

O/0362/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3813830
IN THE NAME OF DAVID MALLON**

**TO REGISTER THE FOLLOWING TRADE
MARK:**

Serial Killer

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600002523**

BY PERVAIS AKHTAR

Background and pleadings

1. On 27 July 2022, David Mallon (“the applicant”) applied to register the trade mark “**Serial Killer**” in the UK under application number 3813830. It was accepted and published in the Trade Marks Journal on 12 August 2022 with registration being sought for *apparel, footwear and headgear* in class 25.

2. On 19 August 2022, Pervais Akhtar (“the opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon its UK trade mark number 3428968. The registration consists of a series of two trade marks: “**KILLER**” and “**killer**”. As the only difference between them is the use of capitalisation, I will refer to them in the singular (i.e., “the earlier mark”) unless it becomes necessary to distinguish between them. The earlier mark was filed on 16 September 2019 and became registered on 13 December 2019. For the purposes of this opposition, the opponent relies on its earlier goods in class 25 namely, *clothing and headgear*.

3. By virtue of its earlier filing date of 16 September 2019, the above registration constitutes an earlier mark within the meaning of section 6 of the Act.

4. The opponent submits that there is a likelihood of confusion because the applicant’s registration is similar to the opponent’s and the respective goods are identical or similar.

5. The applicant filed a counterstatement denying all claims made by the opponent.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file evidence in these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. Both parties have represented themselves throughout these proceedings and a hearing was neither requested nor considered necessary and neither party filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Proof of Use

10. As the earlier mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Decision

11. Section 5(2)(b) of the Act is as follows:

“5(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”.

12. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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 be dominated by one or more of its components; (f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

14. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its 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, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

16. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. The goods to be compared are as follows:

Opponent	Applicant
Class 25: Clothing and headgear.	Class 25: Apparel, footwear and headgear.

18. In their counterstatement, the applicant states:

“In regards to the base product itself we mainly focus on t-shirts and sweat shirts in the class 25 group. Our product is purpose made and not bought off the shelf- but don’t believe there would be much differential between our base product and any other company selling t-shirts or sweat shirts.”

19. The applicant has applied for its mark in respect of goods in class 25, including those such as ‘apparel’ generally. The comparison I must make is a notional one and as such, I am required to consider the terms as they are applied for. The applicant’s comments regarding the way in which they claim to be using the mark are therefore of no relevance to my assessment.

20. I consider the terms *clothing* covered by the earlier mark and *apparel* in the application to be identical albeit expressed in different terms.

21. The term *headgear* appears in both specifications; these goods are identical.

22. I now compare the opponent's *clothing* to the applicant's *footwear*. I find that the nature of these goods differs, however the broader intended purpose, namely for wearing on the body for comfort, protection from the elements or modesty, will be shared. I also consider there will be an overlap in users to the extent that the goods are intended for the general public at large. There will also be an overlap in trade channels with the respective goods often being offered by the same entities. I am not convinced however that there will be any degree of competition between these goods. Overall, I consider there to be a medium degree of similarity.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

24. The average consumer for the parties' goods will be a member of the general public. The goods may vary in price, but none are likely to be prohibitively expensive and all will be purchased reasonably frequently. Even where the cost of the goods is low, various factors will be considered such as aesthetics, durability, and material. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

25. The goods are likely to be self-selected from the shelves of a retail outlet or their online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from retail assistants, I do not discount an aural component to the purchase.

Comparison of marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. The marks to be compared are as follows:

Earlier mark	Applicant's mark
KILLER	Serial Killer

killer	
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Overall impression

29. The earlier mark is a series of two word only marks, both of which are made up solely of the word “KILLER” (albeit one is presented in capital letters and the other is in title case). Whilst the series of earlier marks are each presented in upper case and lower case, they are essentially identical as the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case¹. As there are no other elements, the overall impression of the mark resides in the word itself.

30. The applicant’s mark consists of the words “Serial Killer”. The two words together form a unit and in the absence of any additional components, the marks overall impression resides in the totality of those two words.

Visual comparison

31. Both parties’ marks contain the word “Killer”. This forms the entirety of the earlier mark whereas it is the second element in the applicant’s mark. There is a point of difference created through the use of the word “Serial” in the applicant’s mark which has no counterpart in the earlier mark. This word appears at the beginning of the applicant’s mark, a position which is generally considered to have the most impact². The addition of this word results in the applicant’s mark being noticeably longer. Considering these factors, I find the marks to be visually similar to a medium degree.

Aural comparison

32. The earlier mark will be pronounced in two syllables using the standard English pronunciation of the word “killer”. The applicant’s mark will be pronounced in five

¹ See *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

² See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

syllables as using the standard English pronunciation of the words “Serial Killer”. There is some similarity as both marks include the term “killer”, however, the point of aural difference is the addition of the word “Serial” at the beginning of the applicant’s mark which results in the applicant’s mark being more than double the length of the earlier mark. Taking this into account, I consider the marks to be aurally similar to a low to medium degree.

Conceptual comparison

33. The earlier mark will be understood by the average consumer as a noun, namely referring to a person or animal that kills, or to some consumers, the word may also be perceived as something such as a task or activity that is particularly taxing or exhausting³. I also accept that to some consumers, the word “killer” may also be regarded as a laudatory adjective to describe something that is impressive. There is therefore some overlap owing to the common presence of the word “killer” in both marks. However, when this word is combined with “serial” in respect of the applicant’s mark, I consider that the term will be perceived by the average consumer as a unitary term to describe a person who carries out a series of murders⁴. Overall, I consider there to be a medium degree of conceptual similarity.

Distinctive character of the earlier mark

34. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought 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. In *Lloyd Schuhfabrik*, the CJEU stated that:

³ <https://www.collinsdictionary.com/dictionary/english/killer> [accessed on 02/04/23]

⁴ <https://www.collinsdictionary.com/dictionary/english/serial-killer> [accessed on 02/04/23]

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

35. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

36. The opponent has not filed any evidence to support that the earlier mark’s distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

37. The earlier mark consists solely of the standard dictionary word “KILLER”. As noted above in my conceptual comparison, I consider that a significant proportion of average consumers would consider the earlier mark to mean a person or animal that kills therefore rendering the mark neither descriptive nor allusive to the goods at issue.

I note that I also considered that the earlier mark may be regarded as a laudatory adjective to describe something that is impressive however, I do not consider that this would be a large enough group to constitute a significant proportion of the public. Consequently, I find that the earlier mark holds a medium degree of inherent distinctiveness.

Likelihood of confusion

38. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 (*Lloyd Schuhfabrik* at [26]).

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

40. Earlier in my decision, I found the respective goods to be either similar to a medium degree or identical. I identified the average consumer to be a member of the general public who will purchase the goods predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process.

41. I found the marks to be visually and conceptually similar to a medium degree and aurally similar to between a low and medium degree. I also found the opponent's mark holds a medium level of inherent distinctiveness.

42. When making my decision, I bear in mind that as a general rule the beginning of marks make more impact than the endings. When considered as a whole, there is a clear difference between the marks in the presence of the word "Serial" at the

beginning of the applicant's mark which also results in the mark being noticeably longer than the earlier mark. In this case I find that this difference will not go unnoticed, and the average consumer will first notice the "Serial" element of the applicant's mark which has no counterpart in the earlier mark. Moreover, whilst I noted there is a medium level of conceptual similarity between the marks through use of the word "Killer", I consider that the addition of the word "Serial" in the applicant's mark creates a conceptual hook that carries its own meaning and will assist the consumer with accurately recalling the marks for one another. I do not find that the opponent's mark will be mistaken for the applicant's and as such, I do not consider there to be a likelihood of direct confusion.

43. I now go on to consider indirect confusion.

44. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

45. These examples are not exhaustive but provide helpful focus.

46. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

47. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

48. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

49. I note that the respective marks do not appear to fall directly into one of the categories highlighted in *L.A. Sugar*. However, I note that these categories are not exhaustive, and so I consider again all of the factors I have found within this decision. The respective marks share a common element and the fact that some of the goods are identical is a factor weighing in the opponent’s favour. Nonetheless,

I have carefully considered if the marks may be perceived as a sub brand or brand extension of one another, or for them to be considered to represent economically linked undertakings and I can see no logical reason for this nor have I received any submissions from the opponent outlining any other alternative scenarios where this would occur. I have considered the factors set out in *Whyte and Mackay* above, but as I have found the applicant's mark hangs together as a unit giving the mark a different conceptual meaning, I do not consider a likelihood of indirect confusion to apply based on the common element "Killer" playing an independent distinctive role within the same. I am of the view that the applicant's mark may at best bring to mind the opponent's mark however, any similarities between the same will be put down to a coincidence rather than an economic connection. I am not satisfied that these circumstances give rise to a likelihood of indirect confusion, and as such, the opposition on section 5(2)(b) must fail.

CONCLUSION

50. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal against my decision, the application will proceed in the UK for the full range of goods applied for.

COSTS

51. The applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the Tribunal invited the applicant to indicate whether it wished to make a request for an award of costs and, if so, to complete a pro-forma including a breakdown of its actual costs. The applicant failed to return the pro-forma. As it incurred no official fees in the defence of its application, I make no award of costs in this matter.

Dated this 14th day of April 2023

Catrin Williams
For the Registrar