

O-362-18

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF:

TRADE MARK APPLICATIONS 3120247 & 3120245

IN THE NAME OF

PLANET ENTERPRISES LIMITED

FOR THE TRADE MARKS:

Planet eStream Connect

&



AND

**OPPOSITIONS THERETO (UNDER No 405557/9) BY
PLANETSTREAM LIMITED**

Background and pleadings

1. On 30 July 2015, Planet Enterprises Limited (“the applicant”) applied to register the trade mark **Planet eStream Connect** in respect of the following goods and services:

Class 9: Computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; hardware, software, apparatus and instruments for transcoding and encoding; Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture hardware, software, apparatus and instruments; hardware, software, apparatus and instruments for high definition audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; computers; computer hardware; computer peripherals; data processing apparatus and instruments; computer software; computer programs; telecommunications apparatus and instruments; downloadable electronic publications; CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks; digital, electronic, optical and magnetic data storage means; monitors, computer processors, disc drives; cards and memory add-ons; memory boards, memory chips; video capture cards; encoding cards; video cameras; video editing workstations; video decks; video converters; Internet streaming hardware, software, apparatus and instruments; downloadable recorded content; downloadable media content; software for content delivery and management via the Internet, communications and computer networks; software and interfaces for cloud computing services; software and interfaces for cloud-based content sharing; user interfaces to deliver digital and multimedia content; software to enable searching of data; but not including vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 38: Access to digital and multimedia content; provision of access to digital and multimedia content, including databases of digital and multimedia content via the Internet, communications and computer networks; transmission of digital and multimedia content via the Internet, communications and computer networks; provision of telecommunications access to digital and multimedia content; providing access to content sharing portals; provision of access to cloud-based content sharing services; provision of access to a repository of digital and multimedia recordings; provision of online forums and communities; transmission of user-generated content via the Internet, communications and computer networks; transmission of multimedia and digital content via the Internet, communications and computer networks; transmission of videos, movies, pictures, images, text, photos, games, audio content, user-generated content, data and information via the Internet, communications and computer networks; information, advisory and consultancy services relating to all the aforesaid services; but not including telecommunications services or information, advisory and consultancy services relating to vehicle audio components, namely AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customized vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.


Class 41: Education and training in the field of audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; provision of educational information; provision of educational data and recordings; provision of educational information, data and recordings by electronic and online means; information services for the supply of electronic, digital and multimedia data, information and recordings (including archive data, information and recordings); information, advisory and consultancy services relating to all the aforesaid services; but not including education and training services or information, advisory and consultancy services relating to vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and

speakers, video and television monitors and DVD machines being customised vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 42: IT services, technical support, assistance and consultancy relating to computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; integration and configuration of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; design and development of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; installation, maintenance and repair services relating to computer software for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; cross platform conversion of digital content; hosting of digital content on the Internet, communications and computer networks; provision of temporary use of non-downloadable software to enable content access; provision of temporary use of non-downloadable software to enable the sharing of multimedia content; design and development of software for processing and distribution of digital and multimedia content; design and development of software for conversion, compression and decompression of digital and multimedia content; cloud computing services; technical support, assistance and consultancy relating to cloud computing services; providing temporary use of non-downloadable software for accessing and using a cloud computing network; provision of search engines; provision of software from a hosted platform; information, advisory and consultancy services relating to all the aforesaid services; but not including technical support assistance or information, advisory and consultancy services relating to vehicle audio components, namely AM/FM stereo receivers, cassette tape decks, compact

disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customized vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

The mark was published for opposition purposes on 28 August 2015.

2. On the same date, the applicant also applied for the mark  in respect of:

Class 9: Computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; hardware, software, apparatus and instruments for transcoding and encoding; Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture hardware, software, apparatus and instruments; hardware, software, apparatus and instruments for high definition audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; computers; computer hardware; computer peripherals; data processing apparatus and instruments; computer software; computer programs; telecommunications apparatus and instruments; downloadable electronic publications; CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks; digital, electronic, optical and magnetic data storage means; monitors, computer processors, disc drives; cards and memory add-ons; memory boards, memory chips; video capture cards; encoding cards; video cameras; video editing workstations; video decks; video converters; Internet streaming hardware, software, apparatus and instruments; downloadable recorded content; downloadable media content; software for content delivery and management via the Internet, communications and computer networks; software and interfaces for cloud computing services; software and interfaces for cloud-based content sharing; user interfaces to deliver digital and multimedia content; software to enable

searching of data; digital signage software, interfaces and systems; digital signage monitors, panels and digital signage-playing hardware and apparatus; digital signage software to enable the design of display layouts, templates and elements within displays; digital signage software to enable creation, management and editing of displays and elements within displays; digital signage software to enable control and scheduling of displays and elements within displays; digital signage software to enable looping of displays and elements within displays; digital signage software to enable management and scheduling of groups and zones of displays, and elements within displays; digital signage software to manage and control contributions and access of users to displays and elements within displays; digital signage software to enable management of displays and elements within displays; but not including vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 35: Retail services (including online retail) connected to the sale of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; retail services (including online retail) connected to the sale of hardware, software, apparatus and instruments for transcoding and encoding, Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture; retail services (including online retail) connected to the sale of computers, computer hardware, computer peripherals, data processing apparatus and instruments, computer software, computer programs, telecommunications apparatus and instruments, downloadable electronic publications, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage means, monitors, computer processors, disc drives, cards and memory add-ons, memory boards, memory chips, video capture cards, encoding cards, video cameras, video editing workstations, video decks, video converters, Internet streaming

hardware, software, apparatus and instruments; but not including retail services connected to the sale of vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 37: Installation, repair and maintenance services; installation, repair and maintenance services relating to computer hardware, firmware, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; installation, repair and maintenance services relating to hardware, apparatus and instruments for transcoding and encoding, Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture; installation, repair and maintenance services relating to hardware, software, apparatus and instruments for high definition audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; installation, repair and maintenance services relating to computers, computer hardware, computer peripherals, data processing apparatus and instruments, telecommunications apparatus and instruments, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage means, monitors, computer processors, disc drives, cards and memory add-ons, memory boards, memory chips, video capture cards, encoding cards, video cameras, video editing workstations, video decks, video converters, Internet streaming hardware, software, apparatus and instruments; information, advisory and consultancy services relating to all the aforesaid services; but not including installation, repair and maintenance services or information, advisory and consultancy services relating to vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component,

car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 38: Access to digital and multimedia content; provision of access to digital and multimedia content, including databases of digital and multimedia content via the Internet, communications and computer networks; transmission of digital and multimedia content via the Internet, communications and computer networks; provision of telecommunications access to digital and multimedia content; providing access to content sharing portals; provision of access to cloud-based content sharing services; provision of access to a repository of digital and multimedia recordings; provision of online forums and communities; transmission of user-generated content via the Internet, communications and computer networks; transmission of multimedia and digital content via the Internet, communications and computer networks; transmission of videos, movies, pictures, images, text, photos, games, audio content, user-generated content, data and information via the Internet, communications and computer networks; information, advisory and consultancy services relating to all the aforesaid services; but not including telecommunications services or information, advisory and consultancy services relating to vehicle audio components, namely AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customized vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 40: Custom manufacture, commissioning and assembling for others; custom manufacture, commissioning and assembling for others of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; custom manufacture, commissioning and assembling for others of hardware, software, apparatus and instruments for transcoding and encoding, Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture; custom manufacture, commissioning and assembling for

others of hardware, software, apparatus and instruments for high definition audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; custom manufacture, commissioning and assembling for others of computers, computer hardware, computer peripherals, data processing apparatus and instruments, computer software, computer programs, telecommunications apparatus and instruments, downloadable electronic publications, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage means, monitors, computer processors, disc drives, cards and memory add-ons, memory boards, memory chips, video capture cards, encoding cards, video cameras, video editing workstations, video decks, video converters, Internet streaming hardware, software, apparatus and instruments; information, advisory and consultancy services relating to all the aforesaid services; but not including custom manufacture, commissioning and assembling for others or information, advisory and consultancy services relating to vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 41: Education and training in the field of audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; provision of educational information; provision of educational data and recordings; provision of educational information, data and recordings by electronic and online means; information services for the supply of electronic, digital and multimedia data, information and recordings (including archive data, information and recordings); information, advisory and consultancy services relating to all the aforesaid services; but not including education and training services or information, advisory and consultancy services relating to vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and

speakers, video and television monitors and DVD machines being customised vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 42: IT services, technical support, assistance and consultancy relating to computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; integration and configuration of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; design and development of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; installation, maintenance and repair services relating to computer software for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; cross platform conversion of digital content; hosting of digital content on the Internet, communications and computer networks; provision of temporary use of non-downloadable software to enable content access; provision of temporary use of non-downloadable software to enable the sharing of multimedia content; design and development of software for processing and distribution of digital and multimedia content; design and development of software for conversion, compression and decompression of digital and multimedia content; cloud computing services; technical support, assistance and consultancy relating to cloud computing services; providing temporary use of non-downloadable software for accessing and using a cloud computing network; provision of search engines; provision of software from a hosted platform; information, advisory and consultancy services relating to all the aforesaid services; but not including technical support assistance or information, advisory and consultancy services relating to vehicle audio components, namely AM/FM stereo receivers, cassette tape decks, compact

disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customized vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

The mark was published for opposition purposes on 28 August 2015.

3. Registration of both marks is opposed by PlanetStream Limited (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on its UK registration (no. 2394526) for a series of four marks (**PLANETSTREAM**, **PLANETSTREAM**, **PlanetStream** and **PLANET STREAM**) (unless it is necessary to distinguish between them, I will refer to the marks in the singular) as the basis for its opposition. This registration was filed on 17 June 2005 and subsequently registered on 19 May 2006 in respect of:

Class 38: Streaming of material via the Internet or otherwise through telecommunications means; broadcasting and telecommunications services; provision, operation and/or hosting of communications facilities; provision of access time to communications facilities and resources; hire and leasing of telecommunications devices and equipment; providing user access to communications facilities, resources, portals and gateways; consultancy, information and advice services relating to the aforesaid.

Class 42: Programming and design services; design, construction, programming, provision, installation, operation and/or hosting of Internet websites and web pages; setup, installation, test, repair, refurbishment, diagnostic, and maintenance services relating to computer and communications software, programs and databases, and to Internet websites and web pages; rental, leasing, hire and licensing of and providing access online to computer and communications software, programs and databases; provision of access and/or access time to computer networks, and of facilities for such access; multimedia, animation, graphic, audio-visual, video, and programming design and development services; consultancy, information and

advice services relating to the aforesaid; professional management, advisory and consultancy services relating to websites.

4. The opponent contends that its mark is highly similar to the applicant's marks and that the applied for goods/services are identical or similar to its services, such that there exists a likelihood of confusion. I note that the earlier mark pre-dates the applied for marks and, consequently, constitutes an earlier mark in accordance with section 6 of the Act. The earlier mark was registered more than five years before the publication of the applied for marks, so meaning that it must meet the use conditions set out in section 6A of the Act in order for it to be relied upon. To this extent, the opponent made a statement of use claiming that use had been made in respect of all the services for which it is registered.

5. The applicant filed counterstatements denying the grounds of opposition. It put the opponent to proof of use. The cases were then consolidated.

6. Both sides filed evidence. Neither side requested a hearing. The opponent filed written submissions in lieu of a hearing, the applicant did not. Both sides have been professionally represented during the proceedings, the applicant by jtTM Consultancy Limited, the opponent by Forresters IP LLP.

Evidence

Opponent's evidence

7. This comes from Mr Anthony Burt, the opponent's secretary and director. I note the following from his evidence:

- The domain name planetstream.net was registered in 2003 in the name of Netsecrets Limited¹. The website under this domain was launched in 2004. Exhibit ARB2 contains an archive print from 2004. The witness admits that the

¹ According to the official record, Netsecrets Limited assigned the earlier mark to the opponent in August 2017

earlier mark was not used “massively” at this point, indeed, other than the use of the domain name in the URL, I can find no use of the earlier mark.

- The position changed in 2005 with PlanetStream being used more prominently, for example, at the top of an archived webpage dated 26 April 2006 (a copy of which is provided at exhibit ARB3). The services offered on the website include streaming services for customers wishing to stream content on their own websites (or via a link on the customers’ website). Other services such as “production services”, “encoding services” and “DRM” are mentioned as clickable links.
- The witness lists the specification covered by the earlier mark as representing the services for which the mark has been consistently and continuously used since 2005. He adds that, “more specifically”, the services are for: “on demand video and audio streaming, live video streaming, internet TV and radio, video hosting and distribution and encoding services.”
- Use is said to be primarily in the UK and to sectors such as business, schools, marketing agencies, sports teams and scientific institutions. Most use is made via the website.
- Exhibits ARB4 and 5 are further web-prints, as follows:
 - A print from 10 November 2010 depicting a logo version of the words PlanetStream, plus plain word use, with the page referring to a range of streaming services as mentioned above. Similar pages from 11 January 2011, 18 August 2011, 16 June 2012, 26 October 2012 and 21 September 2012 are provided.
 - A print from 6 November 2013 where the words PlanetStream are used within a logo, again promoting its various streaming services. Similar prints (although the layout varies) are provided dated 26 June 2014, 11 July 2014, 26 March 2015 and 27 June 2015.

- Various other prints about the specific services are provided (live streaming, secure streaming etc.) where PlanetStream is used at least in logo form, with some of the prints using simply the words PlanetStream within its text. The dates range between September 2010 and June 2015.
- The witness explains that because PlanetStream is one of a number of brands owned by the opponent, some of which are provided in combination, it is difficult to provide an exact break down of turnover figures. However, between 2010 and 2015, turnover has fluctuated from £88k at its lowest to £118k at its highest. Promotional spend has fluctuated, in the same period it was between £6k and £11k; much of this seems to be spent on Google AdWord marketing, as shown in material provided in Exhibit AB6.

The applicant's evidence

8. This comes from Ms Wendy Robinson, a director of the applicant. Much of her evidence consists of a critique of the opponent's evidence, including that: the print at ARB2 does not show the earlier mark; the earliest date of use would have been 26 April 2005; the turnover estimates are not objective proof, and that most companies would be able to provide properly broken down figures; no figures are broken down geographically; the AdWord campaigns relate to terms such as "streaming" and "live events". Recent accounts (provided in Exhibit WR4) for the opponent show a negative balance; their first accounts dated 20 March were blank as if the company was dormant; the services on the website are for hosting, streaming and encoding, which does not match the extent of the registered specifications.

9. Ms Robinson also states that the applicant used its mark prior to that of the opponent. Pre-trading use is referred to, but the first sale was to Stockton Sixth Form Collage on 17 August 2004 (Exhibit WR3).

The opponent's reply evidence

10. This comes, again, from Mr Burt. He explains that the PlanetStream mark has been used by both the current and previous proprietor (he is/was a director of both) to “describe a general purpose and comprehensive range of streaming media services”. He further explains that it provides its customers with storage for video and audio and the ability to play this back to the outside world on a range of digital devices, and that it provides facilities for broadcasting video and audio live. The core of the business is said to be streaming. Broadcasting and telecommunications are provided in the field of media streaming but it does not provide free-to air broadcasting or general telecoms services.

11. Mr Burt states, in relation to the class 42 services, that “we maintain a full development service to continually improve our streaming services. We are highly experienced web designers and builders and develop and maintain our own websites. It is accepted that it does not design or produce multimedia content. Various exhibits are then referred to and provided, as follows:

- ARB7 – A number of service orders dated between 2009 and 2013 where PlanetStream is used at least in logo form, with some of the prints using the plain words PlanetStream within its text in relation to *inter alia* streaming, data storage and transfer.
- ARB8 – Google Analytics data showing unique visitors and page views – the former peaked at 50k unique visitors in 2012.
- ARB9 – Further website data showing that around 75% of the visitors are from the UK.
- ARB10 – Evidence showing the opponent purchasing its raw “material” streaming services from a US company.

- ARB11 – End of year accounts (2011, 2012, 2013, 2014 and 2015) for Netsecrets. Again, this is not broken down by reference to the earlier mark, but the witness states it would never have been less than £50k.
- ARB12 – Evidence of amounts spent on Google Ad campaigns from 2012.

Relevance of the applicant's prior use

12. In its evidence, the applicant made a point of highlighting what it says is its own earlier use, compared to that of the opponent. It does not, though, say, what legal impact this has on matters. I can see no legal impact on the matters at hand. Firstly, if the applicant wished to enforce any earlier right then it ought to have sought to cancel the opponent's earlier mark. It has not done so. This was explained in Tribunal Practice Notice 4/2009 and also by the Appointed Person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09.

13. Whilst I accept that earlier (or at least parallel) trade could potentially assist the tribunal in understanding whether two marks are likely to be confused or not (the presence or absence of confusion being the indicator), in the case before me, the degree to which the competing marks have been the subject of parallel trade is insufficient for me to form a view on anything. Put simply, I can see no reason why the applicant's prior use is of any assistance to it in these proceedings. Consequently, I say no more about it.

The proof of use provisions

Legislation and leading case-law

14. The ground of opposition under section 5(2)(b) is dependent on the earlier mark meeting the use conditions set out in section 6A of the Act, which read:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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 [.....]

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5)

15. Section 100 is also relevant, which reads:

“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.”

16. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case-law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in 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 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial

extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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].

(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].

(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].

(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].”

The relevant period

17. The relevant period for the assessment is the five year period ending on the date of publication of the applicant's marks. Consequently, the relevant period in both cases is: 29 August 2010 to 28 August 2015.

The form of use of the mark(s)

18. Whilst the evidence put forward in support of the earlier mark(s) includes use as part of a logo, I am satisfied that the PlanetStream component stands out as an element of the logo and clearly signifies trade origin in its own right. Thus, it constitutes use of PlanetStream per se. This is consistent with the answer the CJEU gave in *Colloseum Holding AG v Levi Strauss & Co* where the question posed to it was answered thus:

“The condition of genuine use of a trade mark, within the meaning of Article 15(1) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, may be satisfied where a registered trade mark, which has become distinctive as a result of the use of another composite mark of which it constitutes one of the elements, is used only through that other composite mark, or where it is used only in conjunction with another mark, and the combination of those two marks is, furthermore, itself registered as a trade mark.”

19. In any event, there is ample use of the plain words **PlanetStream** throughout the evidence in many of the web-prints that have been provided. For this reason, and whilst recognising that the earlier registration is for a series of four, it is the **PlanetStream** mark that I will take forward. Given that the other marks are part of the same series, which, given that they have been accepted as a series and consequently do not differ in their material particulars², nothing turns on this.

² As is required by section 41(2) of the Act

Genuine use or not?

20. Whilst the applicant has criticised some of the opponent's evidence (such as its turnover figures, for which the opponent provided only estimates not accurate breakdowns), it strikes me that the evidence as a whole paints a clear picture of use via the planetstream.co.uk website. There are archive web-prints which show use on the Internet during the relevant period, there are statistics showing web-traffic, including unique visitors, there is evidence showing that the majority of traffic comes from the UK, all of which is supported by various sales orders. While the scale of use is not overly significant, it is clear from the case-law that commercial success is not a pre-requisite. Taken as a whole, the evidence is easily sufficient to demonstrate real commercial use warranted in the economic sector concerned for creating/maintaining a market share.

Fair specification

21. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. 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.”

22. 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.

“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."

23. The opponent's submissions do not specifically address this point, although I note that its witness made a claim to continuous use in relation to all of the services for which the mark is registered, a specification which reads:

Class 38: Streaming of material via the Internet or otherwise through telecommunications means; broadcasting and telecommunications services; provision, operation and/or hosting of communications facilities; provision of access time to communications facilities and resources; hire and leasing of telecommunications devices and equipment; providing user access to communications facilities, resources, portals and gateways; consultancy, information and advice services relating to the aforesaid.

Class 42: Programming and design services; design, construction, programming, provision, installation, operation and/or hosting of Internet websites and web pages; setup, installation, test, repair, refurbishment, diagnostic, and maintenance services relating to computer and communications software, programs and databases, and to Internet websites and web pages; rental, leasing, hire and licensing of and providing access online to computer and communications software, programs and databases; provision of access and/or access time to computer networks, and of facilities for such access; multimedia, animation, graphic, audio-visual, video, and programming design and development services; consultancy, information and advice services relating to the aforesaid; professional management, advisory and consultancy services relating to websites.

24. Despite what the witness states, it is, in my view, clear that some of the services should not form part of a fair specification. For example, in relation to broadcasting and telecommunications services (in class 38), the opponent's witness states that these are provided only in the field of streaming; as streaming is a recognisable service, covered elsewhere by the specification, the broader terms within which it may fall ought not to form part of the fair specification. Further, there is no evidence at all in relation to hire and leasing of telecommunications devices and equipment (class 38) and, further again, I note that the opponent's witness also stated: "we maintain a full development service to continually improve our streaming services. We are highly

experienced web designers and builders and develop and maintain our own websites”; developing your own services and building/developing/maintaining a businesses’ own website does not mean that you are providing such services. This is, essentially, an internal process. Such activity is not for the purpose of creating/maintaining a market share in the relevant market and thus, the terms: programming and design services; design, construction, programming, provision, installation, operation ...of Internet websites and web pages, should not form part of the fair specification. The opponent also accepted that is does not design or produce multimedia content, which means the following terms in class 42 should not form part of a fair specification:

Multimedia, animation, graphic, audio-visual, video, and programming design and development services;

25. In terms of the registered services, that leaves:

Class 38: Streaming of material via the Internet or otherwise through telecommunications means; provision, operation and/or hosting of communications facilities; provision of access time to communications facilities and resources; providing user access to communications facilities, resources, portals and gateways; consultancy, information and advice services relating to the aforesaid.

Class 42: ..hosting of Internet websites and web pages; setup, installation, test, repair, refurbishment, diagnostic, and maintenance services relating to computer and communications software, programs and databases, and to Internet websites and web pages; rental, leasing, hire and licensing of and providing access online to computer and communications software, programs and databases; provision of access and/or access time to computer networks, and of facilities for such access; consultancy, information and advice services relating to the aforesaid; professional management, advisory and consultancy services relating to websites.

26. Having carefully considered the evidence, the whole thrust of the use centres around facilitating the streaming of media content. The customer provides the content,

with the opponent then providing the facilities to allow the customer to stream to the outside world, via, one assumes, the customer's own website. The media content is also hosted or stored by the opponent as part of this facilitation. I see nothing in the evidence that goes materially beyond this. In terms of the remaining services in class 38, a fair specification to reflect such use, which falls within the remaining terms, would be:

Streaming of material via the Internet or otherwise through telecommunications means; consultancy, information and advice services relating to the aforesaid.

27. The broader references to facilitating/accessing communication is much broader than the use shown and should not be included.

28. In relation to class 42, a fair specification to reflect the use made, which falls within the remaining terms, would be:

Hosting of web pages; consultancy, information and advice services relating to the aforesaid.

29. I have not included the hosting of websites because it is not clear if a customer's website is hosted or just parts of it. The other (broader) terminology in the class as registered is not borne out by the evidence.

Section 5(2)(b)

30. Section 5(2)(b) of the Act states that:

"5.-(2) A trade mark shall not be registered if because – ..

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

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

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods/services

32. When making a comparison, all relevant factors relating to the goods/services should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“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.”

33. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

34. The earlier mark is to be considered only on the basis of the following services:

Class 38: Streaming of material via the Internet or otherwise through telecommunications means; consultancy, information and advice services relating to the aforesaid.

Class 42: Hosting of web pages; consultancy, information and advice services relating to the aforesaid

35. The applied for marks cover a broad range of goods and services, which do not necessarily correspond with each other. I will start with the applied for services in class 38, the specification of which is the same for each earlier mark:

Class 38

Access to digital and multimedia content; provision of access to digital and multimedia content, including databases of digital and multimedia content via the Internet, communications and computer networks; transmission of digital and multimedia content via the Internet, communications and computer networks; provision of telecommunications access to digital and multimedia content; transmission of user-generated content via the Internet, communications and computer networks; transmission of multimedia and digital content via the Internet, communications and computer networks; transmission of videos, movies, pictures, images, text, photos, games, audio content, user-generated content, data and information via the Internet, communications and computer networks; provision of access to a repository of digital and multimedia recordings

36. Whilst these services make no mention of streaming, I think it reasonably clear that the services could be provided by way of a stream or other similar technology. Services can be considered identical if one term falls within the ambit of another, or vice versa. As such, I consider the services to be identical on the inclusion principle. If they are not identical, the services are highly similar in nature, purpose, methods of use and trade channels.

Providing access to content sharing portals; provision of access to cloud-based content sharing services

37. Content sharing portals could be for media based content and its sharing could be via streaming. As such, the services are highly similar to the opponent's class 38 services. Even if the content was not shared via a stream, the other ways in which it could be facilitated are likely to be very similar anyway, so the services would still be similar to a reasonably high degree.

Provision of online forums and communities

38. Steaming is a particular form of service quite distinct to the provision of online forums and communities. The purpose and methods of use differ. They are not competitive. There is no evidence to suggest that they are complementary. There is no evidence to suggest that the trade channels are shared to any material extent. I conclude that these services are not similar to any of the services for which the earlier mark is being considered.

Information, advisory and consultancy services relating to all the aforesaid services

39. These terms rest and fall with the aforesaid services to which they relate, with the same level of similarity identified. Further, the services would also be identical/similar to the opponent's consultancy/information services.

40. In reaching all of the above findings, I have borne in mind the exclusion in the applied for specification reading:

but not including telecommunications services or information, advisory and consultancy services relating to vehicle audio components, namely AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customized vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

41. However, put simply, the exclusion has no impact on the comparison I need to make because the opponent's services do not relate to a particular field. The same applies to all the other classes which contain the limitation, which I will not refer to again.

Class 35

42. I turn now to consider the applied for services in class 35, services applied for in relation to the second mark only:

Retail services (including online retail) connected to the sale of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; retail services (including online retail) connected to the sale of hardware, software, apparatus and instruments for transcoding and encoding, Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture

43. The above services, and also those that follow, relate to retailing. Those retail services must be compared to the services of the earlier mark. Whilst its relates to a comparison between retailing and goods, the following case is of assistance when considering the comparison between retailing and services. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the relevant law; he stated:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

44. However, on the basis of the European courts' judgments in *Sanco SA v OHIM, and Assembled Investments (Proprietary) Ltd v. OHIM*, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking; ii) In making a comparison involving a mark registered for retail services and a mark proposed to be registered for goods (or vice versa), it is necessary to envisage the retail services normally associated with the applicant's goods and then to compare the applicant's goods with the retail services covered by the opponents' trade mark; iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X; iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

45. The reason I consider the above case to be of assistance is because there may also be a sufficiently pronounced relationship between retail services and associated other services such that a complementary relationship exists between them. That is what I see in the services identified above. Whilst they are not streaming services, they provide a retail outlet for goods which, in some way or another, can facilitate the streaming of media. That relationship is one whereby there is not only an important link between the retailed goods and the streaming services, but is one with a sufficiently pronounced relationship that the consumer would expect one and the same provider to offer them all. I consider there to be a medium degree of similarity.

Retail services (including online retail) connected to the sale of computers, computer hardware, computer peripherals, data processing apparatus and instruments, computer software, computer programs, telecommunications apparatus and instruments.....

46. Although these services make no mention of media etc, like the previous services, they could be used for the same type of purpose. Given this, I consider there to be a medium degree of similarity.

47. Similarly, the following retail services relate to goods that could well be provided by the provider of streaming services to facilitate a customer's media streaming requirements and, consequently, there is a medium degree of similarity also:

retail services (including online retail) connected to the sale of video capture cards, encoding cards, video cameras, video editing workstations, video decks, video converters, Internet streaming hardware, software, apparatus and instruments

48. However, in relation to the following services, the link with the retailed goods is insufficiently pronounced and I do not regard them as similar.

retail services (including online retail) connected to the sale ofdownloadable electronic publications, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage means, monitors, computer processors, disc drives, cards and memory add-ons, memory boards, memory chips

Class 41

49. The following class 41 services relate to both applications:

Education and training in the field of audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; provision of educational information; provision of educational data and recordings; provision of educational information, data and recordings by electronic and online means; information services for the supply of electronic, digital and multimedia data, information and recordings (including archive data, information and recordings); information, advisory and consultancy services relating to all the aforesaid services

50. All of the services either specifically relate to training/education in streaming or associated production, or are terms which are broad and, therefore, could cover them. The training could be offered to complement the streaming service itself. Even though the nature and methods of use differ, and the specific purpose is not the same, that aspect of complementarity, together with likely shared trade channels, leads me to conclude that there is a moderate (between low and medium) degree of similarity in relation to services which relate to streaming/distribution, and a low level in relation to everything else.

Class 9

51. Both of the applications cover class 9 goods, but, whilst they overlap, the second is for a longer list of goods, which include those of the first mark. I therefore make the analysis with reference to the second mark's class 9 goods:

Computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; hardware, software, apparatus and instruments for transcoding and encoding; Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture hardware, software, apparatus and instruments; hardware, software, apparatus and instruments for high definition audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; Internet streaming hardware, software, apparatus and instruments; video capture cards; encoding cards; video cameras; video editing workstations; video decks; video converters

52. All of the above goods have specifically identified purposes, including for the purpose of streaming, but also for the purpose of creating the media to be streamed. In relation to the former, there seems to me to be a complementary relationship on the basis that a single provider may not only provide a service to facilitate streaming, but this may extend to the goods required to facilitate the same. There could also be a competitive relationship if one could be used instead of the other. The purposes have some overall similarity and the trade channels could be the same. I consider there to

be a medium degree of similarity to these computer/electronic goods which are used to facilitate streaming. I extend this finding to the goods for “distribution” as this would include streaming or other similar methods of delivery.

53. In terms of the goods which have a different purpose such as media production, recordings etc., then, again, whilst the purposes are different, the goods could be provided as single package which allows a customer to create the content which they are planning to stream. I consider there to be a low level of similarity in relation to the other terms.

Computer hardware; computer peripherals; data processing apparatus and instruments; computer software; computer programs; telecommunications apparatus and instruments

54. All these terms could include goods for streaming purposes so are similar to a medium degree for the reasons given above.

Computers

55. A computer per se is unlikely to be sold as part of a streaming package. Even if it is, I doubt whether it would be provided under the same (or similar) badge of origin as that of the service provider; it is more likely to be a computer of a third party manufacturer. These goods are not similar to the services of the earlier mark.

Monitors, computer processors, disc drives

56. The finding made above applies here also given it is, in my view, unlikely that a streaming provider will provide such goods under its own brand. These goods are not similar to the services of the earlier mark.

Downloadable electronic publications

57. I see no obvious reason why such goods are similar to the services on which the opponent can rely. These goods are not similar to the services of the earlier mark.

Downloadable recorded content; downloadable media content

58. Although streaming and downloading are different, a competitive choice may be made between accessing media via a stream on the one hand, or, alternatively, purchasing a download of the media. I consider there to be a medium degree of similarity here.

CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks; digital, electronic, optical and magnetic data storage means; cards and memory add-ons; memory boards, memory chips;

59. These are storage devices. The nature, purpose and methods of use are different. The goods and the services do not compete. I do not regard there to be a complementary relationship in the sense described by the case-law. There is no similarity here.

Software for content delivery and management via the Internet, communications and computer networks; software and interfaces for cloud computing services; software and interfaces for cloud-based content sharing; user interfaces to deliver digital and multimedia content

60. Content delivery, whether it is via the cloud, or through other technology, would include streaming or very similar technology. Thus, these goods could be used to facilitate streaming or other forms of media content delivery/distribution. I consider there to be a medium degree of similarity for reasons already given above.

Software to enable searching of data; digital signage software, interfaces and systems; digital signage monitors, panels and digital signage-playing hardware and apparatus; digital signage software to enable the design of display layouts, templates and elements within displays; digital signage software to enable creation, management and editing of displays and elements within displays; digital signage software to enable control and scheduling of displays and elements within displays; digital signage software to enable looping of displays and elements within displays; digital signage software to enable management and scheduling of groups and zones

of displays, and elements within displays; digital signage software to manage and control contributions and access of users to displays and elements within displays; digital signage software to enable management of displays and elements within displays

61. I see no obvious reason why such goods are similar to the services on which the opponent can rely. My finding is that the goods/services are not similar.

Class 42

62. I now turn to consider the applied for services in class 42, the specification of which is the same for each mark:

IT services, technical support, assistance and consultancy relating to computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; integration and configuration of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; design and development of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; installation, maintenance and repair services relating to computer software for audio, video and digital media recording, capture and acquisition, editing, live video production, post video production, streaming (including Internet streaming), distribution and archiving; cross platform conversion of digital content; hosting of digital content on the Internet, communications and computer networks; provision of temporary use of non-downloadable software to enable content access; provision of temporary use of non-downloadable software to enable the sharing of multimedia content; design and development of software for processing and distribution of digital and multimedia content; design and development of software for conversion,

compression and decompression of digital and multimedia content; provision of software from a hosted platform

63. All of these services relate (or could relate) to either streaming and distribution of media, or the related production of media. For similar reasons given already, I consider there to be a complementary relationship between such services, and the services on which the opponent may rely. In so far as services relating to streaming are considered, there is a reasonably high degree of similarity, for services relating to production etc, there is a low degree.

Cloud computing services; technical support, assistance and consultancy relating to cloud computing services; providing temporary use of non-downloadable software for accessing and using a cloud computing network

64. I see no reason why streaming and the like could not be facilitated via cloud computing. As such, there is an overlap in purpose and trade channels at the least. I consider there to be a medium degree of similarity.

Provision of search engines

65. Whilst I see no particular similarity in such services with streaming services in class 38, I do regard there to be some form of complementarity link with hosting of webpages, and such a link is one whereby the consumer would expect both services to be offered by the same undertaking. The specific purpose and methods of use is not particularly strong. I consider the level of similarity to be low.

Information, advisory and consultancy services relating to all the aforesaid services;

66. These services rest and fall with the aforesaid services to which they relate, with the same level of similarity.

67. The final two classes I consider (37 & 40) relate to the second of the applicant's mark only. I begin with class 37.

Class 37

Installation, repair and maintenance services; installation, repair and maintenance services relating to computer hardware, firmware, apparatus and instruments for audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; installation, repair and maintenance services relating to hardware, apparatus and instruments for transcoding and encoding, Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture; installation, repair and maintenance services relating to hardware, software, apparatus and instruments for high definition audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; installation, repair and maintenance services relating to computers, computer hardware, computer peripherals, data processing apparatus and instruments, telecommunications apparatus and instruments, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage means, monitors, computer processors, disc drives, cards and memory add-ons, memory boards, memory chips, video capture cards, encoding cards, video cameras, video editing workstations, video decks, video converters, Internet streaming hardware, software, apparatus and instruments; Information, advisory and consultancy services relating to all the aforesaid services

68. These services relate (or could relate) to the installation, repair and maintenance or streaming or media production type equipment. As per my earlier findings, I consider there to be a medium degree of similarity (essentially on a complementary basis) to such services in so far as they relate to streaming or other forms of media distribution, and a low degree of similarity to everything else.

Class 40

Custom manufacture, commissioning and assembling for others; custom manufacture, commissioning and assembling for others of computer hardware, firmware, software, apparatus and instruments for audio, video and digital media recording, capture and

acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; custom manufacture, commissioning and assembling for others of hardware, software, apparatus and instruments for transcoding and encoding, Video on Demand, video delivery, IPTV, off-air Freeview recording and lecture capture; custom manufacture, commissioning and assembling for others of hardware, software, apparatus and instruments for high definition audio, video and digital media recording, capture and acquisition, live video production, post video production, streaming (including Internet streaming), distribution, editing and archiving; custom manufacture, commissioning and assembling for others of computers, computer hardware, computer peripherals, data processing apparatus and instruments, computer software, computer programs, telecommunications apparatus and instruments.....video capture cards, encoding cards, video cameras, video editing workstations, video decks, video converters, Internet streaming hardware, software, apparatus and instruments

69. The above services could be used for the bespoke creation of particular streaming equipment/programs or the associated production of the media to be streamed. This could well be offered by the same company, which creates a similar trade channel and contributes to a complementary relationship. In so far as the custom manufacture of goods for streaming/distribution, I consider there to be a medium level of similarity, but a low level for everything else.

Custom manufacture, commissioning and assembling for others of.... downloadable electronic publications, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage means, monitors, computer processors, disc drives, cards and memory add-ons, memory boards, memory chips,

70. I consider it less probable that the custom manufacture of these goods creates the same complementary relationship or trade channels. There is no similarity here.

Information, advisory and consultancy services relating to all the aforesaid services;

71. These services rest and fall with the aforesaid services to which they relate, with the same level of similarity.

Average consumer and the purchasing act

72. 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 goods or 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:

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

73. The goods and services relate to streaming, other forms of media distribution, and ancillary goods/services relating to media production (of the content). Some of the specified goods/services could be purchased by members of the general public. For example, streaming could simply be the use of a streaming service to obtain media to consume. However, the business user is also an average consumer, with streaming being used to facilitate a stream to the public. These two groups apply to a good proportion of the goods/services. For some of the services, the average consumer will likely be the business user only. For example, custom manufacture of equipment will unlikely be needed by members of the general public.

74. The goods and services are so varied that it would be disproportionate to break down the purchasing process for each of them separately. However, suffice to say that all of the goods and services will be selected with at least a medium degree of care and attention. None strike me as casual purchases. The goods and services will be perused through typical means such as brochures, websites etc. with some being made available in stores. This suggests that the visual impression of the marks take

on more importance, but whilst this may be so, I will not ignore the aural impacts of the marks completely.

Comparison of marks

75. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

Planet eStream Connect

&



v

PlanetStream

76. In terms of overall impression, PlanetStream consists of two conjoined words which, effectively, combines to create a single phrase, but given that the second word is either directly descriptive, or strongly allusive, it is the word Planet that will garner most attention.

77. Similar considerations apply to Planet eStream Connect, which, although eStream is not, as far as I am aware, a known term, it is still strongly allusive, as is the word Connect, so meaning Planet will garner more focus. In the stylised earlier mark, the device element is fairly prominent, but not more so than the verbal element.

78. Visually, the marks have similarities because they all contain the word planet and stream, in that order, but they differ due to the “e” before stream in both applied for marks, the additional word Connect in one of the applied for marks, and the addition of the device element in the other. I consider there to be a degree of similarity between medium and high.

79. Aurally, the applied for stylised mark is highly similar to the earlier mark. The respective articulations being: PLAN-ET-STREAM v PLAN-ET-E-STREAM. In terms of the other applied for mark, the addition of Connect introduces an additional syllable which reduces the aural similarity but there is, in my view, still a medium degree of aural similarity.

80. Conceptually, all of the marks make reference to a planet and streaming which creates some conceptual similarity (although not a combined concept of a planet with water as submitted by the opponent). The e and connect change this slightly, but there is still a reasonably high level of conceptual similarity.

Distinctiveness of the earlier mark

81. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *Windsurfing Chiemsee 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).”

82. From an inherent perspective, whilst the earlier mark contains a word which is descriptive/suggestive of the services (Stream), as a whole, and due to the inclusion of the word Planet, the distinctiveness of the earlier mark is of a medium degree.

83. In terms of the use of the earlier mark, whilst I have found that the earlier mark has been genuinely used in relation to certain services, I do not regard the evidence that has been filed as sufficient to establish that its distinctiveness has been enhanced.

Likelihood of confusion

84. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the

same, but puts the similarity that exists between the marks/goods and services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“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).”

85. Some of the goods/services are more similar to the services of the earlier mark than others. However, even in relation to goods/services which have only a low degree of similarity, I am of the view that there is a likelihood of confusion. All the goods and services are of the type that lend themselves to being provided by streaming service providers, be it for the streaming function itself, or for ancillary services connected with the preparation of the media to be streamed. Given the level of similarity between the marks I identified earlier, together with the medium degree of inherent distinctiveness, the average consumer is bound to assume that the goods/services are the responsibility of the same or a related undertaking. There is a likelihood of confusion in relation to all of the goods and services I found to be similar. There, is, though, no likelihood of confusion in relation to the goods/services I found not to be similar, as some similarity is a prerequisite for success.

Conclusion

86. The opposition succeeds in part. However, the applied for marks may proceed in relation to:

No. 3120247

Class 9: Computers; Monitors, computer processors, disc drives; Downloadable electronic publications; CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks; digital, electronic, optical and magnetic data storage means; cards and memory add-ons; memory boards, memory chips; Software to enable searching of data; but not including vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 38: Provision of online forums and communities; Information, advisory and consultancy services relating to all the aforesaid services; but not including telecommunications services or information, advisory and consultancy services

relating to vehicle audio components, namely AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customized vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

No. 3120245

Class 9: Computers; Monitors, computer processors, disc drives; Downloadable electronic publications; CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks; digital, electronic, optical and magnetic data storage means; cards and memory add-ons; memory boards, memory chips; Software to enable searching of data; digital signage software, interfaces and systems; digital signage monitors, panels and digital signage-playing hardware and apparatus; digital signage software to enable the design of display layouts, templates and elements within displays; digital signage software to enable creation, management and editing of displays and elements within displays; digital signage software to enable control and scheduling of displays and elements within displays; digital signage software to enable looping of displays and elements within displays; digital signage software to enable management and scheduling of groups and zones of displays, and elements within displays; digital signage software to manage and control contributions and access of users to displays and elements within displays; digital signage software to enable management of displays and elements within displays;_but not including vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players,power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 35: Retail services (including online retail) connected to the sale of downloadable electronic publications, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage

means, monitors, computer processors, disc drives, cards and memory additions, memory boards, memory chips; but not including retail services connected to the sale of vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 38: Provision of online forums and communities; Information, advisory and consultancy services relating to all the aforesaid services; but not including telecommunications services or information, advisory and consultancy services relating to vehicle audio components, namely AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customized vehicle components, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Class 40: Custom manufacture, commissioning and assembling for others of downloadable electronic publications, CDs, CD-ROMs, interactive CD-ROMs, DVDs, memory sticks, digital, electronic, optical and magnetic data storage means, monitors, computer processors, disc drives, cards and memory additions, memory boards, memory chips; information, advisory and consultancy services relating to all the aforesaid services; but not including custom manufacture, commissioning and assembling for others or information, advisory and consultancy services relating to vehicle audio components, namely, AM/FM stereo receivers, cassette tape decks, compact disc players, power amplifiers, equalizers, electronic cross overs and speakers, video and television monitors and DVD machines being customised vehicle component, car navigation computers, satellite navigational systems namely, global positioning systems (GPS); and parts thereof.

Costs

87. The opponent has won more than it has lost. I therefore consider that it is entitled to an award of costs, albeit reduced somewhat given the partial nature of its success. I award the opponent the sum of £1300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official Fee - £100 x 2

Filing statements of case and considering the counterstatements: £400

Filing and considering evidence: £400

Written submissions - £300

88. I therefore order Planet Enterprises Limited to pay PlanetStream Limited the sum of £1300. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 15th day of June 2018

Oliver Morris

For the Registrar,

the Comptroller-General