BLO/873/22

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,536,345 BY AL ATHEED GENERAL TRADING LLC

AND IN THE MATTER OF AN OPPOSITION UNDER NUMBER 423,680 BY AMAZON EUROPE CORE SARL

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF KAROL THOMAS (O/114/22) DATED 10 FEBRUARY 2022

DECISION

Introduction

1. This is an appeal from the decision of Mrs Karol Thomas, for the Registrar, dated 10 February 2022 (O/114/22) where she upheld the opposition of Amazon Europe Core SARL to Al Atheed General Trading LLC's trade mark application (No. 3,536,345) under section 5(2)(b) of the Trade Marks Act 1994. Al Atheed General Trading appeals.

2. Al Atheed General Trading applied to register the following mark:

3. The mark was applied for in relation to the following goods in Classes 29, 30 and 32:

Class 29
Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Class 30
Coffee, tea, cocoa, and artificial coffee; rice, tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

Class 32
Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages-Energy Drinks.

4. The opposition was based on the earlier word mark AMAZON (European Union trade mark No 16,947,681) and the opponent relies on goods in Classes 29, 30, 32 and 35. The list of these goods is very extensive and is annexed to the Hearing Officer's decision. It should be noted that the Respondent put forward no evidence of its use of the mark at all. Therefore, even though Amazon may well be a well-known online (and offline) retailer, it was accepted by both parties that this should be ignored for the purposes of these proceedings.

Standard of review

5. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that he or she has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]:

> …I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
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> > i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
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> > ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);
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> > iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);
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> > iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions … being further along the spectrum.
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> > v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).
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> > vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

> vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).
> viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).
> ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

6. When considering this appeal, and applying these principles, it is important to remember the high bar set.

The Appeal

7. The Appellant challenges the Hearing Officer's decision on three grounds. First, that the Hearing Officer failed to give proper weight to the geographical nature of the earlier mark when assessing its distinctiveness. Secondly, the Hearing Officer failed to consider properly the additional elements found in the applicant's mark as she placed too much emphasis on the word AMAZON. Finally, the relevant public for the applicant's mark should have been found to be Arabic speaking (and not the wider general public).

Geographical nature of the mark

8. In relation to the first challenge to the Hearing Officer's decision, Mr Wood, for the Appellant, argues as follows. The relevant public upon seeing the word Amazon will think of the huge river in South America which has its source in Peru and its mouth in Brazil. He suggests that this is the "dictionary" definition of the word. He goes on to argue that while the goods in question may not currently be associated in the minds of the relevant public with the geographical place, it may be that they will become so in the future. Accordingly, he suggests, the mark AMAZON should have been found to have been marginally distinctive only. These arguments were addressed by the Hearing Officer in Decision, [22]:

> As the opponent filed no evidence, I have only the inherent position to consider. Referring to the dictionary definition, the applicant submits that Amazon is the name of a river in South America and, therefore, has a geographical connotation that is well known to the average consumer. The applicant also argues that the mark has a low level of distinctive character in relation to the goods and services that could originate from that location. The opponent, however, argues that the earlier mark is inherently highly distinctive as it has no meaning in relation to the goods and services for which the mark is registered. Amazon is not an invented

> word and, therefore, I disagree with the opponent that the earlier mark is distinctive to a high degree. While I accept the applicant's argument that the average UK consumer may be aware that Amazon is the name of a river, it does not appear, nor is there evidence that the earlier mark has a geographic connotation in relation to the goods in Classes 29, 30 and 32. On that basis, I find that the earlier mark possesses a medium degree of distinctive character.

9. Like the Hearing Officer, I accept that the relevant public upon seeing the mark AMAZON may well think of the river in South America. As an aside, this is not really the dictionary definition of the word. Proper nouns are not usually included in conventional dictionaries (and the Oxford English Dictionary does not include this meaning for Amazon, rather confining itself to women with various characteristics being described as Amazons).

10. I now turn to Mr Wood's second proposition. He argues that although the goods in question are not currently associated in the minds of the relevant consumer with the Amazon they may well be in the future and that is sufficient. He referred me to C-108/97 and C-109/97 *Windsurfing Chiemsee* [1997] ECR I-2779, [29], [31], [33] and [34].

> 29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.
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> …
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> 31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.
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> …
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> 33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.
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> 34. However, it cannot be ruled out that the name of a lake may serve to designate geographical origin within the meaning of Article 3(1)(c), even for goods such as those in the main proceedings, provided that the name could be understood by the relevant class of persons to include the shores of the lake or the surrounding area.

11. These passages relate to the absolute ground of refusal found in section 3(1)(c) of the Trade Marks Act 1994 (which was based on Article 3(1)(c) of the original Trade Marks Directive 89/104/EEC). Mr Wood accepts that he is precluded from arguing that the mark AMAZON lacks distinctiveness when the opposition is based solely upon section 5 (see C-196/11P *Formula One Licensing v OHIM*, EU:C:2012:314). He suggests, however, that the principles applied to section 3(1)(c) cases equally apply when a tribunal is determining the distinctiveness of an earlier mark for the purposes of section 5. Therefore, he submits, the mark AMAZON should be accorded the lowest possible

level of inherent distinctiveness necessary to overcome section 3(1)(c) and nothing more.

12. Mr Wood rightly points out that *Windsurfing* presents a two stage approach to assess whether the relevant public will associate the mark with the geographical origin of the goods. The first stage requires an assessment as to whether a "geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned". The second stage asks whether "it is reasonable to assume that such an association may be established in the future". It is the second stage Mr Wood relies upon.

13. It may well be that the first stage of *Windsurfing* is relevant to assessing inherent distinctiveness for the purposes of section 5(2), but I do not agree that this is true of the second.

14. This second stage relates to how consumers may perceive a mark in the future (which is of course relevant under section 3(1)). The question the tribunal is asking itself for the purposes of section 5(2) is how inherently distinctive the earlier mark is to the relevant public on the relevant date. It is not concerned with how distinctive it might be on future dates. Indeed, the distinctiveness of a mark can change after registration either increasing through use (and thereby benefiting from enhanced distinctiveness) or it may be lost (for instance, when the mark moves towards becoming generic).

15. Therefore, the Hearing Officer was right to consider whether the geographical nature of the mark might affect its distinctiveness to the relevant public on the relevant date, but it would have been wrong for her to go on and consider the second stage which is concerned with the future.

16. However, even if I am wrong about the temporal element for section 5(2) there was no reasonable basis for her to assume that the relevant public would come to associate the mark AMAZON with the geographical origin of the relevant goods and services in the future.

17. It must be remembered that some words may be "absurdly inappropriate" as a description (the famous North Pole for bananas example of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281, 306) and this absurdity can make the word particularly distinctive: Lord Walker in *R v Johnstone* [2003] UKHL 28, [2003] 1 WLR 1736, [64].

18. Accordingly, not all marks made up of geographical place names indicate to consumers the origin of the goods. After all, a foolish producer who had an unlimited budget and no concern for the environmental consequences could probably grow bananas at the North Pole in an environmentally controlled biosphere. This does not mean it is reasonable to assume that consumers will in the future associate the mark North Pole with bananas grown in the Arctic.

19. Therefore, there needs to be some basis for a tribunal to decide that it is "reasonable to assume" that in the future an association may be made in the mind of the relevant public between the mark and the geographical origin of the goods. In most cases this will require evidence. For instance, a region of the world may currently have no link to making beer in the mind of the relevant public. However, it may be possible to suggest that in the future the region will be associated with beer production in the consumer's mind because there are some brewers working in the area and they market their beer in the United Kingdom. The extent of such operations would be one factor (of possibly many) in deciding whether the assumption is reasonable.

20. Of course, some places, such as London or Glasgow, are so well known as a location for making or selling things generally that it might be reasonable (in some cases) to assume that the relevant public would make a link with that place for a wide range of goods or services even without direct evidence of any current trade.

21. Mr Wood's submission before me was little more than the assertion that the Amazon is a geographical place and so in the future it could become associated with particular goods made there. This is not sufficient. There was no evidence before the Hearing Officer (or me) regarding sales from the Amazon (or the Amazon region) to the United Kingdom for any of the goods covered by the specification - let alone any such sales using the sign "Amazon" as an indication of geographical origin. Indeed, there was also no evidence that the sign Amazon has been used as an indication of geographical origin in any other countries either.

22. In the absence of such evidence, it would have been quite unreasonable for the Hearing Officer to make assumptions regarding the thoughts of a future relevant public as to the use of the mark Amazon. There are simply too many variables between the furthest point Mr Wood takes us, namely that the Amazon is a river; and the end point required that, say, consumers see beer or wheat marked with Amazon as coming from the region surrounding the river.

23. I therefore reject the first ground of appeal.

Additional elements

24. The second ground of appeal is based on the conclusion of the Hearing Officer that "[a]lthough all the elements contribute to the overall impression of the mark, it is the word Amazon that is the dominant and distinctive part of the applicant's mark": Decision, [28].

25. Mr Wood's challenge is dependent on his succeeding on the first ground of appeal. He argues that if the word Amazon is a weakly distinctive element of the applicant's mark (as it is seen as the geographical origin of the goods) then the small differences in the rest of that mark would make it visually distinct from the earlier mark.

26. As I have held that the Hearing Officer was entitled to find the AMAZON mark was inherently distinctive to a medium degree, her remaining analysis of the visual similarity of the marks, and her conclusion that the marks are visually similar to a medium degree, is quite proper (see Decision, [29]).

27. I therefore reject the second ground of appeal.

Relevant public

28. The final ground of appeal can also be dealt with briefly. Mr Wood originally submitted that the content of the appellant's mark (the Arabic script in particular) meant that the relevant public for the goods would be Arabic speaking (and so any goods would be sold in specialist stores only). This raises an interesting question about the extent to which the nature and character of a mark can affect the characteristics of the relevant public; in other words, whether, for example, fish sold under a mark made up of purely Arabic words would have the same relevant public as fish sold under a mark made up of purely Chinese words. However, it is an issue I do not need to resolve.

29. This is because Mr Wood conceded in the hearing that while the relevant public for the applicant's mark might be Arabic speaking, the relevant public for the opponent's mark would be both Arabic speaking as well as the wider public. Accordingly, even if the Hearing Officer were wrong in her assessment that the relevant public comprises the public at large, her assessment would not be any different if the relevant public were more narrowly defined.

30. I therefore reject this ground of appeal as well.

Conclusion

31. I have dismissed the appeal in its entirety. I order the Appellant to pay the Respondent a contribution of £1,500 towards its costs in this appeal (in addition to the £800 ordered by the Hearing Officer below) within 21 days of the date of the order.

PHILLIP JOHNSON
THE APPOINTED PERSON
9 OCTOBER 2022

Representation:

Mr Aaron Wood, Brandsmiths for the Appellant
Miss Beth Collett instructed by Morgan Lewis & Bockius for the Respondent