

BL O-182-18

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS INVOLVING:

APPLICATION 3201214 BY

FIREFLY INTERNATIONAL LIMITED

FOR THE MARK:

FIREFLY

AND

TWO OPPOSITIONS TO THE REGISTRATION OF THAT MARK BY:

i) AMAZON EUROPE CORE S.A.R.L (OPPOSITION NO. 409092)

&

ii) AMAZON TECHNOLOGIES, INC. (OPPOSITION NO. 409095)

Background and pleadings

1. Firefly International Limited ('the applicant') applied to register the trade mark **FIREFLY** in the UK on 8 December 2016. It was accepted and published in the Trade Marks Journal on 24 February 2017 in respect of the following goods and services:

Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

2. Class 26 has since been removed from the application following unrelated opposition proceedings in respect of that class.

3. These consolidated proceedings involve two oppositions to the registration of the application. First, Amazon Europe Core S.A.R.L. ("the first opponent") opposed the registration of the trade mark on the basis of section 5(2)(b) and section 3(6) of the Trade Marks Act 1994 ("the Act"). The section 3(6) ground was subsequently withdrawn so leaving only the section 5(2)(b) ground of opposition, a ground which is directed only against the class 38 services of the application. This opposition is made on the basis of the opponent's earlier European Union Trade Mark ("EUTM") 013010426 for the mark **AMAZON FIREFLY**. The following services of this earlier mark are relied upon in this opposition:

Class 38: Telecommunications; communication and telecommunication services; providing user access to databases of photographic images; providing access to web sites on the Internet; delivery of digital music, video and other multimedia works by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; communication by computer, computer intercommunication; telex, telegram and telephone services; rental, hire and leasing of communications apparatus and of electronic mailboxes; electronic bulletin board services; electronic communications consultancy; facsimile, message collection and transmission services; transmission of data and of information by electronic means in the nature of computer, cable, radio, teleprinter, teletype, telephone, mobile phone, electronic mail, microwave, laser beam, communications satellite or electronic communication means; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers; broadcasting or transmission of radio and television programmes; time sharing services for communication apparatus; provision of telecommunications access and links to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; web casting services; delivery of messages by electronic transmission; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing access to digital music web sites on the Internet; providing access to MP3 web sites on the Internet; delivery of digital music by telecommunications; providing telecommunications connections to the Internet or databases; providing user access to the Internet (service providers); electronic mail services; telecommunication of information (including web pages), computer programs and any other data; video broadcasting, broadcasting prerecorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment related programs of all kinds, via a global computer network; streaming of video content via a global computer network; subscription audio broadcasting via a global computer network; audio broadcasting, broadcasting music, concerts, and radio

programs, via a global computer network, streaming of audio content via a global computer network; electronic transmission of audio and video files via communications networks; communication services in the form of matching users for the transfer of music, video and audio recordings via communication networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment, music, concerts, videos, radio, television, film, news, sports, games and cultural events; streaming audio, video, and audiovisual content, data and information on the Internet, communications networks and wireless telecommunications networks; providing video on-demand transmission of audio, video and audiovisual content, data and information; Transmission of audio, video and audiovisual content, data and information on the Internet, communications networks and wireless telecommunications networks; electronic transmission of entertainment reviews and information through computer and communications networks; information, advisory and consultancy services relating to all the aforesaid.

4. The second opposition is by Amazon Technologies, Inc. (“the second opponent”) who oppose the registration of the trade mark on the basis of sections 5(1) and 3(6) of the Act. Again, the section 3(6) ground was subsequently withdrawn, so leaving the section 5(1) ground. The opposition is, again, directed only at class 38 of the application. The opposition was actually brought by the then owner of the mark, Percy LLC, who assigned the mark to the second opponent during the course of the proceedings. Before being substituted as opponent in the proceedings, the second opponent confirmed that it had sight of the various documents filed, stood by them and the pleaded case, and accepted any liability for costs that may arise. This opposition is made on the basis of the opponent’s earlier EUTM 013301742 for the mark **FIREFLY**. The following services of this earlier mark are relied upon in this opposition:

Class 38: Telecommunications; communication and telecommunication services; providing user access to databases of photographic images; providing access to web sites on the Internet; delivery of digital music, video and other multimedia works by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to

send and/or receive messages through a wireless data network; one-way and two-way paging services; communication by computer, computer intercommunication; telex, telegram and telephone services; rental, hire and leasing of communications apparatus and of electronic mailboxes; electronic bulletin board services; electronic communications consultancy; facsimile, message collection and transmission services; transmission of data and of information by electronic means in the nature of computer, cable, radio, teleprinter, teleletter, telephone, mobile phone, electronic mail, microwave, laser beam, communications satellite or electronic communication means; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers; broadcasting or transmission of radio and television programmes; time sharing services for communication apparatus; provision of telecommunications access and links to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; web casting services; delivery of messages by electronic transmission; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing access to digital music web sites on the Internet; providing access to MP3 web sites on the Internet; delivery of digital music by telecommunications; providing telecommunications connections to the Internet or databases; providing user access to the Internet (service providers); electronic mail services; telecommunication of information (including web pages), computer programs and any other data; video broadcasting, broadcasting prerecorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment related programs of all kinds, via a global computer network; streaming of video content via a global computer network; subscription audio broadcasting via a global computer network; audio broadcasting, broadcasting music, concerts, and radio programs, via a global computer network, streaming of audio content via a global computer network; electronic transmission of audio and video files via communications networks; communication services in the form of matching users for the transfer of music, video and audio recordings via communication networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment, music, concerts, videos, radio,

television, film, news, sports, games and cultural events; streaming audio, video, and audiovisual content, data and information on the Internet, communications networks and wireless telecommunications networks; providing video on-demand transmission of audio, video and audiovisual content, data and information; Transmission of audio, video and audiovisual content, data and information on the Internet, communications networks and wireless telecommunications networks; electronic transmission of entertainment reviews and information through computer and communications networks; information, advisory and consultancy services relating to all the aforesaid; none of the aforesaid services being for use in medicine or surgery.

5. The first opponent argues that the respective services are identical or similar and that its mark is similar to that of the applicant such that there exists a likelihood of confusion. The second opponent argues that the respective services are identical and that its mark is identical to that of the applicant.

6. The applicant filed counterstatements on 10 July 2017 and 17 July 2017 respectively, denying the claims made by both opponents.

7. The opponents are represented by Cooley (UK) LLP. None of the parties filed evidence. The opponents filed written submissions. None of the parties requested a hearing, although the opponents filed a set of written submissions (covering both oppositions) in lieu of attendance. This decision is, therefore, taken following a careful perusal of the papers.

8. I will initially consider the opposition of the second opponent. I will return to the other opposition only if it is necessary and proportionate to do so.

Opposition 409495 – section 5(1) of the Act

9. Section 5(1) of the Act states that:

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

applied for are identical with the goods or services for which the earlier trade mark is protected.

10. It is clear from the above that this ground only bites if both the marks and the services are identical.

The marks

11. Given that the marks are self-evidently identical (**FIREFLY v FIREFLY**), there is no need for a detailed assessment. Further, the applicant accepted in its counterstatement that the marks are identical.

The services

12. The second opponent states in its grounds of opposition that the services of its prior registration are identical to those of the application. In its counterstatement, the applicant accepts that the term “telecommunications” is a broad term and can include various methods including radio, audio and video broadcasting as well as sending messages. However, whilst acknowledging that there are some similarities in the specifications of the two marks, the applicant goes on to say that simply because common language is used, this does not, of itself, indicate that the services provided are identical to the services of the earlier mark.

13. Even if the services are not worded identically, they can still be considered identical if one term falls within the ambit of another, or vice versa, as referred to in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, where the General Court stated that:

“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”.

14. In order to understand what terms used in a specification mean, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade” and I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning. I also note the judgement of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“....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 “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.”

15. For ease of reference and comparison, I will break the applicant’s applied for specification down term by term, and consider whether the second opponent’s specification covers identical services.

Telecommunication services

16. This term is considered identical to the earlier “telecommunications”. It is acknowledged that the earlier term omits the word ‘services’, however, as this is a service class both terms are services for telecommunication purposes.

Communication services for the electronic transmission of voices; transmission of data; Transmission of data, audio, video and multimedia files; Electronic transmission of images, photographs, graphic images and illustrations over a global computer network

17. These are considered to be identical to the earlier mark's "communication services" and "transmission services". The applicant's terms merely add indications of the subject matter of the communication or transmission being made and, therefore, fall within the ambit of the second opponent's broad term.

Simulcasting broadcast television over global communication networks, the Internet and wireless networks

18. The services of the applicant are considered to be identical to the second opponent's services for the "broadcasting or transmission of radio and television programmes". These earlier services are considered to be of a general category within which simulcasting would fall.

Provision of telecommunication access to video and audio content provided via an online video-on-demand service

19. The term "provision of telecommunication access" is considered to be identical to "providing user access to the Internet (service providers)". A service provider would offer the telecommunication access, so the inclusion of "service provider" in the earlier mark's specification changes nothing, neither does the inclusion of the words "user access". On a practical level, they both imply that the user can obtain, via telecommunications, access to online content or the internet. In any event, the applied for term will also fall within "telecommunications" more generally and is identical on the inclusion basis.

Satellite communication services

20. The services of the applicant are considered to be identical to the second opponent's earlier services "communication and telecommunications". These earlier

services are considered to be of a general category within which the applied for term would fall.

Telecommunications gateway services

21. Whilst it is not altogether clear what a gateway service is, it is clearly, as the full term suggests, a form of telecommunication service. The applicant submits that it does not fall within the ambit of telecommunication services, but I see no logical reason for coming to this conclusion. As part of its counterstatement, the applicant provided a definition of gateway, defining it as a device. This does not help because one is considering services here not goods. The services are identical.

Findings under section 5(1)

22. All of the opposed services are identical. The marks are identical. The opposition under section 5(1) succeeds.

Conclusion

23. Given the second opponent's success, there is no need to separately consider the first opponent's opposition under section 5(2)(b). The application for registration, subject to appeal, is hereby refused.

Costs

24. I have determined these consolidated proceedings in favour of the opponents. In the circumstances, I award the opponents the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fees: £100 x 2

Filing statements of case and considering the counterstatements: £300

Written submissions: £400

25. I therefore order Firefly International Limited to pay Amazon Technologies Inc and Amazon Europe Core S.A.R.L (jointly) the sum of £900. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 22nd day of March 2018

Oliver Morris

For the Registrar

the Comptroller-General