the goods and services will be selected, insofar as the goods and services directed at the public are concerned, this is likely, in my experience, to consist primarily of a visual act having encountered the marks in, for example, traditional retail settings, in catalogues and on websites; whilst oral/aural considerations cannot be discounted they are, I think, likely to feature to a much lesser extent in the selection process. Similar considerations will, I think, also come into play when the position is considered in relation to the specialist user I have identified above, with trade publications and more particularly websites directed at the trade likely to feature in the selection process. Whilst a member of the public is likely to display a reasonable level of attention when selecting, for example, pre-recorded music, I agree with Mr Hicks that the consumer’s attention is more likely to be focused on the name of the artist than the label upon which the artist appears (although I accept that may not always be the case). The likely importance of selecting the most appropriate music for use in, for example, a television programme or motion picture (and, inter alia, the not insignificant sums that are likely to be in play), points, in my view, to the specialist user paying a high level of attention to the selection of the services at issue.

Comparison of goods and services

16. In reaching a conclusion, I will keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

17. At the hearing, Mr Lane said:


“As the Opponent’s mark covers sound storage media, this must be considered identical to recorded media and also compact disc and digital media. Also,

I would say, image storage media would be considered similar to downloadable electronic publications, as well as "printed materials" in Class 16 in the Opponent's mark. Class 41, as obviously the Applicant has filed for a very broad term there, meaning "entertainment", we must assume that this is intended to be covering music publishing services, given that is the activity with which the Applicant is active; and therefore, those services are specifically covered by the Opponent's mark." [page 10 of the transcript]

18. I agree. Mr Hicks' goods in class 9 are, as the opponent argues, either identical, or if not identical, highly similar to the opponent's goods in classes 9 and 16. As the opponent's "music publishing services" and "providing information about and performances of musical artists by means of a global computer information network" in class 41 would both be encompassed by the broad term "entertainment" included in Mr Hicks' application in that class, the competing services are identical on the principle outlined in *Meric*. At the hearing, Mr Hicks did not dispute that the competing goods and services were identical or highly similar.

Comparison of marks

19. The competing marks are as follows:

The opponent's mark	Mr Hicks' mark
KILLER TRACKS	

20. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective marks.

21. The opponent's mark consists exclusively of the words KILLER and TRACKS presented as separate words in upper case. Mr Hicks' mark consists of three elements. The first figurative element is a dark blue circle inside which the second figurative element, presented in white, occupies a substantial portion of the circle. I note that at one point in his submissions, Mr Hicks stated:

"We hope a viewer will empathise with our two matchstick characters, on an equal footing, supporting & looking out for each other, back to back against the infinite blue."

Whilst the opponent argues that this second figurative element will be seen as “play” and “fast forward” or “play” and “forward/rewind” symbols (thus bringing it closer to the use made of its own mark), at the hearing, Mr Lane accepted that the comparison I must make is between the mark applied for and the opponent’s mark as registered, not how it may be used. If the second figurative element of Mr Hicks’ mark conveys any meaning at all to the average consumer (which, in my view, is arguable), it is much more likely, in my view, to be of two letter Ks presented in mirror image. Below this second figurative element and in much smaller text, appears the third element i.e. the conjoined words KILLER and CHORUS presented in white in upper case.

22. As to the distinctive and dominant elements of the competing marks, whilst the circular device in Mr Hicks’ mark is, given its size, a dominant element, the propensity of those in all areas of trade to use simple geometric shapes such as circles as elements of marks, combined with the fact that in Mr Hicks’ mark the circular device is acting as a background, means that it is not a distinctive element. The same is not true of the second figurative element which, in my view, is both a dominant and (for the reasons indicated above) a distinctive element of the mark, as is the combination of these figurative elements. Although both parties have provided evidence from a range of dictionaries as to the meaning of the words TRACKS and CHORUS, at the hearing, Mr Lane indicated that he did not have “any difficulties” with the definitions provided by Mr Hicks in his exhibit 9. I think that in the context of the goods and services of interest to the parties’, the average consumer would be very familiar with the meaning of both words. However, for the avoidance of doubt, exhibit 9 to Mr Hicks’ statement indicates that www.collinsdictionary.com defines “track” as, inter alia:

“10. a path on a magnetic recording medium, esp magnetic tape, on which information such as music or speech, from a single input channel is recorded;

11. any of a number of separate sections in the recording on a record, CD or cassette.”

The same dictionary defines “chorus” as, inter alia:

“1. Music

c. a line or group of lines repeated at intervals in a song;

e. a body of singers who perform choral compositions, usually having more than one singer for each part.”

23. It is, I think, fair to say, that when considered in the context of the goods and services of interest to the parties in these proceedings, both parties accepted that the words TRACKS and CHORUS considered individually were descriptive and non-distinctive. That leaves the meaning of the word KILLER to consider when it is combined with TRACK and CHORUS. Not surprisingly, it was the meaning of this word which gave rise to the vast majority of the evidence filed and submissions made at the

hearing. In his skeleton argument, Mr Lane summarised the parties' respective positions in the following terms:

"5...In relation to the word KILLER, the parties take different positions: the opponent believes the word would be taken by the average consumer as having its literal meaning of "to kill" whereas the applicant believes the word would be seen as a slang term having laudatory meaning..."

24. In reaching a conclusion on the distinctiveness of the word KILLER, I note that in his decision mentioned above, the AP said:

"29. With regard to point (2), the Hearing Officer rightly recognised that dictionaries and works of reference may indicate how a word or expression can be used or understood without also providing any indication as to how likely or unlikely it is to be understood in any of the ways indicated when used commercially in the context and manner envisaged by the trade mark application and the earlier trade mark registration he was considering. However, that did not require him to proceed upon the basis that dictionaries and works of reference could only be considered if the information they provided was verified by evidence. He should have accepted that it was open to him to take account of the information they provided for what it might be thought to be worth in relation to the matters in issue before him.

...

33. Moreover, it is not legitimate to exclude dictionary references from consideration on the basis that they relate to the meaning and significance of a word or expression in (as the Hearing Officer put it in footnote 1 to paragraph [8] of his decision) the realm of slang. The need for due weight to be given to pertinent slang usage is well-understood and cannot be denied.

...

36. The question is not whether a trade mark tribunal can take account of the contents of dictionaries and works of reference (it can) but whether upon doing so it can be satisfied that they provide information which is pertinent to the assessment it is required to make. The weight to be given to pertinent references is a matter which falls to be considered and evaluated in the context of the evidence as a whole

37. I think it is clear that the reference in Chambers Dictionary (2003) should have been regarded as pertinent to the assessment that the Hearing Officer was required to make in the present case:

KILLER: 'adj (sl) spectacularly impressive, stupendous.

and none the less so in circumstances where cross-checking identifies references to KILLER in the Pocket Oxford Dictionary (8th Edition, 1992) as:

colloq. a. impressive, formidable, or excellent thing

and in the Shorter Oxford English Dictionary (5th Edition, 2002) as:

impressive, admirable, formidable. slang instancing Arena Woody Allen can still knock out killer one liners and City Limits Sometimes James Brown's albums stank, but there was always one killer track."

25. As the AP points out, it is appropriate for me to take into account the contents of dictionaries and works of reference (including references to slang), if I am satisfied that in doing so the information they provide is pertinent. What weight I give to such references must be evaluated in the context of the evidence as a whole. In reaching a conclusion, my starting point is the dictionary references mentioned by the AP in his decision. These references show that from as early as 1992 (i.e. some 12 years before the opponent applied for its mark), the *Pocket Oxford Dictionary* defined KILLER as: "colloq. a. impressive, formidable, or excellent thing" and that by 2002 and 2003 respectively (i.e. prior to the application date of the opponent's mark), the *Shorter Oxford English Dictionary* and *Chambers Dictionary* respectively defined the word as: "impressive, admirable, formidable. slang instancing Arena Woody Allen can still knock out killer one liners and City Limits Sometimes James Brown's albums stank, but there was always one killer track" and "adj (sl) spectacularly impressive, stupendous".

26. Thus it appears that since at least as early as 1992, the word KILLER has been used in a slang or colloquial sense to mean something that is impressive or formidable. The question then becomes how likely it is that by the date of Mr Hicks' application in 2010 the word KILLER will be understood in this way by the average consumer in the UK when it is used commercially in the context and manner envisaged by the application and registration in these proceedings.

27. Although Mr Hicks represented himself at the appeal hearing mentioned above, at which the distinction between evidence and submissions was discussed in some detail, a significant number of the documents he filed to support his case when the proceedings were returned to the TMR suffered from a range of defects which might have been avoided. For example, Mr Lane pointed out that a number of Mr Hicks' exhibits consisted of information obtained by him from websites which Mr Hicks then copied into a word processing package (rather than filing copies of the actual websites). As a consequence, Mr Lane considered the "integrity or accuracy" of much of the evidence could not be relied upon, and at the hearing he took me through Mr Hicks' evidence in some detail pointing out what he considered to be its shortcomings. At the hearing, I noted that Mr Hicks' witness statements included the following text:

"I...state the following exhibits to be true, unadulterated downloads from the Internet at the time of writing (or otherwise date recorded – within a page of their first mention – in my submissions." (statement dated 29 January 2013)

And:

"I...state the following to be true screen-prints from the Internet at the time of writing (or otherwise date recorded on the screen print." (statement dated 8 June 2013).

28. Whilst there is no suggestion that Mr Hicks took anything but reasonable care in copying the information he obtained from the Internet into the various exhibits he provided, as I explained to him at the hearing, as copies of the actual websites upon which he relies have not (for the most part) been provided, many of Mr Lane's criticisms of his evidence are valid, a point he appeared to accept. However, as I also explained to the parties at the hearing, Mr Hicks' exhibits were nevertheless evidence in the proceedings, and I would, whilst keeping Mr Lane's comments firmly in mind, give Mr Hicks' evidence whatever weight I considered appropriate.

29. Of the **exhibits** Mr Hicks provided, **1** is described by him as: "a list of the IPO's laudatory registrations for KILLER marks" and **12** is described as showing: "several existing - registered – shared classes with no apparent confusion." Both exhibits consist of details of UK and Community marks which contain the word KILLER which Mr Hicks has copied into a word processing package. However, state-of-the-register evidence of this type is, as Mr Lane pointed out in his written submissions, unlikely to be relevant because it does not show what is happening in the market place.

Exhibit 2 is described by Mr Hicks as: "from the IPO site sees the laudatory "killer" used conversationally." The exhibit consists of two references obtained from the IPO website which have been copied into a word processing package. The first relates to a trade mark application filed in September 2010 in class 25 for the mark: "I am wearing killer heels...and I am not afraid to use them"; exhibit SJL7 to Mr Lane's statement indicates that this application was withdrawn. The second is a reference which appears to date from 2011 and includes, inter alia, a reference to: "We found about 20,000 patents filed by market leaders and inventors. Some were just a nuisance. Others were killer applications...". However, as the actual extract has not been provided and as Mr Lane was unable to locate and verify this reference, it does little to assist Mr Hicks.

Exhibit 3 of the first witness statement is described by Mr Hicks as: "the laudatory KILLERs from Companies House with several in the music business". It consists of a list of UK companies who have the word KILLER in their company name and which has been copied into a word processing package. Exhibit 3 to his second witness statement consists of screen prints obtained on 19 May 2013 in relation to five of these companies. At the hearing, Mr Lane said of this exhibit:

"I think all of the evidence that was resubmitted in relation to exhibit 3, again does not show laudatory use..." [page 6 of the transcript]

Much like the existence of a range of registered marks which incorporate the word KILLER, the mere presence of the word KILLER in a number of company names, does little to assist Mr Hicks.

Exhibit 4 is described by Mr Hicks as clarifying: "how long the Indians have been formally using "killer apps"." It consists of two extracts obtained from Wikipedia which have been copied into a word processing package. The extracts are indicated as dating from 1989. The first extract is said to include a reference to "OS/2: Waiting for the Killer Applications." However, even if printouts had been provided, two examples dating from 1989 which appear to originate in the USA do little to assist Mr Hicks.

Exhibit 5 is described by Mr Hicks as: "starting with "apps", is an A-Z of everyday websites using a laudatory "killer". The references provided which have been copied into a word processing package, are incomplete and as no printouts from the websites concerned have been provided this exhibit does little to assist Mr Hicks. However, this exhibit does contain an image of the opponent's "Promo Reel" from 2012 which appears on www.youtube.com which Mr Hicks notes contains the words "LIVE CHOIRS & ORCHESTRA" and "KILLER SOUND" and of which Mr Hicks says: "Killer sound is not a brand name. It's simply telling us their choirs and orchestra are killer."

Exhibit 6 consists of references obtained from www.urbandictionary.com in relation to the word KILLER which have been copied into a word processing package. The exhibit indicates that Killer can mean, inter alia, "1 "very cool", "That laser light show was killer!", "2 an adjective used to describe high quality thc based substances. damn, those are killer thai sticks", "3. A name given to someone who suddenly becomes overaggressive and violent", "5 Excellent, outstanding, extremely satisfying. Very powerfull. Have you tried the burgers at the new choke and puke? They are killer. That was one killer movie we say last night." At the hearing, Mr Lane said of this exhibit:

"I think it is always very important to be very wary about urban dictionary definitions...My point is that there are certainly a number of terms in that urban dictionary that nobody has ever heard of. I appreciate that is the same for an ordinary dictionary, but it must have less probative weight than a normal dictionary would have..." [page 6 of the transcript]

Exhibit 7 is described by Mr Hicks as: "26 global voices using the term "killer tracks" to describe their favoured music." It consists of references to, inter alia, a range of websites. Exhibit 1 to his second witness statement consists of screen prints obtained on 17 and 18 April 2013 from the websites mentioned. At the hearing, Mr Lane said of this exhibit:

"So, my point in relation to all of that exhibit is that certainly the majority appear to be either blog references, which must be considered to have a low sort of

probative value in terms of assessing the laudatory nature or otherwise of these terms; secondly, the majority are US based...Also, in terms of the relevant dates, we have many of these that are not dated; so, it is unclear as to when these terms are being used and, therefore, when you can argue that the term is considered to be a slang term or a common use. For all these reasons, we do not believe that those particular exhibits are of any value.” [page 8 of the transcript]

Of the screen prints provided which can be attributed to the UK, (f) appears to be undated. It comes from www.amazon.co.uk and contains the following: “...Basement Jaxx have prolifically delivered killer tracks ever since...”, (k) appears to be undated. It comes from ukmusicreviews and contains the following: “...you won’t forget; features killer tracks like...”, (p) comes from castlespoliersblogspot.co.uk and appears to date from 2012; it contains the following: “ The suspicious diva must have some really killer tracks”, (q) appears to be undated and comes from www.brighton-rock.net/; it contains the following; “You’ve got six killer tracks on this CD” and (s) appears to date from September 2012 and comes from sleazybeats.blogspot.co.uk; it includes the following; “Whiskey Disko signed four killer tracks by YSE...”

Exhibit 8 is described by Mr Hicks as having: “7 non Universal websites using “killer tracks” on their domain or (home page) title.” Exhibit 2 to the second witness statement consists of screen prints obtained on 18 April 2013 of the sites referred to. At the hearing, Mr Lane said of this exhibit:

“So, once again, out of all of those, the most relevant was really the first, but of course that is our client’s own website, because that is really the only form of sort of, I would say, its trade mark use, and also the rest are blog entries or references again outside of the United Kingdom.” [page 9 of the transcript]

Of the screen prints provided which can be attributed to the UK, page 3 is dated 28 February 2012 and comes from www.midlandrocks.co.uk; it contains, inter alia, the following: “Peter Keevil takes control of the wifi airwaves to bring you 40 mins of Killer “no filler” Tracks”.

Exhibit 10 consists of screen prints taken from the websites of Channel 4 and E4 television. At the hearing, Mr Hicks confirmed these prints related to the position at Christmas/new year 2012/2013. I note that the exhibit contains a reference to, for example: “4Music – Gallery – Nichole Scherzinger’s Killer No.1’s!”.

Having concluded his review of Mr Hicks’ evidence, at the hearing, Mr Lane went on to say:

“Just to reiterate, I have just been through all the exhibits there. The onus here, or certainly what the applicant is trying to argue, is that the term “killer” is a laudatory term, and is also trying to argue that “killer tracks” is a laudatory term. But as you will see from the majority of those exhibits, they are all US originating; and I come back to my point earlier that if it is a US slang terms and UK slang

terms, you cannot just say that because one is slang in one country, it is also in the other.” [page 9 of the transcript]

30. Insofar as the opponent’s evidence is concerned, the vast majority has been provided to rebut Mr Hicks’ evidence and submissions. Exhibit SL2 to Mr Lane’s first statement consists of extracts taken from the opponent’s production music website www.unippm.co.uk. Although the extracts are of poor quality and, it appears, undated, Mr Lane points to the use of the word KILLER in combination with: ANIMATION, LATINO, SCORES SET, PROMOS, STAGE and SCREEN. Exhibit SL5 to Mr Lane’s second statement, consists of screen prints obtained using the internet archive waybackmachine which shows how the opponent’s website www.killertracks.com looked on 20 December 2001, 7 June 2004 and 4 January 2010; there is also a screen print from April 2013. I note that the mark KILLER TRACKS has been presented in, inter alia, the following manner:

KILLER TRACKS

I also note that the screen print from June 2004 includes the following text:

“By now you’ve either heard or used our music, and certainly you are aware that only KILLER TRACKS possess that distinctive killer sound...”

31. The vast majority of Mr Hicks’ evidence does little to assist him, for many of the reasons put forward by Mr Lane. That said, the dictionary references set out above (which date from 1992, 2002 and 2003) coupled with the proximity of the dates of those screen prints which originate from the UK (exhibits 7, 8 and 10) and the date of filing of Mr Hicks’ application, confirm my own view that the word KILLER would have been understood by the average consumer of the goods and services at issue in the UK at that latter date as a slang or colloquial word meaning e.g. impressive. The evidence which originates from outside the UK (primarily the USA) simply confirms that the word appears to have the same meaning in that jurisdiction. Having reached that conclusion, the word KILLER is not, in my view, a distinctive or dominant element of either parties’ marks. Given the descriptive meanings I have already attributed to the words TRACKS and CHORUS, whatever distinctiveness the opponent’s earlier mark possesses can only lay in the combination of KILLER and TRACKS it creates rather than in the individual elements of which it is made up. Insofar as Mr Hicks’ mark is concerned, the distinctiveness lays in the combination of the figurative elements of the mark together with the words KILLERCHORUS, rather than in the words KILLERCHORUS, which as a combination is neither a distinctive nor dominant element of his mark and which, at the hearing, he accepted was: “such a descriptive term.” I shall approach the visual, aural and conceptual comparison with those conclusions in mind.

32. Although both parties’ marks contain the word KILLER presented in upper case, the presence in Mr Hicks’ mark of a dominant and distinctive figurative element, results, in my view, in only a low/moderate degree of visual similarity between them. Insofar as the

aural comparison is concerned, it is well established that when a mark consists of words and a device, the average consumer is most likely to refer to the mark by the words. As the words KILLER, TRACKS and CHORUS will be well known to the average consumer, their pronunciation (as three and four syllable expressions respectively) is entirely predictable. Considered overall, the competing marks are aurally similar to a fairly high degree. When considered from a conceptual perspective, the word KILLER will, in my view, be understood by the average consumer to mean impressive. As the words TRACKS and CHORUS will, when considered in the context of the goods and services of interest to the parties, be construed in a musical context, the competing marks are conceptually similar to a fairly high degree.

Distinctive character of the earlier mark

33. I must now assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods and services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

34. Although the opponent has filed some examples of its KILLER marks in use, at the hearing Mr Lane accepted that as the opponent has not filed any evidence putting this use into context, for example, figures relating to turnover, promotion, market share etc., I have only the inherent characteristics of its KILLER TRACKS mark to consider. I have already concluded that when considered in the context of the goods and services of interest to the parties, both words in the opponent's mark are descriptive and non-distinctive. When considered as a totality, any inherent distinctiveness the combination KILLER TRACKS possesses must be at the very lowest level.

Likelihood of confusion

35. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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 services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

36. Earlier in this decision I concluded that: (i) insofar as it is relevant, the average consumer is a member of the public who will select the goods and services at issue by primarily visual means and will pay a reasonable level of attention when doing so, (ii) the goods and services are identical or highly similar, (iii) the word KILLER is neither a distinctive nor dominant element of either parties' marks, (iv) the second figurative element (the mirrored letter Ks) and the combination of figurative elements are the distinctive and dominant elements of Mr Hicks' mark, (v) any distinctiveness in the opponent's mark can only lie in its totality, (vi) the marks are visually similar to a low/moderate degree and are aurally and conceptually similar to a fairly high degree and (vii) the opponent's mark is inherently distinctive to a very low degree.

37. As Mr Lane argued at the hearing, and as is made clear in the decision of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, it is not permissible for me to regard the opponent's earlier mark as having no distinctive character. However, given what I consider to be the descriptive/non-distinctive nature of the words of which it consists, I have already concluded that any distinctiveness it has can only lay in the mark as a whole. In reaching a conclusion on the likelihood of confusion, I note the following comments of the CJEU in *L'Oréal SA v OHIM – Case - C-235/05 P*:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

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.”

38. I begin by reminding myself of the identity/high degree of similarity in the goods and services and the fairly high degree of aural and conceptual similarity between the competing marks. I also remind myself that visual considerations are likely to dominate the selection process and that, in my view, the marks at issue share only a low/moderate degree of visual similarity. Even if I assume (contrary to my primary finding) that the average consumer will pay only a low degree of attention when selecting the goods and services at issue, I am satisfied that at the material date in these proceedings the presence in both parties’ marks of the descriptive/laudatory word KILLER combined with the very low level of inherent distinctive character the earlier mark possesses, is insufficient to give rise to a likelihood of either direct confusion (i.e. where one mark is mistaken for the other) or indirect confusion (i.e. where the average consumer assumes the undertakings are economically linked). Much more likely, in my view, is that the average consumer in the UK who, at the material date, would have been familiar with the descriptive/laudatory use of the word KILLER, will simply assume that the shared use of this word in the marks at issue is a result of unrelated undertakings wishing to extol the virtues of their particular goods and services rather than assuming a trade connection between them.

Conclusion

39. The opposition based upon section 5(2)(b) of the Act fails.

Costs

40. As Mr Hicks has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. At the hearing, Mr Hicks confirmed that other than the drafting of his appeal to the AP (for which he obtained professional representation), he has represented himself.

41. The AP’s decision to remit the proceedings back to the TMR was, in large part, a result of a lack of understanding on Mr Hicks’ part on the distinction between evidence and submissions, to which the AP felt the official letter issued by the TMR at that time was a contributory factor. What is beyond argument is that there was no fault on the part of the opponent. In terms of the restored proceedings, a good deal of Mr Hicks’ evidence was not correctly filed i.e. relevant printouts were not provided. However, as Mr Lane pointed out at the hearing these “...still required looking into”; a point with which I agree as did Mr Hicks at the hearing when he said:

“Instead, it is intelligence insulting, since he [the opponent] has already spent many hours, perhaps with his team, checking every single killer track and everything else, in my submission.” [page 25 of the transcript].

42. Whilst I accept that Mr Hicks’ evidence would have taken him some time to prepare, given its nature and bearing in mind the opponent’s submissions filed on 8 July and Mr Lane’s submissions on Mr Hicks’ evidence at the hearing, I have no doubt that the investigation of Mr Hicks’ evidence by the opponent was proportionate and would have taken the opponent some considerable time. In those circumstances, I do not intend to make any award to Mr Hicks in respect of the preparation of his evidence. Mr Hicks however, is entitled to a contribution towards the costs he incurred in reviewing the notice of opposition and filing his counterstatement, reviewing the opponent’s evidence and his preparation for and attendance at the hearing. Using the TPN mentioned as a guide, but bearing in mind the original decision at first instance and the appeal against it, I award costs to Mr Hicks on the following basis:

Preparing a statement and considering the opponent’s statement:	£100
Considering the opponent’s evidence:	£100
Preparing for and attending a hearing:	£300
Total:	£500

43. I order Universal Music MGB NA LLC to pay Anton Hicks the sum of **£500**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of November 2013

C J BOWEN
For the Registrar
The Comptroller-General