

O-308-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2539660
BY ANTON HICKS TO REGISTER THE TRADE MARK**



IN CLASSES 9 AND 41,

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 100683
BY UNIVERSAL MUSIC – MGB NA LLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2539660
By Anton Hicks to register the trade mark**



and

**IN THE MATTER OF opposition thereto under No 100683 by Universal
Music – MGB NA LLC**

BACKGROUND AND PLEADINGS

1. On 19th February 2010, Anton Hicks of 2, Laura Terrace, Brownswood Road, London N4 2SS applied to register the above mark in classes 9 and 41 in respect of the following goods and services:

Class 9

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

Class 41:

Entertainment

2. The application was allocated number 2539660 and was published in the Trade Marks Journal on 9th April 2010 and on 7th July 2010 Universal Music-MGB NA LLC of 245 Fifth Avenue, 8th Floor, New York 10001, United States of America (hereafter, "Universal") lodged an opposition against the goods and services specified above.

3. Universal has opposed on the sole basis of section 5(2)(b), citing the following earlier mark:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
CTM 3811312 KILLER TRACKS 30 th April 2004 25 th July 2005	<p>Class 9: Sound storage media, image storage media and data storage media, all being prerecorded.</p> <p>Class 16: Printed materials.</p> <p>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.</p>

4. Universal say the respective marks share the same distinctive, dominant word or element , 'KILLER'. Furthermore, the 'CHORUS' word or element of Mr Hicks's mark is conceptually similar to the 'TRACKS' element of its mark, as both possess musical overtones. The respective marks cover identical or similar goods and services. Taking all factors into account there is a likelihood of confusion.
5. Mr Hicks, who is unrepresented, filed a counterstatement denying that there is a likelihood of confusion. He says, based on its website, Universal supply 'production music for use in film, television, advertising, and interactive media'. Universal are in the business of providing instrumental music for specific professionals whereas his purpose is to provide popular songs for the buying public. The respective markets are thus very different. It was never his intention to attract the 'KILLER TRACKS' audience and he sees no conflict of interest. Both marks can co-exist. Insofar as 'KILLER TRACKS' has any interest in songs and lyrics this is restricted to Motown classics and not the 100% original work which he will produce.

6. Furthermore, he says the respective logos are different. He notes the number of functioning websites with the word 'killer' in them, such as, KILLER SONGS, KILLER MUSIC, KILLER KEYS, and questions why Universal has not taken action, either against any of those or any of the registered trade marks also with 'KILLER' in them, such as, KILLER INSTINCT, KILLER WATT and KILLER LINE.
7. He says he intends to market his songs through his existing websites www.killerchorus.com or www.killerchorus.co.uk and through all the main social media hubs, and that fortunately no-one had the user-name 'killerchorus' by November 2010. He takes exception to anyone monopolising the word 'killer' which, he says, is increasingly used, even in India where, to use his words, the 'techs speak of 'killer apps''. He concludes by referring to two trade marks cases, one from the USA and one from the Philippines.
8. Formal evidence has been filed only by Universal, which insofar as it is factually relevant I shall summarise below. Submissions have been received from both parties which I shall take into account below. I should mention that certain of Mr Hicks's 'submissions' ought properly to have been filed in the form of factual evidence in accordance with rule 64 of The Trade Marks Rules 2008 ("TMR"). Specifically, he says that:
 - internet searches he conducted establish that 'KILLER TRACKS' has no particular reputation in the field of film and advertising music;
 - further internet searches he undertook establish, beyond doubt, the word 'killer' has, in actual use, a laudatory meaning;
 - definitions from Chambers Dictionary going back as far as 2003 which he says defines 'killer' as "adj (sl) spectacularly impressive, stupendous", also a reference to a definition from www.urbandictionary.com;¹ and
 - that when he searched the internet there is no confusion between the respective terms 'KILLER TRACKS' and 'KILLER CHORUS', in the sense that a search on the one phrase may bring up hits relating to the other.
9. Mr Hicks also seeks to rebut, by reference to certain specific advertising experiments, that consumers pay more attention to the beginnings of trade marks than any other part.

¹ In Case BL O-100-09 (Forex), the Appointed Person endorses the use of works of reference against which a decision taker can check the normality of his or her understanding of a particular word. It seems to me however that caution must be exercised in particular in the realm of slang. According to Mr Hicks, Chambers Dictionary acknowledges its definition to be slang, and in the circumstances it was for Mr Hicks to both prove the definition attributed and to satisfactorily contend that knowledge of that definition can be imputed to the average consumer.

10. All this material, as it is factual, ought to have been properly deposed by Mr Hicks in the form of a witness statement.

11. No hearing was requested by either party and so I give my decision based upon a careful reading of the papers.

Opponent's evidence

12. This takes the form of a witness statement dated 21st March 2011 by Steven Lake a partner in the firm of attorneys acting for Universal. At Exhibit SJL2 there are pages from Universal's production music website, www.unippm.co.uk. These pages show the use of 'KILLER' prefixed marks in use by the opponent, and in relation to the relevant goods and services and these include, KILLER ANIMATION, KILLER LATINO, KILLER SCORES SET, KILLER PROMOS and KILLER STAGE AND SCREEN. There appears to be no (legible) reference to KILLER TRACKS however.

DECISION

Section 5(2)(b)

13. The opposition is founded upon Section 5(2) (b) of The Trade Marks Act 1994 ("the Act"). This reads:

"(2) A trade mark shall not be registered if because –

(a).....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

14. Universal's mark was filed on 30th April 2004 and registered on 25th July 2005. It is therefore an earlier mark in accordance with Section 6 of the Act. Moreover, given its date of registration is within 5 years of the publication of the application, it is not subject to proof of use requirements.

15. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union ("CJEU") in *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 and

Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

- (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 nature of the purchase

- 16. It is important to explain that, in an opposition, I am required to consider a notional question. That is to say, what matters to me are the marks applied for and the goods and services for which they are either already protected, or in respect of which they seek protection. In this regard, Mr Hicks makes the point that Universal are involved in 'production' music whilst he is in the business of providing original, commercial music available direct to the general public. The difficulty with this submission is that the respective class 9 specifications are not framed in those terms and it is the wording in the specifications which must guide me.
- 17. The average consumer for both parties' class 9 specifications will be the music buying public. Such an average consumer will clearly be drawn from, and represent the same pool of people.
- 18. That said, as far as the respective services are concerned, certain of Universal's services are specified by reference to 'production music', but it also has, 'music publishing services' and 'providing information about and performances of musical artists by means of a global computer information network'. Universal say the 'target market' for the respective services is the same, being the 'public', all of whom are (theoretically at least) free to purchase Universal's music files. I must be guided by the terms used in the respective specifications and on that basis, the services of 'publishing music' and 'providing information about and performances of musical artists on a global computer information network' are both services which can, theoretically at least, be accessed by the general public in the same way that broad 'entertainment' services can be. 'Production music' is perhaps different in the sense that a service offering 'production music' is likely only to be accessed by those responsible for the television shows, advertisements, motion pictures and so forth for which the production music is required. In this regard, such a service is not intended to be, or aimed at, the public at large and is thus one remove from being an entertainment service per se.

19. Pre-recorded music is widely accessible to the general public and would not be a highly considered purchase (unlike a car or item of furniture) necessarily. As regards any 'circumspection' in the purchase of pre-recorded music, if anything this will be towards the identity of the artist, for whom the purchaser will already have a loyalty or curiosity towards. The identity of the publisher is perhaps less likely to provide the focus of the purchaser's consideration.
20. I will need to bear these comments in mind when I come to my overall assessment of likelihood of confusion.

Comparison of marks

21. The case law makes it clear I must undertake a full comparison, taking account of visual, phonetic and conceptual similarities and dissimilarities, from the perspective of the average consumer. Marks need to be considered in their totalities and taking account of overall impression (see authorities (c), (e) and (f) above in para 15), giving recognition to distinctive and dominant elements.

Visual comparison

22. Universal's mark comprises two words, 'KILLER' and 'TRACKS', in normal script. There is no other matter in its mark and nor are the words separated beyond a normal typographical space. Mr Hicks's mark comprises the words 'KILLER' and 'CHORUS', presented in a conjoined fashion against a dark blue circular background and beneath a large device comprising a vertical line with opposite and inward facing chevrons either side. The device does not obviously represent anything at all although, given the recognisable words (albeit conjoined) 'KILLERCHORUS', it is possible (but by no means inevitable) the average consumer would take the beginning letter 'K' as being a visual clue to the device, and possibly see the device as two letter 'K's facing in opposite directions. For the record, Universal contends that the device element is intended to show 'Play, Fastforward or Rewind' symbols on a media player (which it also uses in relation to its own mark), but I am not convinced by this given their configuration and possible relationship to the words. Even if this were the case, plainly my comparison must be restricted to the marks as filed. Taking the dissimilarities and similarities (being the shared word 'killer') into account I find the respective marks to be visually similar, at best, to a moderate degree.

Phonetic comparison

23. Universal's mark will be pronounced as 'KILLA TRAX'. Mr Hicks's mark will be pronounced 'KILLA COR-US'. The background and device in Mr Hicks's mark cannot be enunciated. Taking the similarities and dissimilarities into account I find the respective marks are phonetically similar to a high degree.

Conceptual comparison

24. The conceptual comparison is based upon semantic similarity. Plainly both marks share the same word 'killer'. The parties disagree as to the meaning the word would convey to the average consumer. Mr Hicks refers me to Chambers Dictionary (above, para 8) and says the word 'killer' is purely 'functional', an adjective, having a recognisably laudatory meaning. Universal, in turn, quotes from Collins Dictionary (9th Ed) to the effect that 'killer' means "a person or animal that kills, especially habitually" and "something, especially a task or activity, that is particularly taxing or exhausting". On that basis, Universal say use of the word 'killer' as a laudatory adjective is not common. Neither party has submitted their references as formal evidence.
25. Even if these references had been submitted in evidence, this illustrates the danger, in a case such as this, of sole reliance upon dictionaries to derive definitions. Mr Hicks's Chambers Dictionary reference clearly refers to the word as being a slang term. In my opinion, it fell to him, by way of factual evidence rather than assertion, to demonstrate any particular laudatory meaning that may be associated with that word in *actual* usage. Certain words have a plain and fixed laudatory meaning, such as 'best', 'brilliant', 'superb' and so forth. A decision maker in my position would not need to have such words defined and can therefore rely upon his or her own knowledge of the language to derive meaning. I do not believe however 'killer' is such a word.
26. By virtue of its ambivalent, slang nature it is inclined, in my opinion, *and in the course of trading, by which I mean use as a trade mark appearing in relation to goods (as distinct from conversational or editorial activity, for example)* to imbue both parties' marks with distinctive character. Again, it would have helped Mr Hicks's case were he to have submitted formal evidence plainly showing other traders in the field using the word 'killer' in an entirely laudatory sense. No such evidence has been filed.
27. I am left to conclude then that the shared word 'killer' comprises the semantically distinctive element of both parties' respective marks.
28. As far as the (admittedly large) device in Mr Hicks's mark is concerned, this will not vary or disturb the *semantic* meaning conveyed in the verbal element, KILLER CHORUS. As I have said, it is possible but by no means inevitable, the device will take its visual 'clues' from the words, and may well be seen as two letter 'K's facing in opposite directions.

29. The semantic meaning conveyed by the words 'KILLER TRACKS' will be that of a 'killer' type of track which, in the context of music, the word 'track' will have obvious descriptive meaning.

30. On that basis, I find the marks have a highly similar conceptual meaning. The word 'tracks' has obvious musical reference and the word 'chorus' also has musical reference and allusion, being the part of a song which is often most memorable or catchy and engages the whole ensemble. It is true that 'tracks' is perhaps more directly descriptive in the sense that that is what customers actually purchase; they do not purchase a 'chorus' as such but, both words undoubtedly have musical overtones which would be recognised by the average consumer.

Overall similarity of marks

31. At this point I need to bring my individual findings above together in an overall finding of similarity of marks, bearing in mind their distinctive and dominant elements.

32. Taking all factors into account, I find the respective marks to be, overall, similar to a high degree.

Comparison of the goods and services

33. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

'In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature and their method of use and whether they are in competition with each other or are complementary.'

34. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

35. It is important to recognise that even though the factual evidence on similarity may be non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are

not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary.

36. It is worthwhile mentioning a further case of the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

‘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 *Vedial 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).’

37. The relevant goods and services to be compared are:

Mr Hicks’s goods and services	Universal’s goods and services
<p>Class 9</p> <p>Recorded media, downloadable electronic publications; compact discs; digital music.</p> <p>Class 41:</p> <p>Entertainment</p>	<p>Class 09:</p> <p>Sound storage media, image storage media and data storage media, all being prerecorded.</p> <p>Class 16:</p> <p>Printed materials.</p> <p>Class 41:</p> <p>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</p>

	musical artists by means of a global computer information network.
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Class 9

38. The respective goods are identical. Although the wording is different, both parties' specifications cover recorded media, whether in the form of CDs or downloadable electronic media. Although Universal's specification does not use the word 'downloadable', the breadth of the terms used would encompass various formats within class 9, including media that is downloadable.

Class 41

39. Mr Hicks's specification consists of the very broad term, 'entertainment'. Universal's specification in class 41 is, "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". I have already discussed the end users of the services offered by Universal above (para 18) and drew a distinction between the production music element and wider terms, such as 'music publishing' and 'providing information about and performances of musical artists via a global computer information network'. In regard to the former, plainly the end user is more likely to be the various producers of advertising, television shows, motion pictures and so forth. In regard to the latter, the end user could be the general public.

40. The aim and purpose of 'production music', it seems to me, is that it is used in conjunction with, as the specification says, something else, be it a television show, advertisement or whatever. This is not to demean the quality of such music or the fact that such music is capable of being published in its own right. But, given its nature and the end users, I think it is stretching matters to say that such music, *of itself*, has, as its aim and intended purpose, 'entertainment'. On that basis, and bearing in mind all factors, I find that 'Providing music for use in production of television shows, television advertisements, motion pictures, video recordings, in-house productions, and multimedia applications' is not similar to 'entertainment' services.

41. However, again bearing in mind all factors, I find that, 'music publishing services' and 'providing information about and performances of musical artists by means of a global computer information network' are both identical to 'entertainment'. That is to say, the aim and intended purpose is the same, namely to provide 'entertainment', in whatever form. The end users will be the same, the general public. Taking into account the principle outlined in the *Meric* case above, namely, that goods (or in this case, services) can be considered identical if, as designated in an earlier mark, they are included in a more general category in a later mark (and vice versa), then the respective services are identical. I should perhaps reiterate at this point that what I am concerned with here is a notional comparison of the goods and services based on the wording adopted in the respective specifications and *not* what the parties are actually engaged in.

Likelihood of confusion

42. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example.

43. The earlier mark comprises the words, 'KILLER TRACKS'. I have spoken above about the slang and ambivalent nature of the word 'killer' (para 26 and following). There is no factual evidence from Mr Hicks which demonstrates that the word 'killer' has a plainly adjectival and laudatory meaning, such as can be imputed to the average consumer. On that basis, I find the earlier mark to be inherently distinctive but only to a low degree.

44. The evidence from Universal does not indicate its market share, geographical coverage or turnover under its mark, and accordingly I cannot say this degree of inherent distinctiveness has been enhanced through use. Mr Hicks says from his (unevidenced) searches, Universal's mark has no particular reputation through use and I have agreed with this, but plainly the onus was on Universal to establish this enhanced distinctiveness through use, rather than Mr Hicks to prove that no such enhanced distinctiveness arose.

45. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.

46. I have found that the respective goods in class 9 to be identical and some of the services in class 41. I have made observations on the respective average consumers, namely that, again in class 9 that they can be said to be identical

as well as some of the services in class 41. I have found the respective marks to be, overall, similar to a high degree. Finally, I have found the earlier mark to be inherently distinctive, but only to a low degree. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in one party's favour, it inevitably wins. All factors must be weighed in the evaluation of likelihood of confusion.

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's mark is a another brand of the owner of Universal's mark.**²
48. Having arrived at that conclusion, based on notional comparison and the case law principles, I would just like to deal with several outstanding submissions and issues raised.
49. Mr Hicks says there will be no confusion because of the internet searches he has undertaken and the fact that a search on the words, 'KILLER TRACKS', does not bring up, 'KILLER CHORUS'. That is, frankly, inevitable. Even assuming he had put this material properly in evidence, this is not the nature of the test of 'likelihood of confusion'. I must assume notional and fair use of the respective goods and services in all the various circumstances in which they are likely to be accessed by the average consumer, including if appropriate, but not limited to, GOOGLE or YAHOO searches. If a definitive answer to the likelihood of confusion evaluation were to be derived only from a GOOGLE or YAHOO search then, frankly, all the case law recited in para 15 above would effectively be redundant.
50. Secondly, it appears that Universal's evidence seeks to make the case for its use of a 'family' of 'killer' marks. The evidence establishes that on its website Universal prefix a number of their products or services with the word 'killer', but it seems to me that mere existence on a website does not make good the 'family' argument but in the circumstances Universal has not had to rely on this argument in any event.
51. Finally, Mr Hicks queries why Universal has not opposed the registration of other 'killer' marks or taken action against their users. This is not a factor in my analysis as plainly this is entirely a matter for Universal and which has no impact on the matter before me.
52. So, to conclude, the opposition is successful in its entirety.

² The difference between direct and indirect confusion has been the subject of, eg LA SUGAR (BL O-375-10) a decision of the Appointed Person (see paras 16-18).

Costs

53. Universal has been successful in its opposition and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award Universal Music – MGB NA LLC the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Statutory fee for filing opposition - £200
2. Filing notice of opposition and considering counterstatement- £200
3. Filing evidence - £300
4. Filing written submissions - £300

Total £1000

54. I order Mr Anton Hicks to pay Universal Music-MGB NA LLC the sum of £1000. The sum should 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 02 day of September 2011

**Edward Smith
For the Registrar,
the Comptroller-General**