O/0944/23

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK REGISTRATION NO. 1636034

IN THE NAME OF FIREHEART MUSIC, INC.

AND

OPPOSITION THERETO UNDER NO. 434707

BY XILIN GOL LEAGUE XIYANG MUTTON INDUSTRY CO., LTD

Background and pleadings

1. On 27 November 2021, Fireheart Music, Inc. ("the holder") applied to protect international trade mark registration number 1636034 for the words "DEEP SLEEP MUSIC COLLECTIVE" ("the contested mark") in the UK. The trade mark was accepted and published in respect of the following goods:

> Class 9: Audio recordings featuring relaxation, yoga and sleep sounds; audio and video recordings featuring music and artistic performances; digital music downloadable from the internet; downloadable music files; musical recordings; musical sound recordings; series of musical sound recordings; sound recordings featuring relaxation, yoga and sleep sounds; downloadable mp3 files and mp3 recordings featuring relaxation, yoga and sleep sounds; downloadable musical sound recordings.

2. The mark includes a disclaimer to the effect that "Registration of this designation shall give no right to the exclusive use of the words 'MUSIC COLLECTIVE'".

3. Xilin Gol League Xiyang Mutton Industry Co., Ltd ("the opponent") opposes the trade mark on the basis of ss. 3(1)(b) and (c) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the specification. The claim is put as follows:

> "The mark has an immediate and clear meaning in relation to the Class 9 music and audio goods covered and the relevant consumer will simply see the mark as denoting a collection of music for the purposes of deep sleep. This is supported by the disclaimer on the register for the wording 'MUSIC COLLECTIVE' and also the goods covered by [the contested mark] which specially refer to "*relaxation, yoga and sleep sounds*". As such, the mark is devoid of any distinctive character and is descriptive of the goods covered" (original emphasis).

4. The opponent also pointed to the fact that the US trade mark upon which the international registration is based is on the US supplementary register for descriptive and non-distinctive marks, and that other territories have refused registration on the grounds of non-distinctiveness.

5. The holder filed a counterstatement in which it denied the basis of the claims.

6. Only the opponent filed evidence in these proceedings. The holder elected to file written submissions during the evidence rounds, which I will keep in mind.

7. Neither party requested a hearing; the opponent filed written submissions in lieu. This decision is taken following a careful reading of all of the papers.

8. The opponent is represented by Lane IP Limited and the holder by Dummett Copp LLP.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

Evidence

10. The opponent's evidence is given by Matthew Bedford, who is an Associate at the opponent's representatives. His evidence contains information about the registration upon which the contested mark is based, as well as evidence concerning the different elements of the contested mark, their meaning and use. I will refer to the evidence in more detail as appropriate in this decision. It suffices to note here that I have read all of it.

11. Mr Bedford was not cross-examined.

Relevant legislation

12. So far as is relevant, s. 3(1) of the Act reads:

> "3.— Absolute grounds for refusal of registration
>
> (1) The following shall not be registered—
>
> (a) […]
>
> (b) trade marks which are devoid of any distinctive character.

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) […]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

13. There is no claim to acquired distinctiveness. The relevant date for determining whether the mark is objectionable under the above grounds is the date of designation, i.e., 27 November 2021.

Section 3(1)(c)

14. The case law under s. 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows (certain references omitted):

"91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

[…]

36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it.

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration

as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (Koninklijke *KPN Nederland*, paragraph 57).

[…]

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods

or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).'

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

15. The assessment is to be made through the eyes of the average consumer.[1] In this case, that is a member of the general public. The average consumer's level of attention is likely to be medium: the goods are fairly commonplace, frequent and inexpensive

[1] *Matratzen Concord AG v Hukla Germany SA,* Case C-421/04, EU:C:2006:164.

purchases but they are not the most casual, everyday purchases and some care will be taken to ensure that the contents of the recordings are suitable for the user's purpose or taste.

16. The opponent claims that the mark denotes a collection of music for the purposes of deep sleep. Its evidence includes articles entitled "Deep Sleep: How Much Do You Need?" (from www.sleepfoundation.org), "What Is Deep Sleep and Why Is It So Important?" (www.healthline.com) and "What Happens to Your Body During Deep Sleep" (www.webmd.com).[2] These articles all use "deep sleep" to describe a particular stage of the sleep cycle, with varying degrees of precision. For example, the first article says, "Deep sleep, also called slow-wave sleep, occurs in the third stage of non-rapid eye movement" when electrical waves in the brain "have a frequency of 0.5 to 2 Hertz and they must make up at least 6 seconds of a 30-second window for that window to count as deep sleep", whilst the last says "During deep sleep, you pay less attention to the outside world" and "Experts are still figuring out what deep sleep is for". These appear to be US sites, as either the copyright notices are for US companies or the medical verification has been carried out by an "MD".

17. However, the opponent's evidence establishes that, at least by the date of printing in December 2022, amazon.co.uk, spotify.com, soundcloud.com, ebay.co.uk and youtube.com all offered music and sounds which included descriptions such as "music for deep sleep", "deep sleep music" and "deep sleep aid" music and sounds.[3] Some of the albums/singles listed in this evidence, which have titles such as "Deep Sleep: Sleep Music Binaural Beats and Lullabies" and "Music for Deep Sleep: Healing Sounds of Nature", show release dates between 2008 and 2019, i.e. well before the relevant date.

18. Prints from the holder's website identify "sleep music and baby lullabies" as a genre of music which it produces.[4] Titles within this group include references to "Classical Piano for Deep Sleep", "Deep Sleep and Calm Music" and "Deep Sleep Aid".[5] These all show a copyright date of 2018.

[2] MB9.
[3] MB10.
[4] MB7.
[5] MB11.

19. In my view, the words “deep sleep” will be understood by the general public as descriptive of a type of sleep. The average consumer may not understand that “deep sleep” is a specific sleep stage, medically defined, but they will be aware from their own experience that sleep may be light or sound, and that particularly sound sleep is often referred to as “(a) deep sleep”. The evidence showing albums and singles using “deep sleep” descriptively supports the view that the term will be readily understood by the average consumer. The point is also exemplified in a YouTube print provided by the opponent (apparently from 2020, i.e., two years before it was printed in 2022) which says “fall asleep immediately: try for 3 minutes and fall into a deep sleep” and by an example of “deep sleep” in use in the *Collins* COBUILD dictionary online, as follows: “The prisoner lay with his face towards us, in a very deep sleep […]”.[6] It follows that “deep sleep music” will be understood as music which promotes, prolongs or is suitable to be played during deep sleep. These words are descriptive in relation to downloadable music and audio and sound recordings. However, the mark at issue is not merely the words “deep sleep music”, it is “DEEP SLEEP MUSIC COLLECTIVE”. It is the distinctiveness of the mark as a whole which must be considered and key to that is the meaning which will be attributed to “collective”.

20. My understanding of the word “collective” is that it indicates a group of individuals or businesses working together. I find support for this in the *Collins English Dictionary*, which defines “collective”, as a noun and in British English, as “4.a. a cooperative enterprise or unit, such as a collective farm; b. the members of such a cooperative; 5. short for collective noun”.[7] Further support is to be found in the opponent’s evidence of third parties who use “collective” in their undertaking’s name.[8] Specifically, there are website prints for Music Collective Scotland Ltd, Roundhouse Music Collective and Northern Music Collective, which are a group of music schools, a community of artists and musicians, and an initiative aimed at supporting the North East Music Scene, respectively. The only date visible on most of these is the December 2022 printing date, though the Roundhouse page advertises an open day on 3 September 2022. These websites all suggest that “collective” is used to mean a group of businesses or individuals with a common aim, including where the only other

[6] MB10, MB8.
[7] https://www.collinsdictionary.com/dictionary/english/collective [accessed 27 September 2023].
[8] MB6.

matter is a geographical description (e.g. Northern Music Collective; there is also evidence of the "Wakefield Music Collective", though no details are given for the latter). None suggests that an appropriate reading of "collective" would be "collection". Although dated after the relevant date, these websites support my understanding of "collective" and it is unlikely that its meaning has changed materially between the relevant date and the printing of these websites, or indeed the date on which the dictionary definition quoted above was published.

21. The opponent's evidence also includes a definition of "musical collective" from Wikipedia as "a phrase used to describe a group of musicians in which membership is flexible and creative control is shared. The concept is distinct from that of a traditional band in that musical collectives allow for flexibility in their rosters, and members are free to rotate in and out of the line-up".[9] Although the definition is for a slightly different term, it lends more support to the idea that a "collective" means a group of people acting in concert. The fact that individual members may change over time does not affect the ability of the collective to function as an entity and a single source of goods or services, irrespective of who its individual members may be at any given moment.

22. The opponent submits that there is a "direct descriptive link deriving from the fact that the [goods at issue] are *produced* by a group of musicians", because of the words "MUSIC COLLECTIVE" in the mark. I accept that the mark alludes to the goods being music intended to be used for or during deep sleep but the critical distinction, in my view, is that the message conveyed by the mark is that a particular group of musicians is responsible for the goods, i.e., those belonging to the collective. That is not a descriptive message which describes a characteristic of the goods themselves but is an indication of the trade origin of the goods—the raison d'être of a trade mark. It is analogous to a trade mark for "North West Gardening Services Ltd" for gardening services: the trade mark is very weakly distinctive but the addition of "Ltd" serves to indicate a single entity as the source of the services and takes the mark over the line of registrability, which is the function served by "collective" in the contested mark. This conclusion applies whether the mark is split "DEEP SLEEP MUSIC / COLLECTIVE" or "DEEP SLEEP / MUSIC COLLECTIVE". In my view, it matters not whether the

[9] MB5.

source is the collective or the music collective, both versions still indicate that the goods emanate from one undertaking.

23. I acknowledge the opponent's submission that the USPTO refused registration of the basic application on the grounds that the mark was descriptive. However, this was based on an assertion that "the average consumer encountering the applied-for mark in connection with the applicant's goods will immediately understand that the goods feature a collection of music for deep sleep". As I have explained above, my views differ from those of the USPTO on the meaning of "collective". None of the opponent's evidence supports a finding that the UK average consumer would understand "collective" as meaning a "collection"; on the contrary, the entities using "collective" in their names clearly intend the name to indicate a single entity responsible for the group's output. There is no other basis for concluding that it is used or understood in the UK as a synonym for "collection": were that the case, the mark would be plainly unregistrable.

24. I would only add that I attach no particular weight to the disclaimer. This is because the purpose of a disclaimer is to limit a party's rights vis à vis third parties and is not indicative of the descriptiveness, or distinctiveness, of the mark as a whole; and because the USPTO in any event did not insist on "COLLECTIVE" being included in the disclaimer: only "MUSIC" was stipulated.[10]

25. In conclusion, whilst I accept that "DEEP SLEEP MUSIC" is descriptive of music to aid deep sleep, I do not consider that the trade mark "DEEP SLEEP MUSIC COLLECTIVE" as a whole is descriptive. The opposition based on s. 3(1)(c) fails.

Section 3(1)(b)

26. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

[10] MB3.

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, 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 (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public’s perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble* v *OHIM* [2004] ECR I-5173, paragraph 36; Case

C-64/02 P *OHIM* v *Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel* v *OHIM*, paragraphs 36 and 38; and *Audi* v *OHIM*, paragraph 37)."

27. Although ss. 3(1)(b) and (c) are independent and have differing general interests,[11] the pleaded case under s. 3(1)(b) advances no different basis for the objection than that under s. 3(1)(c). That being so, as I have found that the mark is not descriptive, the case under s. 3(1)(b) must fail for the same reasons given above.

COSTS

28. The holder has been successful and is entitled to a contribution towards its costs. In making the award, I bear in mind that the opponent's evidence was light and that the holder filed no evidence. I award costs to the holder, calculated as follows:

Considering the notice of opposition and filing a counterstatement:	£300
Considering the other party's evidence:	£500
Written submissions:	£300
Total:	£1,100

29. I therefore order Xilin Gol League Xiyang Mutton Industry Co., Ltd to pay Fireheart Music, Inc. the sum of £1,100. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of October 2023

Heather Harrison

For the Registrar,

[11] *SAT.1 SatellitenFernsehen GmbH v OHIM,* Case C-329/02 P, EU:C:2004:532.

The Comptroller-General