

O-802-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3486663

**IN THE NAME OF CARVELL GROUP LTD
FOR THE TRADE MARK**



IN CLASSES 41 & 42

AND

THE OPPOSITION THERETO UNDER NUMBER OP000422225

BY

AMAZON EUROPE CORE S.À.R.L

Background and pleadings

1. Carvell Group Ltd (“the Applicant”) applied to register the trade mark as shown on the cover page of this decision, on 4 May 2020; for the services listed below. The application was accepted and published in the Trade Marks Journal for opposition purposes on 28 August 2020.

Class 41: Education and training; Production and sale of compliance documents.

Class 42: Maintenance of software.

2. On 27 November 2020, the application was opposed by Amazon Europe Core S.à.r.l. (“the Opponent”). The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its three earlier Trade Marks: UK00003204461 (“the first earlier mark”), EU012755906 (“the second earlier mark”) and EU011784774 (“the third earlier mark”). The opposition is directed against all of the services in the application. After having considered the earlier marks, in the interest of procedural efficiency, I will approach the assessment, at least initially, on the basis of the Opponent’s first earlier mark; as this mark *prima facie* presents the best prospect of success. I will only consider the second and third earlier marks (which are shown in the Annex to this decision) should it prove necessary to do so.
3. The services relied upon in this opposition (under the first earlier mark) are as follows:

UK00003204461 – Filing date: 31 December 2016; Date of entry in register: 26 May 2017

FIRE

Class 41: Education; providing of training; entertainment; sporting and cultural activities; publishing of books, magazines, periodicals, literary works, visual works, audio works, and audiovisual works; providing non-downloadable pre-recorded audio, visual and audiovisual works via wired and wireless networks on a variety of topics of general interest; providing on-line computer games and on-line interactive stories; providing electronic non-downloadable newsletters and blogs; providing information, news, articles and commentary in the fields of entertainment and education; educational services in the nature of classroom instruction and on-line distance learning on topics of current events, education, history, language, liberal arts, math, business, science, hobbies, technology, culture, sports, arts, psychology, and philosophy; interactive educational services in the nature of computer-based and computer-assisted instruction; educational and entertainment services in the nature of podcasts, and continuing programs; electronic games services provided via the internet or a global computer network; production, presentation and distribution of audio, video, still and moving images and data; publishing services (including electronic publishing services); the provision of discussion forums; non-downloadable electronic publications; organization, production and presentation of shows, competitions, games, concerts, exhibitions and events; provision of information and advisory services relating to any of the aforesaid services; education and entertainment services, namely, providing pre-recorded audio, audiovisual, and multimedia works on a variety of topics of general interest, providing on-line portals and a website featuring educational and entertainment content, providing on-line portals and a website featuring educational and entertainment content, and providing on-line portals and a

website featuring educational and entertainment content; provision of non-downloadable movies and other audiovisual content via a video-on demand service; television scheduling; entertainment services provided by television; television entertainment services; services for the production of entertainment in the form of television.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; hosting of third party content, photos, videos, text, data, images, web sites and other electronic works; providing search engines; providing search platforms to allow users to request and receive photos, videos, text, data, images and electronic works; interactive hosting services which allow users to publish and share their own photos, videos, text, data, images online; computer services, namely, creating virtual communities for users to participate in discussions, obtain feedback, form virtual communities, and engage in social networking; maintenance and updating of software relating to computer, Internet and password security and prevention of computer, internet and password risks; providing information in the field of astronomy, weather, the environment, interior design, technology, computers, software, computer peripherals, computer hardware, geology, engineering, architecture, medical research, and product research and testing via the internet or other computer or communications networks; design and development of computer software; computer software installation and maintenance; providing a website featuring technical information relating to computer software and hardware, TVs and consumer electronics; providing technical troubleshooting support for computer hardware;

computer programming; document data transfer from one computer format to another; hosting of digital content on global computer networks, wireless networks, and electronic communications networks; providing search platforms to allow users to request and receive, content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works; providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software, photos, video, audio content, audiovisual works, data, images, digital content and other electronic works; providing temporary use of online non-downloadable computer software that generates customized recommendations of software applications based on user preferences; monitoring of computerized data and computer systems and networks for security purposes; support and consultation services for developing computer systems, databases and applications; graphic design for the compilation of web pages on the Internet; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; development of multimedia websites; hosting the web-sites of others; providing search engines for obtaining data via communications networks; application service provider (ASP) services featuring computer software; application service provider (ASP) services featuring software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications, online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multimedia content, and software featuring

musical sound recordings; application service provider (ASP) services featuring software for entertainment-related audio, video, text and multimedia content; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing search engines for obtaining data on a global computer network; design of advertisements and advertising material for others; computer hardware, software, application, and network consulting services; computer consulting in the field of configuration management for portable and handheld electronic devices; Technical support in the nature of troubleshooting, namely diagnosing computer hardware and software problems; providing temporary use of on-line non-downloadable software that enables user to designate specific content for future viewing on a streaming media device; Creating an on-line community for registered users to communicate and interact with others, participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking in the field of general interest; providing temporary use of on-line non-downloadable software, namely, software for parental control of access to obscene and inappropriate websites; providing temporary use of online non-downloadable software, namely, software for filtering internet searches that separates desired results from unwanted and inappropriate websites, and software that allows parental control of obscene and inappropriate websites and emails; creating an online community for users to participate in discussions, obtain feedback, form virtual communities, and engage in social networking; maintenance and

updating of software relating to computer, Internet and password security; computer software, application, and network consulting services; Providing on-line network services that enable users to share content, photos, videos, text, data, images and other electronic works relating to entertainment; Software as a Service (SaaS) featuring software for use in connection with audio, video and digital content subscription service and one-time purchases of audio, video and digital content, namely, allowing users to pay for and create seller content; providing a web site that gives computer users the ability to transmit, cache, receive, download, stream, broadcast, display, format, transfer and share photos, videos, text, data, images and other electronic works.

4. The Opponent submits that the competing marks are “closely similar”; that “the services covered by the application in classes 41 and 42 are identical or very similar to the services covered by the Earlier ... Marks in classes 41 and 42”; and that “the Application should be refused under Section 5(2)(b) ... as there would be a likelihood of confusion on the part of the public in the United Kingdom which includes the likelihood of association with the Earlier FIRE Marks”.
5. In its Defence and Counterstatement, the Applicant “denies that the proposed Trade Mark is similar to the Opponent’s earlier mark[s] and [asserts that] it is not for identical or similar goods or services”.
6. In these proceedings, the Applicant is a Litigant in Person; and the Opponent is represented by Morgan, Lewis & Bockius UK LLP. The Applicant has opted not to file evidence, nor submissions. The Opponent filed submissions (during the evidence rounds and in lieu of a hearing), which I shall refer to where necessary, later in this decision. As neither party requested a hearing, and one was not considered necessary, I give this decision after careful review of all the papers before me.

DECISION

Section 5(2)(b)

7. The opposition is founded upon section 5(2)(b) of the Act, which stipulates that:

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

(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”.

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

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

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.”

9. The Opponent’s trade mark registrations, having been registered respectively in: 2017, 2019 and 2013, qualify as earlier trade marks under section 6 of the Act. Although the third earlier mark has been registered for over five years prior to the date of application of the contested mark; and is subject to the proof of

use provisions under section 6A of the Act; and is declared to have been used for all of the goods and services for which it is registered (by the Opponent); it has not been put to proof of use by the Applicant. The first and second earlier marks had not been registered for more than five years at the date the contested application was filed; they are therefore not subject to the proof of use provisions contained in section 6A of the Act.¹ The Opponent is, as a consequence, entitled to rely upon its earlier marks in relation to all of the services indicated without having to prove that genuine use has been made of them. Therefore, I must make the assessment based upon the full width of the services relied upon by the Opponent, regardless of whether or not the marks have actually been used in relation to those goods and services.

Relevant law

10. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Trade Marks 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.

11. The following principles are gleaned from the decisions of the courts of the European Union 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.

¹ As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the filing date of the contested application.

The principles:

- 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 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Services comparison

12. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

13. Guidance on this issue has also 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 users of the respective goods or services;
- b. The physical nature of the goods or acts of services;
- c. The respective trade channels through which the goods or services reach the market;
- d. 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;
- e. 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.

14. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. 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”.

Class 41

15. The Applicant's applied-for class 41 term "Education and training" is self-evidently identical to the Opponent's protected services "Education" and "providing of training". The Applicant also seeks registration for "Production and sale of compliance documents", under the same class; which is encompassed by "publishing of books, magazines, periodicals, literary works, visual works, audio works, and audiovisual works"; and "publishing services (including electronic publishing services)" in the Opponent's specification; and as a consequence, they are identical on the *Merit* principle.

16. In the alternative, these services may be considered to be highly similar; as they relate to the provision of information material or more generally, to the provision of content. Publishing includes copy-editing, production, printing (and its electronic equivalents) and distribution; all of which are invariably involved in the "Production and sale of compliance documents". Accordingly, these competing services are not only complementary, but also are likely to come from the same providers, share the same distribution channels and target the same relevant public. Therefore, if my finding on the identity of said services is challenged, I also find (in the alternative) that they are at least highly similar.

Class 42

17. "Maintenance of software" under the Applicant's class 42 specification is also identically covered by the Opponent's earlier right, by the term "computer software installation and maintenance".

Average consumer and the purchasing act

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. 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”.

19. For the purpose of assessing the likelihood of confusion, it must also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. As I have previously considered, the respective services are likely to be marketed to the same users, which include business users and members of the general public. The degree of attentiveness of all such users may vary from average to high, depending on the price, specialised nature, or terms and conditions of the services purchased.

20. Selection of the services at issue will be primarily a visual process; with the average consumer searching online or seeing the marks in brochures or other printed material. However, I do not ignore the aural impact of the marks and the potential for the marks to be spoken, for example, when making purchases via telecommunication systems, or by word of mouth recommendations.

Comparison of the marks


21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the

overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

22. 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

23. The respective trade marks are shown below:

<p>FIRE (the first earlier mark)</p> <p>AMAZON FIRE (the second earlier mark)</p> <p>FIREDOCK (the third earlier mark)</p>	
<p>Earlier Trade Marks</p>	<p>Contested Trade Mark</p>

Overall Impression

24. As I have previously indicated, I will make the first earlier mark the focus of my comparison on the basis that the second and third earlier marks offer no advantage over the former. I will, of course, revisit the position should it become necessary to do so.

25. The Opponent's earlier mark is a plain word mark, consisting of the ordinary dictionary word "FIRE", presented in uppercase only. As fair and notional use of a word mark means that it may be used in any case (lower, upper or title), this factor does not add to the overall impression of the mark.² There are no other elements to contribute to its overall impression, which lies in the word itself.
26. The Applicant's mark is figurative, consisting of the word "FIRE" in a moderately stylised red, uppercase typeface and the word "DOCS", in dark grey or charcoal block capitals. These words are separated by a hyphen in the same colour as the "DOCS" element. The "FIRE" element is preceded by stylised flames in white and black, enclosed in a red box. All of these elements are set against a black background. The dark grey/charcoal hyphen and "DOCS" elements are almost imperceptible against the black background.
27. In this mark, "FIRE" is more dominant than "DOCS"; not only on account of its distinct design and the primary position it occupies in the mark, but also due to the delicate design of the "DOCS" element, which is almost imperceptible. Moreover, I find that if noticed, the average consumer would attach little, if any, significance to it. I consider that it is likely to be perceived as the abbreviation for "documents"; and as such, has little, if any, distinctive character in respect of most, if not all, of the Applicant's services; as documents (in print or electronic format) may be associated with "education and training", the "maintenance of software" (in the form of a checklist or instructions to facilitate same); and patently, with the "production and sale of compliance documents".
28. The figurative, flame element plays a secondary role in the overall impression of the mark, inasmuch as it reinforces the visual or conceptual perception of the "FIRE" element in the mark. Therefore, for the foregoing reasons, I find that "FIRE" stands out as the distinctive element.

² *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17. The doctrine of fair and notional use extends to use of a registered word mark in any colour. Therefore, the Opponent would be entitled to use of its mark/s in any colour (including the colours used in the mark applied for).

Visual, Aural and Conceptual Comparisons

29. The Opponent submits that: “FIRE is the dominant element of the Applicant’s FIRE-DOCS (Design) mark and the Earlier FIRE Marks. Accordingly, the overlap in this dominant element has a greater impact on the comparison of the marks and the marks are therefore closely visually, aurally and conceptually similar as a result of this shared element”.
30. Visually, the marks coincide in that they share the word element “FIRE”, which is the only element in the earlier mark; and the first word element in the opposed mark. The points of visual difference are the inclusion of the word element “DOCS” and the figurative element (positioned first), in the Applicant’s mark. The fact that the differences in the later mark are unlikely to make a significant contribution to the overall impression it conveys (by virtue of their non-distinctive characteristics, leaving aside the almost indistinct form of the “DOCS” element), results, in my view, in an above average degree of visual similarity between the competing marks.
31. Aurally, the marks overlap in the identical pronunciation of the word “FIRE”. They differ in the presence of the word element “DOCS” in the Applicant’s mark, which has no counterpart in the Opponent’s mark. The fact of the identical pronunciation of the common element alone, inevitably leads to a degree of aural similarity between the marks. Considering that the figurative element (in the Applicant’s mark) is unlikely to be articulated by the average consumer,³ I find that the fact that the word “FIRE” would be the first word articulated in the Applicant’s mark, results in an above average degree of aural similarity between the marks. If, however, the “DOCS” element is not articulated, either

³ With regard to the figurative element ..., where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark. [The Board of Appeal] correctly takes the view that that general line of reasoning could reasonably be applied in the present case. According to the Board of Appeal, it is reasonable to assume that the average consumer will perceive the verbal element as the trade mark and the figurative element as a decorative element. Moreover, the figurative element is placed ... in a less visible position. (T-312/03, Selenium-Ace, § 37).

because it is not perceived, or is perceived to be descriptive, then the marks would be aurally identical.

32. Conceptually, “FIRE” will be readily perceived by the average consumer as a dictionary word with ordinary meaning; for example, as “*Combustion or burning, in which substances combine chemically with oxygen from the air and typically give out bright light, heat, and smoke*”.⁴ The average consumer is therefore likely to apply its understanding of “FIRE” to both marks. However, I accept that the presence of “DOCS” in the later mark acts as a point of conceptual difference between the marks, which as earlier explained, will be seen (for the most part) as allusive to at least some of the services at issue. Therefore, I consider that any conceptual similarity in the word “FIRE” is more significant than the relative conceptual difference presented by the lesser dominant element, “DOCS”. In the light of these considerations, I find that the marks are conceptually similar to an above average degree.

Distinctive character of the earlier trade mark

33. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion⁵. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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.

34. “In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings” -

⁴ Oxford, Lexico, English Dictionary: <https://www.lexico.com/en/definition/fire>

⁵ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

35. Trade marks possess various 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. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, however, the Opponent has not pleaded that its marks have acquired enhanced distinctiveness through use and has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

36. The earlier right consists of the one word "FIRE"; a standard dictionary word, which does not describe nor allude to any characteristics of the services upon which the Opponent relies. As a consequence, I find that the earlier mark is possessed of an average degree of inherent distinctive character.

Conclusions on Likelihood of Confusion

37. In determining whether there is a likelihood of confusion, 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the services, the nature of the purchasing process and 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 they have retained in their mind.

38. I have found the overall impression of the Applicant's mark and its distinctiveness will be heavily weighted in favour of the word "FIRE" which

dominates it; that the respective marks are visually similar to an above average degree; aurally similar to either an above average degree or aurally identical; and that they are conceptually similar to an above average degree.

39. The average consumer has been identified as a member of the general public or a business user who will select the goods primarily by visual means (though I do not discount an aural component). I have concluded that the degree of attention paid will vary from reasonable to high, according to certain considerations. I have found the parties' services to be identical, or at least highly similar, in the alternative, in one respect. I have found the earlier mark to have an average degree of inherent distinctive character.

40. Although I have concluded that the average consumer's degree of attention might be high during the purchasing process (thus making them less susceptible to the effect of imperfect recollection), the above average degree of visual, aural and conceptual similarity I have identified earlier, when combined with the average degree of inherent distinctive character the earlier trade mark possesses, is more than sufficient for me to conclude there is a likelihood of confusion. As the differences between the competing trade marks do not play a significant role in the overall impression they convey, I consider it possible that the respective marks will be mistaken for one another; that is, there will be direct confusion.

41. I consider too, that there are differences between the marks, which may not go unnoticed by a proportion of the relevant consumer, particularly in the context where the services will be selected by primarily visual means. However, given that the services at issue are identical or highly similar and the marks share an above average degree of visual, aural and conceptual similarity, I consider it likely that, even when the differences between the marks are identified and even where a high degree of attention is engaged during the selection process, there will be an expectation on the part of the average consumer that the services at issue come from the same or economically linked undertakings. There is therefore also a likelihood of indirect confusion.

Conclusion

42. The opposition has been successful and, subject to any successful appeal, the application will be refused.

COSTS

43. The Opponent has been successful and is entitled to a contribution towards its costs. I bear in mind that neither party filed evidence and the Applicant has not filed submissions. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying this TPN as a guide, I award costs to the Opponent on the following basis:

Preparing a Notice of Opposition and reviewing the Defence and Counterstatement:	£350
Preparing Written Submissions	£450
Official fee:	£100
Total:	£900

44. Accordingly, I hereby order Carvell Group Ltd to pay to Amazon Europe Core S.à.r.l. the sum of **£900**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of October 2021

**Denzil Johnson,
For the Registrar**

Annex

EU012755906 – Filing date: 2 April 2014; Date of entry in register: 08 May 2019

AMAZON FIRE

Class 41: Education; providing of training; entertainment; sporting and cultural activities; publishing of books, magazines, periodicals, literary works, visual works, audio works, and audiovisual works; providing non-downloadable pre-recorded audio, visual and audiovisual works via wired and wireless networks on a variety of topics of general interest; providing on-line computer games and on-line interactive stories; providing electronic non-downloadable newsletters and blogs featuring entertainment, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion shows, and multimedia presentations; publication of excerpts from books, periodicals, and literary works, and providing virtual environments in which users can interact for recreational, leisure, or entertainment purposes; providing information, news, articles and commentary in the field of entertainment, including, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction; providing information, news, articles and commentary in the field of entertainment, including, clubs, radio, comedy, contests, visual

works, games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion shows, and multimedia presentations; providing information, news, articles and commentary in the field of education and educational institutions; educational services in the nature of classroom instruction and on-line distance learning on topics of current events, education, history, language, liberal arts, math, business, science, hobbies, technology, culture, sports, arts, psychology, and philosophy; interactive educational services in the nature of computer-based and computer-assisted instruction on topics of current events, education, history, language, liberal arts, literature, math, business, science, hobbies, technology, culture, sports, arts, psychology, and philosophy; educational and entertainment services in the nature of podcasts, and continuing programs featuring news and commentary in the field of movies, television programs, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming, festivals accessible via the internet or other computer or communications networks; educational and entertainment services in the nature of podcasts, and continuing programs featuring news and commentary in the field of museums, parks, cultural events, concerts, publishing, animation, current events, fashion, and multimedia presentations accessible via the internet or other computer or communications networks; providing prerecorded audio, audiovisual, and multimedia works featuring entertainment, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming via the internet or other computer or communications networks; providing prerecorded audio, audiovisual, and multimedia works featuring

festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion shows, and multimedia presentations via the internet or other computer or communications networks; electronic games services provided via the internet or a global computer network; provision of entertainment, education, recreation, instruction, tuition and training; production, presentation and distribution of audio, video, still and moving images and data; publishing services (including electronic publishing services); the provision of discussion forums; non-downloadable electronic publications; organisation, production and presentation of shows, competitions, games, concerts, exhibitions and events; provision of information and advisory services relating to any of the aforesaid services; education and entertainment services, namely, providing pre-recorded audio, audiovisual, and multimedia works on a variety of topics of general interest via the internet or other computer or communications networks; education and entertainment services, namely, providing on-line portals and a website featuring educational and entertainment content, namely, movies, television shows, audiovisual works, music, audio works, books, theatrical works, literary works, sporting events, recreational activities; education and entertainment services, namely, providing on-line portals and a website featuring educational and entertainment content, namely, leisure activities in the nature of hobbies, tournaments, art, dance, musicals, culture, sporting and current event exhibitions, sports instruction, clubs, radio programs, comedy, drama, contests, visual works of art, games, gaming, festivals, museums, parks, cultural events, concerts, desktop publishing, animation, current events, fashion shows; education and entertainment services, namely, providing on-line portals and a website featuring educational and entertainment content, namely, multimedia presentations, and interactive educational quizzes; provision of non-downloadable movies and other audiovisual content via a video-on demand service;

television scheduling; entertainment services provided by television; television entertainment services; services for the production of entertainment in the form of television; none of the aforesaid services 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.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; hosting of third party content, photos, videos, text, data, images, web sites and other electronic works; providing search engines; providing search platforms to allow users to request and receive photos, videos, text, data, images and electronic works; interactive hosting services which allow users to publish and share their own photos, videos, text, data, images online; computer services, namely, creating virtual communities for users to participate in discussions, obtain feedback, form virtual communities, and engage in social networking; maintenance and updating of software relating to computer, Internet and password security and prevention of computer, internet and password risks; providing information in the field of astronomy, weather, the environment, interior design, technology, computers, software, computer peripherals, computer hardware, geology, engineering, architecture, medical research, and product research and testing via the internet or other computer or communications networks; design and development of computer software; computer software installation and maintenance; providing a website featuring technical information relating to computer software and hardware, TVs and consumer electronics; providing technical troubleshooting support for computer hardware; computer programming; document data transfer from one computer format

to another; hosting of digital content on global computer networks, wireless networks, and electronic communications networks; providing search platforms to allow users to request and receive, content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works; providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software, photos, video, audio content, audiovisual works, data, images, digital content and other electronic works; providing temporary use of online non-downloadable computer software that generates customized recommendations of software applications based on user preferences; monitoring of computerized data and computer systems and networks for security purposes; support and consultation services for developing computer systems, databases and applications; graphic design for the compilation of web pages on the Internet; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; development of multimedia websites; hosting the web-sites of others; providing search engines for obtaining data via communications networks; application service provider (ASP) services featuring computer software; application service provider (ASP) services featuring software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications, online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multimedia content, and software featuring musical sound recordings; application service provider (ASP) services featuring software for entertainment-related audio, video, text and multimedia content; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music,

concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing search engines for obtaining data on a global computer network; computer consulting and support services for scanning information into computer discs; design of advertisements and advertising material for others; computer hardware, software, application, and network consulting services; computer consulting in the field of configuration management for portable and handheld electronic devices; Technical support in the nature of troubleshooting, namely diagnosing computer hardware and software problems; providing temporary use of on-line non-downloadable software that enables user to designate specific content for future viewing on a streaming media device; Creating an on-line community for registered users to communicate and interact with others, participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking in the field of general interest; providing temporary use of on-line non-downloadable software, namely, software for parental control of access to obscene and inappropriate websites; providing temporary use of online non-downloadable software, namely, software for filtering internet searches that separates desired results from unwanted and inappropriate websites, and software that allows parental control of obscene and inappropriate websites and emails; creating an online community for users to participate in discussions, obtain feedback, form virtual communities, and engage in social networking; maintenance and updating of software relating to computer, Internet and password security; computer software, application, and network consulting services; Providing on-line network services that enable users to share content, photos, videos, text, data, images and other electronic works relating to entertainment, including, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals,

exhibitions, sports instruction, clubs, radio, comedy, contests, visual works; Providing on-line network services that enable users to share games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion, multimedia presentations, history, language, liberal arts, math, business, science, technology, hobbies, culture, sports, arts, psychology, and philosophy; Software as a Service (SaaS) featuring software for use in connection with audio, video and digital content subscription service and one-time purchases of audio, video and digital content, namely, allowing users to pay for and create seller content; providing a web site that gives computer users the ability to transmit, cache, receive, download, stream, broadcast, display, format, transfer and share photos, videos, text, data, images and other electronic works; Application service provider (ASP), namely, hosting computer software applications of others; none of the aforesaid services 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.

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FIREDOCK

Class 41: Publishing of books, magazines, periodicals, literary works, visual works, audio works, and audiovisual works; providing non-

downloadable pre-recorded audio, visual and audiovisual works via wireless networks; providing on-line computer games and on-line interactive stories; providing online newsletters and blogs featuring entertainment, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion shows, and multimedia presentations; publication of excerpts from books, periodicals, and literary works, and providing virtual environments in which users can interact for recreational, leisure, or entertainment purposes; providing information, news, articles and commentary in the field of entertainment, including, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion shows, and multimedia presentations; providing information, news, articles and commentary in the field of education and educational institutions; education services in the nature of classroom instruction and on-line distance learning on topics of current events, education, history, language, liberal arts, math, business, science, hobbies, technology, culture, sports, arts, psychology, and philosophy; interactive educational services in the nature of computer-based and computer-assisted instruction on topics of current events, education, history, language, liberal arts, literature, math, business, science, hobbies, technology, culture, sports, arts, psychology, and philosophy; educational and entertainment services in the nature of podcasts, webcasts, and continuing programs featuring news and commentary in the field of movies, television programs,

audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion, and multimedia presentations accessible via the internet or other computer or communications networks; providing prerecorded audio, audiovisual, and multimedia works featuring entertainment, movies, television, audiovisual works, music, audio works, books, theatre, literary works, sporting events, recreational activities, leisure activities, tournaments, art, dance, musicals, exhibitions, sports instruction, clubs, radio, comedy, contests, visual works, games, gaming, festivals, museums, parks, cultural events, concerts, publishing, animation, current events, fashion shows, and multimedia presentations via the internet or other computer or communications networks.

Class 42: Hosting of third party content, photos, videos, text, data, images, web sites and other electronic works; providing search engines; providing search platforms to allow users to request and receive photos, videos, text, data, images and electronic works; interactive hosting services which allow users to publish and share their own photos, videos, text, data, images online; computer services, namely, creating virtual communities for users to participate in discussions, obtain feedback, form virtual communities, and engage in social networking; maintenance and updating of software relating to computer, Internet and password security and prevention of computer, internet and password risks; providing information in the field of astronomy, weather, the environment, interior design, technology, computers, software, computer peripherals, computer hardware, geology, engineering, architecture, medical research, and product research and testing via the internet or other computer or communications networks;

design and development of computer software; computer software installation and maintenance; providing a website featuring technical information relating to computer software and hardware; computer hardware, software, application, and network consulting services; computer consulting; providing technical troubleshooting support for computer hardware; computer programming; document data transfer from one computer format to another; hosting of digital content on global computer networks, wireless networks, and electronic communications networks; providing search platforms to allow users to request and receive, content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works; providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software; providing temporary use of online non-downloadable computer software that generates customized recommendations of software applications based on user preferences; monitoring of computerized data and computer systems and networks for security purposes.