

O-123-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2610697
BY DENNIS BENCE
TO REGISTER THE TRADE MARK**

KILL STAR

IN CLASSES 14, 18 & 25

AND:

**OPPOSITION THERETO UNDER NO. 103513
BY SIXTY INTERNATIONAL S.A.**

BACKGROUND

1. On 15 February 2012, Dennis Bence applied to register **KILL STAR** as a trade mark. The application was accepted and published for opposition purposes on 23 March 2012 for the following goods:

14 - Jewellery; costume jewellery; chains (for wearing); ear pins and ear rings; decorative pins and brooches; hair ornaments; charms (jewellery); jewellery boxes and cases.

18 - Goods made of leather and/or imitations of leather; all for personal, domestic and/or household use; purses; wallets; trunks and travelling bags; umbrellas, parasols and walking sticks; bags; leather belts and straps; leather whips; luggage; parts and fittings for all the aforesaid.

25 – Clothing, including footwear and headgear; outfits; corsetry; belts.

2. On 22 June 2012, Sixty International S.A. (“Sixty”) filed a notice of opposition directed against all of the goods in Mr Bence’s application. Following amendment, Sixty’s opposition is now based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which it relies upon the following trade mark registrations:

CTM no. 4677126 for the trade mark **KILLAH** applied for on 13 October 2005 and registered on 30 May 2009 for the following goods:

25 – Clothing, footwear, headgear.

CTM no. 7279649 for the trade mark **KILLAH** applied for on 1 October 2008 and registered on 25 June 2009 for the following goods:

3 - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

9 - Optical apparatus and instruments; glasses, sunglasses, spectacles frames; spectacles cases.

14 - Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

18 - Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

3. On 28 August 2012, Mr Bence filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based.

4. Neither party filed evidence or asked to be heard; Sixty filed written submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

DECISION

5. 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.”

6. 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.”

7. In these proceedings Sixty is relying upon the trade marks shown in paragraph 2 above, which constitute earlier trade marks under the above provisions. Given the interplay between the date on which Mr Bence’s application was published and the date on which Sixty’s registrations completed their registration procedure, the registrations are not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

8. 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 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

9. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. The average consumer of the goods at issue in these proceedings is a member of the general public who is, in my view, most likely to select all of the goods from either a shelf in a conventional retail setting or from the pages of a website or catalogue. While the latter conclusion indicates that visual considerations will dominate the selection process, aural considerations may still play their part, albeit, in my view, to a lesser extent. As to the degree of care the average consumer will take when selecting the goods, in its submissions Sixty said:

“...The clothing covered in class 25 [of the competing trade marks] is likely to be purchased casually or on impulse, so potentially increasing the possible effects of imperfect recollection.

The goods in classes 14 and 18 may be expensive, and purchased with some care as to the quality of a product, but may also be of lower value and therefore purchased casually or on impulse, so potentially increasing the possible effects of imperfect recollection.”

10. While the cost of all of the goods at issue can vary considerably, as neither parties' specifications are limited in any way, it is goods across the whole price spectrum I must keep in mind. While I accept that when selecting, for example, an inexpensive pin, bag or article of clothing the average consumer's level of attention may be somewhat

reduced, as many of the goods at issue in these proceedings will either be worn by the average consumer or used by them for personal adornment (or both) or form part of a co-ordinated look, and bearing in mind that the average consumer will need to consider factors such as material, size, colour, cost and compatibility with other items, they will, I think, pay at least a reasonable degree of attention to the selection of the majority of the goods at issue, but as the cost and importance of the purchase increases, so will the degree of care the average consumer pays to the selection.

Comparison of goods

11. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. In reaching a conclusion I will also 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).”

13. In relation to complementary goods and services the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraNAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

<u>Sixty's goods</u>	<u>Mr Bence's goods</u>
<p>3 - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p>	<p>14- Jewellery; costume jewellery; chains (for wearing); ear pins and ear rings; decorative pins and brooches; hair ornaments; charms (jewellery); jewellery boxes and cases.</p>
<p>9 - Optical apparatus and instruments; glasses, sunglasses, spectacles frames; spectacles cases.</p>	<p>18 - Goods made of leather and/or imitations of leather; all for personal, domestic and/or household use; purses; wallets; trunks and travelling bags; umbrellas, parasols and walking sticks; bags; leather belts and straps; leather whips; luggage; parts and fittings for all the aforesaid.</p>
<p>14 - Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.</p>	<p>25 – Clothing, including footwear and headgear; outfits; corsetry; belts.</p>
<p>18 - Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p>	
<p>25 – Clothing, footwear, headgear.</p>	

Class 14

14. The term “jewellery” in Sixty’s earlier CTM no. 7279649 is identical to “jewellery” in Mr Bence’s application. As the word “jewellery” in Sixty’s registration would, in my view, include “costume jewellery, chains (for wearing), ear pins and ear rings, decorative pins and brooches, hair ornaments” and “charms (jewellery)” in Mr Bence’s application, these goods are, on the principles outlined in *Meric*, identical. That leaves “jewellery boxes and cases” in Mr Bence’s application to consider. The nature, intended purpose and method of use of jewellery and jewellery boxes and cases differ; in addition, these goods are not, in my view, complementary in the sense identified in *Boston Scientific*, i.e. is not essential to store jewellery in a jewellery box or case. However, as the competing goods do, in my experience, originate from the same undertakings and bearing in mind the similarity in users and trade channels through which the respective goods reach the market, there is, in my view, a degree of similarity between jewellery and jewellery boxes and case, albeit, I think, a relatively low degree.

Class 18

15. The phrases “trunks and travelling bags”, “umbrellas, parasols and walking sticks” and “leather whips” in Mr Bence’s application also appear in Sixty’s earlier trade mark CTM no. 7279469 and are identical. As the term “bags” in Mr Bence’s application would include the “travelling bags” in Sixty’s registration, these goods are identical on the principles outlined in *Meric*. Given that the phrase “Leather and imitations of leather, and goods made of these materials and not included in other classes” in Sixty’s registration would encompass “Goods made of leather and/or imitations of leather; all for personal, domestic and/or household use”, “purses”, “wallets”, “leather belts and straps” and “luggage” in Mr Bence’s application, these goods are also identical on the *Meric* principle; “luggage” would also be identical/highly similar to “trunks and travelling bags” in Sixty’s registration. Finally, as I have already found that the competing goods in this class are identical or highly similar, it follows that the “parts and fittings for the aforesaid” in Mr Bence’s application in this class must also be either identical or highly similar to the goods in Sixty’s registration.

Class 25

16. Sixty’s earlier CTM no. 4677126 is registered for “Clothing, footwear, headgear”. As Mr Bence’s application in this class includes identical terms, and as the terms “outfits, corsetry” and “belts” would be included within the term “clothing” in Sixty’s registration, the competing goods in this class are identical.

Comparison of trade marks

17. The trade marks to be compared are:

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18. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade 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 trade 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 identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

19. Sixty's earlier trade marks both consist of the word KILLAH presented in upper case; as no part of the word is emphasised or highlighted in any way, there are no dominant elements; the distinctiveness lies in the trade mark as a whole. Mr Bence's trade mark consists of two well known English language words KILL and STAR presented separately in upper case. In its submissions Sixty said:

“Both marks start with the word KILL and it is generally accepted that the start of a mark dominates and is remembered more readily than later elements”

20. In his counterstatement Mr Bence said:

“4...[his trade mark] is a complex mark consisting of elements which are of equal dominance...”

21. Although the word KILL is the first word in Mr Bence's trade mark, as the word STAR which follows it is a clearly identifiable element which will not be overlooked or disregarded by the average consumer, I am inclined to agree with him that the two elements are of equal importance. Although well known words with which the average consumer would be very familiar, as far as I am aware, neither word (either alone or in their somewhat ungrammatical combination) has any meaning when considered in relation to the goods for which Mr Bence seeks registration; they are both, therefore, distinctive elements.

Visual similarity

22. In its submissions Sixty said:

“[Mr Bence's trade mark] also bears some visual similarity to [Sixty's trade mark] due to the common element KILL and the fact that they are not very different in length.” (my emphasis)

23. The competing trade marks are six and eight letters in length respectively. The fact that both parties' trade marks have the first four letters in common, results in a degree of visual similarity between them. However, keeping in mind that these letters do not

form an identifiable element of Sixty's trade mark, combined with the presence in Mr Bence's trade mark of the word STAR, the result is, in my view, only a low degree of visual similarity overall.

Aural similarity

24. In its submissions Sixty said:

“The later elements AH and STAR are phonetically similar, and could readily be mistaken for each other, particularly if spoken quickly. Both marks contain two syllables...”

25. I agree that both parties' trade marks consist of two syllables. In my view, Sixty's trade mark is most likely to be pronounced by the average consumer as they would the word KILLER. As well known English language words, the pronunciation of Mr Bence's trade mark is entirely predictable. Once again although the presence of the letters KILL in both parties' trade marks will result in a degree of aural similarity between them, the inclusion of the word STAR in Mr Bence's trade mark will, on the above analysis, result in significant aural differences which in turn will reduce the degree of aural similarity overall to low.

Conceptual similarity

26. As far as I am aware neither parties' trade marks have any meaning; the conceptual position is, therefore, neutral.

Distinctive character of Sixty's earlier trade mark

27. I must now assess the distinctive character of Sixty's earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 trade 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 trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As Sixty have not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. Consisting as it does of what appears to be an invented word, Sixty's trade mark is possessed of a high degree of inherent distinctive character.

Likelihood of confusion

28. 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 vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of Sixty's earlier trade mark as the more distinctive this is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, 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.

29. Earlier in this decision I concluded that:

- the average consumer of the goods at issue is a member of the general public who will pay at least a reasonable degree of attention when selecting the goods;
- the competing goods are, for the most part, identical or highly similar, and, insofar as "jewellery boxes and cases" are concerned, there is a relatively low degree of similarity;
- Sixty's earlier trade mark has no distinctive and dominant elements, the distinctiveness lies in the trade mark as a whole;
- while both elements of Mr Bence's trade mark are distinctive, there is no dominant element;
- there is low degree of visual and aural similarity between the competing trade marks and the conceptual position is neutral;
- Sixty's earlier trade mark is possessed of a high degree of inherent distinctive character.

30. In reaching a conclusion, I must keep in mind what is for the most part the identity/high degree of similarity in the goods and the high degree of inherent distinctive character Sixty's earlier trade mark possesses. Having done so, the low degree of both visual and aural similarity between the competing trade marks (the former of which is, in my view, the most important) and which even Sixty characterises as "some visual similarity", is, even when considered in the context of relatively inexpensive goods in relation to which the average consumer will be more susceptible to the effects of imperfect recollection, more than sufficient to avoid the likelihood of either direct or indirect confusion. As a consequence, Sixty's opposition to Mr Bence's application fails in all classes.

Conclusion

31. Sixty's opposition has failed in all classes.

Costs

32. As Mr Bence 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. Using that TPN as a guide, I award costs to Mr Bence on the following basis:

Preparing a statement and considering Sixty's statement:	£300
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Total:	£300
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33. I order Sixty International S.A. to pay to Mr Dennis Bence the sum of **£300**. 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 14th day of March 2013

C J BOWEN
For the Registrar
The Comptroller-General