

TRADE MARKS ACT 1995

DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS, WITH REASONS

Re: Opposition by Bencom s.r.l to registration of trade mark application 912346(25) - **KILLER INSTINCT** - filed in the name of Peter Loccisano and Matthew Rooke.

DELEGATE:	Terry Williams
REPRESENTATION:	Opponent: Bencom s.r.l Applicants: Peter Loccisano and Matthew Rooke
DECISION:	S 52 opposition: s 44 etc, KILLER INSTINCT not deceptively similar to KILLER LOOP; lack of case for s 59 ground. Registration proceeding

Background

1. Peter Loccisano and Matthew Rooke have applied to register the trade mark KILLER INSTINCT in relation to “footwear, clothing and headwear”. The application, number 912346, has been examined and accepted for possible registration but the latter is now opposed by Bencom s.r.l. (Bencom). Both parties have filed evidence to support their positions and the matter was set down for hearing.
2. At the hearing, James Maxwell appeared for the applicant and Simon Williams for Bencom. Mr Williams directed argument to grounds of opposition under sections 41, 42, 44, 59 and 60 of the *Trade Marks Act 1995*..

Grounds considered

Deceptive similarity issues

3. Leaving aside the ground under s 59, Mr Williams argued that all of the other grounds have a common hinge, deception and/or confusion brought on by the resemblance alleged to exist between the trade mark sought to be registered and that relied on by Bencom¹. The conflict is said to be between the applicants’ trade mark KILLER INSTINCT and Bencom’s, both used and registered, KILLER LOOP.

¹ Mr Williams argued that, for the purposes of s 41, a deceptive trade mark is not capable of distinguishing. This is an interesting proposition but I do not think that it is correct. In brief, a trade mark such as COCA COLA does not lose its capability of distinguishing goods simply because it is being used by some fraudulent misappropriator. As matters transpire below I will not need to draw the matter out by considering this issue further.

4. The hearing of this matter took place a considerable time ago, and I stress that I have carefully reviewed the tape of the hearing, the written submissions of the parties and my notes. However, it seems to me that the opposition has little merit and, on all grounds where the question of deception or confusion is at issue, it must fail.
5. At its strongest, Bencom's argument is that s 10, which deals with deceptive similarity, is triggered. The section in question provides that:

For the purposes of this Act, a trade mark is taken to be *deceptively similar* to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

6. There is no need to set out the full provisions of sections 44 and 60. Their terms are such that deceptive similarity is the key issue in both. If s 10 is not triggered, s 42 (which is said to be enlivened because of the fair-trading legislation of the various States) must also fail².
7. There was considerable discussion at the hearing, and in the evidence, about what the state of the register might establish about the extent of similarity between the two trade marks. I agree with Mr Williams that it cannot be said that KILLER is an element common to the trade. However, I think this sheds little useful light on the question "is there deceptive similarity?" In my view, there is not, and I will now explain why that is so.
8. Mr Williams, for Bencom, traversed the full range of issues to be looked at here:
 - presence of a common idea, a KILLER trade mark:
 - tendency of imperfect recollection to increase the likelihood of confusion, which was to be judged both visually and aurally
 - possibility that confusion might exist because some common trade connection was inferred despite clear visual differences
 - weight to be given to the first element, common to both trade marks
 - notional fair use for all or any of the goods set out in the respective application and registration
 - real risk of sales through the same outlet

² The laws on which Mr Williams relied trigger at a higher level, that of being misleading or deceptive.

- the likelihood of slurring or otherwise reduced impact of the second elements³.

Each of these he amply supported by reference to case law, and I do not believe that Mr Maxwell, for the applicants, disputed the applicability of any of these principles.

9. I have allowed for the caution sounded by Kitto J⁴: that the risk of confusion need not be anything more than a real tangible danger of people being caused to wonder at a common trade source. Or as French J⁵ put it, the possibility of confusion must be finite and non-trivial. However, my reason for finding that the grounds relating to deception or confusion are not established can be put simply and this aspect of the matter disposed of. These trade marks do not look much alike, they do not sound at all alike, and there is no reason apparent to me for anyone to expect a quirky expression like KILLER LOOP (“nonsensical”, as Mr Maxwell put it) to denote a common trade source with KILLER INSTINCT. The latter is, as Mr Maxwell pointed out, a well-known expression meaning “determination to win”.
10. Mr Williams, at the hearing, stressed the “edgy, streetwise” image presented by both trade marks. To the extent that he is at all correct here, and it is in my own view a very limited extent, the marks would still be comparable to RAINMASTER and RAINKING. There⁶ the High Court, per Dixon, Williams and Kitto JJ, said:

But it is obvious that trademarks, especially word marks, could be quite unlike and yet convey the same idea ... To refuse an application for registration on this ground would be to give the proprietor of a registered trademark a complete monopoly of all the words conveying the same idea as his trademark. The fact that two marks convey the same idea is not sufficient in itself to create a deceptive resemblance between them, although this fact could be taken into account in deciding whether two marks which really looked alike or sounded alike were likely to deceive.

11. In my own view, the marks at issue in the case before the High Court are closer in look and idea to those now at issue, and markedly so. Mr Williams referred at the hearing to the propensity for customers (and particularly the customers for whom Bencom and the two applicants compete, the youth market for surf, skate and casual clothing) to shorten trade marks by way of “casual informality”. Again, I have noted

³ This is said to be justified by the tendency to accent the first *syllable* of words – *London Lubricants appn*, (1925) 42 RPC 264 at 279 – but the facts here involve completely separate second word elements, a different proposition entirely

⁴ *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592 at 594-595

⁵ *Registrar of Trade Marks v Woolworths* [1999] FCA 100 (Full Federal Court)

⁶ (1952) 86 CLR 536 at 538:

his caution that I should look at the overall impression, the effect on the memory, which these trade marks would have. However, while these things are correct in principle⁷ the principle simply will not stretch to cover the present facts. I see no reason at all why goods bearing the trade mark KILLER INSTINCT would be seen as “just another of the KILLER [LOOP] marks or like/family (sic) of marks” of Bencom. These marks are not sufficiently similar as to cause confusion, let alone actual deception. Accordingly, the grounds involving s 44, 60, 42 and, with them, 41, must fail.

Intention to use

12. The remaining ground goes to section 59 of the Act. This deals with trade marks where the applicant does not intend to use the mark, authorize its use or assign the trade mark to a body corporate for use by the latter. Mr Williams accepted that the onus is on his client. However, he reminded me that the applicants must display a “real resolve, intention and purpose”⁸.
13. While Mr Williams did not stress this ground, he did note that the goods of interest to the applicants were specified as “footwear, clothing and headwear”, where the only use in evidence went to use on the front of a t-shirt. It is fairly clear, moreover, that Mr Loccisano, who gives evidence on behalf of the two applicants, has not always clearly distinguished between his own use, joint use with Mr Rooke or the use of the trade mark by “the Killer Instinct Clothing Company”. The latter is a business name that appears to now be inactive but there remains an incorporated company with a similar name, and to which Mr Loccisano claims to have assigned the trade mark.
14. Mr Maxwell conceded that the domain name referred to in Mr Loccisano’s declaration is not active. Mr Williams described the detail beyond this and the administrative details and information provided to support the use claimed by the applicants as “a complete mish-mash”. This is probably somewhat harsh but I agree that it is not easy to be clear, from Mr Loccisano’s evidence, on the distinction between the business of which he and Mr Rooke are (or were) co-owners and the

⁷ Mr Williams referred, most relevantly in my own view, to *George Ballantine & Sons Ltd v Ballantyne Stewart & Co Ltd* [1959] RPC 273, *Nuts Chocoladefabriek BV v Cadbury Ltd* (1985) 5 IPR 77 at 80, *DREADNOUGHT* case (1922) 17 AOJP 1196, *Mothercare UK Ltd v Serry (A’Asia) Pty Ltd* (1991) 21 IPR 469, *Johnson & Johnson v Kalnin* (1993) 26 IPR 435.

⁸ This is based on the formulation in *Ducker’s Trade Mark* (1928) 45 RPC 397 at 402.

subsequent company. However, there does appear to have been use of the applicants' trade mark on t-shirts although it would be unsafe to give this full weight⁹. Now is not the time or place to conduct a further investigation into the detail of this, or of the applicants' intention with regard to footwear and headgear. The evidentiary onus rests on Bencom. The inconsistencies in the applicants' evidence do not, collectively, rise to a point that they would support an inference of lack of intention within the terms of s 59. The registrar's practice in that regard follows from *Aston v Harlee*¹⁰.

Conclusion

15. No ground of opposition has been established. The trade mark application may therefore proceed to registration one month from the date of this decision. If the Registrar has been served with a notice of appeal before that time, I direct that registration shall not occur until either the appeal has been discontinued or registration is ordered by the court.
16. I direct that Bencom pay the costs of the applicants in accord with the relevant scale in the regulations.

Terry Williams
Hearing Officer
Trade Marks Hearings
3 August 2006

⁹ The Loccisano declaration refers to use "on the front, back and the inside of the T-shirt and on the swing-tag". An exhibit which verifies this was filed by the applicants. However, for reasons which were not clear to Mr Maxwell, only a defective photocopy was served on the opponent and the applicants are not, strictly, entitled to rely on the details of the actual exhibit that were obscured.

¹⁰ (1960) 103 CLR 391 at 401