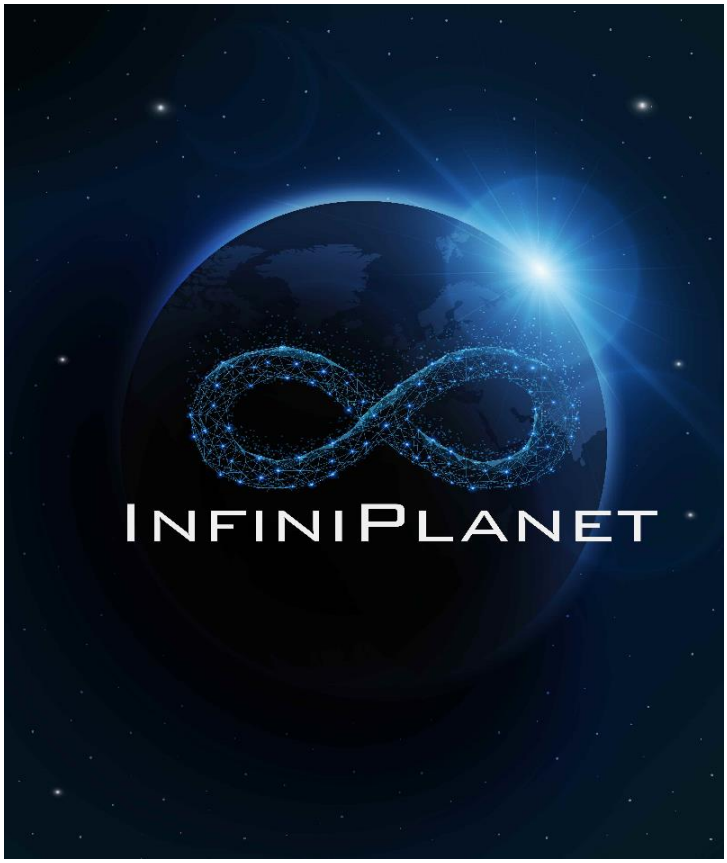
BL O/0291/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003890996

IN THE NAME OF INFINIPLANET INC.

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 9, 28, 35, 38, 41 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000441694

BY GROUPE CANAL+

Background and pleadings

1. On 20 March 2023, InfiniPlanet Inc. ("***the Applicant***") applied to register the trade mark shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 31 March 2023 in respect of goods and services in classes 9, 28, 35, 38, 41 and 42 which are outlined in **Annex A** of this decision.

2. On 30 June 2023, GROUPE CANAL+ ("***the Opponent***") opposed the application under section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***"). The opposition is directed at the following goods and services in the application:

   Class 9: Interactive touchscreen terminals; Interactive terminals; Virtual and augmented reality software; Virtual reality software; Augmented reality software; Interactive entertainment software; Augmented reality software for use in mobile devices; Interactive entertainment software for use with personal computers; Interactive touch screen terminals; Information technology and audio-visual, multimedia and photographic devices.

   Class 38: Interactive transmission of video over digital networks; Communication via virtual private networks; Streaming of audio, visual and audiovisual material via a global computer network; Transmission of vision via interactive multimedia networks.

   Class 41: Interactive entertainment; Online interactive entertainment.

   Class 42: Design and development of virtual reality software; Design services relating to virtual reality software; Design and development of computer game software and virtual reality software; Design and development of virtual private network (VPN) operating software.

3. The Opponent relies upon the following mark:

UK registration number: UK00909781791

Filing date: 3 March 2011

Date of registration: 26 December 2012

Goods and services relied upon:

Class 9: Scientific (except for medical purposes), nautical, surveying, photographic, cinematographic, optical and electro-optical, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Decoders; Electronic apparatus for data processing; Electric measuring devices and Electronic checking (supervision); Teaching apparatus and instruments; Apparatus and instruments for recording, transmission, reproduction, storage, encoding, decoding, conversion and processing of sound or images; Communications and telecommunications apparatus; Audiovisual, telecommunications, data transmission, television apparatus and instruments, remote controls; Cassette recorders; Video recorders, Film cameras; Telephones, mobile telephones; Personal organisers (PDAs); Electronic diaries; Radio sets, Personal stereos; Projectors (projection apparatus); Antennas, aerials, satellite dishes; Speakers, amplifiers; Computers, computer screens, computer keyboards, peripheral devices for computers, modems, decoders, encoders; Access devices (apparatus) and access control devices for data processing apparatus; Authentication apparatus for use in telecommunications networks; Apparatus for scrambling and

descrambling signals and retransmissions; Digital terminals; Video films; CD-ROMs, recording discs, digital video discs (DVDs), video discs and audio discs, digital discs, video tapes; CD players, DVD players, digital disc players, magnetic disc players, video and audio disc players, recording disc players; Video game cartridges; Video game software; Video games adapted for use with a television screen; Magnetic data carriers; Magnetic cards, Chip cards, Electronic cards; Integrated circuits and microcircuits; Card readers; Electronic components; Worldwide computer network data reception monitors; Automatic vending machines and mechanisms for coin-operated apparatus; Calculating machines and data processing equipment; Satellites for scientific and telecommunications use; Spectacles (optics); Optical goods, spectacle cases; Smart cards, cards with microprocessors; Electronic radio and television programme guide; Apparatus and instruments for programming and selection of television programmes; Interactive television apparatus and instruments; Television screens; Computer software (recorded programs); Fibre-optic cables and optical cables; Electric batteries and cells.

Class 38: Telecommunications services; Communications by computer terminals or by optical fibres; Information about telecommunications; News and information agencies; Radio communications, communications by telegrams, by telephones or video phones, by television, by personal stereo, by personal video player, by interactive videography; Broadcasting (television -); Transmission of information by data transmission; Transmission of messages, telegrams, images, videos, mail; Transmission of information by teleprinter; Data communications; Radio and television broadcasting; Broadcasting of programmes by satellite, by cable, by computer network (in particular via the Internet), by radio networks, by radio-telephone networks and by radio link; Broadcasting of audio, audiovisual, cinematographic or multimedia programmes, text and/or still or moving images and/or sound, whether musical or not, ringtones, whether or not for interactive purposes; Electronic advertising (telecommunications); Rental of

telecommunications equipment and apparatus; Rental of data transmission apparatus and instruments namely telephones, facsimile machines, apparatus for transmitting messages, modems; Rental of aerials and satellite dishes; Rental of devices (apparatus) for access to interactive audiovisual programmes; Leasing access time to telecommunications networks; Providing services to download video games, Digital data, Communications (transmission) on open (Internet) or closed (intranet) global computer networks; Online downloading of films and other audio and audiovisual programmes; Transmission of programmes and selection of television channels; Providing access to a computer network; Providing connections to telecommunications services, to Internet and database services; Routing and connecting services for telecommunications; Connection by telecommunications to a computer network; Telecommunications consultancy; Professional consultancy relating to telephony; Consultancy in the field of video programme broadcasting; Consultancy relating to the transmission of data via the Internet; Consultancy relating to providing access to the Internet; Sending and receiving video images via the Internet using a computer or mobile telephone; Telephone services; Cellular telephone services; Cellular telephone communication; Paging by radio; Voice messaging, call forwarding, electronic mail, electronic message transmission; Video-conferencing services; Video messaging services; Video-telephone services; Answering machines (telecommunications); Providing access to the Internet (Internet service provider); Electronic mail exchange, e-mail services, instant electronic messaging services, non-instantaneous electronic messaging services; Transmission of information via the Internet, an extranet and an intranet; Transmission of information via secured messaging systems; Providing access to electronic conferencing and discussion forums; Providing access to Internet websites containing digital music or audiovisual works of all kinds; Providing access to telecommunications infrastructures; Providing access to search engines on the Internet; Transmission of electronic publications online; Rental of decoders and encoders.

Class 41: Providing of training; Providing of training; Entertainment; Radio and television entertainment on media of all kinds, namely television, computer, personal stereo, personal video player, personal assistant, mobile phone, computer networks, the Internet; Leisure services; Sporting and cultural activities; Animal training; Production of shows, films and television films, of television broadcasts, of documentaries, of debates, of video recordings and sound recordings; Rental of video recordings, films, sound recordings, video tapes; Motion picture rental; Rental of movie projectors; Audiovisual apparatus and instruments of all kinds, radios and televisions, audio and video apparatus, cameras, personal stereos, personal video players; Theater decorations; Production of shows, films, audiovisual, radio and multimedia programs; Movie studios; Arranging competitions, shoes, lotteries and games relating to education or entertainment; Production of audiovisual, radio and multimedia programs, text and/or still or moving images, and/or sound, whether musical or not, and/or ring tones, whether or not for interactive purposes; Arranging exhibitions, conferences, seminars for cultural or educational purposes; Booking of seats for shows; News reporter services; Photography, namely photographic services, photographic reporting; Videotaping; Consultancy relating to the production of video programs; Game services provided online from a computer network, gaming; Casino facilities; Editing and publication of text (except publicity texts), sound and video media, multimedia (interactive discs, compact discs, storage discs); Electronic online publication of periodicals and books; Publication and lending of books and texts (except publicity texts); Providing movie theatre facilities; Micro publishing.

Class 42: Research and development of new products (for others); Technical research; Expertise (engineering), professional consultancy relating to computers; Providing Internet search engines; Design, upgrading and rental of computer software; Rental of computer apparatus and instruments, namely screens; Consultancy in the field of computer hardware, computer rental; Design (creation) of systems for encrypting

and decrypting and for controlling access to television or radio programmes, in particular nomad systems and data transmission systems of all kinds; Design (creation) of computer systems and software; Drawing up technical standards (standardisation), namely drawing up (design) of technical standards for manufactured products and telecommunications services; Weather information services; Research and development, for others, of electronic, computer and audiovisual, scrambling and access control systems in the fields of television, data processing, telecommunications and audiovisual technology; Authentication (origin searches) of electronic messages; Rental of computer filess; Information about computing applied to telecommunications.

4. The Opponent's registration is a comparable mark.[1] By virtue of its earlier filing date of 3 March 2011, the Earlier Mark qualifies as an earlier mark under section 6(1) of the Act. As the Earlier Mark completed its registration procedure more than five years before the filing date of the Contested Mark, it is, in principle, subject to the use provisions set out in section 6A of the Act. The Opponent has stated that it has used the mark for the goods and services relied on.

5. In its notice of opposition, the Opponent submits that the Applicant's mark is highly similar to its mark, as the dominant and distinctive term 'Planet' contained within the application is wholly contained within the Earlier Mark creating aural, visual and conceptual similarities. It argues that the contested goods and services are identical or similar to those covered by the Earlier Mark as they share the same method of use, trade channels and users. The Opponent contends that there exists a likelihood of confusion, including a likelihood of association, and that the application should be refused.

6. On 16 August 2023 the Applicant filed its counterstatement and defence denying the claims made by the Opponent. More specifically, the Applicant contends that the marks have very different stylisations, and the Earlier Mark contains the '+'

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

symbol which is absent in the Applicant's mark. The Applicant also submits that the goods and services differ from those of the Opponent and requested the Opponent to provide evidence of use in respect of all of the goods and services relied upon.

7. The applicant is unrepresented. The Opponent is represented by D Young & Co LLP.

Relevance of EU law

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

9. During the evidence rounds the Opponent filed evidence in chief in the form of a witness statement from Clément Hellich Praquin, the Corporate General Counsel of Groupe Canal+, signed and dated 18 December 2023, and Exhibits CHP1-CHP20. The Applicant filed evidence in the form of a witness statement from Rogelio Guzman, the founder and CEO of InfiniPlanet, signed and dated 30 March 2024, along with Exhibits INFP1–INFP4. The Opponent filed evidence in reply in the form of a second witness statement from Clément Hellich Praquin, signed and dated 29 May 2024 accompanied by Exhibits A-D. All the witnesses are duly authorised to provide evidence on behalf of both parties. Neither party requested an oral hearing, however, the Opponent filed written submissions in lieu of a hearing.[2] I will not summarise the submissions here, but I will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

Decision

[2] Dated 4 July 2024.

Proof of use

10. I will begin by assessing whether there has been genuine use of the Earlier Mark.

The law

11. Section 6A of the Act states:

> "(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if –
>
> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
>
> (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
>
> (4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

12. As the Earlier Mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7. (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) […]

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day -

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union".

11. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

13. Consequently, the onus is upon the Opponent to prove that genuine use of the registered trade mark was made in the relevant period. The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the Contested Mark. The Opponent states that the relevant period is 20 March – 19 March 2023.[3] I find this calculation of the proof of genuine period to be erroneous. In the case before me, the correct relevant period is **21 March 2018 to 20 March 2023**. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the first two years (and nine months) of the relevant period which falls prior to IP Completion Day (i.e., 31 December 2020).

Case Law

14. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the Court of Justice of the European Union (***"CJEU"***) in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

[3] Witness statement of Clément Hellich Praquin dated 18 December 2023, [4].

[EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet

for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

15. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

Form of the mark

16. Before I move on to assess if the Opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA*, Case O/265/22,[4] the use of the mark in a different form may also constitute use of the mark as registered.

17. For convenience, I reproduce the registered mark below:

18. The Earlier Mark features the verbal element "PLANETE +" all in white capital letters and contained in a grey rectangle that forms the background for the mark's verbal component. The mark also features a red sphere placed at the centre of the mark and behind the grey rectangle. Due to its size and position I find the mark's text "PLANETE +" to be the main distinctive element in the mark with its stylisation contributing in minimum part to the mark's distinctiveness, but without being completely negligible.

19. I remind myself that in *Lactalis*, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said (my emphasis):

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

[4] At [13 – 15]. See also *Hyphen GmbH v EUIPO*, Case T-146/15, at [28-32].

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements."

20. The Opponent has shown uses of the Earlier Mark as registered in most of the evidence, but there are instances where the Earlier Mark has been used in different stylisations (as described below). The Opponent submitted that such variations are broadly equivalent to the mark as registered and do not alter the distinctive character of the Earlier Mark.[5]

21. There are instances where the mark has been used with the same figurative structure (i.e., the text "PLANETE +" contained in a rectangle and with a sphere in the background), but in different colour variations (i.e., the sphere in green or grey) and the rectangle in black as shown below:

Figure 1

Figure 2

[5] Submissions in lieu dated 5 July 2024, paragraph 16.

22. With regard to these colour variations, I find the word element “PLANETE +” to be the main distinctive element in the marks and the difference in colour between the mark as registered (i.e., grey rectangle and red sphere) and the figurative variants has minimum impact on its distinctiveness. This is because the relevant consumer will recognise the colourful variants for what they are, namely colour variations of the same elements that compose the contested mark (i.e., the words “PLANETE +”, the rectangle, and the circular shape in the background), which do not send any other message about trade origin.

23. Furthermore, as the Opponent offers different types of documentaries and, more specifically, provides a documentary series on “adventure” and another one on “crime and investigation”, the evidence shows uses of the Earlier Mark in the colour variations reproduced above with the addition of the text ‘PLANETE+ A&E AVENTURE EXPERIENCE’ (“***PLANETE+AE”***) and ‘PLANETE+ CRIME+INVESTIGATION’ (“***PLANETE+CI***”) respectively for the green and grey colour variations as shown below:

Figure 3

Figure 4

24. To this regard, I find that the word element “PLANETE +” remains the main distinctive element in the mark along with the fact that the Opponent’s brand identifier consists of the words “PLANETE +” in a rectangle placed on a sphere and such figurative structure remains the same (apart from the different colours which I found to be an acceptable variants) and the additional text is merely descriptive (or, at least, non-distinctive) matter to indicate the type of documentary to which the brand origin identifier refers (i.e., adventure or crime). Thus, the additional wording does not change the mark’s distinctive character and are acceptable variants.

25. I appreciate the text “A&E AVENTURE EXPERIENCE” features the letters “A&E” in a stylised manner (i.e., the ampersand is visible as negative space deriving from the combination of the letters ‘A’ and ‘E’) and that “AVENTURE” is French for “adventure”. However, as found in the paragraph above, the Opponent’s brand origin identifier remains the same and the additional matter will likely be perceived as descriptive (or at least non-distinctive) matter. Therefore, also the stylisation of ‘PLANETE+AE’ does not change the mark’s distinctive character and consists of an acceptable variant of the Earlier Mark.

26. The evidence also shows another variation of the Earlier Mark the Opponent uses to address the Polish consumers (both French-speaking and Polish-speaking consumers in Poland) (“***Polish PLANETE+***”). This variation features a partially different stylisation from the Earlier Mark: the red sphere is more of an orange circle; the rectangle is broken into two parts with the left one partially overlapping with the orange circle and ending in a rounded edge; this part of the rectangle contains the letter “Pla” of ‘Planete+”. The right side of the rectangle does not overlap with the circle (seems like it extends behind the circle) and contains the symbol “+”. The text “Planet +” has only the first letter capitalised. The ‘Polish PLANETE+’ mark is shown below:

Figure 5

27. In this variation the main distinctive element (i.e., the word “Planete +”) is present in the mark and clearly visible. I do not find the changes in stylisation (i.e., the rectangle split into two parts, the orange circle, and the lower-case lettering) to substantially impact the mark’s distinctive character and, thus, I find also this variation is an acceptable variant of the Earlier Mark.

28. Thus, I consider all the mark’s variations to be acceptable variant uses in accordance with the guidance in *Lactalis*.

Summary of the evidence of use

29. The Opponent has claimed that genuine use has been made in relation to all the goods and services on which it relies under the Earlier Mark for the purposes of the opposition as indicated above in this decision. I must consider whether, or the extent to which, the evidence shows genuine use of the Earlier Mark in relation to such goods and services covered under classes 9, 38, 41, and 42.

30. Mr Praquin submitted, in his witness statement dated 18 December 2023, that the Opponent is a French audiovisual media group leader in the market of content production, creation of thematic and free-to-air channels, and distribution of pay-TV services in France and other major markets in the world (i.e., Poland, Belgium, Switzerland, Canada and Africa). Mr Praquin provided the history and development of the PLANETE brand (created in 1988 under the name 'PLANETE CABLE', subsequently changed in 1999 to 'PLANETE' and then rebranded in 2011 to 'PLANETE+').

31. Mr Praquin's second witness statement (dated 29 May 2024) is in reply to the arguments made by the Applicant concerning the Opponent's provided evidence.

32. **Exhibit CHP1** contains an extract from the UKIPO database of the Earlier Mark.

33. **Exhibit CPH2** provides an overview of the development of the 'PLANETE+' brand since 1988. The exhibit features one printout from the Wayback Machine database (dated May 2020) showing a page of the CANAL+ Group website reporting that the Group is the leading French audiovisual media group and a major player in the production of pay-TV and theme channels and the bundling and distribution of pay-TV services. The page also indicates the Group (as of May 2022) had a total of 20.3 million subscribers with a strong presence in Asia, Africa (4.9 million subscribers) and Poland (2.7 million subscribers). The Group also provides some free channels in France. The page reports that the Group is the leader in Europe in the production and distribution of movies and TV series and has one of the largest movie catalogues in the world with thousands of titles.

34. The Exhibit also contains few printouts from the Wayback Machine database (dated January 2020) featuring the Wikipedia page for the Canal+ Group. This evidence reports Canal+ is a French premium television channel, launched in 1984, that broadcasts several kinds of programming. The page describes the history of Canal+ indicating the company has, over various years, broadcasted

channels in different regions, gathering a wider pool of subscribers and acquiring the rights to broadcast different programmes and sport channels. The evidence shows a list of various TV shows the Group has broadcasted over the years as well as a list of channels the Group provides. The Exhibit also contains extracts from the Wayback Machine (dated July 2019) for the Canal+ Group reporting the Group is a film and television studio and distributor with a film library of thousands of films; the Group is also a major source of finance for domestic film production in France (e.g., one of the Group's subsidiaries reportedly spends 200 million euro a year on movie production).

35. The evidence also features a Wikipedia page (dated March 2022) indicating that 'PLANETE+' is one of the Group's corporate divisions consisting of a cable TV channel transmitting documentaries. The evidence reports that 'PLANETE+' was launched in 1988 and broadcasts in Poland and Africa in the French language.[6] The evidence also contains a table of the Earlier Mark's brand evolution between 1988 and 2011 showing the adoption of the Earlier Mark as registered in May 2011.

36. **Exhibit CHP3** consists of a brochure the Opponent distributed on the occasion of the 30th anniversary of the 'PLANETE+' channel. The mark as registered appears on various pages of the brochure. The brochure is in French, but the Opponent provided the translation of few paragraphs; the material reports that the year 2018 marked 30 years since the launch of the documentary channel 'PLANETE+' and provides a brief description of the various documentaries the Opponent intended to release for the occasion. All the marketing material provided is in French.

37. **Exhibit CHP4** features screenshots of the 'PLANETE+' channel (also available via a website with a subscription to the 'PLANETE+ channel') showing previews of clips of the programmes broadcasted on the channel. The exhibit features:

- 1 screenshot dated December 2018, of the 'PLANETE+' channel (extracted from the 'mycanal.fr' website) showing a series of previews for the documentaries' trailers. The 'PLANETE+' mark is shown as a word-only mark at the centre of the page as well as in its registered form on all the preview clips next to the documentaries' titles. The page is in English, but the previews' titles are in French

[6] Exhibit CHP2, page12.

(with an English description underneath). The page has the Top Level Domain (TLD) '.fr', therefore it is likely to target the French public.

- 1 screenshot of the 'PLANETE+' channel (extracted from the 'mycanal.fr' website), dated December 2018, featuring a series of preview clips. The mark is represented in its registered stylisation, but in different colours. The page is in English, but the previews' titles are in French (with an English description underneath).
- 2 screenshots of the 'PLANETE+' channel (extracted from the 'mycanal.fr' website) dated October 2018 showing a series of preview clips for the documentaries' trailers (with some clips referring to the channel's '30 years' anniversary). The 'PLANETE+' mark is shown as a word-only mark at the top of the page as well as in its registered stylisation on all the clip previews next to the documentaries' titles; for some clip previews the mark's sphere is red (as registered) and for some others it is in its green variant. The pages are all in French.
- 1 screenshot of the 'PLANETE+' channel (extracted from the 'mycanal.fr' website) dated October 2018. The mark is clearly visible at the top of the page featuring clip previews of documentaries available on the channel. The mark is visible, in its colour variants, next to the titles of the previews. The page is in French.
- 1 screenshot of CANAL+ channel webpage (extracted from the 'mycanal.fr' website) dated October 2018 listing some of the Opponent's channels available on the platform; among these features the mark as registered. The page is in French.
- 2 screenshots, dated October 2018, featuring the 'PLANETE+' channel webpage (extracted from the 'planeteplus.pl' website) containing previous titles of some documentaries. In both pages the Earlier Mark is represented in the variant stylisation (Figure 5 above). The page is in French, but the TLD is '.pl'. Thus, the evidence likely targets the French-speaking Polish public.
- 1 screenshot, dated October 2018, featuring the 'PLANETE+' channel webpage (extracted from the 'planeteplus.pl' website). The Earlier Mark is represented in the variant stylisation (Figure 5 above). Part of the page is in French and another part in a foreign language that is likely Polish. The page's TLD is '.pl'. Thus, the evidence is likely targeting both the French-speaking and Polish-speaking public in Poland. Furthermore, whilst I appreciate the page shows the date of 18 October

2018 at the bottom, it also contains the date of 28 November 2016 at the top of the page.

- 2 screenshots, dated October 2018, featuring the ‘PLANETE+’ channel webpages (extracted from the ‘planeteplus.pl’ website). In both pages the Earlier Mark is represented in the “Polish PLANETE+” variant, the pages are in French, and the TLD is ‘.pl’ likely targeting the French-speaking public in Poland.
- 1 screenshot of the ‘PLANETE+’ channel webpage (extracted from the ‘planeteplus.pl’ website) dated December 2018. The Earlier Mark is represented in the “Polish PLANETE+” variant, the pages are in French, and the TLD is ‘.pl’ likely targeting the French-speaking public in Poland.
- 3 printouts of the Wayback Machine database, dated October 2019, extracted from the website ‘planateplus.com’ and ‘canalplus.com’ featuring preview clips of the programmes available on the ‘PLANETE+’ channel. In the first screenshot the ‘PLANETE+’ mark is shown as a word-only mark at the top of the page. In the first two screenshots the clips feature the titles in French with an English description underneath. The last screenshot is all in French. Throughout this piece of evidence, the Earlier Mark appears mostly as registered with a few instances where ‘PLANETE+’ is in its green variant with the addition of ‘AE’ on the side (i.e., ‘PLANETE+AE’).
- 1 printout of the Wayback Machine database, dated September 2020, extracted from the ‘canalplus.com’ website featuring the ‘PLANETE+’ channel (‘PLANETE+’ is featured in plain text at the top of the page) and showing examples of the programmes available on the channel. The programmes’ previews have their titles in French with their English description underneath. On some previews the Earlier Mark is featured as registered.
- 2 printouts from the Wayback Machine database, dated September 2020 and January 2021, extracted from the ‘canalplus.com’ website featuring the channels available. The channel ‘PLANETE+’ (represented in its registered form) is featured among these channels. The page is in English.
- 2 printouts from the Wayback Machine database, dated April 2021, showing screenshots from the ‘canalplus.com’ website featuring examples of the ‘PLANETE+’ channel. The first screenshot shows some programmes available on

the channel and the second screenshot shows the packages of channels that can be purchased. 'PLANETE+' (in its registered form) is featured as part of these channel packages.

38. **Exhibit CHP5** shows examples of marketing material and screenshots of frames extracted from the documentary series about the moon the Opponent co-produced and televised. The printouts are extracted from the 'lune-lefilm.com' website, the 'planeteplus.com' website, and YouTube. The evidence also shows one instance of physical advertising material (i.e., a sign affixed to a building) concerning the docuseries where the mark (in its registered form) is featured. The evidence from 'lune-lefilm.com' is dated April 2019, the extract from the 'canalplus.com' website is undated, and the YouTube extract is dated May 2023 (outside the relevant period). All the evidence is in French. Throughout the evidence the mark (in its registered form) appears various times to indicate the documentary in object was, at least in 2019, available on the 'PLANETE+' channel.

39. **Exhibit CHP6** shows extracts from the Amazon website featuring the offer for sale of the book concerning the Opponent's documentary on the moon. The price is indicated in pounds sterling, however the book's title is in French and also the book's description and the information regarding the book's author are in French. The evidence contains few reviews for the book dated May and August 2015, January 2016, and December 2018. Regarding the latter review (the only one within the relevant period), I notice the page indicates the book was reviewed in France and it indicates the English review was translated from French.

40. **Exhibit CHP7** features extracts of websites where the book on the moon's documentary is marketed. The extracts are in French and the prices in euro. These pages are dated March 2015 (outside the relevant period). The last page of this exhibit features an article in French where 'Planete+' is mentioned as the co-producer of the documentary in object.[7] Albeit the Opponent did not provide a translation for the article, I note the title makes a reference to May 2018 although further context is unclear (perhaps the article refers to the 'International book and film festival' taking place on 19/20/21 May 2018).

[7] Exhibit CPH7, page 150.

41. **Exhibit CHP8** – in his witness statement Mr Praquin submitted that the Opponent released an iOS application in connection with the moon documentary. The evidence contains extracts dated April 2019 featuring a screenshot from the website (or webpage) 'Iphoneaddict.fr/apps' where the Opponent's application can be downloaded for free on iPhone and iPad devices and an extract from the 'lune-lefilm.com' website advertising the application in object. All the evidence is in French.

42. **Exhibit CHP9** contains pictures of three DVD boxes of movies, series and, documentaries (in French) produced by the Opponent. The mark (as registered) is reproduced on the back cover of the DVD boxes. The evidence is undated, but Mr Praquin submitted, in his first witness statement, that these were released between 2012 and 2014 (i.e., outside the relevant period).

43. **Exhibit CHP10** - in his first witness statement Mr Praquin submitted that the Opponent used the Earlier Mark in a collaboration with the video game 'World of Tanks'. The exhibit features 4 screenshots extracted from the webpage 'worldoftanks.eu' where the Opponent advertised to the players of the 'World of Tanks' video game the opportunity to win a 1-year subscription to the Opponent's CANAL+ channels. In the first page the Opponent explains the competition and exhorts the game players to watch 'Tanks, in the hell of combat' on the 'PLANETE+' channel to win the prize. The extract features the Opponent's mark as registered. The second extract provides more details on the documentary being transmitted (the mark appears in various instances in plain text) and the following page features again the mark as registered. The last page, extracted from the Wayback Machine database and dated November 2017, provides evidence that in that year 'World of Tanks' had more than 110 thousand players.

44. **Exhibit CHP11** features reports on the Opponent's social media presence in 2017. The evidence also refers to the action plan for the media coverage for the subsequent year 2018. The evidence shows the total media coverage for the channels 'PLANETE+', 'PLANETE+AE' and 'PLANETE+CI' with 'PLANETE+' having a reach of almost 26 million users and the three channels combined of almost 30 million.[8] The evidence shows the presence of 'PLANETE+' on Facebook

[8] Exhibit CPH11, page 4.

and Twitter. The evidence shows the Facebook page is called 'planeteplusfrance' and has 116,298 fans whilst the Twitter account is called 'planeteplus' and has 2,300 fans. The Opponent also provided evidence concerning some of its programmes transmitted on 'PLANETE+', 'PLANETE+AE' and 'PLANETE+CI' and their media reach. The evidence shows the use of the Opponent's mark (as registered and in its variations) on various social media posts. All the posts provided in the evidence are in French. From this it appears clear that the Opponent's mark has had a wide social media coverage in France in 2017.

45. **Exhibit CHP12** features a series of screenshots from the Opponent's Facebook and Twitter accounts for the years 2018 and 2019. The mark as registered appears various times in the posts as well as the mark's colour variations for 'PLANETE+AE' and 'PLANETE+CI'. I note that all the examples of posts on the social media platforms, both on Facebook and Twitter, are in French. Furthermore, the screenshots of the Twitter's home page for the 'PLANETE+', 'PLANETE+AE', and 'PLANETE+CI' accounts show France as location.[9] The Facebook accounts for 'PLANETE+AE', and 'PLANETE+CI' do not show a precise location, but they are all in French.

46. The evidence also features two screenshots of the Facebook home page for the 'Polish PLANETE+' mark.[10] The second screenshot features a post in a foreign language (most likely Polish) and in the page's '*A propos*' section there is a reference to 'www.planete.pl', thus, referring to the Polish TLD '.pl'.

47. **Exhibit CPH13** contains examples of advertising leaflets, showing the Earlier Mark, for various shows and documentaries featured on 'PLANETE+'. The Opponent submitted that such advertisement material was displayed between 2013 and 2017 (i.e., outside the relevant period).

48. **Exhibit CPH14** contains third-party online articles where 'PLANETE+', 'PLANETE+AE', and 'PLANETE+CI' are featured. The articles are dated between 2018 and 2021. The evidence contains:

- 1 article in English, dated September 2019, from the 'francetvinfo.fr' concerning an interview with Christine Cauquelin (director of the Decouverte channels and

[9] Exhibit CPH12, pages 9, 15, and 16.
[10] Exhibit CPH12 pages 4 and 20.

documentaries of Canal+) on Radio France. The exhibit also contains preview clips of the interview with French writings on it (the interview was likely held in French).

- 1 article in English, dated October 2018, from the 'megazap.fr' website concerning the 30-year anniversary of the PLANETE+ channel. The mark as registered is clearly visible at the top of the article.
- 1 screenshot dated September 2018, from 'telesatellite.com' indicating that the 'PLANETE+' channel is available on the CANAL platform (the mark is featured in word-only format). The article's top band is in French, but the paragraph underneath is in English. The evidence contains a screenshot of the same article also featured on 'telesatellite.com' dated September 2018.
- 1 article in English from 'megazap.fr' where 'PLANETE+', 'PLANETE+AE', and 'PLANETE+CI' are mentioned in word-only format.
- 1 article in English, dated November 2019, from 'cnews.fr' where the mark 'PLANETE+' is referred to in its plain text.
- 1 article in English from 'midilibre.fr', dated March 2020, titled "How to enjoy all Canal+ programs for free". The article mentions refers to the channel 'Planete+' in plain text. The article reports that Canal+ because of the coronavirus crisis offered one month of access to the channel free of charge "*to help the French confined to their homes to find the time shorter*".
- 6 screenshots from the 'en-net4.canal-plus.com' website dated November 2019, October/November 2020, and January/March/May 2021. The articles concern various programmes available on the PLANETE+ and PLANETE+CI channels. The mark is visible as registered and in its variants on most pages. All the articles are in French.
- 2 screenshots from the YouTube channel, dated October 2020 and November 2019, featuring previews of documentaries available on the PLANETE+ channel. The mark as registered is clearly visible. Both screenshots are in French.
- 1 screenshot from the 'echsdunet.net' website in English, dated June 2021, featuring the fee packages for the 'PLANETE+' channel. The mark is also featured as registered at the top of the page.

49. **Exhibit CPH15** contains press releases showing the success of CANAL+ and its channels (including 'PLANETE+'). The evidence contains 2 articles in English, dated March 2019, from the 'vivendi.com' website and titled "*The CANAL+ Group once again confirms its status as the leading publisher of thematic channels in France*". The articles refer to the 'PLANETE+' channels (including 'PLANETE+AE', and 'PLANETE+CI') stating: "*PLANETE+ channels, France's first documentary offer*". Additionally, the evidence features the same press release also provided in French and an article in French (for which the opponent provided a partial translation) also titled "*The PLANETE+ channels, France's leading documentary offering*".

50. **Exhibit CPH16** contains sample invoices for the promotion of 'PLANETE+'. The invoices are dated November 2013 and October 2015 (outside the relevant period).

51. **Exhibit CPH17** contain extracts from the 2021 "Le Guide DES CHAINES" (translated to "the guide to digital channels"). Mr Praquin submitted, in his first witness statement, that the guide provides economic data on French pay channels and that the edition covers the years 2019 and 2020. The guide shows that between January and June 2020 'PLANETE+' and 'PLANETE+AE' had 0,1% each of the audience's share and 'PLANETE+CI' had the 0,2% in the market of documentary channels in France.[11] The evidence also shows that GROUPE CANAL+, of which all the 'PLANETE+' channels are part, in 2018 had a turnover of 170,5 million euro and in 2019 of 171 million euro. The evidence also shows that between 2019 and 2020 'PLANETE+' had an increase in advertising spending from 5,5 million euro to 5,8 million euro (increase of 5,5%) and that in 2019 'PLANETE+' had a 37% increase in advertising revenues.

52. **Exhibit CPH18** contains printouts of brochures containing promotional offers. Some of the evidence is dated 2014, 2015, and 2021. However, Mr Praquin submitted, in his first witness statement, that this evidence features sample subscription and promotional offers that were available to the consumers in France within the relevant period (e.g., in 2018 as some promotional material refers to 'PLANETE+''s 30-year anniversary). The Earlier Mark as registered, and its variants, are featured throughout the material. Mr Praquin also submitted that this

[11] Exhibit CPH17, page 3.

material was available to French consumers and such targeting is also clear from the fact that all the material is in French.

53. **Exhibit CPH19** shows a contract between the Opponent (for the mark 'PLANETE+') and Mr Jan Vasak, dated August 2015, for the production of the documentary "*Despot housewives*" in French. Mr Praquin, in his first witness statement, submitted that although the contract was signed in 2015, the show aired between 2015 and 2017.

54. **Exhibit CPH20** consists of a leaflet from 2015 showing that by December 2014 CANAL+ Group was France's number one media group with a turnover of 5,456 billion euro and a total of 15,3 million subscribers (of which 5,886 were international) with a strong presence online and on social media platforms. In the same year the Opponent was the leader in the French pay-tv market with 3,454 billion euro in turnover and 6,1 million subscribers. The evidence also shows the Opponent is present in foreign markets with a total of 5 million subscribers from Poland, Africa, Vietnam, and other French overseas territories. Regarding the Polish market, the evidence reports that by December 2014 Poland had become CANAL+ Group's second most important market after France and the Group held a 51% controlling stake in the Polish market. The evidence also shows the Opponent's total turnover as of December 2014 consisting of 533 million euro with 75% coming from the international market and 25% from the French one.

55. This concludes my summary of the Opponent's evidence of use.

Assessment of the evidence of use

56. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the Union during the relevant 5-year period. In making the required assessment I need to consider all relevant factors, including:

    i) The scale and frequency of the use shown

    ii) The nature of the use shown

    iii) The goods and services for which use has been shown

iv) The nature of those goods/services and the market(s) for them

v) The geographical extent of the use shown

57. According to the evidence provided, the Opponent is a long-established company specialising in the production and transmission of audiovisual media content (i.e., pay-TV channels) in France and has some reach also in other EU countries (i.e., Poland). The Opponent provides the 'CHANNEL+' channel encompassing different channels among which 'PLENETE+' is the documentary channel (also encompassing the subcategories of 'PLENETE+AE' and 'PLANETE+CI' for the different types of documentaries). The evidence provided mostly showed the provision of documentaries and movies in France with some evidence also referring to the distribution of audiovisual material (in French) for the Polish territory. The Opponent also provided advertising material and brochures detailing the Opponent's economic offer for its channels (including 'PLANETE+'), mentions by third-party articles where the Earlier Mark is featured, and a good social media presence (mainly in France). All this evidence is likely to target the French public as almost the totality of the material provided is in French. The Earlier Mark appears clearly in most evidence in its registered form along with its acceptable variant forms.

58. With regard to the social media presence, I appreciate the evidence provided refers to 2017, however as the evidence shows that 'PLANETE+' had a reach of almost 26 million users and that combined with the 'PLANETE+AE' and 'PLANETE+CI' channels they had almost total 30 million users, this shows a good social media presence that is likely to have continued at least also into the following year 2018. Thus, I find this evidence to be at least partially relevant for my assessment of use.

59. The evidence also shows that GROUPE CANAL+, of which all the 'PLANETE+' channels are part, had a turnover of 170,5 million euro in 2018 and a turnover of 171 million euro in 2019. The evidence also shows that between 2019 and 2020 'PLANETE+' had an increase in advertising spending from 5,5 million euro to 5,8 million euro (increase of 5,5%) and that in 2019 'PLANETE+' had a 37% increase in advertising revenues (the figures in million euro are not provided).

60. The evidence also shows that in 2022 the Opponent had 2,4 million subscribers for 'CANAL+' channel in Poland.

61. Turning to the relevant territory for which genuine use has been shown, in *Leno Merken BV v Hagelkruis Beheer BV,* Case C-149/11, the CJEU noted that:

> "36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."
>
> And
>
> "50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."
>
> And
>
> "55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider* v *OHIM*, paragraphs 72 and 77)."

62. In *Leno Merken* the court concluded that:

> "Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.
>
> A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

63. From the above, I derive that use of the Earlier Mark in France (i.e., one Member State) and some use in Poland for the period 2018 – 2020 (before IP Completion Day) amounts to genuine use of the Earlier Mark in the relevant territory (hence, also covering the UK). Therefore, following from the above considerations and case law, whilst I appreciate that a fair amount of evidence refers to years outside of the relevant period (e.g., 2017, 2014, and 2015), nonetheless, looking at the evidence as a whole[12] and keeping in mind that use does not necessarily have to be shown throughout the entirety of the relevant period, I find that (1) most of the Opponent's evidence falls within the relevant period (2018 – 2020), and (2) the evidence shows genuine use of the Earlier Mark for some of the services at hand (as further clarified below in this decision) for the period 2018 – 2022. However, I must consider only use for the period 2018 – 2020 since the Opponent's evidence showed the mark's use exclusively for the French public and, to some extent, the Polish public.

Fair specification

[12] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

64. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

65. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd [2014]* EWHC 2631 (Ch) ("*Thomas Pink*") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].
>
> vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably

be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("*Asos*") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

66. From the evidence provided I understand the Opponent is a company that specialises in the production and transmission of audiovisual media content and, more specifically, the Earlier Mark is used for the provision of documentary channels.

67. Regarding the goods in class 9 relied upon for this opposition, the evidence showed the Opponent has a large library of films that are made available on the 'PLANETE+' channel. I appreciate the Opponent's specification contains the term "*Video films*" and that the Nice Classification's general description for the goods in class 9 includes 'recorded media'.[13] However, the Opponent offers films (i.e., motion pictures) on a digital platform and there is no evidence showing that it also markets physical recorded films as proper to class 9. The Opponent's online distribution of films is intended as the services of broadcasting audiovisual material (proper to class 38).

68. I also appreciate that the Opponent provided evidence concerning the use of the Earlier Mark for DVDs (i.e., pictures of three DVDs' boxes), however, the Opponent submitted that these DVDs were distributed between 2012 and 2014 (i.e., outside the relevant period). Hence, I do not find the Opponent provided me enough

[13] Nice General remarks and explanatory notes.

evidence to show use for the term "*recording discs, digital video discs (DVDs), video discs and audio discs, digital discs, video tapes*".

69. With regard to all the remaining goods contained in class 9 relied upon in this opposition, there is no evidence of these goods being marketed by the Opponent. I therefore do not consider that there is enough evidence of use for the Opponent to rely upon its class 9 terms in these proceedings.

70. Turning to class 38, the evidence showed the mark 'PLANETE+' is used to identify an audiovisual channel where TV documentaries are transmitted. I appreciate the Opponent's class 38 contains '*telecommunications services*', however I do not believe the Opponent to be a telecommunications company as it does not provide telecommunications services (such as telephony and data communications access). In contrast, the Opponent offers broadcasting services of television programmes (i.e., documentaries). Class 38 also contains the term "*Online downloading of films and other audio and audiovisual programmes*"; whilst the Opponent may allow its users to download its programmes, there is no evidence of such feature for the 'PLANETE+' channels (the evidence merely shows this channel to be a pay-tv channel that users can access to watch films or documentaries). Regarding the remaining services in class 38, the Opponent has not provided me evidence of use to rely upon these services for these proceedings.

71. In class 41 the Opponent has shown use for services consisting of the provision of television programmes via different media for entertainment purposes and media publication services because such services consist, among others, of the publication of documentary programmes for educating the public. However, the Opponent failed to show use for various services contained in class 41 (e.g., "*Leisure services*", "*Animal training*", "*News reporter services*", "*Casino facilities*") and upon which I find I cannot rely for these proceedings.

72. Turning to class 42, the Opponent did not provide evidence for many services contained in this class (e.g., "*Providing Internet search engines*", "*Rental of computer apparatus and instruments, namely screens*", "*Weather information services*"). Regarding the term "*Design (creation) of systems for encrypting and decrypting and for controlling access to television or radio programmes, in particular nomad systems and data transmission systems of all kinds*", whilst the

Opponent is likely to have systems in place to restrict and control users' access to its television programmes (as they are likely accessible only with a paid subscription), there is no evidence before me to show that the Opponent designs and offers to third parties such services.

73. From the considerations above, it follows that I find the Opponent's fair specification to be:

Class 38: Broadcasting (television -); Transmission of images, videos; television broadcasting; Broadcasting of programmes by satellite, by cable, by computer network (in particular via the Internet); Broadcasting of audiovisual, cinematographic or multimedia programmes, text and/or still or moving images, whether or not for interactive purposes; Transmission of programmes and selection of television channels; Providing access to Internet websites containing audiovisual works.

Class 41: Entertainment, **in the form of television programmes**; television entertainment on media of all kinds, namely television, computer, personal video player, mobile phone, computer networks, the Internet; Production of shows, films and television films, of television broadcasts, of documentaries, of debates, of video recordings; Rental of video recordings, films; Motion picture rental; Production of shows, films, audiovisual, and multimedia programs; Production of audiovisual and multimedia programs, text and/or still or moving images, whether or not for interactive purposes; publication of video media.

74. In contrast, the Opponent has failed to show use for the following goods and services:

Class 9 Scientific (except for medical purposes), nautical, surveying, photographic, cinematographic, optical and electro-optical, weighing, measuring, signalling, checking (supervision) and life-saving apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Decoders; Electronic apparatus for data processing; Electric measuring devices and Electronic checking (supervision); Teaching apparatus and

instruments; Apparatus and instruments for recording, transmission, reproduction, storage, encoding, decoding, conversion and processing of sound or images; Communications and telecommunications apparatus; Audiovisual, telecommunications, data transmission, television apparatus and instruments, remote controls; Cassette recorders; Video recorders, Film cameras; Telephones, mobile telephones; Personal organisers (PDAs); Electronic diaries; Radio sets, Personal stereos; Projectors (projection apparatus); Antennas, aerials, satellite dishes; Speakers, amplifiers; Computers, computer screens, computer keyboards, peripheral devices for computers, modems, decoders, encoders; Access devices (apparatus) and access control devices for data processing apparatus; Authentication apparatus for use in telecommunications networks; Apparatus for scrambling and descrambling signals and retransmissions; Digital terminals; Video films; CD-ROMs, recording discs, digital video discs (DVDs), video discs and audio discs, digital discs, video tapes; CD players, DVD players, digital disc players, magnetic disc players, video and audio disc players, recording disc players; Video game cartridges; Video game software; Video games adapted for use with a television screen; Magnetic data carriers; Magnetic cards, Chip cards, Electronic cards; Integrated circuits and microcircuits; Card readers; Electronic components; Worldwide computer network data reception monitors; Automatic vending machines and mechanisms for coin-operated apparatus; Calculating machines and data processing equipment; Satellites for scientific and telecommunications use; Spectacles (optics); Optical goods, spectacle cases; Smart cards, cards with microprocessors; Electronic radio and television programme guide; Apparatus and instruments for programming and selection of television programmes; Interactive television apparatus and instruments; Television screens; Computer software (recorded programs); Fibre-optic cables and optical cables; Electric batteries and cells.

Class 38 Telecommunications services; Communications by computer terminals or by optical fibres; Information about telecommunications; News and

information agencies; Radio communications, communications by telegrams, by telephones or video phones, by television, by personal stereo, by personal video player, by interactive videography; Transmission of information by data transmission; Transmission of messages, telegrams, mail; Transmission of information by teleprinter; Data communications; Radio broadcasting; Broadcasting of ringtones, whether or not for interactive purposes; Broadcasting of programmes by radio networks, by radio-telephone networks and by radio link; Electronic advertising (telecommunications); Broadcasting of audio, sound, whether musical or not; Rental of telecommunications equipment and apparatus; Rental of data transmission apparatus and instruments namely telephones, facsimile machines, apparatus for transmitting messages, modems; Rental of aerials and satellite dishes; Rental of devices (apparatus) for access to interactive audiovisual programmes; Leasing access time to telecommunications networks; Providing services to download video games, Digital data, Communications (transmission) on open (Internet) or closed (intranet) global computer networks; Online downloading of films and other audio and audiovisual programmes; Providing access to a computer network; Providing connections to telecommunications services, to Internet and database services; Routing and connecting services for telecommunications; Connection by telecommunications to a computer network; Telecommunications consultancy; Professional consultancy relating to telephony; Consultancy in the field of video programme broadcasting; Consultancy relating to the transmission of data via the Internet; Consultancy relating to providing access to the Internet; Sending and receiving video images via the Internet using a computer or mobile telephone; Telephone services; Cellular telephone services; Cellular telephone communication; Paging by radio; Voice messaging, call forwarding, electronic mail, electronic message transmission; Video-conferencing services; Video messaging services; Video-telephone services; Answering machines (telecommunications); Providing access to the Internet (Internet service provider); Electronic mail exchange, e-mail services, instant electronic messaging services, non-instantaneous

electronic messaging services; Transmission of information via the Internet, an extranet and an intranet; Transmission of information via secured messaging systems; Providing access to electronic conferencing and discussion forums; Providing access to Internet websites containing digital music of all kinds; Providing access to telecommunications infrastructures; Providing access to search engines on the Internet; Transmission of electronic publications online; Rental of decoders and encoders.

Class 41 Providing of training; Providing of training; Radio entertainment on media of all kinds, namely personal stereo, personal assistant; Leisure services; Sporting and cultural activities; Animal training; Production of sound recordings; Rental of sound recordings, video tapes; Leisure services; Sporting and cultural activities; Animal training; Rental of movie projectors; Audiovisual apparatus and instruments of all kinds, radios and televisions, audio and video apparatus, cameras, personal stereos, personal video players; Theater decorations; Production of radio programs; Movie studios; Arranging competitions, shoes, lotteries and games relating to education or entertainment; Production of radio programs, and/or sound, whether musical or not; Arranging exhibitions, conferences, seminars for cultural or educational purposes; Booking of seats for shows; News reporter services; Photography, namely photographic services, photographic reporting; Videotaping; Consultancy relating to the production of video programs; Game services provided online from a computer network, gaming; Casino facilities; Editing of text (except publicity texts), sound and multimedia (interactive discs, compact discs, storage discs); Electronic online publication of periodicals and books; Publication and lending of books and texts (except publicity texts); Providing movie theatre facilities; Micro publishing; Production of ring tones, whether or not for interactive purposes.

Class 42: Research and development of new products (for others); Technical research; Expertise (engineering), professional consultancy relating to

computers; Providing Internet search engines; Design, upgrading and rental of computer software; Rental of computer apparatus and instruments, namely screens; Consultancy in the field of computer hardware, computer rental; Design (creation) of systems for encrypting and decrypting and for controlling access to television or radio programmes, in particular nomad systems and data transmission systems of all kinds; Design (creation) of computer systems and software; Drawing up technical standards (standardisation), namely drawing up (design) of technical standards for manufactured products and telecommunications services; Weather information services; Research and development, for others, of electronic, computer and audiovisual, scrambling and access control systems in the fields of television, data processing, telecommunications and audiovisual technology; Authentication (origin searches) of electronic messages; Rental of computer filess; Information about computing applied to telecommunications.

Section 5(2)(b)

75. The relevant parts of section 5(2)(b) are as follows:

> "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."

76. Section 5A reads:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case law

77. The leading authorities which guide me are from the Court of Justice of the European Union: *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.

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 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

78. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

> "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".

79. 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.

80. Section 60A of the Act sets out that goods or services are not to be considered similar simply because they appear in the same classes. Alternatively, section 60A also states that goods or services are not to be considered dissimilar simply because they appear in different classes.

81. 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 fur 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."

82. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court stated that "complementary" means:

> "[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

83. 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."

84. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

> "[…] the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of

services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded."

85. For the purposes of considering the issue of similarity, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.[14]

86. The competing goods and services are as follows:

Opponent's services	Applicant's goods and services
	Class 9
	Interactive touchscreen terminals; Interactive terminals; Virtual and augmented reality software; Virtual reality software; Augmented reality software; Interactive entertainment software; Augmented reality software for use in mobile devices; Interactive entertainment software for use with personal computers; Interactive touch screen terminals; Information technology and audio-visual, multimedia and photographic devices.
Class 38	**Class 38**
Broadcasting (television -); Transmission of images, videos; television broadcasting; Broadcasting of programmes by satellite, by cable, by computer network (in particular via the	Interactive transmission of video over digital networks; Communication via virtual private networks; Streaming of audio, visual and audiovisual material via a global computer network;

[14] See *Separode* Trade Mark (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Internet); Broadcasting of audiovisual, cinematographic or multimedia programmes, text and/or still or moving images, whether or not for interactive purposes; Transmission of programmes and selection of television channels; Providing access to Internet websites containing audiovisual works.	Transmission of vision via interactive multimedia networks.
Class 41	**Class 41**
Entertainment, **in the form of television programmes**; television entertainment on media of all kinds, namely television, computer, personal video player, mobile phone, computer networks, the Internet; Production of shows, films and television films, of television broadcasts, of documentaries, of debates, of video recordings; Rental of video recordings, films; Motion picture rental; Production of shows, films, audiovisual, and multimedia programs; Production of audiovisual and multimedia programs, text and/or still or moving images, whether or not for interactive purposes; publication of video media.	Interactive entertainment; Online interactive entertainment.
	Class 42
	Design and development of virtual reality software; Design services relating to virtual reality software; Design and development of computer game software and virtual reality software; Design and

	development of virtual private network (VPN) operating software.

87. Mr Guzman, in his witness statement, brings forward the argument that the competing goods and services are dissimilar as the parties operate in different market sectors. Accordingly, he provided submissions and evidence to show that the Applicant provides content in the virtual reality space.[15] To this regard, I am reminded of the findings of Dr. Brian Whitehead in *City Storage Systems LLC v Kenmark Kitchen Limited,*[16] where, sitting as the Appointed Person, he stated (my emphasis):

> "18. The authors of Kerly state at 11-055: "It is the goods or services covered by the specifications of the marks at issue that must be considered when making this assessment, and not the goods or services actually marketed under those marks", referring to *Present-Service Ullrich GmbH & Co KG v OHIM* (T-66/11) [2013] E.T.M.R. 29. In that case, the General Court said at 45:
>
> > "Secondly, the applicant's claim that it operates in a completely different commercial sector from the intervener is also irrelevant. In order to assess the similarity of the goods or services at issue for the purposes of art.8(1)(b) of Regulation 207/2009, the group of goods or services protected by the marks at issue must be taken into account, and not the goods or services actually marketed under those marks".

88. It follows that in my assessment I must look at the similarity of the goods and services solely on the basis of those registered and applied for (along with the considerations made above concerning the Opponent's fair specification deriving from the evidence of genuine use) and it is impermissible for me to take into account the goods and services actually provided by the parties.

Class 9

[15] Witness statement and Exhibits INFP1 – INFP4 dated 31 March 2024.
[16] Decision BL O/0065/24.

- "*Interactive touchscreen terminals; Interactive terminals; Interactive touch screen terminal*"

89. The Opponent submitted that "*Interactive touchscreen terminals; Interactive terminals; Interactive touch screen terminal; Information technology and audio-visual, multimedia and photographic devices*" are similar and complementary to the Earlier Mark's goods relating to DVDs in class 9, services relating to broadcasting and telecommunications in class 38 and class 41 services relating to entertainment.[17] The Opponent did not provide further clarification on the reasons for such similarity.

90. The Applicant's goods above consist of interactive touchscreen monitors generally used in public spaces to enable users to access information or services (e.g., in banks, airports, shopping centres). Given the intended purpose and public availability of the Applicant's goods, it is very unlikely touchscreen terminals are used for the transmission of television programmes or other audiovisual content of this nature and for entertainment purposes. Thus, I find the Applicant's goods are dissimilar from the Opponent's class 38 services "*Transmission of images, videos*" or "*Broadcasting of audiovisual […] programmes*" as they have different nature, method of use (television programmes are usually watched privately at home and not on public interactive terminals), intended purpose (provision of information or other services against entertainment), end user, and do not share the same trade channels. The competing goods and services are neither complementary nor in competition.

- *"Information technology and audio-visual, multimedia and photographic devices"*

91. The goods above consist of devices used for the exchange of data (among other functionalities) and audiovisual content. In Mr Praquin's second witness statement, the Opponent contended that virtual reality (VR) devices are becoming increasingly popular for the transmission of audiovisual content (e.g., television programmes and series including documentaries).[18] When comparing the Applicant's terms above with the Opponent's "*Transmission of images, videos*" or "*Broadcasting of*

[17] Submissions in lieu dated 5 July 2024, paragraph 53.
[18] Witness statement dated 3 June 2024.

audiovisual programmes", I find the these goods and services have different nature (audiovisual and information technology equipment against the provision of audiovisual material), trade channels and end users (the consumers interested in purchasing a VR headset or tablet differ from those who purchase and watch a film). The Opponent provided evidence and submissions showing that audiovisual material (including interactive television series) is being increasingly made available to be watched with VR headsets.[19] Whilst I appreciate that such uses may show that the competing goods and services share the same intended purpose to some extent (i.e., access and watch audiovisual material), I do not find that the mere fact of watching a movie on a tablet or VR makes these goods and services to fall within the definition of complementarity as defined by the case law above. Thus, I find the Applicant's goods above to be dissimilar from the Opponent's services in class 38.

- "*Virtual and augmented reality software; Virtual reality software; Augmented reality software; Interactive entertainment software; Augmented reality software for use in mobile devices; Interactive entertainment software for use with personal computers*"

92. The Opponent provided evidence showing that VR devices are increasingly being used to watch television content and interactive television series (including documentaries).[20] In its submissions in lieu the Opponent contended that "*the evidence highlights the overlapping nature and purpose of these goods and services* [broadcasting and telecommunications services in class 38 and class 41 services relating to entertainment and production] *and, in particular, how they relate and could easily be perceived as originating from the Opponent. For example, television services and virtual and augmented reality software both deliver content for entertainment purposes, can be used in combination together (and in some respects can fall under the same category or at least can have the same manufacturers and distribution channels) and target the same public*".[21]

[19] Witness statement of Mr Praquin dated 3 June 2024.
[20] Witness statement of Mr Praquin dated 3 June 2024, paragraphs 6-9.
[21] Submissions in lieu dated 5 July 2024, paragraph 54.

93. I acknowledge the Opponent's submissions and appreciate the Applicant's terms above and the Opponent's services of broadcasting/transmission of audiovisual content can partially overlap in their end user, method of use (it is possible for television programmes to be transmitted and watched on VR devices), and intended purpose (interactive purposes). However, I do not find that the transmission of videos on VR devices amounts to the traditional definition of broadcasting or transmission of audiovisual content which normally involves viewers watching content on televisions, tablets, mobile phones or other devices that do not have virtual reality features. To his regard, also in the Opponent's evidence it can be seen that interactive tv shows and movies (such as those provided by Netflix) are made available on media that do not encompass virtual reality devices (i.e., smart TVs, steaming media players, game consoles, computer browsers, android phones and tablets, iPhones, iPads, iPod touch).[22] Additionally, I disagree with the Opponent that interactive software and transmission services fall within the definition of complementarity merely because videos can be watched on virtual reality devices. I also find the respective goods in class 9 and services in class 38 to differ in their nature (broadcasting services against virtual reality software), trade channels (companies providing interactive software for entertainment purposes do not usually broadcast audiovisual content), and not to be in competition. Additionally, I do not believe that consumers will likely think that the responsibility for the respective goods and services lies with the same undertaking. Overall, I find the competing goods and services at hand to have a low level of similarity.

Class 38

- "*Interactive transmission of video over digital networks; Communication via virtual private networks; Streaming of audio, visual and audiovisual material via a global computer network; Transmission of vision via interactive multimedia networks*"

94. The Applicant's terms above all fall within the wider definitions of the Opponent's "*Broadcasting of programmes by satellite, by cable, by computer network (in*

[22] Exhibit B, page 1.

particular via the Internet)" and "*Transmission of images, videos*". Thus, the competing services are identical in line with the principle outlined in *Meric*.

Class 41

- "*Interactive entertainment; Online interactive entertainment*"

95. In interactive entertainment the user can interact with the type of programme being transmitted (e.g., video games). The Opponent provides "*television entertainment on media of all kinds, namely […] the Internet*" in class 41. Whilst I appreciate the Opponent provided evidence showing that, in some instances, broadcasters (such as Netflix) can offer interactive television shows or programmes, however I find that these instances are not the traditional way television entertainment is provided being a more passive activity involving the mere act of watching a film or television show. Accordingly, I find the traditional definition of interactive entertainment refers to video games rather than films/shows. Thus, I find the respective services to have different nature (interactive content against online television programmes), and method of use (for television programmes interaction is not usually required). I do not discount a partial overlap in trade channels and end users (e.g., platforms like Netflix can provide for its users both traditional tv programmes and interactive entertainment), but I do not find this to be a common practice in the market. The services are neither in competition nor complementary. Overall, I find the services at hand to have low degree of similarity.

Class 42

- "*Design and development of virtual reality software; Design services relating to virtual reality software; Design and development of computer game software and virtual reality software; Design and development of virtual private network (VPN) operating software*"

96. The Opponent has not provided submissions on the similarity between the Applicant's services above and the Earlier Mark's specification. In any case, I find the Applicant's services of design and development of software (VR, computer game, or VPN) to differ from the Opponent's broadcasting/transmission services in

class 38 as well as from the entertainment services or the rental, production or publication of audiovisual material services in class 41. Whilst the competing services can have a similar intended purpose (e.g., provision of video games), I find the respective services have different nature, method of use, and end users. Also, companies that broadcast or make available audiovisual content do not usually offer software development services to third parties; thus, the services at hand differ in their trade channels and are neither in competition nor complementary. I find the above services to be dissimilar from the Opponent's services.

Average consumer and the purchasing act

97. It is necessary for me to determine who the average consumer is for the services in question; I must then determine the manner in which the services are likely to be selected by the average consumer in the course of trade.

98. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* 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:

> "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."

99. The average consumer for the services in classes 38 and 41 for which I found similarity (i.e., broadcasting/transmission of programmes and interactive entertainment services) will be members of the general public. The cost of

purchase for these services can vary, but it is likely not to be excessively high (e.g., subscription to a streaming platform for entertainment purposes or the purchase of video games), and such services will be purchased relatively frequently (especially in cases of regularly renewed subscriptions). However, various factors are still likely to be taken into consideration during the purchasing process, such as the type of programmes available, the devices/consoles for which the programmes or games are compatible, and the programmes/games' suitability for the consumers' specific preference and needs. Thus, for these services it is my view that, overall, the general public will demonstrate a medium degree of attention during the purchasing process.

100. I consider the purchase of the services to be mainly visual with the services likely being advertised on television or online equivalent (e.g., social media platforms) with the consumers self-selecting the services by accessing and purchasing them directly from the Opponent's website or other online platforms. However, I do not discount aural considerations will play their part, particularly when advice is sought from sales representatives or for word-of-mouth recommendations.[23]

Comparison of marks

101. 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.

102. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

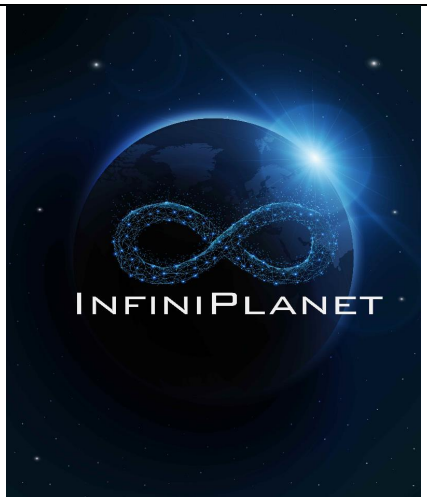
> " [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

[23] Regarding the Applicant's software goods for which I found low similarity, I make the same findings as to the degree of attention of the relevant consumer and the purchasing (visual and aural) considerations.

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."

103. It would be wrong, therefore, to dissect the trade marks artificially, 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.

104. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	

Overall impression

105. The Earlier Mark consists of the all-capitalised verbal element "PLANETE" and the mathematical symbol "+" (all in white and plain font). The text "PLANETE +" is contained in a grey rectangle that also forms the background for the mark's verbal component. A red sphere is placed behind the rectangle and verbal element as the mark's background. The mark's text "PLANETE +" is the main distinctive element in the mark but given the size and position of the rectangle and red sphere they also contribute, although in minor part, to the mark's overall impression.

106. The Contested Mark features the word combination "InfiniPlanet" and an infinity symbol placed above the mark's text. The infinity symbol's stylisation resembles a

net of shining dots. Behind the mark's text and the infinity symbol the mark features a real-life representation of a planet with the sun (or a star different from the sun) rising from the planet's top right-hand side. An outer-space sky forms the mark's background and varies from dark blue at the top right corner to black in the bottom left corner. All the elements of the mark are in blue tones. Whilst I appreciate the consumer's eye is naturally drawn to the elements of the mark that can be read (namely, "InfiniPlanet"), given the size and complexity of the image in the Contested Mark, I find, on balance, that both the figurative elements and words form the overall impression in roughly equal measure.

Visual similarity

107. The respective marks contain the letters 'PLANET' as a point of similarity. The Opponent contended that *"[the] signs should be considered visually similar insofar as they share a significant number of letters and are stylised in the same or similar manner […] as they utilise the same shapes and colours and similar verbal elements and symbols*".[24] Differently from the Opponent's submission, I find there are several points of dissimilarity between the marks. First, the Earlier Mark features an extra 'E' at the end of "PLANET-" and the mathematical symbol "+" while the Contested Mark contains the initial letter combination "Infini-" before "Planet" and a stylised infinity symbol. Second, the Earlier Mark features a grey rectangle (containing the white text "PLANETE +") and a red sphere in the background, none of this is reproduced in the Contested Mark. Third, the Contested Mark contains various additional figurative elements that are not reproduced in the Earlier Mark (i.e., the real-life representation of a planet with the sun (or star) rising from behind it, an outer space sky, a stylised infinity symbol, and blue colour tones throughout the whole mark). Taking all this into account, I find there is a low degree of visual similarity between the marks.

Aural similarity

108. The Earlier Mark's verbal element 'PLANETE' is likely to be read as "PLAN-ETT" with the "+" symbol being verbalised as the word "PLUS". I appreciate the

[24] Submissions in lieu dated 5 July 2024, paragraph 41.

mark contains an extra letter ‘E’ at the end, but this is unlikely to affect the mark’s pronunciation. Thus, the consumers will likely read the mark’s text as “PLAN-ETT PLUS”.

109. Although the Contested Mark is composed of one verbal element (i.e., ‘InfiniPlanet’), consumers, when perceiving a verbal sign, may break it down into elements that suggest a concrete meaning, or that resemble words that they already know.[25] This may also be the case when a mark contains elements that would encourage such a split, such as irregular capitals (like in the Contested Mark). Therefore, it is likely that the relevant public will read the Contested Mark’s verbal element breaking it down into ‘infini-‘ and ‘Planet’. The first half of the mark’s text (‘infini-‘) calls to mind the English word “infinity”, therefore ‘infini-‘ will be pronounced accordingly and ‘planet’ will be perceived as an English dictionary word and will be pronounced as such. Contrary to the “+” symbol in the Earlier Mark, consumers will not voice the infinity symbol in the Contested Mark.

110. With regard to the other figurative elements in both marks, consumers will not pronounce them.

111. From the above it follows that the words “PLANETE” and “Planet” in the respective marks will be pronounced identically. However, ‘planet’ is placed at the end of the Contested Mark after ‘infini-‘ and as consumers read from left to right and the beginning of marks tend to have more visual and oral impact than the endings of marks,[26] I find the marks share a medium degree of aural similarity.

Conceptual similarity

112. In both marks the relevant public will understand the word “planet” with its dictionary meaning. In the Earlier Mark the inclusion of the symbol “+” will be perceived as indicating that something is being added (e.g., a positive advantage or good features). In the Contested Mark the letter combination ‘infini’ is likely to be understood as “infinity” and such meaning is reinforced by the infinity symbol in the mark. Thus, the Contested Mark conveys the meaning of “infinity planet”. Therefore, the respective marks share the same semantic reference to “planet”,

[25] Case T-256/04, *Respicur*, [57]; Case T-146/06, *Aturion*, [58].
[26] Cases T-183/02 and T-184/02, *El Corte Ingles, SA v OHIM.*

but such meaning is lessened by additional verbal and symbolic elements in both marks. Therefore, overall, I find the marks have a medium degree of conceptual similarity.

Distinctive character of the earlier trade mark

113. 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 C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, 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 promoting 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)."

114. Dealing first with the inherent distinctiveness of the Earlier Mark, the Opponent submitted that the Earlier Mark possesses "*at least an average degree of inherent distinctiveness*".[27] The Opponent's mark is a stylised mark featuring verbal and figurative elements. The mark's verbal component "PLANETE +" is formed by the French word for "planet" resembling the English dictionary word for the same

[27] Submissions in lieu dated 5 July 2024, paragraph 48.

meaning (and the English-speaking consumers will likely understand it with such meaning) along with the "+" symbol. Thus, neither the mark's text nor its stylisation (i.e., the red sphere or grey rectangle) describe, allude, or have any semantic correlation with the goods and services for which the mark is registered. Overall, I find the Earlier Mark possesses a medium degree of inherent distinctive character.

115. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, the evidence demonstrated that there has been use of the Earlier Mark in the EU for part of the relevant period, however the market for enhanced distinctiveness I must look to is the UK. It is clear from the evidence that the broadcast language for the TV channel is largely French, although some evidence showed a few instances where the services had been offered and advertised in Polish, and the audience share figures refer to other international reach (e.g., Africa and Asia). However, no customer base is given for the UK. Taking this into account I do not find that the Earlier Mark's distinctive character has been enhanced through use in the UK.

Likelihood of confusion

116. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

117. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

118. I have found the respective goods and services to range from dissimilarity to identity. The level of attention is medium for the general public. The distinctiveness of the Earlier Mark is medium. The degree of visual similarity is low and the aural

and conceptual similarity is medium. The purchase of the contested goods and services is considered to be mainly visual but the potential for aural use is borne in mind. I found that the respective marks differ in their stylisation, their coinciding word “planet” is placed at the end of the Contested Mark, and each mark has additional matter that is not reproduced in the other (e.g., the “+” and infinity symbols, the red sphere and the real-life representation of a planet, the grey rectangle, and the outer space sky). Weighing these factors, I find that the marks are unlikely to be mistakenly recalled or misremembered as each other and I do not consider there to be a likelihood of direct confusion.

119. It now falls to me to consider the likelihood of indirect confusion. The concept of 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply

even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

120. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[28] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[29] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[30]

121. The Opponent submitted that "*[…] there is a high risk of indirect confusion. There is a possibility that some consumers will recognise that the Application bears a slight variation to the Earlier Registration, but will notice the common elements between the marks, e.g., shared colours use in text, use of symbols and planet imagery, and will conclude that the Application is another brand of the Opponent*".

122. Following the considerations above and the Opponent's submission, whilst the marks overlap in part of their verbal element (i.e., the letter sequence "p-l-a-n-e-t") I do not find the Contested Mark's stylisation to be a "slight variation" of the Earlier Mark's since the marks differ in their symbols (i.e., plus vs. infinity) both in their meaning and graphic representation, in their colours (apart from the text in white) and the representation of a planet (a red sphere vs a real-life representation with the outer space sky and stars all around). Additionally, the word "planet" in the Contested Mark is placed after the initial part "Infini-". Therefore, I do not

[28] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.
[29] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[30] *Liverpool Gin Distillery*.

believe the relevant consumers will perceive the Contested Mark as a sub-brand or brand extension deriving from the Earlier Mark. This is because the removal of the letter 'E' and the plus symbol from the Opponent's "PLANETE +" mark, the addition of "Infini-" at the beginning of the Contested Mark, the addition of the infinity symbol and the Contested Mark's overall stylisation are unlikely to lead the consumers to believe that the Contested Mark represents a sub-brand, brand extension or re-branding of the Earlier Mark. The later mark also does not strike me as being entirely logical or consistent with a brand extension of the Earlier Mark. Therefore, I do not find that there is a likelihood of indirect confusion.

Conclusion

123. The opposition fails under section 5(2)(b) of the Act.

124. The Applicant has been successful. Subject to any successful appeal, the application by InfiniPlanet Inc. may proceed to registration.

Costs

125. The Applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice (TPN) 1/2023.

126. The Applicant has been successful and would normally be entitled to a contribution towards its costs. However, as the Applicant is unrepresented, at the conclusion of the evidence rounds, the official letter, dated 10 June 2024, advised the Applicant that, if it intended to make a request for an award for costs it should complete and return the relevant costs proforma by 8 July 2024. The same letter stated, inter alia, that:

> "If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded."

127. No costs proforma has been filed by the Applicant in response to the abovementioned letter and paid no official fees. As such, I make no award of costs in this matter.

Dated this 27th day of March 2025

Andrea Rossi
For the Registrar

Annex A

Goods and services of UK trade mark application no. UK00003890996

Class 9: Virtual reality games software; Virtual reality software for education; Interactive touchscreen terminals; Interactive terminals; Virtual and augmented reality software; Virtual reality software for playing virtual reality games; Virtual reality headsets; Virtual reality software; Virtual reality glasses; Virtual reality headsets adapted for use in playing video games; Augmented reality software; Augmented reality software for education; Virtual classroom software; Interactive entertainment software; Augmented reality software for use in mobile devices; Interactive game software; Downloadable interactive entertainment software for playing computer games; Interactive computer systems; Interactive entertainment software for use with personal computers; Virtual assistant software; Interactive touch screen terminals; Head mounted augmented reality displays; Information technology and audio-visual, multimedia and photographic devices.

Class 28: Stand-alone video game machines; Interactive gaming chairs for video games.

Class 35: Conducting virtual trade show exhibitions online; Retail services relating to clothing.

Class 38: Providing virtual facilities for real-time interaction among computer users; Interactive transmission of video over digital networks; Communication via virtual private networks; Streaming of audio, visual and audiovisual material via a global computer network; Transmission of vision via interactive multimedia networks; Virtual chatrooms established via text messaging; Providing online facilities for real-time interaction with other computer users; Providing an online interactive bulletin board.

Class 41: Virtual reality arcade services; Interactive entertainment; Online interactive entertainment; Providing online virtual guided tours.

Class 42: Design and development of virtual reality software; Design services relating to virtual reality software; Design and development of computer game software and virtual reality software; Hosting online facilities for conducting interactive discussions; Design and development of virtual private network (VPN) operating software; Hosting on-line facilities for conducting interactive discussions; Hosting online web facilities for others for conducting interactive discussions.