

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 100683

IN THE NAME OF UNIVERSAL MUSIC MGB LA LLC

TO TRADE MARK APPLICATION No. 2539660

IN THE NAME OF ANTON HICKS

DECISION

Application No. 2539660

1. On 19 February 2010 Anton Hicks (**'the Applicant'**) applied to register the following sign as a trade mark for use in relation to *'recorded media; downloadable electronic publications; compact discs; digital music'* in Class 9 and *'entertainment'* in Class 41:



Opposition No. 100683

2. Universal Music MGB LA LCC (**'the Opponent'**) objected to the application for registration, citing the earlier right to which it was entitled as proprietor of the following Community trade mark registered on 25 July 2005 pursuant to an application filed under number 38811312 on 30 April 2004:

KILLER TRACKS

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.

3. The Opponent contended that the opposed application for registration should be refused under section 5(2)(b) of the Trade Marks Act 1994 on the ground that there would be a likelihood of confusion if the Opponent's mark and the Applicant's mark were used concurrently in the United Kingdom for goods and services of the kind for which they were respectively registered and proposed to be registered.

4. The Applicant represented himself in defence of the opposition. He disputed the objection to registration on the grounds set out in a counterstatement 'declared' on 7 July 2010. With reference to the meaning and significance of the word **KILLER**, he

contended that ‘to find for the Opposition would allow a company that heralds creativity to stifle mine and monopolise what is demonstrably an ordinary word (used as part of two-word phrase) throughout the English-speaking world’.

Procedure

5. The following provisions of the Trade Marks Rules 2008 were directly applicable to the conduct of the proceedings in the Registry:

Opposition proceedings: evidence rounds

20.–(1) Where–

- (a) ...
- (b) ...
- (c) the registrar has indicated to the parties that it is inappropriate for rule 19 to apply,

the registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(2) ...

(3) ...

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

General powers of registrar in relation to proceedings

62.–(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may–

- (a) require a document, information or evidence to be filed within such period as the registrar may specify;

...

(2) The registrar may control the evidence by giving directions as to—

- (a) the issues on which evidence is required; and
- (b) the way in which the evidence is to be placed before the registrar.

(3) ...

(4) ...

Evidence in proceedings before the registrar; section 69

64.—(1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

- (a) by witness statement, affidavit, statutory declaration; or
- (b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement may only be given in evidence if it includes a statement of truth.

(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.

(4) For the purposes of these Rules, a statement of truth—

- (a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and
- (b) shall be dated and signed by—
 - (i) in the case of a witness statement, the maker of the statement,
 - (ii) in any other case, the party or legal representative of such party.

(5) In these Rules, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

(6) Under these Rules, evidence shall only be considered filed when—

- (a) it has been received by the registrar; and
- (b) it has been sent to all other parties to the proceedings.

6. The reference in Rule 20(1) to **‘evidence and submissions’** maintains the legally and procedurally important distinction between filing **‘evidence’** i.e. information introduced into the proceedings under the provisions of Rules 62 and/or 64 for the purpose of substantiating the facts and matters to which it relates; and filing **‘submissions’** i.e. representations made by the party putting them forward as to the position and approach which the Registrar should adopt in relation to the matters addressed.

7. At this point it is necessary to observe firstly, that this distinction is frequently overlooked or ignored by parties and their advisers in Registry proceedings and secondly, that it is the experience of tribunals involved in civil proceedings (not confined to Registry proceedings) that litigants in person generally find it difficult to understand the distinction and the potentially adverse consequences for them of not adhering to it. Both of these observations are amply borne out by the way in which matters proceeded in the circumstances of the present case.

8. On 21 September 2010, the Registry wrote to the Applicant (and, in parallel, to the Opponent) giving directions for the conduct of the proceedings in the following terms, with underlining in bold added by me:

The Registry has an overriding objective to ensure that proceedings are completed within a reasonable time. As a result, the Registry has reviewed the proceedings and in light of the grounds claimed in the notice of opposition, would expect the parties to adhere to the following timetable:

Filing of opponent's <u>evidence/submissions</u>	21 November 2010
Filing of applicant's <u>evidence/submissions</u>	two months from receipt of opponent's evidence
Filing of opponent's <u>evidence in reply/submissions</u>:	two months from receipt of applicant's evidence

Upon conclusion of the evidence rounds the parties will be asked if they wish to be heard on this matter.

The opponent is now invited to **submit evidence or submissions** in accordance with Rule 20 of the Trade Marks Rules 2008. Therefore, in accordance with Tribunal Practice Notice 3/2008 a period of two months from the date of this letter is allowed for this purpose.

The evidence or submissions should therefore be received on or before **21 November 2010** and in accordance with Rule 64(6) a copy must be sent to the other party.

If evidence is filed it must be in the form of either, a Witness Statement, Statutory Declaration or Affidavit. This is in accordance with Rule 64. Further guidance can be found on our website at <http://www.ipo.gov.uk/tmmanual-chap7-law.pdf>.

Unfortunately, the wording I have underlined was apt to be understood as indicating (contrary to the distinction I have referred to in paragraph [6] above) that the filing of 'evidence' and the filing of 'submissions' were alternative ways in which either party could equally effectively provide the Registrar with the information they wanted him to take into account in his determination of the case. And the official letter of 21 September

2010 plainly appears to have been understood by the Applicant and the Opponent in that way in this case.

9. The Opponent filed written submissions in support of the opposition on 21 February 2011. However, the submissions were accompanied by documentary material which the Registry was not prepared to accept as ‘**evidence**’ unless and until it was introduced into the proceedings by being exhibited to a witness statement. A witness statement exhibiting the material was thereafter filed on 21 March 2011. That, together with a re-filed version of the written submissions filed on 21 February 2011, carried the proceedings forward to the point at which the Applicant was required to file ‘**evidence/submissions**’ in accordance with the directions given in the Registry’s letter of 21 September 2010.

10. On 28 March 2011, the Applicant filed written submissions in defence of his application for registration. His submissions contained many narrative references to otherwise undocumented facts and matters that he wanted the Registrar to take into account. In one passage, he sought to refute the suggestion that consumers pay more attention to the beginning of a trade mark than any other part by referring to the contents of: ‘**Radio 4 The Bottom Line 24 February 2011 (5 mins. mp3 excerpt emailed)**’. The Registry was not prepared to accept the mp3 excerpt as ‘**evidence**’, so he re-filed the written submissions on 30 March 2011 with the wording I have underlined in bold omitted. He understood that by so doing he was complying in full with the Registry’s directions for the filing of ‘**evidence/submissions**’. He therefore assumed that the Registrar would take account of what he had written with regard to his main point that the

word **KILLER** is ‘functional/utilitarian’ and ‘loosely translates as “the best” or “killing the competition”’.

11. On 3 May 2011, the Opponent filed written submissions contesting the points made in the Applicant’s written submissions filed on 30 March 2011. The Opponent’s submissions narratively addressed various matters of fact, both in the course of responding to what the Applicant had said and also for the purpose of bringing further information to the attention of the Registrar.

12. With regard to the meaning of the word **KILLER** the Opponent stated:

The Collins English Dictionary (9th Edition) defines the word **KILLER** as ‘a person or animal that kills, especially habitually’ and ‘something, especially a task or activity, that is particularly taxing or exhausting’. We submit that use of the word **KILLER** as a laudatory adjective is not common, and the word **KILLER** does not have a widely recognised meaning in respect of the goods and services covered by the relevant marks.

That was followed by the filing of further written submissions by the Applicant on 11 May 2011 (without objection from the Opponent) in which he addressed the meaning of the word **KILLER** by reference to dictionaries and by seeking ‘to prove my case with logarithmically-calibrated yet blissfully-obvious, instantly verifiable and overwhelming evidence from the world’s two biggest search engines’. He did not set out or exhibit the search results to which he referred. He quoted Chambers Dictionary (2003) in support of the definition of **KILLER** as ‘*adj (sl) spectacularly impressive, stupendous*’ and sought to establish that this meaning remained current by recounting, in general terms, the results

of internet searches of a kind that he was apparently expecting the Registrar's hearing officer to carry out for himself as part of the decision-taking process.

13. At the end of these exchanges, the Registry wrote to the parties confirming the then current state of the proceedings in the following terms:

The evidence rounds are now complete. **Below is a list of all the evidence that has been filed by both parties in these proceedings.**

Opponents evidence and/or submissions

Witness Statement
Steven John Lane

Exhibits
SJL2

Written submissions filed on behalf of the opponent.

Applicants evidence and/or submissions

Written submissions filed by the applicant

Opponents evidence and/or submissions in reply

Written submissions in reply filed on behalf of the opponent

Further applicant's submissions in reply

Further written submissions in reply filed by the applicant

The headings, together with the wording I have underlined in bold, were apt to indicate to the Applicant and the Opponent that they had complied with the Registry's directions for the filing of the '**evidence/submissions**' that were to be taken into account by the Registrar in his determination of the case. From the parties' point of view, the Registry had raised only two limited and specific objections in relation to the evidential status of

their written submissions (see paragraphs [9] and [10] above) and these had both been resolved to the apparent satisfaction of the Registrar.

14. The Applicant telephoned the Registry on 17 June 2011 expressing concern that his counterstatement 'declared' on 7 July 2010 had not been included in the list set out in the official letter of 16 June 2011. I understand that this was one of approximately five occasions on which the Applicant spoke on the telephone to Registry officials about the pending opposition. He was told that his counterstatement had not been listed because the official letter only listed the evidence and was informed that the hearing officer would take the counterstatement into account as part of his consideration of the case. This perpetuated the message of the official letter to the effect that the list was '*a list of all the evidence that has been filed by both parties in these proceedings*'.

15. Both parties were content for a decision to be made on the basis of the papers on file without recourse to a hearing. They both filed further written submissions for consideration by the Registrar's hearing officer in that connection.

Outcome of the Registry proceedings

16. The Opposition succeeded in relation to all of the goods and services specified by the Applicant for the reasons given in a written decision issued on 2 September 2011 (under reference BL O-308-11) by Mr. Edward Smith acting on behalf of the Registrar. He ordered the Applicant to pay £1,000 to the Opponent as a contribution towards its costs of the Registry proceedings.

17. The Hearing Officer stated his decision with regard to the existence of a likelihood of confusion in the following paragraphs:

[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 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.

The key factor in his decision, '*noting in particular the absence of crucial evidence from Mr. Hicks*' (paragraph [47]), was his conclusion '*that the shared word KILLER comprises the semantically distinctive element of both parties' respective marks*' (paragraph [27]).

'The absence of crucial evidence from Mr. Hicks'

18. The Hearing Officer's reference to *'the absence of crucial evidence from Mr. Hicks'* reflected his reasoning to the effect that the Applicant's written submissions provided no '**evidence**' on which he could rely for the purpose of discharging the burden, which was upon him, of showing that use of the word **KILLER** in the context and manner envisaged both by the earlier trade mark registration and by the opposed application for registration was, in February 2010, liable to be understood in the sense indicated by Chambers Dictionary (2003) and the other sources of information to which the Applicant had referred.

19. With regard to the written submissions which the parties had filed in accordance with the directions given by the Registry in September 2010, the Hearing Officer strictly applied the distinction between '**evidence**' and '**submissions**' which I have referred to in paragraph [6] above.

20. He made his views clear in paragraphs [8] to [10] of his decision:

[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' '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) speculatory impressive, stupendous', also a reference to a definition from www.urbandictionary.com¹; 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.

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

21. Footnote 1 to paragraph [8] noted that:

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.

The absence of '**evidence**' was therefore taken to amount to a failure by the Applicant to discharge a burden of proof that was upon him.

22. The Hearing Officer expanded upon his thinking with regard to the Applicant bearing the burden of proving the applicability of the dictionary meanings upon which he relied in paragraphs [24] to [26] of his decision:

[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.

23. There was nonetheless a degree of ambivalence in the way in which the Hearing Officer evaluated the meaning and significance of **KILLER** in the context of the Opponent's mark **KILLER TRACKS**. He said:

[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.

For **KILLER** to signify a 'type of track', the word would need to possess overtones or connotations of a descriptive nature. In circumstances where the Hearing Officer considered that the obviously descriptive word **TRACKS** was qualified by the word **KILLER** so as to convey the semantic meaning of a 'killer' type of track, it is not altogether easy to see why he characterised **KILLER** as 'the distinctive and common element' of the marks in issue (paragraph [47]) rather than proceeding more broadly upon the basis that in the Opponent's mark the word **TRACKS** was qualified by the word **KILLER** (and vice versa) and similarly in the Applicant's figurative mark the word **CHORUS** was qualified by the word **KILLER** (and vice versa).

The Appeal

24. The Applicant appealed to an Appointed Person under Section 76 of the Trade Marks Act 1994. He instructed solicitors to prepare and file the Notice and Grounds of Appeal. In paragraphs 1 to 9 of the Grounds of Appeal it was, in substance, contended that the Hearing Officer ought to have dismissed the objection to registration under Section 5(2)(b) of the Act irrespective of whether the written submissions of the parties

lacked the status of ‘evidence’ as he had found. In paragraphs 10 to 13 of the Grounds of Appeal it was, in substance, contended that the Hearing Officer’s approach to ‘evidence’ and proof of the meaning of words was too strict and/or procedurally erroneous by reason of ‘the reliance placed by the Applicant on conversations and correspondence he had with other officers of the Registry which gave him the impression that it was not necessary to submit substantive evidence on issues that were obvious’.

25. The Opponent did not file a Respondent’s Notice under Rules 71(4) to (6) of the Trade Marks Rules 2008 and thereby opted to proceed on the basis that the Hearing Officer’s decision was correct and should be upheld for the reasons he had given.

26. The Applicant filed written submissions in the form of a skeleton argument and thereafter represented himself at the hearing of the appeal. The Opponent filed written submissions in the form of a skeleton argument, but elected not to attend the hearing. In its written submissions, the Opponent confirmed its support for all relevant aspects of the Hearing Officer’s reasoning. It maintained (paragraph 7) that his approach to evidence and proof of the meaning of words was correct, with the result that **KILLER** fell to be regarded as distinctive when used in the context of the marks of both parties.

Decision

27. The Registrar’s hearing officers are entitled to insist (and generally do insist) upon observing the distinction between ‘**evidence**’ and ‘**submissions**’ which I have referred to in paragraph [6] above. So long as that distinction continues to be observed in Registry proceedings under the 1994 Act, it must remain necessary: (1) for parties and their

advisers to appreciate that ‘**submissions**’ cannot be used to inform the Registrar of facts and matters which need to be established by ‘**evidence**’; (2) for the Registrar’s hearing officers to appreciate that ‘**evidence**’ is not needed to prove matters of which they can legitimately take notice for the purposes of the assessment in hand; and (3) for the Registry not to encourage or reinforce the belief among parties and their advisers that ‘**evidence**’ and ‘**submissions**’ are alternative ways in which the Registrar can equally effectively be provided with the information they want him to take into account. I consider that the proceedings in the Registry were, in the present case, marred by failings in each of these three respects.

28. With regard to point (3), I consider that the Registry’s communications with the parties as noted in paragraphs [8] to [14] above blurred the distinction between ‘**evidence**’ and ‘**submissions**’ in a manner which was retroactively contradicted by the Hearing Officer’s insistence upon the materiality of the distinction between the two types of statement.

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.

30. The use of works of reference to identify the ordinary meaning(s) of words or expressions in the English language as written and spoken in this country is not normally regarded as evidence gathering. In Baldwin & Francis Ltd. v. Patents Appeal Tribunal¹ Lord Reid said²:

A judge is supposed to know the law, the English language and such facts as are common knowledge. If he refers to authorities or dictionaries or other works dealing with these matters he can safely do so because his general knowledge enables him to check and appreciate them.

and Lord Denning said³:

And no one ever calls the author of a dictionary to give evidence. All that happens is that the court is equipping itself or its task by taking judicial notice of all such things as it ought to now in order to do its work properly.

31. In The Coca-Cola Co. of Canada Ltd. v. Pepsi-Cola Co. of Canada Ltd⁴, Lord Russell of Killowen confirmed that:

While questions may sometimes arise as to the extent to which a court may inform itself by reference to dictionaries, there can, their Lordships think, be no doubt that dictionaries may properly be referred to in order to ascertain not only the meaning of a word, but also the use to which the thing (if it be a thing) denoted by the word is commonly put.

¹ [1959] AC 663 (HL).

² At p.684.

³ At p.691.

⁴ (1942) 59 RPC 127 (PC) at p.133.

32. Sir Raymond Evershed MR subsequently observed in Broadhead's Application⁵ that:

It has been authoritatively said that we make look at dictionaries and, taking the Shorter Oxford Dictionary and looking at the word "Seltzer" I find the definition to be: 'An effervescent mineral water obtained near Nieder-Selters containing certain mineral constituents; also an artificial mineral water of similar composition'.

and Lloyd-Jacob J. endorsed the practice of referring to dictionaries in Registry proceedings in Colgate-Palmolive Company's Application⁶ in the following terms:

... it is said that the Hearing Officer fell into error in approaching the matter as he did. He has perused a number of references to this word in Murray's Dictionary and has set out in extenso the meanings of the word which are therein contained. In my judgment it was not only proper for him to do so, but I find it hard to suppose that he could satisfactorily discharge his duty without referring to current authority in dictionaries for the purpose of satisfying himself as to any potential meaning of a mark propounded for registration.

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-understood⁷ and cannot be denied.

34. There are numerous instances of dictionaries and other works of reference being considered in decisions issued by the Community Trade Marks Office and the supervising

⁵ (1950) 67 RPC 201 (CA) at p.216.

⁶ [1957]RPC 25 at p.30.

⁷ not least as a result of the observations of Cotton LJ in Arbenz' Application (1887) 4 RPC 143 (CA) at p.148.

courts in Luxembourg in proceedings under the Community Trade Mark Regulation. A recent example is provided by Case T-470/09 medi GmbH & Co. KG v. OHIM⁸ where the General Court upheld the decision of the Community Trade Marks Office to refuse registration of the word **medi** for lack of distinctiveness in relation to various goods and services in Classes 1, 3, 5, 9, 10, 17, 35, 38, 39, 41, 42 and 44 on the basis of information as to its meaning and significance provided by Gale's Acronyms, Initialisms & Abbreviations Dictionary (32nd Edn) and The New Shorter Oxford English Dictionary (1993 Edn).

35. The distinction between '**evidence**' and '**submissions**' could not have been invoked to prevent refusal of registration at the Community level in the light of such information⁹. I see no reason to believe that it could have been invoked to prevent reference to such information at the national level in the United Kingdom under the Trade Marks Act 1994. This is not an aspect of decision taking in which the distinction between '**evidence**' and '**submissions**' should be taken to the lengths envisaged by the decision under appeal in the present case.

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

⁸ 12 July 2012 at paragraphs [20] to [23].

⁹ See paragraphs [22] and [23] of the Judgment.

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.¹⁰

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.

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).

¹⁰ see, for example, the approach adopted in Hasbro Inc v 123 Nahrungsmittel GmbH [2011] EWHC 199 (Ch); [2011] ETMR 25 (Floyd J) at paragraphs [116] to [163] and the approach adopted in CHUNKY Trade Mark [1978] FSR 322 (Whitford J.) at pp.331 to 335.

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.

Geoffrey Hobbs QC

30 October 2012

The Applicant represented himself.

Mr. Steven Lane of Lane IP Ltd filed written submission on behalf of the Respondent.

The Registrar was not represented.