

Flagging the risk of trade mark infringement on Amazon

- Amazon seller claims for trade mark infringement and passing off
- Defendant selling products using claimant's listing details
- Consideration of whether Amazon listings are generic

What's it about?

Jadebay Limited (**Jadebay**) sold flagpoles through Amazon under the figurative trade mark "design elements".

Sellers operating on Amazon create a listing for their products, which is allocated a unique Amazon Identification Number (**ASIN**). A listing is not limited to one seller: it can be used by multiple sellers provided that the products they sell on it are identical to the specification of the goods for which the listing was initially created. When multiple sellers use the same listing then one will be selected by Amazon as the default seller. Generally, the default seller offers the lowest price and will receive the majority of sales from the listing.

Jadebay had created a listing for its 20ft flagpoles which stated that they were sold "by Design Elements". The Defendant, Clarke-Coles Limited (**Clarke-Coles**), listed its products on Jadebay's listing. Jadebay claimed trade mark infringement and passing off in the Intellectual Property Enterprise Court, alleging that Clarke-Coles was using its sign "Design Elements".

Why does it matter?

Clarke-Coles argued that Amazon listings are generic, which the Court rejected. The Court, finding that Jadebay's trade mark had been infringed, noted that while Amazon might suggest an ASIN, it was for the user to assess the specification and determine if its products were the same. The presentation of the product being "by Design Elements" told the consumer that this was the manufacturer's brand and the consumer would identify it as being so.

The Court went on to consider whether there was a likelihood of confusion on the part of the average consumer. It concluded that confusion was likely given the high degree of similarity between the sign and the trade mark, the fact that the goods were identical, and the real possibility that the consumer would consider that the products emanated from the same source. The Court was not, however, willing to find that the Design Element trade mark had a reputation in the United Kingdom due to its limited commercialisation (Jadebay only sold through Amazon). Therefore, Jadebay's separate claim for taking unfair advantage of the reputation of the trade mark failed. The Court did, though, find passing off, building on the conclusion of the likelihood of confusion in respect of the trade mark claim.

Now what?

The Court was not prepared to classify Amazon listings as being generic or to say that as a result of Amazon policies and approach there could be no trade mark liability. Instead, it confirmed that responsibility for ensuring that a product matches the specification lies with the listing party. Therefore, when a seller lists, there is a risk that it could infringe another seller's trade mark depending on the content of the listing. Where there are a substantial number of sellers offering the same product, for example, widely available branded goods, then this is unlikely to cause an issue. However, if the market is far more limited with only one source for the product (as in the Jadebay case) then sellers may risk infringement if they do not create their own individual listing.

[*Jadebay Ltd and others v Clarke-Coles Ltd \(t/a Feel Good UK\) \[2017\] EWHC 1400 \(IPEC\)*](#)

For further information on this or any other IP related matter please contact [Rachel Cook](#) on 020 7160 3028