

O-370-13

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO 2636395
BY KINDLE ENTERTAINMENT LIMITED

AND

OPPOSITION THERETO UNDER NO 104149
BY AMAZON EUROPE HOLDING TECHNOLOGIES SCS

Background

1. Application No 2636395 stands in the name of Kindle Entertainment Limited (“the applicant”) and was applied for on 29 May 2009. The application seeks registration of the mark KINDLE in respect of the following goods and services:

Class 25: Clothing, footwear, headgear

Class 41: Entertainment; entertainment services; entertainment services in the form of television programmes, radio, cable, satellite and Internet programmes; production and presentation of television programmes, shows, films, videos and DVDs; production and presentation of television, radio, cable, satellite and Internet programmes; production, presentation, distribution, syndication, networking and rental of television, radio, cable, satellite and Internet programmes and of films, sound recordings, video recordings and DVDs; educational services relating to entertainment; information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media; publishing; music publishing; audio and video recording services; organisation, production and presentation of events for educational, cultural or entertainment purposes; conducting, organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, shows, roadshows, staged events, raves, theatrical performances, concerts, live performances and participation events; information and advisory services relating to any of the aforesaid services.

2. Following publication of the application in the Trade Marks Journal No 6967 on 23 November 2012, notice of opposition was filed by Amazon Europe Holding Technologies SCS (“the opponent”). The grounds of opposition are founded on objections under sections 5(1) and 5(2)(a) of the Act and are directed to the application only insofar as it seeks registration of the above services in class 41. In support of its claims, the opponent relies on the following Community trade mark (“CTM”):

Mark	Relevant dates	Specification of goods and services relied upon
CTM 5376108 KINDLE	Filing date: 11 October 2006 Priority date: 2 May 2006 (USA) Registration date: 21 December	Class 9: Scientific, nautical, surveying, photographic, cinemato-graphic, optical, weighing, measuring, signalling, checking (su-pervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, trans-forming, accumulating, regulating or controlling electricity; ap-paratus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated appa-ratus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; port-able electronic device for receiving and reading text and images and sound through wireless internet access; device for the display of elec-tronically published materials, namely, books, journals, newspapers, magazines, multimedia presentations; computer hardware and soft-

	2010	<p>ware in the field of text, image and sound transmission and display; transmission of text, images and sound through a portable electronic device; providing information in the field of electronic publishing in all forms via a global computer information network.</p> <p>Class 41: Education; providing of training; entertainment; sporting and cultural activities; publishing services, in particular publishing of books and media content in digital format</p>
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3. The applicant filed a counterstatement in which it accepts that the respective trade marks are identical but indicates it makes no admissions as to whether the respective services are identical, similar or complementary and puts the opponent to strict proof of its claims under section 5(1) and 5(2)(a) of the Act.

4. Neither party filed evidence but the opponent filed written submissions. Neither party sought to be heard. I therefore give this decision after a careful review of all of the written material before me.

Decision

5. The opposition is founded on grounds under Section 5(1) and 5(2)(a) of the Act. The relevant parts of the Act read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b)

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

6. An “earlier trade mark” is defined in section 6 of the Act. It states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

7. In support of its opposition, the opponent relies on its CTM 5376108, details of which are set out above. Whilst it is an earlier mark within the meaning of the Act, it is not subject to the proof of use requirements set down in section 6A as it had not been registered for five years at the date of publication of the application now under consideration. The opponent is therefore entitled to rely on it, to the extent it sees fit, in these proceedings.

8. In determining the question under section 5(2)(a) of the Act, I take into account the guidance provided by the European Court of Justice (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion

Comparison of the respective marks

9. In deciding whether or not the respective trade marks are identical, I take account of the following statement from the Court of Justice of the European Union (“CJEU”):

S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA [2003] FSR 34

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

10. It is self evident, and there is no dispute, that the respective trade marks are identical.

Comparison of the respective goods and services

11. For ease of reference, the goods and services to be compared are set out below:

Opponent's goods and services	Applicant's services
<p>Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving 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; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; portable electronic device for receiving and reading text and images and sound through wireless internet access; device for the display of electronically published materials, namely, books, journals, newspapers, magazines, multimedia presentations; computer hardware and software in the field of text, image and sound transmission and display; transmission of text, images and sound through a portable electronic device; providing information in the field of electronic publishing in all forms via a global computer information network.</p> <p>Class 41: Education; providing of training; entertainment; sporting and cultural activities; publishing services, in particular publishing of books and media content in digital format</p>	<p>Class 41: Entertainment; entertainment services; entertainment services in the form of television programmes, radio, cable, satellite and Internet programmes; production and presentation of television programmes, shows, films, videos and DVDs; production and presentation of television, radio, cable, satellite and Internet programmes; production, presentation, distribution, syndication, networking and rental of television, radio, cable, satellite and Internet programmes and of films, sound recordings, video recordings and DVDs; educational services relating to entertainment; information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media; publishing; music publishing; audio and video recording services; organisation, production and presentation of events for educational, cultural or entertainment purposes; conducting, organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, shows, roadshows, staged events, raves, theatrical performances, concerts, live performances and participation events; information and advisory services relating to any of the aforesaid services.</p>

12. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.

13. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed. He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

He went on to say:

“in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”.

14. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 the court said:

“Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning”

15. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) Floyd J stated:

“12. There are sound policy reasons for this. Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

16. I must also consider how the average consumer would view the goods and services. *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but is still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied

by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

17. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* the General Court (GC) explained when goods are complementary:

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

18. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* paragraph 29 it was stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

19. Both specifications in class 41 include the term *entertainment* and so identical services are involved. *Entertainment services* as appears in the application are also identical to *entertainment*. Similarly, both include the identical *publishing (services)*.

20. The specification of the earlier mark includes *Education; entertainment; sporting and cultural activities; publishing services*. These are broad terms which will include, in normal language, a wide range of services. I consider they include the following services as are included within the applicant’s specification: *entertainment services in the form of television programmes, radio, cable, satellite and Internet programmes; production and presentation of television programmes, shows, films, videos and DVDs; production and presentation of television, radio, cable, satellite and Internet programmes; production, presentation, distribution, syndication, networking and rental of television, radio, cable, satellite and Internet programmes and of films, sound recordings, video recordings and DVDs; educational services*

relating to entertainment; information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media; music publishing; audio and video recording services; organisation, production and presentation of events for educational, cultural or entertainment purposes; conducting, organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, shows, roadshows, staged events, raves, theatrical performances, concerts, live performances and participation events.

21. That leaves *information and advisory services relating to any of the aforesaid services* as appears in the application. It is a normal part of the provision of a given service for information and advice also to be given in relation to that service. I consider these services to be included within, and therefore identical to, the specification of services of the earlier mark.

22. I have found both the respective marks and respective services to be identical. The opposition brought on grounds under section 5(1) of the Act therefore succeeds.

23. In case I am found to be wrong in my assessment that each of the respective services are identical, I would have found that they are very highly similar such that the opposition would have succeeded under the provisions of section 5(2)(a) of the Act as confusion is inevitable.

Summary

24. The opposition succeeds in full under the provisions of section 5(1) of the Act. The application will, in due course, proceed to registration in respect of the specification as applied for in class 25 which has not been subject to opposition.

Costs

25. The opponent having succeeded, it is entitled to an award of costs in its favour. I take into account that neither party filed evidence and that no hearing took place. Whilst the opposition was launched without prior warning being given to the applicant, the applicant, in filing a counterstatement, sought to defend it. I make the award on the following basis:

For filing a statement and reviewing the other side's statement:	£300
Opposition fee:	£200
For filing written submissions:	£300
Total:	£800

26. I order Kindle Entertainment Limited to pay Amazon Europe Holding Technologies SCS the sum of £800 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of September 2013

**Ann Corbett
For the Registrar
The Comptroller-General**