

O/1006/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003912870

IN THE NAME OF

KERNELTECH SOFTWARE (SHENZHEN) CO., LTD.

TO REGISTER THE FOLLOWING TRADE MARK:

Minifire

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000442801

BY AMAZON TECHNOLOGIES, INC.

Background and pleadings

1. On 18 May 2023, KernelTech Software (Shenzhen) Co., Ltd. (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 02 June 2023 in respect of the following goods:

Class 9: All in one computers; Batteries; Bullhorns; Electronic displays; Flat panel displays; Lap Top computers; LED televisions; Monitors; Projection screens; Projectors; Remote controls; Speakers [audio equipment]; Tablet computers; Televisions; USB adapters.

2. On 01 September 2023, Amazon Technologies, Inc. (“the Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in the application. The Opponent relies upon the following two marks:

FIRE

UK Registration no. UK00003204461 (“The first earlier mark”)

Filing date: 31 December 2016

Date of registration: 26 May 2017

Relying upon the goods set out in paragraph 18.

AMAZON FIRE

UK Registration no. UK00912755906 (“The second earlier mark”)

Filing date: 02 April 2014

Date of registration: 08 May 2019

Relying upon the goods set out in paragraph 31.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created, on 01 January 2021, comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the Opponent's second earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.¹
4. The Opponent submits that the marks are similar and that the goods are identical or similar, resulting in a likelihood of confusion.
5. The Applicant filed a counterstatement within which it denied the claims made and put the Opponent to proof of use in respect of UK Registration no. UK00003204461 (the first earlier mark).
6. The Opponent filed evidence and written submissions. Neither party requested a hearing, nor filed submissions in lieu. This decision is taken following a careful consideration of the papers.
7. The Applicant is represented by Pawel Wowra; the Opponent is represented by Morgan, Lewis & Bockius UK LLP.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

¹ See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

Evidence

9. The Opponent filed evidence in the form of the witness statement of Aimee Mahan, Assistant Secretary of Amazon.com, Inc., signed and dated 21 January 2024. The witness statement is accompanied by 41 exhibits (AM1 – AM39 & AM42- AM43). There appears to be no Exhibit AM40 or AM41. The purpose of the Opponent’s evidence is to demonstrate that the first earlier mark has been put to genuine use for the goods on which it relies.

DECISION

Proof of use

10. The Opponent’s first earlier mark had been registered for more than five years at the filing date of the application and therefore the proof of use provisions apply to this mark only. However, the Opponent’s UK Registration no. UK00912755906 (the second earlier mark) is not subject to the use requirements specified within Section 6A of the Act as it had not been protected for five years or more at the filing date of the application.
11. The Applicant has requested proof of use in these proceedings in respect of the Opponent’s first earlier mark. I will begin by assessing whether and to what extent the evidence supports the Opponent’s statement that it has made genuine use of the mark in relation to the goods relied upon. The relevant period for this purpose is the five-year period ending with the date of the application in issue, namely 19 May 2018 to 18 May 2023.
12. The relevant statutory provisions are set out in Section 6A of the Act, which states:

“(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of

whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)- (5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. Consequently, the onus is upon the Opponent to prove that genuine use of the earlier mark was made within the relevant territory in the relevant period, and in respect of the relevant goods as registered.

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall*

Radetsky [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of

the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:
- i) The scale and frequency of the use shown.
 - ii) The nature of the use shown.
 - iii) The goods for which use has been shown.
 - iv) The nature of those goods and the market(s) for them.
 - v) The geographical extent of the use shown.
17. As indicated in the case law cited above, use does not always need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.
18. The Opponent claims to have used its earlier mark ‘FIRE’ in relation to the following goods:

Class 9: Scientific, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software; portable and handheld electronic devices for transmitting, storing, manipulating, recording, and reviewing text, images, audio, video and data, including via global computer

networks, wireless networks, and electronic communications networks and electronic and mechanical parts and fittings therefor; tablet computers, electronic book readers, audio and video players, computer peripheral devices; computer and portable and handheld electronic device accessories, including, monitors, displays, keyboards, mouse, wires, cables, modems, printers, disk drives, adapters, adapter cards, cable connectors, plug-in connectors, electrical power connectors, docking stations, including electronic docking stations, headphones and earphones and drivers; charging stations, battery chargers; battery packs; memory cards and memory card readers; speakers, microphones, and headsets; cases, covers, and stands for portable and handheld electronic devices and computers; devices for the display of electronically published materials, in the nature of books, journals, newspapers, magazines, multimedia presentations, television programs and films; headphones and earphones; data synchronization programs, and application development tool programs for personal and handheld computers; downloadable pre-recorded audio and audiovisual content, information, and commentary; downloadable electronic books, magazines, periodicals, newsletters, newspapers, journals, and other publications; electronic bulletin boards; electronic circuits, magnetic discs, optical discs, optical magnetic discs, magnetic tapes, ROM cards, ROM cartridges, CD-ROMs, and DVD-ROMs; portable computers; remote controllers for computers; portable terminals for displaying electronic publications; electronic agendas; flash memory cards; memory modules; optical discs [blank], magnetic discs [blank], compact discs [blank], and magnetic cards [blank]; DVD players; DVD recorders; remote controllers for DVD recorders and players; remote controllers; digital video players; television receivers [TV sets] and television transmitters; telecommunication machines and apparatus; recorded compact discs; metronomes; electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments; downloadable music files; exposed cinematographic films; exposed slide films; slide film mounts; downloadable image files; cameras; photographic machines and apparatus; cinematographic

machines and apparatus; optical machines and apparatus; batteries and cells; rechargeable batteries; AC adapters; protective films for liquid crystal displays for handheld game apparatus with liquid crystal displays; data recordings including audio, video, still and moving images and text; computer software, including software for use in downloading, storing, reproducing and organizing audio, video, still and moving images and data; downloadable electronic publications; computer, electronic and video games programs and equipment; electronic instructional and teaching apparatus and instruments; television and radio signal transmitters and receivers; televisions (TV); television tuners; game controllers; set-top boxes; television receivers and transmitters; electronic controllers; electronic controllers to impart sensory feedback, namely, sounds and vibrations that are perceptible to the user; motion sensitive interactive video game remote control units; interactive video game remote control units; portable and handheld electronic devices for video games; video games; computer hardware, software, and peripherals for personalized, interactive television (TV) programming and for use in generating, displaying and manipulating visual media, graphic images, text, photographs, illustrations, digital animation, video clips, film footage and audio data, and for social networking; wireless controllers to monitor and control the functioning of other electronic devices; remote controls; joysticks; computer touchscreens; consumer video game machines fitted with a camera function adapted for use with external display screen or monitor; consumer video game machines adapted for use with external display screen or monitor; downloadable audio works, visual works, audiovisual works and electronic publications; computer software development kit consisting of computer software development tools for the development of content and service delivery across global computer networks, wireless networks, and electronic communications networks; computer software for personalized, interactive television programming and accompanying manuals distributed therewith; application development computer software programs; downloadable software in the nature of a mobile application for computers or other portable consumer electronic device; television

standards converters; television program decoders; interactive television terminal sets; parts and fittings for all the aforesaid goods.

19. I note the following from the Opponent's evidence:

1. The Opponent's evidence includes a number of exhibits that contain information that is undated, from outside of the relevant period, or does not demonstrate any use of the subject mark, but instead relates to other marks owned by the Opponent. Exhibits AM1 – AM4, AM8 – AM11, AM15, AM17, AM19, AM22, AM25 – AM28, AM30 – AM36, AM38 – AM39, AM42 are all such examples of exhibits that are not useful in demonstrating genuine use of the subject mark. Additionally, whilst Exhibit AM37 shows examples of the social media pages for 'Fire TV', they are largely undated, or if they are dated, the date is not legible.

2. The remaining exhibits predominantly consist of screenshots from Amazon press releases, listings, and reviews of the various 'FIRE' products, namely for tablet computers, televisions, media streaming devices, remote controllers for the aforesaid devices, and operating system software. This is a significantly smaller list of goods than the Opponent has indicated it has used the mark in relation to. They include the product specifications and prices. The evidence also demonstrates that the Opponent has released a number of different iterations of the specific goods listed above. These exhibits all show use of the mark on the products listed above, within the relevant period, and within the relevant territory. The reviews from the Amazon website demonstrate use of the mark from customers who have bought the products in the UK, but also from outside of the relevant territory (mainly the USA).

3. There are third-party reviews of the above products in national publications such as 'PC Mag UK', 'The Guardian', and 'The Independent'. Additionally, there are screenshots of competitions from the 'Sky History', and 'Crime + Investigation' websites where the prize included a 'Fire TV stick' (Sky History), and a 'Fire TV stick 4K' (Crime +

Investigation). However, there is no indication of how many people had viewed these reviews, or the readership figures for these publications, or the number of entrants to the competitions.

4. Throughout the whole evidence there are no sales or advertising figures, nor is there any reference to the number of each product sold within the relevant period and territory. The only reference to how many units had been sold under the mark appears in exhibit AM21 which is an Amazon press release that states “Fire TV has sold over 200 million devices globally across its family of streaming media players and smart TVs.” However, this is merely a headline figure and does not indicate how many of each product had been sold throughout the relevant territory and during the relevant period.

Conclusions from the evidence on genuine use

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²

22. The case law summarised in the passage from *easyGroup* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e., it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's* Application, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they

² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

23. In considering the evidence as a whole it appears to be lacking in respect of a number of key areas such as the lack of turnover and advertising figures, as well as no information as to the number of units sold under the trade mark. Further, as noted above, a number of the exhibits show use outside of the relevant period and territory and are therefore not helpful in supporting the Opponent's case to show genuine use. However, it is not necessarily fatal that there is limited evidence of sales or advertising, if other material filed by the Opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector.
24. The majority of the exhibits that have been provided show the subject mark in use on the Opponent's e-commerce website, as well as press releases in relation to goods such as tablet computers, televisions, media streaming devices, remote controllers for the aforesaid devices, and operating system software. Whilst no figures have been provided showing how many units have been sold of each product, the evidence includes numerous reviews from UK customers who have purchased the aforementioned goods during the relevant period. Further, the evidence includes reviews from both slightly before and after the relevant period, demonstrating consistent use of the subject mark that started before, and continued throughout, the relevant period. The reviews from just after the relevant period also cast light backwards onto the continuous use of the subject mark as it is likely that they relate to purchases made within the relevant period. Additionally, the evidence includes third-party reviews from major nationwide publications such as 'The Guardian', 'The Independent', and 'PC Mag UK', which refer to updates and upgrades to previous models and iterations of the relevant goods, again demonstrating continual use of the subject mark in the UK both before and during the relevant period.

25. Further, Exhibit AM21 includes a press release from the Opponent that states that over 200 million Fire TV devices have been sold globally. Whilst this does not demonstrate how many of the products have been sold in the UK, it cannot be denied that the figure is significant, even if it is somewhat abstract. In addition to this, the witness statement of Aimee Mahan states at paragraph 58 that the Opponent has promoted its 'FIRE' brand and offerings through commercial advertisements aired on national television channels such as ITV. It has also used its 'FIRE' brand to sponsor international television shows with global appeal like 'Downton Abbey' which was viewed in over 200 countries and territories and had an estimated global audience of 120 million people.³ Again, whilst these figures do not show how many people in the relevant territory had viewed the advertisements, the fact that they appeared on national television channels and sponsored a hugely popular British television series suggests that a significant amount of UK consumers will have been exposed to the subject mark, nationally. I must also say though, that exhibit AM39 appears to show use of the subject mark before the relevant period. However, as is clear from other parts of the evidence, the use of the subject mark has persisted throughout the relevant period and beyond.
26. Having considered the evidence as a whole, whilst it is lacking in a number of areas, it is conclusive in showing that a number of the Opponent's goods bearing the mark have clearly been sold in this territory during the relevant period. Additionally, it is evident that the widespread press coverage of such goods has also contributed to creating or preserving a market share for the relevant goods. Therefore, on balance, I am content that genuine use has been shown in respect of a proportion of the relevant goods.

Fair Specification

27. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair

³ Exhibit AM39 of Opponent's evidence.

specification where the mark has not been used for all the goods for which it is registered. He said:

“64. [...] The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.”

28. I also bear in mind the law summed up by Mr Geoffrey Hobbs Q.C (as he then was) as Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.

29. I must now consider the fair description of the Opponent’s goods in Class 09 as shown in paragraph 18 above. The Opponent’s current specification includes terms which are considered extremely broad, and others of which there is no evidence of the Opponent providing. Whilst I accept that the goods shown in evidence would be contained within some of the broad terms, in my view, the evidence only demonstrates that genuine use has been shown in respect of

some items. Therefore, the Opponent is not entitled to retain all of the terms listed. In that regard I find that a fair specification of goods in Class 09 to be the following:

Class 09: Tablet computers; televisions; media streaming devices; remote controllers for the aforesaid devices; operating system software.

Section 5(2)(b)

30. 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;
Page 8 of 20

(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

31. The goods for comparison are as follows:

Opponent's goods	Applicant's goods
<p>UK00003204461</p> <p><u>Class 9:</u> Tablet computers; televisions; media streaming devices; remote controllers for the aforesaid devices; operating system software.</p>	<p><u>Class 9:</u> All in one computers; Batteries; Bullhorns; Electronic displays; Flat panel displays; Lap Top computers; LED televisions; Monitors; Projection screens; Projectors; Remote controls; Speakers [audio equipment]; Tablet computers; Televisions; USB adapters.</p>
<p>UK00912755906 – AMAZON FIRE</p> <p><u>Class 9:</u> Scientific, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software; portable and handheld electronic devices for transmitting, storing, manipulating, recording, and reviewing text, images, audio, video and data, including via</p>	

global computer networks, wireless networks, and electronic communications networks and electronic and mechanical parts and fittings therefor; computers; tablet computers, electronic book readers, audio and video players, computer peripheral devices; computer and portable and handheld electronic device accessories, namely, monitors, displays, keyboards, mouse, wires, cables, modems, printers, disk drives, adapters, adapter cards, cable connectors, plug-in connectors, electrical power connectors, docking stations, including electronic docking stations, headphones and earphones and drivers; charging stations, battery chargers; battery packs; memory cards and memory card readers; speakers, microphones, and headsets; cases, covers, and stands for portable and handheld electronic devices and computers; devices for the display of electronically published materials, in the nature of books, journals, newspapers, magazines, multimedia presentations, television programmes and films; headphones and earphones; data synchronization programs, and application development tool programs for personal and handheld computers; computer software for authoring, downloading, transmitting, sharing

receiving, editing, extracting, encoding, decoding, displaying, manipulating, and transferring content, text, visual works, audio works, audio visual works, literary works, data, files, documents and electronic works, graphics, images, and electronic publications via portable electronic devices and computers; downloadable pre-recorded audio and audiovisual content, information, and commentary; downloadable electronic books, magazines, periodicals, newsletters, newspapers, journals, and other publications; database management software; character recognition software; voice recognition software; electronic mail and messaging software; computer software for accessing, browsing and searching online databases; electronic bulletin boards; data synchronization software; application development software; programs for consumer video game apparatus; electronic circuits, magnetic discs, optical discs, optical magnetic discs, magnetic tapes, ROM cards, ROM cartridges, CD-ROMs, and DVD-ROMs storing programs for consumer video game apparatus; electronic circuits, magnetic discs, optical discs, optical magnetic discs, magnetic tapes, ROM cards, ROM cartridges, CD-ROMs, and DVD-ROMs downloadable computer

programs; game programs for computer; computer programs; electronic circuits, magnetic discs, optical discs, optical magnetic discs, magnetic tapes, ROM cards, ROM cartridges, CD-ROMs, DVD-ROMs and storage media storing programs for computers; portable computers; monitors for computers; remote controllers for computers; portable terminals for displaying electronic publications; mouse [data processing equipment]; printers for use with computers; computer peripheral devices; monitors [computer hardware]; scanners [data processing equipment]; electronic pens [visual display units]; electronic agendas; flash memory cards; memory modules; optical discs [blank], magnetic discs [blank], compact discs [blank], and magnetic cards [blank]; DVD players; DVD recorders; remote controllers for DVD recorders and players; remote controllers for video disc recorders and players; remote controllers for recording devices; digital audio players; audio recorders; digital video players; portable apparatus for recording and reproduction of music; portable apparatus for recording and reproduction of video; other apparatus for recording and reproduction of video; monitors for television receiver; television receivers [TV sets] and

<p>television transmitters; remote controllers for television receiver [TV set]; remote controllers for radio set; telecommunication machines and apparatus; recorded compact discs; phonograph records; metronomes; electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments; downloadable music files; exposed cinematographic films; exposed slide films; slide film mounts; downloadable image files; recorded video discs and video tapes; electronic publications; cameras; photographic machines and apparatus; cinematographic machines and apparatus; optical machines and apparatus; batteries and cells; rechargeable batteries; AC adapters for consumer video game apparatus; earphones for consumer video game apparatus; microphones for consumer video game apparatus; monitors for consumer video game apparatus; memory cards for consumer video game apparatus; monitors for arcade video game machines; protective films for liquid crystal displays for handheld game apparatus with liquid crystal displays; apparatus for image and sound archiving and visualisation, apparatus for recording, transmission or reproduction</p>	
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of sound or images; fittings and software for the aforesaid apparatus; data recordings including audio, video, still and moving images and text; computer software, including software for use in downloading, storing, reproducing and organising audio, video, still and moving images and data; downloadable electronic publications; computer, electronic and video games programmes and equipment; electronic instructional and teaching apparatus and instruments; television and radio signal transmitters and receivers; televisions (TV); television tuners; game controllers; set-top boxes; television receivers and transmitters; electronic controllers; electronic controllers to impart sensory feedback, namely, sounds and vibrations that are perceptible to the user; motion sensitive interactive video game remote control units; interactive video game remote control units; portable and handheld electronic devices for video games; video games; computer hardware, software, and peripherals for personalized, interactive television (TV) programming and for use in generating, displaying and manipulating visual media, graphic images, text, photographs, illustrations, digital animation, video clips, film footage and audio data, and for social networking;

wireless controllers to monitor and control the functioning of other electronic devices; remote controls; joysticks; computer touchscreens; consumer video game machines fitted with a camera function adapted for use with external display screen or monitor; consumer video game machines adapted for use with external display screen or monitor; downloadable audio works, visual works, audiovisual works and electronic publications; computer software for use on electronic devices, namely computer software development kit consisting of computer software development tools for the development of content and service delivery across global computer networks, wireless networks, and electronic communications networks; computer software for personalized, interactive television programming and accompanying manuals distributed therewith; computer software for use in generating, displaying and manipulating visual media, graphic images, photographs, illustrations, digital animation, video clips, film footage and audio data; application development computer software programs; computer software for formatting and converting content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works

into a format compatible with portable electronic devices and computers; computer software enabling content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works to be downloaded to and accessed on a computer or other portable consumer electronic device, computer and electronic game software and machines adapted for use with external display screen or monitor; downloadable software in the nature of a mobile application for computers or other portable consumer electronic device; remote controls for portable and handheld electronic devices and computers; software for use in connection with electronic publications; software tool in the nature of a publication/book exploration guide; computer software for searching, locating, compiling, indexing, correlating, navigating, obtaining, downloading, receiving, encoding, decoding, playing, storing and organizing text, data, images, graphics, audio and video on a global computer network; Internet browser software; mobile computers, and mobile communications devices; computer and mobile device software for enhancing uploading and downloading capabilities on computers, mobile

computers, and mobile communications devices; computer software enabling content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works to be downloaded to and accessed on a computer or other portable consumer electronic device, computer and electronic game software, publishing software; downloadable audio works, visual works, audiovisual works, and electronic publications featuring books, magazines, newspapers, periodicals, newsletters, guides, quizzes, tests, journals and manuals on a variety of topics including those of interest to children; downloadable software in the nature of a mobile application in the field of childhood education and development for developing cognitive skills, counting skills, fine motor skills, imaginative play, language, and creative expression; downloadable video games, interactive game programs and applications for computer or other portable consumer electronic device; computer software for transmitting, sharing, receiving, downloading, streaming, displaying and transferring content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works via portable electronic devices and computers and global

<p>computer and communications networks; parental control software; television standards converters; television program decoders; interactive television terminal sets; software for interactive televisions; internet connected interactive televisions; internet connected interactive television set top boxes; computer programmes for interactive televisions and for interactive games, quizzes and puzzles and parts and fittings for all the aforesaid goods; none of the aforesaid goods for use in connection with tax, accounting, cost control, labour law, data security, data protection , personnel management, leadership management, interim management, permanent placement, temporary staffing, or recruitment services.</p>	
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My Approach

32. I will proceed by comparing the Opponent’s second earlier mark on the basis that it is the less similar out of the two relied upon marks. I will continue by comparing the specification of the Opponent’s second earlier mark, however, for completeness, if there is found to be no likelihood of confusion with this mark then I will return to compare the Opponent’s first earlier mark.

33. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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 für 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”.

All in one computers; Lap Top computers; Tablet computers

34. I consider the Opponent’s term ‘*Computers*’ in its second earlier mark broad enough to cover the above terms from the Applicant’s specification. It is my view that the Applicant’s terms would be included in the more general category contained within the Opponent’s specification. The above goods are all types of computers therefore, bearing in mind the principles of *Meric*, are considered identical.

Batteries; remote controls;

35. The terms listed above appear in both the Applicant’s and the Opponent’s specifications. They are identical.

Bullhorns

36. The Collins English Dictionary defines a bullhorn as “a portable loudspeaker having a built-in amplifier and microphone”.⁴ I consider the Opponent’s term ‘*speakers, microphones*’ in its second earlier mark broad enough to cover the above term from the Applicant’s specification. It is my view that the Applicant’s term would be included in the more general category contained within the Opponent’s specification. The above good is a type of loudspeaker, and, bearing in mind the principles of *Meric*, is considered identical.

Electronic displays; Flat panel displays; Monitors.

⁴ <https://www.collinsdictionary.com/dictionary/english/bullhorn>

37. I consider the Opponent's term '*computer and portable and handheld electronic device accessories, namely, monitors, displays [...]*' in its second earlier mark broad enough to cover the above terms from the Applicant's specification. It is my view that the Applicant's terms would be included in the more general category contained within the Opponent's specification. Bearing in mind the principles of *Meric*, they are considered identical.

LED televisions; Televisions.

38. I consider the Opponent's term '*televisions (TV)*' in its second earlier mark broad enough to cover the above terms from the Applicant's specification. The Applicant's '*Televisions*' are self-evidently identical, and its '*LED televisions*' would be included in the more general category contained within the Opponent's specification. Bearing in mind the principles of *Meric*, they are considered identical.

Projection screens; projectors.

39. I consider the Opponent's term '**apparatus for recording, transmission or reproduction of sound or images**' in its second earlier mark broad enough to cover the above terms from the Applicant's specification. It is my view that the Applicant's terms would be included in the more general category contained within the Opponent's specification. The above goods are both apparatus that are used in the reproduction of images, and therefore, bearing in mind the principles of *Meric*, are considered identical.

Speakers [audio equipment].

40. The Opponent's term '*speakers [...]*' is self-evidently identical to the Applicant's term above.

USB adapters.

41. I consider the Opponent's term '*computer and portable and handheld electronic device accessories, namely, [...] **adapters, adapter cards, cable connectors, plug-in connectors** [...]*' in its second earlier mark broad enough to cover the above term from the Applicant's specification. It is my view that the Applicant's term would be included in the more general category contained within the Opponent's specification. Bearing in mind the principles of *Meric*, they are considered identical.

Comparison of the marks

42. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgement 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 relative 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".

43. 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 trade marks.
44. The trade marks to be compared are as follows:

Opponent's trade marks	Applicant's trade mark
("The first earlier mark") FIRE	Minifire
("The second earlier mark") AMAZON FIRE	

45. The Opponent submits that visually, its AMAZON FIRE mark and the Applicant's mark are similar, with both marks ending with the identical 'FIRE' element, and the marks being of a similar length. Further, the Opponent rejects the Applicant's claim that the marks are visually dissimilar because of the differences in the beginning of the marks, given that it is submitted that the 'FIRE' verbal element in the Applicant's mark is the dominant and distinctive element. The Opponent also submits that phonetically, the signs are similar because the pronunciation of the 'FIRE' element is identical in both marks. Finally, the Opponent argues that the marks are conceptually similar because both marks will be seen as a reference to the meaning of the English word 'FIRE,' and that that the inclusion of the 'AMAZON' word element in the Opponent's 'AMAZON FIRE' mark does not offset the perceived conceptual similarity between the marks to any significant degree. Further it submits that the 'MINI' element of the Applicant's mark is likely to be perceived as a description of the size of the goods claimed and therefore again does not offset the conceptual similarity between the marks to any significant degree.
46. The Applicant submits that its mark and the Opponent's 'AMAZON FIRE' mark are visually dissimilar. It states that the beginnings of each mark are distinctly different and that this is significant because consumers typically direct their attention to the beginning of a trademark when they first encounter it. Additionally, the Applicant submits that the 'FIRE' element that is present in both marks is a highly generic term frequently used in trade marks across various sectors which reduces the weight of the shared term in the overall

comparison. Further, the Applicant states that the typographical arrangement of the marks is visually different due to their differing lengths and the space they occupy. The Applicant submits that the marks are aurally dissimilar due to the differences in syllable count, rhythm, and length. It states that 'Minifire' has three syllables and eight characters, but crucially begins with the two distinct syllables "Mi-ni", while 'AMAZON FIRE' has eleven characters and begins with the three syllables "A-ma-zon" followed by a further two syllables. Further, the Applicant states that the additional length and complexity of the Opponent's mark creates a different rhythm and pattern that distinguishes it from its mark. Finally, the Applicant submits that the marks are conceptually dissimilar. It states that its mark 'Minifire' conveys the idea of a smaller or less intense fire due to the prefix 'Mini'. In contrast, the Opponent's mark 'AMAZON FIRE' suggests something vast or powerful and conveys connotations of the rainforest. The Applicant also states that it could be associated with the large e-commerce company 'Amazon'. Although both marks share the word 'Fire', their differing prefixes lead to distinct conceptual impressions, reinforcing that the marks are not conceptually similar.

Overall Impression

47. The Opponent's mark is a word-only mark consisting of the two words 'AMAZON' and 'FIRE'. There are no other elements in the mark to contribute to its overall impression, which lies in the words themselves. I consider the words to be co-dominant, distinctive elements, with both contributing equally to the overall impression of the mark.
48. The Applicant's mark is again a word-only mark, though it consists of the word 'Minifire'. Whilst the word is conjoined, it is my view that the relevant public would perceive it as two separate elements: 'Mini' and 'Fire', due to the natural break between the two recognisable, and readily understood dictionary words. The word 'Mini' would likely be perceived as a reference to the size of the goods and therefore I consider that the 'fire' element plays a more dominant and distinctive role in the mark as a whole. There are no other elements in the mark to contribute to its overall impression.

Visual Comparison

49. The Applicant's mark consists of one eight-letter word and contains the four-letter word 'Mini' before the 'fire' element, which is not present in the Opponent's mark. The Opponent's mark consists of two words, made up of ten letters and contains the six-letter word 'AMAZON' before the 'FIRE' element, which is not present in the Applicant's mark. These act as visual points of difference. However, both marks are similar in length (8 letters vs 10 letters) and contain the identical word 'fire' towards their ends. Bearing in mind my assessment of the overall impression of the marks, I consider there to be between a low and medium degree of visual similarity.

Aural Comparison

50. Aurally, the Applicant's mark consists of three syllables "Mi-Nee-Fire". The 'Mini' element will be pronounced in the ordinary way, as would the 'fire' element. The Opponent's mark consists of four syllables "Ah-Ma-Zon-Fire". Both the word 'AMAZON' and 'FIRE' will again be pronounced in the usual way. There is no aural similarity between the 'Mini' and 'Amazon' elements of the marks, however the 'Fire' element will be identically articulated in both marks. Bearing in mind my assessment of the overall impression of the marks, I consider there to be between a low and medium degree of aural similarity.

Conceptual Comparison

51. The relevant consumer would perceive the words 'Mini' and 'fire' in the Applicant's mark as per their respective dictionary definitions, namely 'small; miniature'⁵ and 'the hot, bright flames produced by things that are burning'⁶ respectively. In combination, the Applicant's mark conveys the concept of a small (mini) fire. The word 'AMAZON' in the Opponent's mark would be

⁵ <https://www.collinsdictionary.com/dictionary/english/mini>

⁶ <https://www.collinsdictionary.com/dictionary/english/fire>

perceived as a reference to South America's longest river, or the largest rainforest in the world by the relevant consumer. Whilst I note the Applicant states that it could also be associated with the large e-commerce company, I respectfully disagree. It is important to point out that reputation and conceptual meaning are not the same thing. Reputation, in a trade mark sense, concerns the factual extent to which a sign is recognised by a significant part of the public as a trade mark, whereas conceptual meaning is a level of immediately perceptible notoriety or independent meaning, outside of a purely trade mark context.⁷ Although there are cases where an extensive reputation has transferred into conceptual meaning, these are the exception rather than the rule and depend on their own facts.⁸ Exceptional cases where trade mark reputation evolves into a conceptual meaning need to be properly proven. It is my view that the evidence filed in these proceedings does not establish that the word 'AMAZON' has evolved into a conceptual meaning. Moving to the word 'FIRE' it would again be perceived in accordance with its dictionary definition. As a result, although the two words somewhat hang together, the combination of them doesn't convey a different concept to that of the two words taken independently. In other words, the words 'AMAZON' and 'FIRE' still mean the same thing in combination as they do separately. Both the Opponent's and the Applicant's marks bring to mind the idea of a fire of some kind and therefore this concept is shared. However, bearing in mind my assessment of the overall impression of the marks, I consider there to be a low degree of conceptual similarity.

Average consumer and the purchasing act

52. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

⁷ *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20, paragraphs 74-75

⁸ *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20, paragraph 76

53. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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:

“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.”

54. I have no submissions from the Applicant regarding the identity of the relevant consumer or the nature of the purchasing act, however, the Opponent submits that the goods claimed in the application are aimed at the average consumer, who is defined above (paragraph 50), who will pay an average level of attention when purchasing the goods.
55. The Applicant's goods are considered to be general consumer goods and therefore the average consumer is the general public at large. The cost of the goods in question is likely to vary due to their differing natures, as will the frequency of purchase. As a result, the consumer is likely to pay varying degrees of attention depending on the goods concerned. For the more everyday goods such as batteries and USB adapters, the average consumer is likely to pay between a low and medium degree of attention, whereas goods such as all in one computers, televisions, tablet computers, or projectors are likely to be more considered purchases, meaning the level attention paid during the purchasing process is likely to be higher than average but not at an outright

high level. The average consumer will take various factors into consideration such as technical reviews of the goods, price, quality, ease of use, and suitability of the product. The selection process would be primarily visual whereby consumers would view the goods on a shelf or display in a physical retail environment, or view images of the goods on websites. Some consumers would also seek information from written reviews and recommendations, particularly on the internet. However, I also do not discount that there will be an aural component to the purchase through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

Distinctive character of the earlier trade mark

56. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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 *Lloyd Schuhfabrik*, the CJEU stated that:

“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).”

57. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are suggestive or allusive of a characteristic of the goods or services, 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. The Opponent has not claimed that the distinctiveness of its ‘AMAZON FIRE’ mark has been enhanced per se, however, it did submit that its ‘FIRE’ mark had. Consequently, I must consider if the ‘FIRE’ element of the Opponent’s mark has been enhanced through the use made of it.⁹ I will firstly consider the inherent distinctiveness of the Opponent’s ‘AMAZON FIRE’ mark, then proceed to assess to what extent, if any, the distinctiveness of the ‘FIRE’ element has been enhanced.
58. The earlier mark consists of the plain words ‘AMAZON FIRE’ without any additional stylisation or figurative elements. As such, the inherent distinctive character rests solely in the words themselves. As stated above, both words are dictionary defined words that would be readily understood by the relevant consumer, however, neither word is descriptive or allusive of the goods concerned. Again, as stated above, neither word is considered to dominate the mark, over and above the other, and are considered independent distinctive elements of the mark. I find the Opponent’s mark to be inherently distinctive to a medium degree.
59. Above I have found the Opponent’s evidence sufficient to prove genuine use of its ‘FIRE’ mark, however, whilst genuine use and enhanced distinctive character are interrelated, they are two distinct concepts. The fact that genuine use of a mark has been found does not automatically mean that it also enjoys

⁹ *China Construction Bank Corp. v EUIPO*, T-665/17, paragraph 52

enhanced distinctiveness. As stated above, the Opponent's evidence is sufficient in demonstrating genuine use of the mark 'FIRE', however, having considered that same evidence, I do not believe it has proven that the mark has developed an enhanced distinctive character. Again, as stated previously, the Opponent's evidence is lacking in a number of areas, *inter alia*, no indication of the market share, no information relating to advertising spend, and no direct evidence of what the consumer's perception of the mark is. Consequently, I am not persuaded that the Opponent has sufficiently demonstrated how strongly the 'FIRE' element of its mark is associated with the goods, to support a conclusion that its inherent distinctiveness has been enhanced through use.

Likelihood of confusion

60. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.
61. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). 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 (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods, and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.
62. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual,

aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

63. Throughout the course of this decision, I have determined that:

- The respective goods are identical.
- The average consumers are members of the general public at large who will demonstrate between a low and above average (but not outright high) degree of attention when purchasing the goods, depending on the particular goods concerned.
- The purchasing process for the goods will be primarily visual in nature, though aural considerations have not been excluded.
- The Opponent's mark possesses a medium degree of inherent distinctive character.
- The marks at issue are visually and aurally similar to between a low and medium degree. The marks are conceptually similar to a low degree.

64. I acknowledge that both marks contain the identical word 'Fire', however, the marks differ in that the Applicant's mark is immediately preceded by, and combined with, the word 'Mini', whereas the Opponent's mark includes the word 'AMAZON'. Although the marks overlap in the shared use of 'Fire', the additional words in the Applicant's and Opponent's marks create differences that are unlikely to be overlooked. Therefore, despite some overlap created by the commonality of the word 'Fire', in my view, this will be outweighed by the differences. Consequently, it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers, even those paying a low level of attention, to avoid mistaking the marks for one

another, notwithstanding the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

65. I turn now to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.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)".

66. 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, 16 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.
67. As highlighted above, Mr Purvis Q.C. in *L.A Sugar* sets out that there are three main categories of indirect confusion, and that indirect confusion 'tends' to fall in one of them.
68. In this instance, I consider the word 'Fire' to be independently distinctive, possessing a medium degree of distinctiveness. It has no relationship to the goods concerned and would be considered arbitrary by the relevant consumer. Moreover, the additional element, 'Mini' in the Applicant's mark is considered to be a non-distinctive element of the mark, indicating the size of the goods. It is therefore considered that the shared use of 'Fire' would not be perceived as a mere coincidence by the relevant consumer, but instead they would assume there is an economical connection between the marks. This is even more the case where the goods are identical. Further, I also remind myself that I have found the two elements in the Opponent's mark to be co-dominant, with the

word 'FIRE' retaining an independent distinctive role.¹⁰ Finally, whilst I appreciate that beginnings of marks tend to have more visual and aural impact than the ends of marks, it is also accepted that that a common element at the end of a mark can be sufficient to create a likelihood of confusion. In *Bristol Global Co Ltd v EUIPO*, T-194/14, the General Court held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed. Taking all of the above into consideration, I find there to be a likelihood of indirect confusion.

CONCLUSION

69. The opposition under Section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal, the application will be refused for all of the goods concerned.
70. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade mark upon which the opposition is based.

COSTS

71. As it has been successful, the Opponent is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. Applying the guidance in the TPN, I consider the following to be fair:

Official Fee:

£100

¹⁰ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

Preparing the notice of opposition and considering the counterstatement	£250
Preparing evidence ¹¹	£300
Written submissions in lieu	£350
Total:	£1000

72. I therefore order **KernelTech Software (Shenzhen) Co., Ltd.** to pay **Amazon Technologies, Inc.** the sum of £1000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of October 2025

Oliver Rose'Meyer
For the Registrar

¹¹ The Opponent's evidence consisted of over 750 pages, of which, a large amount of it was considered unnecessary and irrelevant. Consequently, I have reduced the amount awarded for the preparation of the evidence.