

O/103/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003422223

BY AMAZON TECHNOLOGIES, INC.

TO REGISTER THE TRADE MARK:

 **amazon** project**ZERO**

IN CLASS 35, 42 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 419299

BY YELLOW BRAND PROTECTION ZERO AB

## **Background and pleadings**

1. On 19 August 2019, Amazon Technologies, Inc. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 1 November 2019. The applicant seeks registration for the following services:

Class 35 Business services, namely, providing, conducting and administering a program to record intellectual property rights and report violations; Business services, namely, providing, conducting and administering a program to protect intellectual property rights on a marketplace using recordation of trademark registrations, reporting of violations, and removal of listings; Business services, namely, providing, conducting and administering a program to combat infringement, counterfeiting, tampering and diversion; Business services, namely, providing, conducting and administering a program to monitor and manage product through a supply chain; Business services, namely, administration of a program to record and protect intellectual property rights; Compilation of information into computer databases for purposes of tracing and tracking product origin, ingredients, materials, and manufacture.

Class 42 Platform as a service (PaaS) featuring computer software for use in recording intellectual property rights; Platform as a service (PaaS) featuring computer software for use in reporting violations of intellectual property rights; Platform as a service (PaaS) featuring computer software for use in removing product listings from an online marketplace; Platform as a service (PaaS) featuring computer software for use in monitoring product location for the protection of intellectual property rights; Platform as a service (PaaS) featuring computer software for use in tracing and tracking product through a supply chain.

Class 45 Providing information in the field of intellectual property rights protection.

2. The application was opposed by Yellow Brand Protection ZERO AB (“the opponent”) on 31 January 2020. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

# ZERO

EUTM registration no. EU016374605<sup>1</sup>

Filing date 15 February 2017; registration date 13 June 2017

Relying upon all goods for which the earlier mark is registered, namely:

Class 9        Software for commercial and business research and surveys on online marketplaces, auction sites, online stores, websites, app and social media with regards to companies’ use of intellectual property and their sale of Products; software for online investigations in relation to how intellectual property is used on online marketplaces, auction sites, online stores, websites, apps and social media; software for the enforcement of intellectual property rights; software for marketing analysis; software for the comparison of prices.

Class 35       Commercial and business research and surveys on online marketplaces, auction sites, online stores, websites apps and social media with regards to companies’ use of intellectual property and their sale of Products.

Class 45       Enforcement of intellectual property rights, namely actions vis-à-vis administrators of online marketplaces, auction sites, online stores, websites, apps and social media notifying them of illicit on-line advertisements containing proprietors’ protected intellectual property, or the display of counterfeit products, on these sites with the purpose of having such advertisements removed.

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/200 for further information.

3. The opponent claims that there is a likelihood of confusion because its mark is similar to the applicant's mark and the parties' respective goods and services are similar. The opponent is opposing all services for which the applicant seeks protection.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Boulton Wade Tennant LLP and the applicant is represented by Morgan, Lewis & Bockius UK LLP. Only the opponent filed evidence. The applicant filed written submissions during the evidence rounds dated 7 December 2020. Neither party requested a hearing. However, both the applicant and opponent filed written submissions in lieu. Whilst I do not propose to summarise those submissions here, I have taken them into consideration, and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

6. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

### **Opponent's Evidence**

7. The opponent filed evidence in the form of the witness statement of Naomi Clare Jenkins dated 6 October 2020, which is accompanied by three exhibits. Ms Jenkins is the Chartered Trade Mark Attorney acting on behalf of the opponent.

8. The opponent has submitted the following evidence:

- a) Exhibit 1 is a series of four screenshots, all undated. In particular, I note as follows:

- a. Page 6 contains a screenshot is of Amazon's Project Zero page which explains what the platform does and what eligibility requirements there are to use this service.
  - b. Pages 7-9 contain screenshots from the website Corsearch which has brand protection technology called ZERO and explains what this technology does.
- b) Exhibit 2 is a series of screenshots print dated 6 October 2020. In particular, I note as follows:
- a. Pages 11-13 contain screenshots from a blog about "The Partnership between Amazon and Slack and the Future of Enterprise Workplaces" dated 20 July 2020.
  - b. Pages 14-16 contain screenshots from a blog about "Shopify and Amazon Partner to Bring Amazon Services to Merchants" dated 17 September 2015.
  - c. Page 17 is a screenshot from a Morrisons page which shows that if you sign in, you can get a free grocery delivery which is only available to Prime members. Pages 18-20 are screenshots from Amazon which depict morrisons branded groceries.
  - d. Pages 21-22 are screenshots from the Amazon site, which says "Amazon Platinum Mastercard by Amazon", with a picture of a card, with an apply now button underneath. In the product description it tells users how you can earn Amazon reward points when spending money on Amazon or elsewhere. This contains reviews dated the 28 January and 13 September 2018.
  - e. On page 23 is a screenshot is of an "Amazon Rewards Visa Signature Cards" page.
  - f. On pages 24-27 are screenshots of how you can use "American Express Membership Rewards points at Amazon.co.uk".

- g. On pages 28-30 are screenshots of Amazon Business American Express cards, their rewards and benefits.
  - h. On pages 31-34 are screenshots from the TSC website regarding TSC Amazon Connect, which is a contact centre service.
- c) Exhibit 3 is an extract from the United States Securities and Exchange Commission which contains Amazon's public securities filings for the year of 2018.

9. I will refer to the evidence below where appropriate.

### **Preliminary Issues**

10. In the applicant's written submissions they submitted that:

"The Applicant again highlights the Opponent did not file any legal submissions in explanation of the evidence filed within the Witness Statement of Naomi Clare Jenkins and Exhibits 1-3 thereto.

The applicant notes that final submissions are not an opportunity to give further evidence. Accordingly, the Applicant submits that the Opponent should not be permitted to use its final written submissions to supplement the Witness Statement of Naomi Clare Jenkins and Exhibits 1-3 thereto."

11. In response to the comments, the tribunal wrote out as follows:

"The applicant's comments under paragraphs 13-14 of their final written submissions are noted by the hearing officer.

If the Hearing Officer considers that any part of the opponent's final written submission amounts to substantive evidence, then it will be disregarded."

12. I have noted the applicant's concerns. However, this will have no bearing on the outcome of these proceedings for the reasons set out below.

13. A suspension request had also been made because the applicant brought an application for a declaration of invalidity at the EUIPO against the opponent's mark under Article 7(1)(b) and Article 7(1)(c) EUTMR. I declined to grant this suspension on the basis that a provisional decision can be issued if necessary. However, for the reasons set out below, the invalidation will not have an impact on the outcome of these proceedings.

### **Section 5(2)(b)**

14. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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

(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.”

16. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the opponent’s mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

#### **Section 5(2)(b) case law**

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

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



- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

### Comparison of goods and services

18. The competing goods and services are as follows:

<b>Opponent's goods and services</b>	<b>Applicant's services</b>
<p><u>Class 9</u> Software for commercial and business research and surveys on online marketplaces, auction sites, online stores, websites, app and social media with regards to companies' use of intellectual property and their sale of Products; software for online investigations in relation to how intellectual property is used on online marketplaces, auction sites, online stores, websites, apps and social media; software for the enforcement of intellectual property rights; software for marketing analysis; software for the comparison of prices.</p> <p><u>Class 35</u> Commercial and business research and surveys on online marketplaces, auction sites, online stores, websites apps and social media with regards to companies' use of intellectual property and their sale of Products.</p>	<p><u>Class 35</u> Business services, namely, providing, conducting and administering a program to record intellectual property rights and report violations; Business services, namely, providing, conducting and administering a program to protect intellectual property rights on a marketplace using recordation of trademark registrations, reporting of violations, and removal of listings; Business services, namely, providing, conducting and administering a program to combat infringement, counterfeiting, tampering and diversion; Business services, namely, providing, conducting and administering a program to monitor and manage product through a supply chain; Business services, namely, administration of a program to record and protect intellectual property rights; Compilation of information into computer databases for purposes of tracing and</p>

<p><u>Class 45</u> Enforcement of intellectual property rights, namely actions vis-à-vis administrators of online marketplaces, auction sites, online stores, websites, apps and social media notifying them of illicit on-line advertisements containing proprietors' protected intellectual property, or the display of counterfeit products, on these sites with the purpose of having such advertisements removed.</p>	<p>tracking product origin, ingredients, materials, and manufacture.</p> <p><u>Class 42</u> Platform as a service (PaaS) featuring computer software for use in recording intellectual property rights; Platform as a service (PaaS) featuring computer software for use in reporting violations of intellectual property rights; Platform as a service (PaaS) featuring computer software for use in removing product listings from an online marketplace; Platform as a service (PaaS) featuring computer software for use in monitoring product location for the protection of intellectual property rights; Platform as a service (PaaS) featuring computer software for use in tracing and tracking product through a supply chain.</p> <p><u>Class 45</u> Providing information in the field of intellectual property rights protection.</p>
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19. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective 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

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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) (IP TRANSLATOR)* [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.”

21. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course,

to the normal and necessary principle that the words must be construed by reference to their context.”

22. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

23. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording ‘namely’ should be interpreted as covering only the named services within that specification. Therefore, the specification is limited to only those services.

### Class 35

*Business services, namely, providing, conducting and administering a program to record intellectual property rights and report violations; Business services, namely, providing, conducting and administering a program to protect intellectual property rights on a marketplace using recordation of trademark registrations, reporting of violations, and removal of listings; Business services, namely, providing, conducting and administering a program to combat infringement, counterfeiting, tampering and diversion; Business services, namely, administration of a program to record and protect intellectual property rights;*

24. Software is defined as “the programs that can be used with a particular computer system”.<sup>2</sup> Therefore, “software for the enforcement of intellectual property rights” in the opponent’s specification is a type of computer program which is administered as a service in the applicant’s specification. These will, therefore, be in competition with each other, in that consumers may choose to buy either software for managing

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<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/software>

intellectual property rights violations or the business services in the applicant's specification which overlap in purpose. The user of the goods and services, businesses and brand owning members of the general public, will overlap. There may also be overlap in trade channels, as businesses that provide these services, may also provide software goods for different intellectual property purposes such as recording and enforcing. Consequently, the purpose of the goods and services overlap because they are both used to protect intellectual property rights. However, the goods and services will differ in nature and method of use. Consequently, I consider the goods and services to be similar to a medium degree.

25. These terms are also similar to "Enforcement of intellectual property rights, namely actions vis-à-vis administrators of online marketplaces, auction sites, online stores, websites, apps and social media notifying them of illicit on-line advertisements containing proprietors' protected intellectual property, or the display of counterfeit products, on these sites with the purpose of having such advertisements removed". The services would overlap in user and purpose. The users of these services will be businesses and brand owning members of the general public. The purpose will be the same in that they are both services aimed at the protection of intellectual property rights and the removal of infringing content. There may also be overlap in trade channels. The services differ in nature and method of use as the applicant provides a program to carry out the task, whereas the opponent uses administrators to achieve this purpose. They may also be in competition because the average consumer could choose either to achieve the same result. Taking the above into account, I consider there to be a medium degree of similarity between the services.

*Business services, namely, providing, conducting and administering a program to monitor and manage product through a supply chain;*

26. The opponent submits that this term is similar to a high degree to "software for the enforcement of intellectual property rights". They submit that they overlap in users and trade channels as well as being in competition with each other. As highlighted by the above case law, I should not give the specifications such 'a wide construction covering

a vast range of activities'.<sup>3</sup> There is no reference in the opponent's specification to monitoring products through their supply chain. In the absence of any evidence, I see no reason why these two activities would overlap. Therefore, I consider that there is no overlap in use, nature or method of use with any of the terms identified by the opponent. I can see no other point of similarity with the opponent's specification. I recognise that there may be an overlap in user but this is not enough, on its own, for a finding of similarity. There is no overlap in trade channels, and the services are not in competition because they serve different purposes. I do not consider there to be any complementarity.<sup>4</sup> Taking the above into account, I consider the services to be dissimilar. Even if I am wrong in this finding, and there is some overlap, then it will only lead to a low degree of similarity.

*Compilation of information into computer databases for purposes of tracing and tracking product origin, ingredients, materials, and manufacture.*

27. This term is dissimilar to the opponent's specification as there is no reference to tracing and tracking product origin, ingredients, materials and manufacture and no other obvious point of overlap. The users will, of course, overlap. However, the nature, purpose, method of use and trade channels will all differ. The goods and services will not be in competition because you would not select one as an alternative for the other as they serve different purposes. I do not consider there to be complementarity. Taking into account the above, I consider the goods and services to be dissimilar. Even if I am wrong in this finding, and there is some overlap, then it will only lead to a low degree of similarity.

#### Class 42

*Platform as a service (PaaS) featuring computer software for use in recording intellectual property rights;*

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<sup>3</sup> *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated

<sup>4</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

28. This term is similar to “Software for the enforcement of intellectual property rights” in the opponent’s specification. The goods and services both involve software which overlap in purpose because they are both used to protect intellectual property rights. There may also be overlap in trade channels as businesses that provide a platform as a service which uses computer software to record intellectual property rights, may also provide software goods for different intellectual property purposes such as enforcement. The user of the goods and services will also overlap. However, the goods and services will differ in nature and method of use. Taking the above into account, I consider the goods and services to be similar to a medium degree.

*Platform as a service (PaaS) featuring computer software for use in reporting violations of intellectual property rights;*

29. This term is similar to “software for the enforcement of intellectual property rights” in the opponent’s specification. The goods and services both involve software which would be used to enforce against infringements and protect brands and businesses’ intellectual property rights. The enforcement of intellectual property rights would likely involve the report of violations which would consequently lead to its removal. Consequently, they overlap in purpose and user. However, the goods and services will differ in nature and method of use as the applicant has a platform as a service which uses software, whereas the opponent’s specification is just the software itself. They also may overlap in trade channels. These will, therefore, be in competition in that consumers may choose to buy either the software itself or the platform as a service. Taking the above into account, I consider the goods and services to be similar to a medium degree.

*Platform as a service (PaaS) featuring computer software for use in removing product listings from an online marketplace;*

30. This term is similar to “Enforcement of intellectual property rights, namely actions vis-à-vis administrators of online marketplaces, auction sites, online stores, websites, apps and social media notifying them of illicit on-line advertisements containing proprietors’ protected intellectual property, or the display of counterfeit products, on these sites with the purpose of having such advertisements removed”. Both overlap in



use and user as these services will be used by businesses and brand owning members of the general public, in order to protect their intellectual property rights and remove infringing content. However, the nature of the services differ as the applicant has a platform as a service which uses software to remove the products, whereas the opponent uses administrators to achieve the same result. There may be a degree of competition between them. There will also be an overlap in trade channels because the same undertakings may provide both services as an alternative way of achieving the desired result. Taking the above into account, I consider there to be a medium degree of similarity between the services.

*Platform as a service (PaaS) featuring computer software for use in monitoring product location for the protection of intellectual property rights;*

31. The opponent submits that this term is similar to a high degree to “software for the enforcement of intellectual property rights”. The goods and services both involve software which would be used to enforce against infringements and protect brands and businesses intellectual property rights. However, there is no reference in the opponent’s specification to monitoring product location. They overlap in purpose and user, as they will be used by businesses and brand owning members of the general public, to protect their intellectual property rights. However, the goods and services will differ in nature and method of use as the applicant has a platform as a service which uses software, whereas the opponent’s specification is just the software itself. They also may overlap in trade channels. There may also be competition in that consumers may choose to buy either the software itself or the platform as a service. Taking the above into account, I consider the goods and services to be similar to a medium degree.

*Platform as a service (PaaS) featuring computer software for use in tracing and tracking product through a supply chain.*

32. The opponent submits that this term is similar to a high degree to “software for the enforcement of intellectual property rights”. They submit that they overlap in users and trade channels as well as being in competition with each other. They submit that “tracing and tracking of products is one method of combatting infringement and

counterfeits”. I have no evidence regarding this. As highlighted by the above case law, I should not give the specifications such ‘a wide construction covering a vast range of activities’.<sup>5</sup> There is no reference in the opponent’s specification about the tracking and tracing of products and no other point of obvious overlap. The users will, of course, overlap. However, the nature, method of use and trade channels will all differ. The goods and services are not in competition because you would not select one as an alternative for the other. I consider that these goods and services are dissimilar. Even if I am wrong in this finding, and there is some overlap, then it will only lead to a low degree of similarity.

### Class 45

*Providing information in the field of intellectual property rights protection.*

33. This term will overlap with “Enforcement of intellectual property rights, namely actions vis-à-vis administrators of online marketplaces, auction sites, online stores, websites, apps and social media notifying them of illicit on-line advertisements containing proprietors’ protected intellectual property, or the display of counterfeit products, on these sites with the purpose of having such advertisements removed”. The users of these services will be the same as they will both be used by businesses and brand owning members of the general public. There may also be overlap in trade channels as businesses that provide information in the field of intellectual property rights protection may also provide the service of enforcing against violations of intellectual property rights. I consider that there may be an overlap in purpose, as both the goods and services are being used for the protection of intellectual property rights, however, they differ in method of use and nature. Consequently, I consider there to be a medium degree of similarity between the goods and services.

### **The average consumer and the nature of the purchasing act**

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then

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<sup>5</sup> *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated

determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

35. The goods and services are largely aimed at businesses and brand owning members of the general public. The cost of the goods and services in question could vary and would be purchased relatively infrequently. The average consumer will take various factors into consideration such as the cost, the services on offer and the suitability for their specific intellectual property requirements. Therefore, the level of attention paid during the purchasing process will be medium.

36. The goods and services are likely to be purchased from physical premises, websites or advertisements. Visual considerations are, therefore, likely to dominate the selection process. I do not discount that there may also be an aural component to the purchase through sales pitches or advice sought from a sales assistant or specialist representative.

### **Comparison of the trade marks**

37. 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 judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their 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.”

38. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

39. The respective trade marks are shown below:

Opponent’s trade mark	Applicant’s trade mark
<b>ZERO</b>	 The logo for the applicant's trade mark consists of the word "amazon" in a lowercase, sans-serif font with a curved arrow underneath it. To the right of "amazon" is the word "project" in a smaller, lowercase, sans-serif font, followed by the word "ZERO" in a large, bold, uppercase, sans-serif font.

40. The opponent’s mark consists of the word ZERO. There are no other elements to contribute to the overall impression of the mark which lies in the word itself.

41. The applicant’s mark consists of the words amazon, project and ZERO. Underneath the word amazon is an arrow device curving upwards. The opponent submits that the word ZERO in the applicant’s mark stands out as it is in a bold and upper-case font. The applicant submits that the ZERO is only “marginally larger” than the word amazon, which is the dominant part of their mark, alongside the “smile device” which sits underneath it. I have taken both submissions into consideration. I consider that the words ‘project ZERO’ will be read in conjunction with each other, with

one word qualifying the other. The words “amazon” and “project ZERO” play the greater role in the overall impression, with the device and stylisation playing a lesser role.

42. Visually, the marks coincide in the fact that the opponent’s mark is entirely replicated in the applicant’s mark. However, as a general rule, the beginnings of the marks tend to make more impact than the ends<sup>6</sup>, especially as words are read from left to right. The words ‘amazon’, ‘project’ and the arrow device all act as visual points of difference between the marks. I consider the marks to be visually similar to between a low and medium degree.

43. Aurally, the word ZERO will be given its ordinary English pronunciation in both marks. The words amazon and project will also be given their ordinary English pronunciation in the applicant’s trade mark. These are both points of aural difference between the marks. I consider the marks to be aurally similar to between a low and medium degree.

44. Conceptually, the applicant submits that the arrow is a “smile device”. However, I consider that there is no reason to conclude that the curved arrow will be seen as a smile by the average consumer.

45. The word ZERO in the opponent’s mark will be given its ordinary dictionary meaning of “nothing” or something that has no numerical value. The marks overlap conceptually, therefore, to the extent that they both refer to ZERO. A conceptual point of difference between the marks is the words amazon and project which have no counterpart in the opponent’s mark. The words amazon and project will also be attributed their ordinary dictionary meanings; project being a type of activity that someone works on for a prolonged period of time, and the word amazon being the name of a river. The words project and ZERO in combination will convey the meaning of a project called ZERO. Although the common use of the word ZERO in both marks is a point of conceptual overlap, the meanings of the marks when taken as a whole

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<sup>6</sup> *El Corte Ingles, SA v OHIM, Cases T-183/02 and T-184/02*

are quite different. I consider there is a low degree of conceptual similarity between the marks.

### **Distinctive character of the earlier trade mark**

46. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

47. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods 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.

48. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

49. The word ZERO is a recognisable ordinary dictionary word which would be known by the average consumer. The applicant submits that the opponent's mark is distinctive but to "only a very minimal degree as there is a direct and specific relationship" between the word ZERO and the goods and services. They submit that "the average consumer will simply understand ZERO to denote that the software and services covered by the Earlier Mark will allow the consumer to have a "zero" tolerance approach to the enforcement of intellectual property rights by stopping at nothing to identify and prevent infringement". However, I disagree. I consider this to be too tenuous a link with the goods/services for the average consumer to identify. Based on its ordinary dictionary meaning, it is neither allusive nor descriptive of the goods and services for which the mark is registered. Taking the above into consideration, I consider the opponent's mark to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

50. 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 or services down to the responsible undertakings being the same or related. 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. 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services 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.

51. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to between a low and medium degree.
- I have found the marks to be conceptually similar to a low degree.
- I have found the earlier mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be businesses and brand owning members of the general public, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties goods and services to vary from being dissimilar (or, if I am wrong in that finding, similar to a low degree) to similar to a medium degree.

52. Taking all of the factors listed in paragraph 51 into account, particularly the visual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the additional words “amazon” and “project” in the applicant’s mark will be overlooked by the average consumer. I do not consider there to be a likelihood of direct confusion.

53. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

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

55. Having identified the visual, aural and conceptual differences between the marks, I do not consider that the average consumer would conclude that they originate from the same or economically linked undertakings. Although both marks share the common element ZERO, its use in combination with the word project means that it takes on a different meaning i.e. the name of the project itself. I do not, therefore, consider that the average consumer will view it as a logical brand extension or variant of the opponent’s mark.

56. In reaching my conclusion, I have also taken into consideration the evidence filled by the opponent. This evidence is supported in the opponent’s written submissions that “the Applicant is known for co-branding with other entities” and entering into joint ventures with other brands, such as those included in Exhibit NCJ-2. They submit that there is a likelihood of indirect confusion, which “is increased even further to the point where it will be inevitable” as the consumer would “believe that the Opponent has entered into a joint venture or co-branded with the Applicant”. This submission is flawed and does not assist establishing a likelihood of confusion. For there to be a likelihood of confusion, there must be some similarity between the trade marks themselves, (and the goods/services for which they are registered/applied-for) which creates confusion as to trade origin. The evidence filed by the opponent does nothing more than demonstrate that with education through promotional activities, the average

consumer may see the two companies with entirely different trade marks working together, in collaboration. This is not the same as confusion. For example, whilst the members of the public may have seen promotional activity confirming that Mastercard and Amazon are working together, there is nothing about those trade marks themselves that would leave the average consumer to conclude that they originate from the same undertaking; they are entirely different. If the average consumer concludes that the trade marks belong to separate entities that are merely working together, that would not be indirect confusion. Consequently, I do not consider that this evidence assists the opponent. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion.

### **Conclusion**

57. The opposition is unsuccessful and the application may proceed to registration.

### **Costs**

58. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,050** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Considering and commenting on Opponent's evidence	£500
Preparing and filling written submissions in lieu	£350
<b>Total</b>	<b>£1,050</b>

59. I therefore order Yellow Brand Protection ZERO AB to pay Amazon Technologies, Inc. the sum of £1,050. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 15<sup>th</sup> day of February 2021**

**L FAYTER**

**For the Registrar**