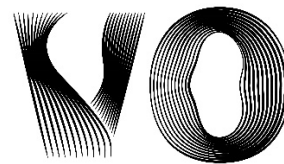
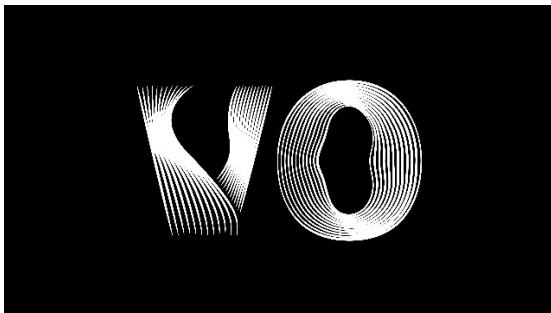
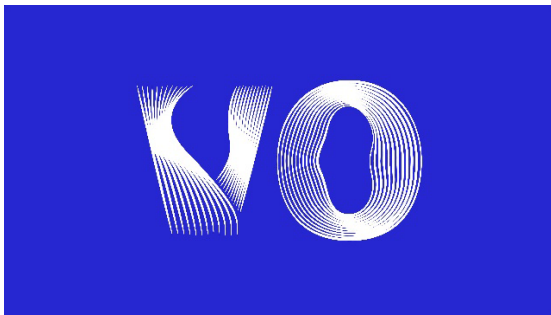


O/836/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003648212
BY THREE NINE SIX FOR DIGITAL PRODUCTION AND BROADCASTING
SERVICES LIMITED TO REGISTER:**



(SERIES OF FOUR)

AS A TRADE MARK IN CLASSES 9, 35, 38 AND 41

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427388
BY VIACCESS**

BACKGROUND AND PLEADINGS

1. On 27 May 2021, Three Nine Six For Digital Production and Broadcasting Services Limited (“the applicant”) applied to register the series of trade marks shown on the cover of this decision (“the application”) in the UK for the goods and services set out in **Annex 1** of this decision.

2. The application was published for opposition purposes on 20 August 2021 and, on 8 October 2021, it was opposed by VIACCESS (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:



International registration number: WO0000001151704

Registration date 24 October 2012: date of protection in the UK 13 June 2013.

Priority date 11 June 2012

Relying on all the goods and services set out in **Annex 2** of this decision.

(“the opponent’s mark”)

3. The opposition is aimed at the entirety of the applicant’s goods and services. The opponent submits that there is a likelihood of confusion because the mark is similar to its mark and the respective services are identical or similar. The applicant filed a defence and counterstatement denying the claims made and requested that the opponent provide proof of use of its mark.

4. The applicant is represented by Harbottle & Lewis LLP; the opponent is represented by Novagraaf UK. The opponent filed evidence in chief and the applicant elected to file written submissions during the evidence round. No hearing was requested. Only the opponent filed written submissions in lieu of a hearing. The decision is taken following a careful perusal of the papers.

5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Evidence

6. As set out above, only the opponent filed evidence in these proceedings. The opponent's evidence in chief came in the form of the witness statement of Christine Maury Panis dated 10 March 2022 and was accompanied by eight exhibits. Ms Panis is the Executive Vice President and General Counsel of Public Affairs, these are positions she has held for over 20 years.

7. While I do not intend to summarise the evidence and submissions at this stage, I have considered them in detail and will, where necessary, refer to them below.

Preliminary issue

8. In its counterstatement the applicant states:

“19. The Applicant notes that there are several stylised “VO” marks in the relevant classes on the register (some of which predate the Earlier Mark) which appear to have co-existed for a considerable period of time with the Earlier Mark”

9. For the reasons that I will now explain, the applicant's submission above regarding the presence of multiple allegedly similar trade marks on the Register has no bearing on the outcome of this opposition. The applicant does not specifically state the purpose of raising this issue, however, I am able to infer that they are stating that the opponent's mark is of a weak distinctive character due to the presence of several similar marks on the trade mark register.

10. I note that in the case of *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, 7 paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). “

11. The fact that there are a number of trade marks on the UK register that consist of the letters ‘VO’ is not a relevant factor to the distinctiveness of the opponent’s mark. In its submissions the applicant filed a list of allegedly similar marks they identified from the UK register and for the reasons set out above this would not be relevant to my assessment. Further, I note that no evidence has been provided on the use of these allegedly similar marks in the marketplace. Taking this into account, the outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the state of the register is not relevant to that assessment.

Proof of use

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

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

(a) a registered trade mark ... or international trade mark (UK) ... which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks, (aa) a comparable trade mark

(EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or 5 protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

13. Given its filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. I note that in its counterstatement, the applicant sought to put the opponent to proof of use of its mark because its mark completed its registration process more than 5 years before the date of the application in issue. Therefore, it is subject to proof of use pursuant to section 6A of the Act.

14. The relevant statutory provisions are as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes–

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

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

(5) - (5A) [Repealed]

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

15. Section 100 of the Act is also relevant, which reads:

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

16. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I- 9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

17. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the 5-year period ending with the date of the application in issue i.e. 28 May 2016 to 27 May 2021.

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

Form of the mark

19. Where the opponent has used its mark as registered, that will clearly be use on which the opponent can rely. In addition, the evidence shows that the opponent has also used its mark in the following ways:



(Example 1)



(Example 2)

20. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the Court of Justice of the European Union (CJEU) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another

mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

21. The opponent's mark is a figurative mark that is registered in greyscale. I am of the view that the use of the text "VO" in the above examples is in line with notional fair use of the mark as registered. Whilst I note that the colours that have been used in the above examples may be considered as a contrived colour split, I am not of the view that the colour has been used in a complex colour arrangement.¹ As per the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark so long as the mark at issue continues to be perceived as indicative of the origin of the goods and services at issue. In the examples shown above, I consider that the 'VO' element will be perceived independently and continue to be viewed as indicative of the origin of the goods and services at issue. As a result, and in accordance with *Colloseum*, I consider the marks shown above are examples of use of the opponent's mark as registered.

Genuine use

22. I note that in its written submissions, the applicant states that it does not consider the evidence to show use of the mark in relation to the goods and services relied upon. The applicant did not elaborate on this or give any reasons why they deem this to be the case. I note that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²

23. The opponent has provided evidence regarding its turnover. Of this, I note that the opponent states that between 2016 and 2021 the following value of products were sold in the UK: €217,688 (2016), €356,210 (2017), €343,133 (2018), €303,603 (2019), €247,571 (2020) and €29,541 (Up to May 2021) for a total of €1,497,746 during the relevant period.³ The opponent has not provided a breakdown as to what products are

¹ *J.W. Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290

² *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

³ Exhibit 1 of the witness statement of Christine Maury Panis

included in the turnover figures. Whilst I note that the opponent has clarified which figures in 2021 fell within the relevant period, the opponent has not done this in respect of the figures in 2016. Consequently, I bear in mind that some of the figures in 2016 will fall outside of the relevant period.

24. As set out above, the evidence contains a number of sample invoices. It can be identified that the invoices were for the sale of goods and services to customers in London, Southampton, Winchester, Manchester, Livingstone, Portsmouth and West Yorkshire. From the invoices, I am able to identify the sale of licences, software maintenance and smartcards. The invoices are dated within the relevant period, namely between 21 June 2016 and 20 May 2021.⁴ The witness statement of Ms Panis states that the opponent's company provides "Over the Top (OTT) media services and TV platforms, content protection, and advanced data solutions". When this information is cross referenced with the customer list for the UK it can be identified that the customers are TV and broadcasting providers such as "BBC Worldwide", "Ericsson television limited", "Inter TV Ltd" and "Sky CP Ltd".⁵ Therefore, it can be inferred that the turnover figures will be attributed to broadcasting and television goods and services relating to the sectors that the opponent operates in.

25. The opponent has provided figures regarding its annual spend on advertising for its mark. Of this, I note that the opponent states that between 2019 to 2021 the following amount was spent on advertising in the UK: €8,230 (2019), €20,150 (2020) and €3,000 (2021).⁶ The opponent has provided sample invoices to indicate how this money was spent; from the invoices, it appears that the money was spent on attendance at the Cable & Satellite Awards 2019, a video interview in 2019, technology and its installation in 2019 at a trade fair stand, membership to "iamb", for an educational webinar, an "email blast" and sponsorship or attendance at the 2020 OTT Summit. These invoices were all dated in the relevant period. In relation to the Cable & Satellite Awards in 2019 and the 2020 OTT Summit, it is unclear whether the opponent was paying for attendance to the awards or sponsoring the event.

⁴ Exhibit 2 of the witness statement of Christine Maury Panis

⁵ Exhibit 4 of the witness statement of Christine Maury Panis

⁶ Exhibit 3 of the witness statement of Christine Maury Panis

26. The opponent has also provided evidence of corporate events in the UK where the opponent's mark was used, undated screenshots from YouTube and social media posts. In relation to the corporate events, the opponent's mark is used throughout the images. Whilst the images are undated Ms Panis in her witness statement states that they are images from the TV Connect Events in 2016, 2017 and 2021. In relation to the YouTube videos, I note that the videos that were uploaded on 4 May 2016 and 7 April 2017 have 491 and 384 views respectively. However, no evidence has been provided to indicate where the audience was located geographically or when the video was accessed. In relation to the Twitter post, this is undated. In the post, an image of the opponent's mark can be seen above a post relating to the Video Tech Innovation Awards 2019. I note that the Tweet does not show how many followers the Twitter handle has, meaning that I am unable to determine the distribution of this evidence. I also note that the image does not display the number of likes and retweets. Consequently, I note that the social media evidence is of no assistance to the proprietors as marketing or advertising evidence.

27. Although I do not have any evidence or submissions from either party to assist me on the matter of the size of the UK markets of broadcasting networks, content protection or even maintenance for broadcasting for the goods and services concerned, I believe the markets to be substantial. It is my view that the markets will collectively amount to billions of pounds per annum. In my view, when compared to the size of the relevant market, the total sales figures of €1,497,746 are low. However, despite this, I note that the case law cited above states that use of a mark need not always be quantitatively significant for it to be deemed genuine.

28. As noted above genuine use requires a global assessment of the evidence as a whole. The figures in relation to sales from the opponent are far from overwhelming. Despite this, the sale of €1,497,746 of products to customers in the UK constitutes a genuine attempt to create a market for the goods and services under the opponent's mark. The opponent has demonstrated evidence in relation to marketing and advertising expenditure. Further, the evidence has demonstrated sales of the opponent's goods and services to various customers situated throughout the UK, the geographical spread of customers is quite significant across the UK. The sales are attributable to a repeated pattern of sales to customers throughout the relevant period. However, there is no information as to how these figures are broken down by goods

or services. Despite this, I consider that the sample invoices that have been provided show the sale of services and some goods by the opponent. Taking all of the above evidence into account, I am of the view that it is clear that the opponent has attempted to create and maintain a market for its goods and services under the mark. Therefore, I am satisfied that the opponent has demonstrated genuine use of its mark during the relevant period in the UK.

Fair specification

29. I must now consider whether, or the extent to which, the evidence shows use of the opponent's registration in relation to the services relied upon. 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.”

30. 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.

31. I have set out above that the turnover figures are not specifically broken down into the opponent's goods and services. Therefore, I am required to consider the evidence as a whole and compare what is shown within it to the opponent's specification. It cannot be reasonably expected for me to simply accept the turnover figures provided are for any or all of the goods and services for which the opponent's mark is registered without any evidence in support. Any use that I am able to identify will be determined by cross referencing the turnover figures with the evidence that has been provided. As mentioned above, the invoice evidence provided gives an indication of some of the goods and services sold, from the invoices I am able to identify sales in relation to licences, software maintenance and smartcards. I note that Ms Panis in her witness statement states that the opponent operates in the sectors of Over the

Top (OTT) media services and TV platforms, content protection, and advanced data solutions. This statement from Ms Panis is accompanied by a statement of truth, this alongside the applicant's statement that the UKIPO should make its own assessment of the evidence, where the applicant does not specify its challenge to the evidence, leads me to conclude that the turnover figures provided are attributable to some of the goods and services in the opponent's specification. This is further supported by the customer list at exhibit 4 which identifies UK customers are TV and broadcasting providers such as BBC worldwide. Further, I note that the evidence in the articles provided in exhibit 7 appears to show the provision of TV advertising, smart advertising platforms and anti-piracy services. However, I note that these services are not included in the opponent's specification.

32. It is my view that the bulk of the opponent's evidence is technical in nature. I note that the evidence wherein the goods and services are described, it makes mention of a number of technical terms such as 'technicolour STB's' and 'Broadcom 1721 chipset' amongst others. There is nothing in the evidence to enable me to ascertain what any of the terms mean or how they are implemented in the scope of goods and services being offered. I am of the view that, in the present case, written submissions from the opponent would have been of some assistance in helping to understand what the evidence shows. In the absence of such, I am required to assess what category the goods and services the evidence shows based on my own understanding.

33. In relation to the services for which the opponent's mark is registered, I will now go through the opponent's specification to determine a fair specification. Based on the evidence, I make the following findings in respect of fair specification:

Class 9

Television apparatus, television monitors; digital data transmitting and/or receiving apparatus; antennas, electric and data transmission cables; radio relay cables

34. In respect of all the above terms, I am of the view that the opponent has not shown use of the above goods during the relevant period. Whilst there are examples of television monitors that have been used as part of a stall at a trade fair which has

been provided by the opponent in its evidence. There is nothing to indicate that those goods were sold by the opponent, advertised by the opponent or even that the goods bore the opponent's mark. Further, I note it is included in the invoices as goods purchased to be used at trade fairs rather than goods sold by the opponent. Consequently, I am of the view that these goods were used as a tool at the fair stall. Therefore, I do not consider that there has been any use of these goods.

35. In respect of the following terms, I am of the view that the opponent has not provided evidence that it has used its registration in relation to any of these services. It cannot be reasonably expected for me to simply accept that there has been use of the following services, rather, it is for the opponent to demonstrate the specific use of the services. Therefore, I do not consider that there has been any use of the following services:

Apparatus for sending, recording, transmission or reproduction of sound or images; data processing apparatus, computers, satellites, telecommunications transmitters, telephones, display screens, audiovisual equipment, telecommunication devices; transmitting and receiving apparatus for radio and television broadcasting and for long-distance transmission; devices for encoding and decoding images and sound terminals providing access to several media; computer, data communication and telephone terminals, especially for accessing global telecommunication networks (the Internet) or private access networks (intranets); computer terminals; video servers, software for live broadcasting of images, sounds, films, videos, information, data; so-called "middleware" software for converting, transmitting and disseminating data, sounds, images; decoder boxes; electronic decoders, digital decoders, digital decoders for television; apparatus and instruments for recording, transmission, reproduction, storage, encryption, decryption, transformation and processing of sound or images; access devices and access control devices for data processing apparatus

Video on demand (VOD) streaming software

36. In respect of the above term, I am of the view that the opponent has not shown evidence of use during the relevant period. Whilst I note that the article entitled

“Viaccess-Orca joins forces with Technicolor for Android TV” in exhibit 7 makes repeated reference to a “VO Player”. I also note that there is discussion within the article which states that “VO allows for de facto support of the various Android TV apps and players, including the VO player” and that the integration of the VO player with various software provides a “fully integrated Android TV solution that is easy to deploy and that provides the highest security level for premium video content protection”. This evidence leads me to infer that the VO player is not a piece of video on demand streaming software. It appears that the various Android TV apps and players provide the streaming software and the opponent’s software does not. Rather, it appears that the opponent provides software that is used in conjunction with the streaming software which protects the security of the videos being streamed. In my view, the content of the article is very technical in nature and is unclear to me what this evidence is trying to indicate. Therefore, without any further supporting explanation or submissions from the opponent, it is not possible for me to determine whether the opponent provides these services. Taking this all into account, it is my view that the opponent has failed to demonstrate specific use of the goods.

Software, software packages

37. In respect of the above term, in the absence of any submissions or evidence to the contrary, it is my view that software packages are a collection of programs that either provide similar functions or have similar features. Whilst I recognise that in relation to video on demand streaming software, discussed above at paragraph 36, there is a discussion of VO player and DRM (digital rights management) software which provides a fully integrated Android TV solution; software used together is not the same as a software package. I do not consider that “software, software packages” has been shown in the evidence provided. However, there is evidence of DRM software being provided. I am content to conclude that when confronted with the use shown, the average consumer would categorise the goods using a narrower term. Therefore, taking this into account, I consider it appropriate to allow the opponent to proceed with “*digital rights management software*”.

Smart cards; access cards and key cards for use with decoders (smart cards)

38. In respect of these goods, I am of the view that the opponent has shown use of the above goods in the evidence provided during the relevant period. The opponent has provided invoices and commercial proposals demonstrating the sale of these goods. Therefore, the opponent has provided evidence of use of these goods. Further, I consider the above terms to be a fair specification in respect of the above goods.

Printed circuit boards, electronic circuit cards, electronic identification cards, electronic cards for image processing; apparatus for receiving and processing encoded signals (decoders)

39. In respect of the above terms, I am of the view that the opponent has not shown use of the above goods in any evidence during the relevant period. It is my view that smartcards, as referenced above at paragraph 38, are goods that are used to clearly identify and authenticate the card holder for a variety of purposes. Whilst I note that the opponent has provided evidence of smartcards, the evidence does not provide specific detail on the purpose of the smartcards i.e. whether the smartcards are used for identification, banking or even healthcare. It cannot reasonably be expected for me to simply accept that there has been use of the goods on the basis that there is evidence of use in relation to smartcards; rather, it is for the opponent to demonstrate specific use of the goods. Further, I note that even if the use was specified, it is my view that the average consumer would categorise the goods as smartcards and they would not seek to interpret it by using narrower terms. Therefore, whilst in my view the evidence is insufficiently solid in determining use of the goods, if it was correctly evidenced I would have accepted that it showed use for a broader term of “smartcards” already evidenced by the opponent.

Class 38

40. In respect of the following terms, I am of the view that the opponent has not provided evidence that it has used its registration in relation to any of these services. Whilst I note that the opponent is a provider of broadcasting services and there is some reference to broadcasting in the opponent’s witness statement, I am of the view that the opponent has not produced sufficient evidence in respect of the following services. Therefore, it is my view that the opponent has failed to demonstrate use of the following services:

Telecommunications, transmission and reception of data, signals, information processed by a computer or telecommunication apparatus and instruments; secure data transmission services communication via computer terminals, transmission of information by data transmission, transmission of information by data transmission accessible by access code or via terminals; transmission of information by satellite; transmission of data in databases; transmission of messages, encoded images and sounds; messaging and e-mail and computer services, electronic dissemination of information, especially for global communications networks (Internet) or private or restricted-access networks; data transmission services, particularly packet transmission of information and images, multimedia data transmission services; provision of access to a global computer network; provision of telecommunication connections to a global computer network, provision of access to search engines; services for connecting to the Internet or to local networks, provision of access to the Internet or to local networks, Internet address routing and filtering services; providing Internet access via portals; providing access to computer networks; rental of telecommunication apparatus and installations; videophone services; communication services by telephone, radio, radiotelephone, telegraph, as well as by all remote data processing means, via interactive videography, and particularly via computer terminals or peripherals or electronic and/or digital equipment, by videophone, video telephony; rental of access time to a database server center.

Providing access to video on demand (VOD) services

41. In respect of the above term, I am of the view that the opponent has not shown use of the above services in the evidence provided during the relevant period. As discussed above at paragraph 36, it is not my view that the opponent provides video on demand streaming software, rather, it provides software that is used in conjunction with the streaming software which protects the security of the videos being streaming. In relation to the services, the witness statement of Ms Panis states that her company permits the consumption of content and that its services permit the operators and its subscribers to benefit from protected content. Whilst I note that the opponent's customers are mainly pay TV operators and/or operators of platforms, similarly to what

was discussed in relation to video on demand software, it is my view that the services referenced in the witness statement are directed towards the security of video on demand services rather than the provision of access to video on demand services itself. Taking into account the reasoning discussed at paragraph 36, I find that the opponent has not provided evidence of the services.

Broadcasting of radio and television programs

42. In respect of the above term, which appears twice in the opponent's specification, I am of the view that the opponent has not provided evidence of use of the services during the relevant period. Whilst there is reference in the evidence to the provision of security for streaming services, there is no reference to broadcasting of radio and television programs other than in the witness statement of Ms Panis which states broadcasting services are provided. While noted, I do not consider that it would be reasonable for me to simply accept that there has been use of these services on the basis of the narrative evidence alone. This is particularly the case given the broad nature of such services. Rather, it is for the opponent to demonstrate specific use of the services. I note that the opponent's witness statement in relation to the provision of broadcasting services is unchallenged by the applicant – which is in the opponent's favour. However, I note that there is a lack of reference to the services in the supporting evidence or invoices provided by the opponent and I do not consider it appropriate to allow the opponent to monopolise such use in relation to a very broad category of services based on the witness statement that references an even wider category of services in passing and without any further elaboration. Therefore, I find that there has not been use of the services.

On-line retransmission of television broadcasts and programs

43. In respect of the above term, I am of the view that the opponent has not shown use of the above services in any evidence during the relevant period. I note that the article entitled "Content security: keeping one step ahead of the pirates" in exhibit 7 of the opponent's evidence, discusses anti-piracy services offered by the opponent which work to remove redistributed or retransmitted content. It is my understanding that this service is contrary to the provision of online retransmission services as the purpose of

the services discussed in the evidence are to prevent retransmission services. Therefore, I do not consider that there has been any use of these services.

44. In respect of the following terms, I am of the view that the opponent has not provided evidence that it has used its registration in relation to any of these services. Whilst I note that the opponent is a provider of a range of services, as referenced by Ms Panis in her witness statement, the opponent has failed to demonstrate specific use of these services. The evidence provided does not indicate the use of the following services and the nature of the evidence provided would not lead the average consumer to describe the use of the services to cover any of the following terms. Therefore, I find that there has not been any use of the following services:

Distribution (transmission) of audio and video content via terminals connected to the Internet and for the end user; providing access by computer and via communication networks, including the Internet, databases, texts, electronic documents, audiovisual information and television programs; technical consultancy in the field of telecommunications and broadcasting; technical consulting and advice in the field of telecommunications and broadcasting; downloading services for audio-video content, particularly videos on demand (VID).; dissemination of information and programs via radio, television, cable, terrestrial broadcast, satellite and the Internet; broadcasting (transmission) of television programs by means of telecommunications and computer broadband, cable networks, fiber-optic networks; providing access to a bundle of television channels by computer networks, cable networks, fiber-optic networks; distribution (transmission) of television channels via the Internet, cable networks, fiber-optic networks.

Providing secure access to pay TV channels

45. In relation to the term above, I am of the view that the opponent has not provided evidence of use of the services. In the article entitled “Viaccess-Orca joins forces with Technicolor for Android TV” in exhibit 7 it states that in combining some of the products offered by VO it provides a service where “pay-TV operators gain a fully integrated Android TV solution that is easy to deploy and that provides the highest security levels for premium video content protection”. The evidence appears to

demonstrate that the various Android TV apps and players provide the streaming software and the opponent's is used in conjunction with the streaming software which protects the security of the videos being streaming. On this point, I note the oft-quoted guidance of Mr Daniel Alexander KC who, sitting as the Appointed Person in the case of *Plymouth City Council* (cited above) noted, at paragraph 22, that the burden to prove use lies on the party required to prove it and that the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which that party is legitimately entitled to. In my view, this is relevant here in that the evidence provided by the opponent in respect to the following services is insufficiently solid to assist in determining use of the services. Consequently, I do not consider that there has been any use of the services.

Class 42

46. I will be taking the term "*sechnical assistance services for the operation and supervision of computer networks*" in the opponent's specification to mean "*technical assistance services for the operation and supervision of computer networks*". This is on the basis that there is clearly a typographical error on the specification, consequently, throughout the decision, I will view the term as outlined above.

47. In respect of the following terms, I am of the view that the opponent has not provided evidence that it has used its registration in relation to any of these services. It is my view that the opponent has failed to demonstrate use of the services. Therefore, I find that there has been no use of any of the following services:

Technical assistance services for the operation and supervision of computer networks; research in telecommunications and broadcasting, consulting and technical advice in the field of computers; design (development) of computer systems, telecommunications and broadcasting systems; maintenance and updating of a telecommunication and broadcasting network search engine; design of computer networks and telecommunications; design and development of computer systems and broadcasting systems; support services (advice) and computer engineers work, video transmission and communication and broadcasting networks; design (development) of encryption, decryption

and access control systems for television and broadcast programs, as well as all types of information transmission.

Establishment and maintenance of broadcasting networks

48. In respect of the above term, I am of the view that the opponent has shown use of the above services in the evidence provided during the relevant period. The invoices provided in exhibit 1 include the provision of maintenance services for customers. When cross referencing these invoices with the client list, which are all customers who provide television and broadcasting services such as the BBC, and the narrative evidence from the personal statement of Ms Panis, which states that the opponent operates in the sectors of Over the Top (OTT) media services and TV platforms, content protection, and advanced data solutions; it is possible to infer from the evidence that the opponent provides the services of maintaining broadcasting networks. Taking this into account, I consider it appropriate to allow the opponent to proceed with the maintenance of broadcasting networks. However, I do not consider that the establishment of broadcasting networks has been shown in the evidence provided. I determine that a fair specification for this term is “*maintenance of broadcasting networks*”.

49. Bearing the above in mind, I do not consider the use shown to be broad enough to allow the opponent to rely on its current specification. I was only able to identify some of the goods and services by cross referencing the evidence provided. Consequently, I consider a fair specification of the mark to be as follows:

Class 9: *smart cards; access cards and key cards for use with decoders (smart cards); digital rights management software.*

Class 42: *maintenance of broadcasting networks.*

Section 5(2)(b): legislation and case law

50. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

(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 or association with the earlier trade mark.”

51. The following principles are gleaned from the decisions 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 impression 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 to mind the earlier mark, 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 the goods and services

52. The applicant's specification can be found in Annex 1 to this decision. Further to what I have said about the fair specification above, the opponent's specification for its mark is the following:

Class 9: *smart cards; access cards and key cards for use with decoders (smart cards).*

Class 42: *maintenance of broadcasting networks; digital rights management software.*

53. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

54. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.”

55. *Separode* Trade Mark BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the

extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

56. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the GC stated that “complementary” means:

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

Class 9

57. I compared “*pre-recorded television programmes and films*”, “*films and programmes prepared for television*”, “*cinematographic films and photographic films*”, “*motion picture films*”, “*downloadable films*”, and “*downloadable television shows*” in the applicant’s specification to the closest clash that I was able to identify, being “*digital rights management software*” in the opponent’s specification. I was unable to find any obvious similarity between the goods. Whilst I note that the opponent’s goods may be used to protect the applicant’s goods from piracy when they are published, this is insufficient to find similarity between the goods. In my view, the goods will not overlap in users as the users of the applicant’s goods will be the general public and the users of the opponent’s goods will be publishers and/or producers of audiovisual content. The goods will also differ in purpose, nature and method of use. Further, the goods will not share the same trade channels nor will they be in competition or complementary. Therefore, I find the goods to be dissimilar.

58. Applying the same reasoning discussed above at paragraph 57, it is my view that the following goods in the applicant’s specification are dissimilar to the closest clash I could identify in the opponent’s specification, being “*digital rights management software*” in the opponent’s specification. The goods differ in users, nature, purpose, method of use and trade channels. They are also neither complementary nor in competition. Therefore, I find the following goods to be dissimilar:

Sound recordings; multi-media recordings; audio and visual recordings; podcasts; downloadable podcasts; application software for mobile telephones and mobile devices; interactive entertainment software; pre-recorded compact discs; pre-recorded DVDs; electronic publications (downloadable).

Class 35

59. I was unable to identify any obvious counterpart in the opponent's specification nor was I able to identify any obvious similarity between the services in the parties' specification. Therefore, I find the following services to be dissimilar:

Production of advertising films and commercials; production of video recordings for advertising purposes; television advertising; providing marketing consulting in the field of television and media; arranging subscriptions to media packages.

60. I am unable to identify any obvious counterpart in the opponent's specification. I do not consider that these services have any obvious overlap in users, nature, method of use, purpose or trade channels with any of the goods or services in the opponent's specification. The services are neither in competition nor complementary. Therefore, I find the services in the applicant's specification are dissimilar:

Advertising; marketing; publicity services; production of advertising matter; production of advertising material; online advertising on a computer network; production of sound recordings for publicity purposes; distribution of advertising, marketing and promotional material; development of promotional campaigns; negotiation of advertising contracts; procurement of contracts [for others].

Class 38

61. "Broadcasting services", "transmission of television programmes and films", "video-on-demand transmission", "provision of access to an internet portal featuring video-on-demand content", "video, audio and television streaming services" and "online broadcasting" in the applicant's specification are all broadcasting services that distribute audio and/or video content to a wide audience. I find these services in the applicant's specification to be similar to "maintenance of broadcasting networks" in the opponent's specification. In my view the nature, purpose and method of use of the

services differ, however, the services may coincide in users and providers. In the absence of any submissions or evidence to the contrary, it is my view that the trade channels of the parties' services will be shared, on the basis that providers of the services will also maintain the services they offer and the services may be offered by the same providers. I recognise that the services at issue are technical in nature and I have a limited understanding of how they operate; further evidence or submissions would have been beneficial to assist me. Whilst I recognise that there is a possibility that third parties may provide maintenance services in the broadcasting industry, it is also my view that the providers of both parties' services may be shared. Taking this all into account, I consider that there is a connection between the services, in the sense that one is indispensable or important for the use of the other in such a way that the consumers may think that the responsibility for these services lies with the same undertaking, therefore, it is my view that the services are complementary to a degree. It is not my view that the services are in competition. Bearing all of the above in mind, I find the services to be similar to a medium degree.

62. I compared "*webcasting*", "*podcasting*" and "*streaming of audio and video material on the internet*" in the applicant's specification to the opponent's goods and services and was unable to find any similarity between them. In relation to the opponent's "*digital management software*", whilst I note that the service providers may use the opponent's services to protect the applicant's services from piracy when they are published, this alone is insufficient to find similarity between the goods and services. Further, in relation to "*maintenance of broadcasting networks*", it is not my view that the providers of the applicant's services will provide maintenance for networks. Therefore, in my view, the goods and services will not overlap in users. The services will also differ in purpose, nature and method of use. Further, services are neither in competition nor are they complementary. Therefore, I find the services to be dissimilar.

63. I compared "*data streaming*" in the applicant's specification to "*maintenance of broadcasting networks*". In my view, it is accepted that the applicant's services are commonly provided over the internet. It is also my view that the opponent's services are very broad and no evidence or submissions to provide further clarity on the term

have been provided. Whilst there may be a very general overlap in users, in that some users of data streaming services may also need to maintain broadcast networks, this is insufficient to substantiate similarity. The services provided and the related market all concern a very specialised market and I have nothing before me to suggest any further sufficient overlap in factors or level of similarity. In the absence of such, I find the services to be dissimilar.

64. I compared “*transmission of written and digital communications*” in the applicant’s specification with the closest clash that I could identify, being “*maintenance of broadcasting networks*”. Whilst I am able to identify that there may be a very general overlap in users, it is my view that the parties’ services do not coincide in nature, method of use or trade channels. The applicant’s services belong in different markets to the opponent’s goods and services and, therefore, I find that there is no competition between the services. I also find that there is no complementarity. As a general overlap in users is insufficient to substantiate similarity, I find the services to be dissimilar.

65. I compared “*provision of access to content, websites and portals*” in the applicant’s specification with the closest clash that I could identify, being “*maintenance of broadcasting networks*”. In the absence of any evidence or submissions to the contrary, it is my view that the applicant’s services allow the users to access websites, search engines and the like. These services are not the provision of the any broadcasting service itself. Bearing this in mind, I am unable to find any obvious similarity between the services. The services will differ in users, as the users of the applicant’s services are the general public whereas the users of the opponent’s services will be providers of broadcasting networks. It is also my view that the services will differ in nature, purpose, methods of use and trade channels. The services are not in competition nor are they complementary. Therefore, I find the services to be dissimilar.

66. “*Telecommunication services*”, “*transmission of information by electronic communication networks*” and “*satellite transmission*” in the applicant’s specification are all telecommunication services that transmit and deliver data via electronic means. I find these services in the applicant’s specification to be similar to “*maintenance of broadcasting networks*” in the opponent’s specification. It is my understanding that broadcasting is a form of telecommunications service. Taking this into account, it is

my view that the purpose, nature and method of use of the services differ. This is on the basis that the applicant's services are inclusive of all telecommunication services whereas the opponent's services are for the maintenance of telecommunication services, specifically broadcasting services. However, the services are likely to have a general overlap in users, and they may also overlap in providers and trade channels. It is my view that the services are not in competition. I recognise that the services at issue are technical in nature and I consider that further evidence or submissions would have been beneficial to assist me. Whilst I recognise that there is a possibility that third parties may provide maintenance services in the industry, it is also my view that the providers of both parties' services may be shared. This is on the basis that it is my view that when an issue arises with a telecommunications service and maintenance is required the consumer is likely to contact the telecommunications provider or, alternatively, there may be a package offered by the provider at the outset of a contract between the customer and provider to maintain the telecommunications services. Consequently, I consider that there is a connection between the services, in the sense that one is indispensable or important for the use of the other in such a way that the consumers may think that the responsibility for these services lies with the same undertaking, therefore, , I find the services to be complementary to a degree. Taking all of this into account, I find the services to be similar to a medium degree.

67. Applying the reasoning above, I find "*provision of access to a global computer network*" in the applicant's specification concerns the provision of the internet which is another telecommunications service. I compared the services to "*maintenance of broadcasting networks*" in the opponent's specification. While the services differ in nature, purpose and methods of use, I find the services share general users and may overlap in trade channels and providers. It is also my view that the services share a degree of complementarity. Therefore, I find the services to be similar to a medium degree.

Class 41

68. I compared "*entertainment services*", "*entertainment services provided by online streams*" and "*television, radio, and cinema entertainment services*" in the

applicant's specification to the closest clash that I could identify in the opponent's specification, being "*maintenance of broadcasting networks*" in class 42. I am unable to identify any obvious similarity between the services. Therefore, I find the services to be dissimilar.

69. I compared "*television, film, audio and radio production and distribution*" in the applicant's specification to the closest clash that I could identify in the opponent's specification, being "*maintenance of broadcasting networks*" in class 42. In the absence of any evidence or submissions to the contrary, it is my view that the applicant's services create or make television, film, audio and radio creations available for viewing by an audience. I recognise that the end products of film, audio etc may be made available to an audience via the broadcasting networks that the opponent maintains. I also note that there may be an overlap in users, as producers of the applicant's goods may have broadcast networks that may require maintenance, however, that is where, in my view, I find that the connection between the services ends. In my view, the services differ in nature, purpose, trade channels and method of use. Further, I find that the services are neither in competition nor are they complementary. Despite the similarity in users, it is my view that this is insufficient to substantiate similarity between the services. Therefore, I find the services to be dissimilar. Further, I note that "*audio and video editing services*" in the applicant's specification may edit some of the end products, such as film and television programmes, that may be accessed by the broadcasting networks that the opponent's services maintain. However, applying the same reasoning as above, I find the services to be dissimilar to the opponent's services.

70. I compared "*film studio services*" and "*television studio services*" in the applicant's services to the closest clash that I could identify in the opponent's specification, being "*maintenance of broadcasting networks*" in class 42. I note that the applicant's services pertain to services that will be used for the creation of films and television programmes, this is an end product that may be accessed via the broadcasting networks that are maintained by the opponent's services. Despite this, it is my view that the services will differ in users, purpose, nature, trade channels and method of use. It is also my view that the services are not complementary nor are they in competition. Therefore, I find the services to be dissimilar.

71. *“Providing films, not downloadable, via video-on-demand transmission services”* and *“providing television programs, not downloadable, via video-on-demand transmission services”* in the applicant’s specification and *“maintenance of broadcasting networks”* in the opponent’s specification are similar. In my view the nature, purpose and method of use of the services differ, however, the services may coincide in users and providers. In the absence of any submissions or evidence to the contrary, it is my view that the providers of the applicant’s and opponent’s services will be shared, on the basis that providers of the services will also maintain the services they offer. Whilst I recognise that there is a possibility that third parties may provide maintenance services in the industry, it is my view that the providers of both parties’ services may be shared. I consider that there is a connection between the services, in the sense that one is indispensable or important for the use of the other in such a way that the consumers may think that the responsibility for these services lies with the same undertaking, therefore, I find the services to be complementary to a degree. It is not my view that the services are in competition. Bearing all of the above in mind, I find the services to be similar to a low degree.

72. I am unable to identify any obvious counterpart in the opponent’s specification for the applicant’s services below. I do not consider that these services have any obvious overlap in users, nature, method of use, purpose or trade channels. The services are neither in competition nor complementary. Therefore, I find the services in the applicant’s specification are dissimilar:

“cultural activities”, “organisation and provision of games and competitions, including provision of games and competitions via the internet”, “screenplay writing”, “electronic publications (non-downloadable)”, “providing online publications”, publishing services”, “educational services”, “television programming services” and “organisation, presentation and production and performance of shows and live performances”

73. In relation to *“information, advisory and consultancy services relating to the aforesaid services”* in the applicant’s class 35, 38 and 41 specifications, in respect of the services that I found to be similar to a medium degree, it is likely that this term also overlaps with the opponent’s goods and services. I consider that any overlap in users and trade channels between the terms assessed above will also be found in relation

to providing information, support and advisory services relating to the applicant's services. In my view, the services are not complementary or in competition. Therefore, I consider that the information, support and advisory services in relation to those services I have found to be similar to a medium degree are similar to the corresponding services to a low degree. In relation to the services that I have found to be similar to a low degree, I find that the information, support and advisory services in relation to those services will be dissimilar. Where I find the goods and services to be dissimilar, I find that the information, support and advisory services in relation to those services will also be dissimilar.

74. That leaves "*all of the aforesaid services also provided online via a database or the internet*" in the applicant's class 35, 38 and 41 specifications. The above assessments were made on the basis that the services at issue were provided online and, therefore, this assessment is not required again. As a result, I consider that any degree of similarity between services will also be found in relation to services provided via the internet. Therefore, I consider that the findings above I have made in respect of the class 35, 38 and 41 services also apply in relation to the services provided via the internet. It follows that where I have found the services to be dissimilar, the same will also apply to the services that this term covers.

75. I note that the nature of the goods and services discussed above are very technical. Whilst it was not expressly pleaded in the course of the proceedings, I have given consideration to paragraph 3.2.2 of Tribunal Practice Notice 1/2012⁷ ("the TPN") where it is open to me to propose a 'save for' provision to these goods and services or amend the terms accordingly so as to prevent them from being objectionable under section 5(2)(b) of the Act. However, I note that the practices set out in the TPN are only to be applied where it is appropriate to do so. In the present case, I am of the view that given the broad and technical nature of the goods and services at issue and the lack of any alternative proposals from the parties, it is disproportionate for me to embark upon formulating proposals to allow these terms to proceed to registration.

⁷ <https://webarchive.nationalarchives.gov.uk/ukgwa/20140714074028/http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2012/p-tpn-12012.htm>

76. As some degree of similarity between the goods and services is necessary to engage the test for the likelihood of confusion, my findings above mean that the opposition aimed against those services I have found to be dissimilar will fail.⁸ For ease of reference, the opposition fails against the following goods and services in the applicant's specification:

Class 9: *Pre-recorded compact discs; pre-recorded DVDs; electronic publications (downloadable); pre-recorded television programmes and films; films and programmes prepared for television; cinematographic films and photographic films; motion picture films; downloadable films; downloadable television shows; Sound recordings; multi-media recordings; audio and visual recordings; podcasts; downloadable podcasts; application software for mobile telephones and mobile devices; interactive entertainment software.*

Class 35: *Production of advertising films and commercials; production of video recordings for advertising purposes; television advertising; providing marketing consulting in the field of television and media; arranging subscriptions to media packages; advertising; marketing; publicity services; production of advertising matter; production of advertising material; online advertising on a computer network; production of sound recordings for publicity purposes; distribution of advertising, marketing and promotional material; development of promotional campaigns; negotiation of advertising contracts; procurement of contracts [for others]; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the internet.*

Class 38: *webcasting; podcasting; streaming of audio and video material on the internet; data streaming; transmission of written and digital communications; provision of access to content, websites and portals information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the internet.*

⁸ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Class 41: *Entertainment services; entertainment services provided by online streams; television, radio, and cinema entertainment services; television, film, audio and radio production and distribution; film studio services; television studio services; audio and video editing services; cultural activities; organisation and provision of games and competitions, including provision of games and competitions via the internet; screenplay writing; electronic publications (non-downloadable); providing online publications; publishing services; educational services; television programming services; organisation, presentation and production and performance of shows and live performances.*

The average consumer and the purchasing process

77. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

78. It is my view that the average consumer for the goods and services at issue will consist of members of the general public and business users. For example, the consumer of services such as “*video, audio and television streaming services*” is likely to be a member of the general public whereas the user of services such as “*maintenance of broadcasting networks*” is likely to be business users looking to maintain their broadcasting networks.

79. As for how the goods and services are purchased/selected, this will vary. For example, some goods and services (such as some types of telecommunication services selected by the general public) are likely to either be selected directly from the provider itself via catalogues, brochures or on the internet. In my view, the visual component is likely to dominate the purchasing/selection process of these types of services. However, I do not discount an aural component playing a part by way of word of mouth recommendations or advice from a salesperson, for example. For some services, such as telecommunication services that are sought by business users, these are likely to be selected from a specialist retailer by either visiting their premises in person or via their website. When selecting these services, the customer will do so after having viewed them in a catalogue/pamphlet or in a list on the provider's website. In my view, both methods of sale will sometimes be followed by a discussion with a salesperson either in person or over the phone. Therefore, the selection process for these types of services is going to be made up of both visual and aural considerations.

80. As for the level of attention paid during the selection process, this is also likely to vary. While the attention paid for some of the services at issue is likely going to be of a medium degree, especially when selected by members of the general public, I am of the view that it will be higher for those services sought by business users. For example, when a business user selects services relating to telecommunications, the average consumer may consider multiple factors such as, but not limited to, testimonials from former or current customers, the equipment used, the advertised speed of transmission and the expertise of the persons involved in the process. For these types of services, the level of attention paid will be high. Therefore, I am of the view that for the goods and services at issue, the level of attention paid will range from medium to high, depending on the goods/services selected.

The distinctive character of the opponent's mark

81. 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 1-2779, 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. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities. While the opponent has not pleaded enhanced distinctive character, it did file evidence of its use of the mark. I have considered the evidence provided in support of a claim of enhanced distinctiveness and do not consider that the evidence is sufficient to demonstrate such a claim in regard to the opponent’s mark in the UK.

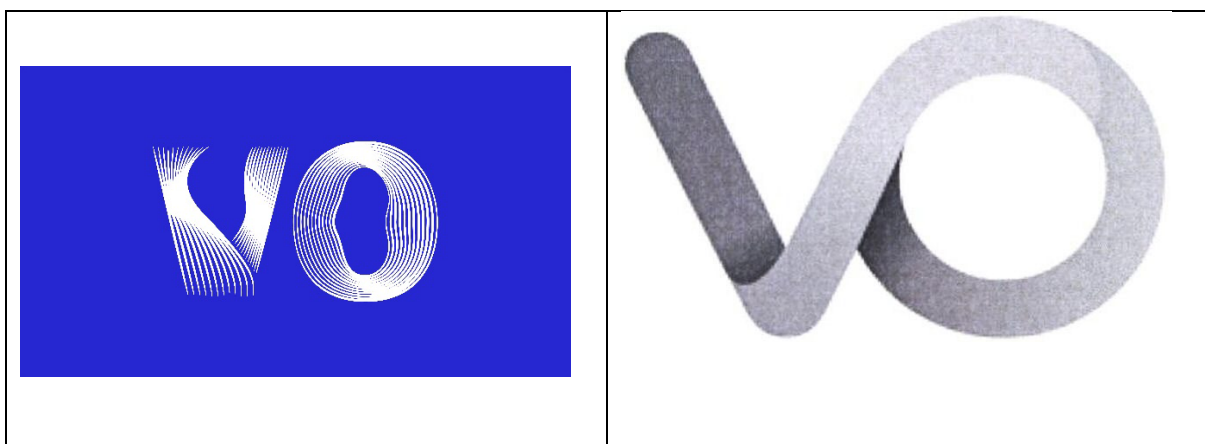
83. I note that there is no evidence of the market share of the opponent’s mark. Further, I note that the evidence of turnover that has been provided is low. I note that there is evidence of marketing and advertising expenditure to support a claim of enhanced distinctiveness, however, I consider this to be very low. While the evidence is noted, it is not sufficient enough to be capable of pointing towards there being a proportion of the relevant class of people who, a result of the use made of the mark, identify the goods as originating from the opponent. Overall, taking this all into consideration, the evidence does not point to the opponent’s mark having

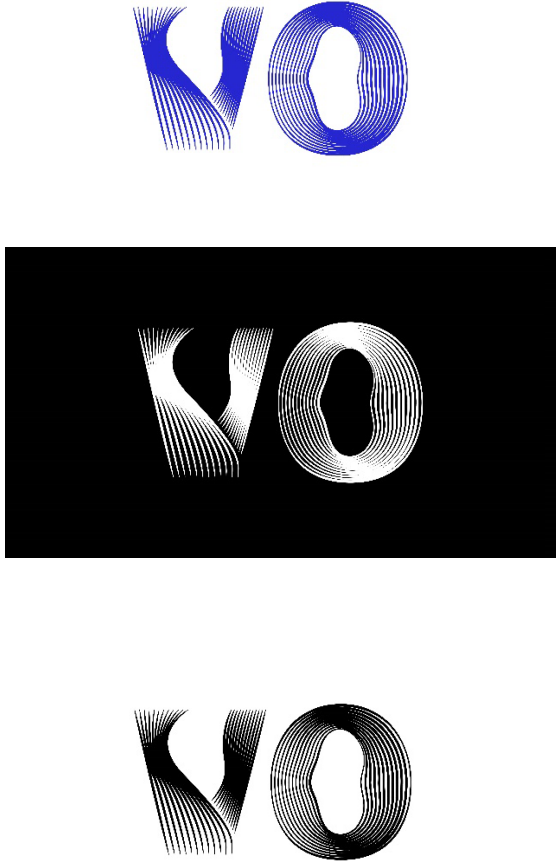
acquired any enhanced distinctiveness in the UK through use. I have, therefore, only the inherent position to consider.

84. The opponent's mark is discernible as a figurative mark of the letters 'VO' in a stylised form. Although it may take a little work from the consumer to make out the letters 'VO', it is my view that consumers will look for the recognisable elements within a mark, and as such the mark will be recognised as 'VO' in a stylised form.

85. I find that the letters 'VO' dominate the distinctive character of the opponent's mark with the stylisation and grey gradient contributing a lesser role. To my mind, the average consumer will likely perceive the letters 'VO' as an initialism that carries no meaning. For the average consumer, the mark would be neither descriptive nor allusive. I do not consider the mark to be particularly remarkable on the basis that the average consumer is used to seeing initialisms in trade marks. It is my view the stylisation of the mark contributes to its distinctiveness; I consider that it will do so to the extent that it results in an increased level of inherent distinctive character. As a result, I find that the earlier mark enjoys an above medium degree (but not high) degree of inherent distinctive character.

Comparison of the marks



 <p>(Series of four marks)</p>	
The application	The opponent's mark

86. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to all the overall impressions created by the trade 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.”

87. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

Overall comparison

88. The applicant has submitted that the marks are visually dissimilar or, in the alternative, similar to a low degree. In particular, the applicant states the following:

7. The stylisation of the Earlier Mark is vastly different to the Application. In particular, but without limitation:
 - a. The letters VO in the Earlier Mark are joined together to form a single shape, which is shaded in a gradient to give it a three-dimensional appearance. The letters in the Application are separate, two-dimensional and have no colour gradient.
 - b. The letters in the Earlier Mark form a single slimline shape. The letters in the Application form two distinct, wider shapes.
 - c. The most distinctive element of the Application is its striking and unusual asymmetric ‘wave’ design. The waves are akin to sound waves, or contour lines found on an Ordinance Survey map. The Earlier Mark has none of these features or anything resembling them.
 - d. The combination of these features gives the Earlier Mark a clean, industrial appearance; whereas the Application has a more disrupted, organic look.
8. Taking all of the above into account, the Applicant submits that the Earlier Mark is visually dissimilar to the Application or that the degree of visual similarity is low.

Whereas the opponent submits that the marks are similar to a very high degree. This is on the basis that the opponent’s mark consists of the letters ‘VO’ in a stylised format and the applicant’s mark is a series of four marks with the letters ‘VO’ in various stylisations.

89. Whilst I note that the applicant submits (as seen above) that the most distinctive element of the application is the ‘wave’ stylisation of the mark, which it states will be

viewed as either sound waves or contour lines on an ordinance map, I disagree. The application is a series of four figurative marks that consist of the letters 'VO' presented in stylised text. The letters 'VO' will dominate the overall impression of the applicant's mark with the different colours of the marks, the alternative backgrounds where relevant, and the stylisation playing lesser roles. While I find that the background has no trade mark significance, I do note that it acts as a contrast to the other elements of the mark, especially the stylised white word element.

90. As mentioned above in the applicant's submissions, the applicant submits that the opponent's mark is made up of the letters 'VO' joined together to create a single shape three dimensional shape that appears shaded in gradient. I agree that the opponents mark is made up of the letters 'VO' joined together in a stylised form. As mentioned in paragraph 84, It is my view that the opponent's mark is discernible as a figurative mark of the letters 'VO' in a stylised form. I find that the letters 'VO' play the dominant role in the overall impression of the opponent's mark with the stylisation and grey gradient contributing a lesser role.

Visual comparison

91. Whilst I note the submissions from both parties, it is my view, visually, that the text in the marks are identical in length. All of the marks share the same two letters 'V-O'. The marks differ in their stylisation. However, I note that just because the marks may share representations of the same thing, it does not automatically result in a finding of visual similarity between them.⁹ Whilst I note that the stylisation may detract from some of the visual similarities between the marks, I note the similarities mentioned above. Taking this all into consideration, I find the marks to be visually similar to a medium degree.

Aural comparison

92. It is my view that the parties' marks will be seen as the letters 'VO'. The pronunciation of 'VO' in both marks will be identical.

Conceptual comparison

⁹⁹ *The Royal Academy of Arts v Errea Sport S.P.A.* BL O-016-16

93. Conceptually, it is my view that the letters 'VO' in both marks will have no particular meaning to the average consumer. In my view, the letters will be viewed by the average consumer as an initialism but there is no indication from either party what the marks stand for. Therefore, it is my view that neither mark will create a particular concept in the mind of the consumer. I, therefore, find the marks to be conceptually neutral.

Likelihood of confusion

94. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

95. I have found that the average consumer will be a member of the general public or a business user who will purchase the goods at issue via primarily visual means, although I do not discount an aural component. However, the services may be selected via both visual and aural means. I have concluded that the level of attention paid by the average consumer will range from a medium to high degree, depending on what goods and services are being selected. I have found that the opponent's mark has an above medium (but not high) degree of inherent distinctive character. I also found that the marks are visually similar to a medium degree, aurally identical and

conceptually neutral. I have found that the goods and services at issue to have a between a low to medium degree of similarity.

96. The opponent's submissions, in this case, seem to rely on a side by side comparison of the parties' marks. Whilst it is true that in making decisions about the likelihood of confusion between competing marks, the decision maker is presented with the marks side by side, as set out above, that is not the way in which the likelihood of confusion must be assessed.

97. I have found the 'VO' element will play a greater role in both parties' marks. I have also found that the stylisation will play a lesser role in the respective marks. Whilst I note that the colours, background and stylisation elements will not be disregarded or overlooked, the differences are not stark enough to be sufficient for the consumer to remember which mark belongs to either party. Because of imperfect recollection, it is my view that when attempting to recall the marks the average consumer will inaccurately recollect the marks and not be able to remember which mark belongs to which party, instead, it is likely that the 'VO' is the element of the marks that the average consumer will recall and seek to use to identify them. This is on the basis that the average consumer will misremember which mark is stylised in the form of 'wave contours' and which mark is stylised as a conjoined gradient mark; I consider that the average consumer will not be able to say with accuracy which mark belongs to which party. Consequently, I consider there to be a likelihood of direct confusion between the marks, even for those services that I have found to be similar to a medium degree. Even where a heightened level of attention applies, the average consumer will still focus on the 'VO' element and the findings that I made above will still apply. However, for those goods and services that I have found to be similar to a low degree, I do not consider that the similarity between the marks is sufficient to offset the low similarity between the goods.

98. For completeness, I will now move to consider whether there is a likelihood of indirect confusion. In the present case, I am of the view that the average consumer, having recognised the differences in the marks, will believe that the application is a rebranding of the opponent's mark, or vice versa.¹⁰ Mr Purvis KC in the *L.A Sugar*

¹⁰ Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10

Limited case sets out that there are three main categories of indirect confusion – he stated that indirect confusion ‘tends’ to fall in one of them. In my view, even when the stylisation of the marks is noted, I consider that the presence of the identical “VO” element in the parties’ marks, which is not descriptive, allusive or suggestive of the opponent’s and applicant’s goods and services, will indicate a mark that is used by the same company and the differences in the stylisation of the marks will be indicative of a logical re-branding. For example, when noticed, I consider that the average consumer would find that “VO” in various stylised forms was a rebranding of the same mark. I make this finding having taken into account that the marks are quite stylistically different. Despite this, the stylistic differences are not so stark that the average consumer will consider that the undertakings providing the goods and services are different or economically unconnected. This, alongside the similarity of the goods and services, will lead the average consumer to think that the marks come from the same or related undertaking. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even for those services that I have found to be similar to a medium degree. Even where a heightened level of attention applies, the average consumer will still focus on the ‘VO’ element and the findings that I made above will still apply. However, for those goods and services that I have found to be similar to a low degree, I do not consider that the similarity between the marks is sufficient to offset the low similarity between the goods.

CONCLUSION

99. The opposition has succeeded for the following goods and services which will be refused:

Class 38: *Broadcasting services; transmission of television programmes and films; video-on-demand transmission; provision of access to an internet portal featuring video-on-demand content; video, audio and television streaming services; online broadcasting; telecommunication services; transmission of information by electronic communication networks; satellite transmission; provision of access to a global computer network; all of the aforesaid services also provided online via a database or the internet.*

100. The opposition has failed in relation to the following goods and services which will proceed to registration:

Class 9: *sound recordings; multi-media recordings; audio and visual recordings; podcasts; downloadable podcasts; interactive entertainment software; pre-recorded compact discs; pre-recorded DVDs; electronic publications (downloadable); pre-recorded television programmes and films; films and programmes prepared for television; cinematographic films and photographic films; motion picture films; downloadable films; downloadable television shows; application software for mobile telephones and mobile devices; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the internet.*

Class 35: *production of advertising films and commercials;; production of video recordings for advertising purposes; television advertising; providing marketing consulting in the field of television and media; arranging subscriptions to media packages; advertising; marketing; publicity services; production of advertising matter; production of advertising material; online advertising on a computer network; production of sound recordings for publicity purposes; distribution of advertising, marketing and promotional material; development of promotional campaigns; negotiation of advertising contracts; procurement of contracts [for others]; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the internet.*

Class 38: *webcasting; podcasting; streaming of audio and video material on the internet; data streaming; transmission of written and digital communications; provision of access to content, websites and portals; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the internet; information, advisory and consultancy services relating to broadcasting services, transmission of television programmes and films, video-on-demand transmission, provision of access to an internet portal featuring video-on-demand content, video, audio and television streaming services, online broadcasting, telecommunication services, transmission of information by electronic communication networks, satellite transmission, provision of access to a global computer network.*

Class 41: *entertainment services; entertainment services provided by online streams; television, radio, and cinema entertainment services; television, film, audio and radio production and distribution; film studio services; television studio services; audio and video editing services; providing films, not downloadable, via video-on-demand transmission services; providing television programs, not downloadable, via video-on-demand transmission services; cultural activities; organisation and provision of games and competitions, including provision of games and competitions via the internet; screenplay writing; electronic publications (non-downloadable); providing online publications; publishing services; educational services; television programming services; organisation, presentation and production and performance of shows and live performances; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the internet.*

COSTS

101. Both parties have achieved a measure of success. In the circumstances, the applicant has had more success overall and is entitled to an award of costs based on the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the applicant the sum of £400 as a contribution towards its costs. I have reduced the award to reflect the overall balance of success. I will award costs to the applicant as follows:

Preparing a statement and considering the opponent's statement	£200
Preparing submissions and considering the opponent's evidence	£200
Total	£400

102. I, therefore, order VIACCESS to pay Three Six Nine Digital Production and Broadcasting Services Limited the sum of £400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 28th day of September 2022

A Klass

For the Registrar

Annex 1

Class 9: *Pre-recorded television programmes and films; films and programmes prepared for television; cinematographic films and photographic films; motion picture films; downloadable films; downloadable television shows; sound recordings; multi-media recordings; audio and visual recordings; podcasts; downloadable podcasts; pre-recorded compact discs; pre-recorded DVDs; application software for mobile telephones and mobile devices; interactive entertainment software; electronic publications (downloadable).*

Class 35: *Advertising; marketing; publicity services; production of advertising matter; production of advertising material; production of advertising films and commercials; production of video recordings for advertising purposes; television advertising; online advertising on a computer network; production of sound recordings for publicity purposes; distribution of advertising, marketing and promotional material; development of promotional campaigns; providing marketing consulting in the field of television and media; arranging subscriptions to media packages; negotiation of advertising contracts; procurement of contracts [for others]; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the Internet.*

Class 38: *Broadcasting services; telecommunications services; transmission of television programmes and films; video-on-demand transmission; provision of access to an Internet portal featuring video-on-demand content; transmission of information by electronic communication networks; video, audio and television streaming services; streaming of audio and video material on the Internet; data streaming; provision of access to content, websites and portals; provision of access to a global computer network; online broadcasting; webcasting; podcasting; satellite transmission; transmission of written and digital communications; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the Internet.*

Class 41: *Entertainment services; television, radio, and cinema entertainment services; television, film, audio and radio production and distribution; providing films,*

not downloadable, via video-on-demand transmission services; providing television programs, not downloadable, via video-on-demand transmission services; film studio services; television studio services; television programming services; screenplay writing; audio and video editing services; electronic publications (non-downloadable); providing online publications; publishing services; organisation and provision of games and competitions, including provision of games and competitions via the internet; cultural activities; organisation, presentation and production and performance of shows and live performances; entertainment services provided by online streams; educational services; information, advisory and consultancy services relating to the aforesaid services, all of the aforesaid services also provided online via a database or the Internet.

Annex 2

Class 9: *Apparatus for sending, recording, transmission or reproduction of sound or images; data processing apparatus, computers, satellites, telecommunications transmitters, telephones, display screens, audiovisual equipment, telecommunication devices; transmitting and receiving apparatus for radio and television broadcasting and for long-distance transmission; television apparatus, television monitors; digital data transmitting and/or receiving apparatus; antennas, electric and data transmission cables; radio relay cables; devices for encoding and decoding images and sound; terminals providing access to several media; computer, data communication and telephone terminals, especially for accessing global telecommunication networks (the Internet) or private access networks (intranets); computer terminals; video on demand (VOD) streaming software; video servers, software for live broadcasting of images, sounds, films, videos, information, data; so-called "middleware" software for converting, transmitting and disseminating data, sounds, images; software, software packages; decoder boxes; printed circuit boards, smart cards, electronic circuit cards, electronic identification cards, electronic cards for image processing; apparatus for receiving and processing encoded signals (decoders), access cards and key cards for use with decoders (smart cards), electronic decoders, digital decoders, digital decoders for television; apparatus and instruments for recording, transmission, reproduction, storage, encryption, decryption, transformation and processing of sound or images; access devices and access control devices for data processing apparatus.*

Class 38: *Telecommunications, transmission and reception of data, signals, information processed by a computer or telecommunication apparatus and instruments; transmission of data in databases; secure data transmission services communication via computer terminals, transmission of information by data transmission, transmission of information by data transmission accessible by access code or via terminals; transmission of information by satellite; transmission of messages, encoded images and sounds; data transmission services, particularly packet transmission of information and images, multimedia data transmission services; messaging and e-mail and computer services, electronic dissemination of information, especially for global communications networks (Internet) or private or restricted-access networks; provision of access to a global computer network;*

provision of telecommunication connections to a global computer network, provision of access to search engines; services for connecting to the Internet or to local networks, provision of access to the Internet or to local networks, Internet address routing and filtering services; providing Internet access via portals; rental of telecommunication apparatus and installations; videophone services; communication services by telephone, radio, radiotelephone, telegraph, as well as by all remote data processing means, via interactive videography, and particularly via computer terminals or peripherals or electronic and/or digital equipment, by videophone, video telephony; rental of access time to a database server center; broadcasting of radio and television programs; dissemination of information and programs via radio, television, cable, terrestrial broadcast, satellite and the Internet; broadcasting of radio and television programs; broadcasting (transmission) of television programs by means of telecommunications and computer broadband, cable networks, fiber-optic networks; providing access to computer networks; providing access to a bundle of television channels by computer networks, cable networks, fiber-optic networks; providing access to video on demand (VOD) services; on-line retransmission of television broadcasts and programs; downloading services for audio-video content, particularly videos on demand (VID); distribution (transmission) of television channels via the Internet, cable networks, fiber-optic networks; distribution (transmission) of audio and video content via terminals connected to the Internet and for the end user; providing secure access to pay TV channels; providing access by computer and via communication networks, including the Internet, databases, texts, electronic documents, audiovisual information and television programs; technical consultancy in the field of telecommunications and broadcasting; technical consulting and advice in the field of telecommunications and broadcasting.

Class 42: *Sechnical assistance services for the operation and supervision of computer networks; research in telecommunications and broadcasting, consulting and technical advice in the field of computers; design (development) of computer systems, telecommunications and broadcasting systems; maintenance and updating of a telecommunication and broadcasting network search engine; design of computer networks and telecommunications; Design and development of computer systems and broadcasting systems; establishment and maintenance of broadcasting networks; support services (advice) and computer engineers work, video transmission and*

communication and broadcasting networks; design (development) of encryption, decryption and access control systems for television and broadcast programs, as well as all types of information transmission.