BL O/1151/24

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF PROCEEDINGS

FOR INTERNATIONAL REGISTRATION NO. WO0000001635000 DESIGNATING THE UK

IN THE NAME OF TÜRK HAVA YOLLARI ANONİM ORTAKLIĞI FOR THE TRADE MARK

IN CLASSES 38 AND 41

AND THE OPPOSITION THERETO UNDER NO. 434985

BY GROUPE CANAL+

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF T PARKES (O/0554/24) DATED 17 JUNE 2024.

DECISION

Introduction

1. This is an appeal by GROUPE CANAL+ ("**Appellant**") from decision O/0554/24 of Ms Teresa Parks ("**Decision**") concerning the opposition by the Appellant to TÜRK HAVA YOLLARI ANONİM ORTAKLIĞI's ("**Respondent**") International Registration for the mark shown below ("**IR/Application**"). The IR is registered with effect from 26 August 2021 but claims a priority date of 18 August 2021. With effect from 26 August 2021, the Respondent designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement.

2. The Respondent seeks protection for the following services:

> **Class 38:** *Radio and television broadcasting services; telecommunication services; providing access to the Internet; news agencies.*
>
> **Class 41:** *Education and training; arranging and conducting of conferences, congresses and seminars; sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment, sporting and cultural events, including ticket*

reservation and booking services for theatres, cinemas, museums and concerts; publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; production of movie films, radio and television programmes; news reporters services; photographic reporting services; photography; translation.

3. On 15 July 2022, the Appellant opposed the protection of the IR in the UK under section 5(2)(b) of the Trade Marks Act 1994. The Appellant relied upon trade mark number UK00909781791 shown below (the "**Earlier Mark**"), which has a filing date of 3 March 2011 and a registration date of 26 December 2012.

4. The Respondent relied upon the following services:

Class 38: *Telecommunications services; Communications by computer terminals or by optical fibres; Information about telecommunications; News and information agencies; Radio communications, communications by telegrams, by telephones or video phones, by television, by personal stereo, by personal video player, by interactive videography; Broadcasting (television -); Transmission of information by data transmission; Transmission of messages, telegrams, images, videos, mail; Transmission of information by teleprinter; Data communications; Radio and television broadcasting; Broadcasting of programmes by satellite, by cable, by computer network (in particular via the Internet), by radio networks, by radio-telephone networks and by radio link; Broadcasting of audio, audiovisual, cinematographic or multimedia programmes, text and/or still or moving images and/or sound, whether musical or not, ringtones, whether or not for interactive purposes; Electronic advertising (telecommunications); Rental of telecommunications equipment and apparatus; Rental of data transmission apparatus and instruments namely telephones, facsimile machines, apparatus for transmitting messages, modems; Rental of aerials and satellite dishes; Rental of devices (apparatus) for access to interactive audiovisual programmes; Leasing access time to telecommunications networks; Providing services to download video games, Digital data, Communications (transmission) on open (Internet) or closed (intranet) global computer networks; Online downloading of films and other audio and audiovisual programmes; Transmission of programmes and selection of television channels; Providing access to a computer network; Providing connections to telecommunications services, to Internet and database services; Routing and connecting services for telecommunications; Connection by telecommunications to a computer network; Telecommunications consultancy; Professional consultancy relating to telephony; Consultancy in the field of video programme broadcasting; Consultancy relating to the transmission of data via the Internet; Consultancy relating to providing access to the Internet; Sending and receiving video images via the Internet using a computer or mobile telephone; Telephone services;*

Cellular telephone services; Cellular telephone communication; Paging by radio; Voice messaging, call forwarding, electronic mail, electronic message transmission; Video-conferencing services; Video messaging services; Video-telephone services; Answering machines (telecommunications); Providing access to the Internet (Internet service provider); Electronic mail exchange, e-mail services, instant electronic messaging services, non-instantaneous electronic messaging services; Transmission of information via the Internet, an extranet and an intranet; Transmission of information via secured messaging systems; Providing access to electronic conferencing and discussion forums; Providing access to Internet websites containing digital music or audiovisual works of all kinds; Providing access to telecommunications infrastructures; Providing access to search engines on the Internet; Transmission of electronic publications online; Rental of decoders and encoders.

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

5. Only the Appellant filed evidence, but both sides filed written submissions. A hearing was not requested, and a decision was made on the papers. In the Decision, T. Parkes for the Registrar held that the opposition was unsuccessful.

6. On 16 July 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

7. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

    a. The Appellant being put to proof of use, a fair specification for the Earlier Mark was:

        Class 38: *Broadcasting (television -); Broadcasting of programmes by satellite, Transmission of programmes and selection of television channels; all of the aforementioned services relating to the broadcasting of documentaries.*

Class 41: *television entertainment on media of all kinds, namely television, computer, personal stereo, personal video player, personal assistant, mobile phone, computer networks, the Internet; all of the aforementioned services relating to documentaries; Production of television broadcasts, of documentaries.*

b. The average consumer of the broadcasting services in class 38 and entertainment services in class 41 will be members of the general public, who will pay a medium degree of attention to the selection of such services. The services will be selected visually, although word of mouth recommendations must be taken into account. The production services in class 41 will be purchased by entertainment outlets, who will pay a high degree of attention to the selection of the services. Visual aspects are most important to the selection process by such business consumers, although aural considerations also have to be taken into account;

c. The marks are visually and aurally similar to a low to medium degree. As for conceptual similarity, some average consumers will perceive the word PLANETE as invented, and for those consumers the marks are conceptually different. However, the subset of consumers who recognise that PLANETE means or resembles the word PLANET will regard the marks as conceptually similar to the extent that they convey the concept of a planet;

d. For average consumers who perceive PLANETE as an invented word, the Earlier Mark is inherently distinctive to a high degree. For those consumers who recognise that PLANETE means or evokes the word PLANET, the Earlier Mark is distinctive to a below average degree in the context of the services for which the mark has been used. There is no enhanced distinctiveness through use;

e. The Hearing Officer carried out the assessment of likelihood of confusion by taking the Appellant's best case, considering the *Broadcasting (television -) relating to documentaries* in the Earlier Mark's specification to be *Meric* identical to *television broadcasting services; telecommunication services* in the Application, and the Appellant's *television entertainment on media of all kinds, namely television, computer, personal stereo, personal video player, personal assistant, mobile phone, computer networks, the Internet; all of the aforementioned services relating to documentaries and production of television broadcasts, of documentaries* to be *Meric* identical to the Respondent's *entertainment* and *production of television programmes*;

f. The Hearing Officer held that there is no likelihood of direct or indirect confusion for the above identical services, for either set of average consumers, and therefore the same finding would apply for the rest of the Respondent's specification.

Grounds of Appeal

8. The Appellant's Grounds of Appeal are as follows:

<u>Grounds relating to proof of use</u>

a. **Ground 1**: The evidence submitted was sufficient to justify a specification for at least the services for which proof of use was found in Decision 0-1060-22 by June Ralph (the "**Previous Decision**"). The Hearing Officer erred in failing to take account of the Previous Decision which considered identical and highly similar evidence of use of the Earlier Mark. Alternatively, she failed to give reasons as to why she took such a different approach to the same evidence which was addressed in the Previous Decision.

b. **Ground 2**: The Hearing Officer failed to take into account the most recent and authoritative case law in respect of partial revocation, which was crucial to the framing of the fair specification.

c. **Ground 3**: Alternatively, if the Hearing Officer were correct to proceed to determine a fair specification in the way that she did, she nonetheless made findings which were inconsistent and contradictory, and erred in arriving at a specification which is insufficiently clear and precise.

Grounds relating the assessment of a likelihood of confusion

d. **Ground 4**: Given that the comparison of services was made in respect of the limited specification, it was made on a flawed basis for the reasons set out above.

e. **Ground 5**: The Hearings Officer's overall assessment of the marks and findings on distinctiveness are inconsistent, contradictory and in some instances contrary to the evidence. These multi-factorial assessments are therefore wrong and should be considered afresh by the appointed person.

f. **Ground 6**: The Hearing Officer erred in her assessment of the aural and conceptual similarities between the Contested Mark and the Earlier Mark. She should have held aurally and conceptually, the marks are identical or at least highly similar.

g. **Ground 7**: The Hearings Officer's overall assessment of the likelihood of confusion was made on a flawed basis, being found on the erroneous assessments set out above. The assessment of a likelihood of confusion is ultimately inconsistent, contradictory and in some instances contrary to the evidence. This multifactorial assessment is therefore wrong and should be considered afresh by the appointed person.

9. The Appellant's Counsel, Ms Wickenden, expanded upon the above in her skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent filed a skeleton argument and its Counsel, Mr Carter, expanded on those arguments in the hearing. I am grateful to both Counsel for their clear and detailed written and oral submissions, which I found very helpful.

Standard of review

10. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

"Appellate Function

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);

ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English*

at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"…the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

11. To the above should be added:

- The judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ said at §110 “It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable”; and

- The Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 where it stated at §49 "…on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion".

12. I shall bear all the above in mind when reviewing the Decision.

Discussion

Grounds relating to proof of use

13. Before turning to the individual grounds 1-3 under this heading, I address first the Respondent's submission that it is not necessary to deal with those grounds because i) the finding of no likelihood of confusion was expressly made even in the context of identical services, so the Appellant's position would not improve even if any of grounds 1-3 succeeded, and ii) in any event the Decision did not involve revocation of the Earlier Mark so has no impact of the registration of the Earlier Mark.

14. At first sight, that submission appears to be a good one. However, Counsel for the Appellant responded that it is necessary to address grounds 1-3, because if the fair specification is held on appeal to be wider than that found by the Hearing Officer, it will impact on the assessment of likelihood of confusion. Specifically, the Hearing Officer held at §70 that for "*For those consumers who will understand the word PLANETE/PLANÈTE as meaning PLANET or for which the word PLANETE evokes the word PLANET, the mark is distinctive to a below an average degree in the context of the services for which the mark has been used. I say this because the word PLANET is at least allusive in relation the production and broadcasting of documentaries, as documentaries are aimed at educating the audience about our natural world and our planet*". Therefore, if the fair specification is broadened on appeal beyond services relating to documentaries, the mark may have a higher degree of distinctive character in relation to those broader services, thereby increasing the likelihood of confusion.

15. I agree with the Appellant in this regard and will therefore consider grounds 1-3 in turn.

(1) Failure to take account of the Previous Decision

16. In the Previous Decision, Hearing Officer June Ralph, concluded, having reviewed the evidence that:

> "25. The evidence demonstrates that the opponent has used its mark across a number of goods and services relating largely to broadcasting in various media and production of audio-visual programmes. I find that a fair specification which reflects use made of the mark demonstrated by the evidence provided is as follows:
>
> Class 38: *Communications by television, by telephones or video phones, Broadcasting (television -); television broadcasting; Broadcasting of programmes by satellite, by cable, by computer network (in particular via the Internet); Broadcasting of audio, audiovisual, cinematographic or multimedia programmes, text and/or still or moving images and/or sound, whether musical or not; Communications (transmission) on open (Internet) or closed (intranet) global computer networks; Online downloading of films and other audio*

and audiovisual programmes; Transmission of programmes and selection of television channels; Consultancy in the field of video programme broadcasting; Sending and receiving video images via the Internet using a computer or mobile telephone; transmission of information via the Internet, an extranet and an intranet; Providing access to Internet websites containing audiovisual works of all kinds.

Class 41: *television entertainment on media of all kinds, namely television, computer, personal stereo, personal video player, personal assistant, mobile phone, computer networks, the Internet; Production of shows, films and television films, of television broadcasts, of documentaries, of debates, of video recordings and sound recordings; Production of shows, films, audiovisual, and multimedia programs; Editing and publication of text (except publicity texts), sound and video media, multimedia (interactive discs, compact discs, storage discs)*" (the "**Previous Fair Specification**").

17. The Appellant submits that this is a case of different assessments of apparently the same evidence, for the same mark, the same services, and during effectively the same period. Either the Hearing Officer failed to take into the Previous Decision, and the Appellant's reliance on it in respect of demonstrating partial use, or she failed to give reasons as to why she disregarded these and took a different view.

18. In response, the Respondent cites the rule in *Hollington v Hewthorn* [1943] KB 587, as more recently addressed by the Court of Appeal in *Rogers v Hoyle* [2014] EWCA Civ 257 at §39:

> "*the foundation on which the rule must now rest is that findings of fact made by another decision maker are not to be admitted in a subsequent trial because the decision at that trial is to be made by the judge appointed to hear it ("the trial judge"), and not another. The trial judge must decide the case for himself on the evidence that he receives, and in the light of the submissions on that evidence made to him. To admit evidence of the findings of fact of another person, however distinguished, and however thorough and competent his examination of the issues may have been, risks the decision being made, at least in part, on evidence other than that which the trial judge has heard and in reliance on the opinion of someone who is neither the relevant decision maker nor an expert in any relevant discipline, of which decision making is not one. The opinion of someone who is not the trial judge is, therefore, as a matter of law, irrelevant and not one to which he ought to have regard.*"

19. I agree with the Respondent. The Hearing Officer was not required to, and indeed was not entitled to, take into account the Previous Decision. Nor was she required to explain why, following her own analysis of the evidence, she arrived at a fair specification which differed from the Previous Fair Specification. She accordingly made no error of principle in analysing the evidence for herself and arriving at her own fair specification.

20. I therefore dismiss this first ground of appeal.

(2) Failure to take into account the most recent and authoritative case law in respect of partial revocation

21. The Appellant contends that:

> "The Hearing Officer did not take into account the recent CJEU cases of C-714/18 P *ACTC v EU/PO* EU:C:2020:573 [2020] E.T.M.R. 52; and *Ferrari SpA v DU* (C-720/18) [2021]

E.T.M.R. 9. Those cases (both of which were handed down prior to IP Completion Day and are therefore binding) make clear that:

> a. The purpose or intended use of the product or service in question is the essential criterion for defining an independent subcategory of goods or services: *ACTC* §§32, 44; *Ferrari* §40.
>
> b. On the contrary, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services: *ACTC* §32.
>
> c. That goods are aimed at different groups of people and are sold in different shops will not be relevant criteria for defining an independent subcategory of goods: *ACTC* §53. Likewise the particular market segment in which the goods are sold, such as the market for luxury goods of the particular type, is not a relevant defining feature for the purpose of identifying an independent subcategory of the relevant class of goods: *Ferrari* §§42-50.

22. Put simply, the Appellant contends that "documentaries" is a characteristic of the services, rather than a sub-category, and the Hearing Officer therefore erred in principle by limiting the services in the Earlier Mark by reference to such a characteristic.

23. The Respondent contends that, given that the Appellant did not draw the Hearing Officer's attention to either of the above authorities, it cannot be an error of principle for her to fail to consider them. However, given that this issue was fully argued both in the skeleton arguments and orally during the hearing, I shall address it in any event.

24. The distinction between characteristics and sub-categories of goods and services derives from the CJEU decision in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ("*POSTKANTOOR*") (C-363/99 [2004] E.T.M.R. 57 at §§114-115. The distinction between characteristics and sub-categories is elusive, however. The issue has been considered both by the Appointed Person (Geoffrey Hobbs QC, as he then was, in *Croom's Trade Mark Application* [2005] RPC 2) and the English High Court (Arnold J, as he then was, in *Omega Engineering Inc v Omega SA* [2013] FSR 25 at §§46-57).

25. As explained by Geoffrey Hobbs QC at §29 in *Croom*, "The mischief countered by the ruling of the [CJEU in *POSTKANTOOR*] is identified as "*legal uncertainty as to the extent of the protection afforded by the mark*" ([115])". However, the difficulty of precisely delineating between characteristics and sub-categories can be seen from the following passages in *Omega*:

> "50 In *Patak (Spices) Ltd's Community Trade Mark Application* (R746/2005-4) [2007] E.T.M.R. 3 at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation "none of the aforesaid being dart games or darts" to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN* [1997] R.P.C. 871 that is a matter of form, not substance, and so should not have been determinative.
>
> …
>
> 54 The Registry's Practice Amendment Notice 02/11 states:

"**Example:**

Mark: **Four by Four** — Vehicles; land vehicles; motor vehicles; motor cars and bicycles.

The mark is descriptive of motor vehicles incorporating a four wheel drive capability and objection would be raised in respect of motor vehicles and those terms which contain motor vehicles within their ambit.

The examination report would indicate that the mark is refused in respect of 'Vehicles; land vehicles; motor vehicles; motor cars', but is acceptable in respect of 'Bicycles'.

The broad terms 'vehicles and land vehicles' are excluded from acceptance because they can include 'motor vehicles' within their scope. However if the applicant were to suggest limiting the broad terms to e.g. 'Space vehicles, aircraft, ships, locomotives; trailers; 6 wheeled tractor units; bicycles' then the objection would be overcome.

Alternatively, an exclusion of the objectionable goods may be acceptable providing it excludes a category of goods and not merely a characteristic of those goods (as per guidance provided in *POSTKANTOOR*). 'Four wheel drive' is a property of the goods claimed and to merely exclude four wheel drive vehicles would not be acceptable. Whereas 'motor vehicles' is a category of goods which would include vehicles incorporating a 4 wheel drive capability and an acceptable exclusion would read: 'Vehicles; land vehicles; but not including motor land vehicles; bicycles'."

55 As counsel for Swiss submitted, this guidance is problematic for two reasons. The first, which is incidental to the present case, is that it overlooks the fact that a locomotive may have four wheels each of which is driven. The second, which is germane to the present case, is that it is difficult to see why it would be unacceptable to exclude "four wheel drive vehicles" from the specification. In my view four wheel drive vehicles are a recognised category of goods defined by reference to the nature or function of the goods, and not by reference to a characteristic in the *POSTKANTOOR* sense."

26. I note that the abovementioned guidance in the Registry's Practice Amendment Notice 02/11 no longer appears in the Registry's Manual of Trade Mark Practice, the relevant excerpt of which I set out in Annex 1. Some alternative examples of acceptable and unacceptable exclusions are set out in that excerpt. Further examples are given in Tribunal Practice Notice 1/2024, an excerpt from which I set out in Annex 2, which also addresses the mischief identified by Geoffrey Hobbs QC in *Croom* mentioned at §25 above.

27. The cases of *ACTC* and *Ferrari*, relied upon by the Appellant, advance matters little further. The CJEU said in *ACTC* at §31 (but citing the General Court's decision in the same case at §32):

"*As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for goods or services which can meet their specific needs, the purpose or intended use of the goods or services in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services. In contrast, the nature of the goods at*

issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, August Storck v EUIPO — Chiquita Brands (Fruitfuls), T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited)."

28. The CJEU further said in *Ferrari* at §§40-42:

> "*40. With regard to the relevant criterion or criteria to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently, the criterion of the purpose and intended use of the goods or services at issue is the essential criterion for defining an independent subcategory of goods (see, by analogy, judgment of 16 July 2020, ACTC v EUIPO (C-714/18 P) EU:C:2020:573 at [44]).*
>
> *41. It is important therefore to assess in a concrete manner - principally in relation to the goods or services for which the proprietor of a mark has furnished proof of use of his mark - whether those goods or services constitute an independent subcategory in relation to the goods and services falling within the class of goods or services concerned, so as to link the goods or services for which genuine use of the mark has been proved to the category of goods or services covered by the registration of that trade mark (judgment of 16 July 2020, ACTC v EUIPO (C-714/18 P) EU:C:2020:573 at [46]).*
>
> *42. It follows from the considerations set out in [37]-[41] of this judgment that the concept of "particular market segment", referred to by the referring court, is not, as such, relevant to the assessment of whether the goods or services in respect of which the proprietor of a trade mark has used it fall within an independent subcategory of the category of goods or services in respect of which that mark was registered.*"

29. However, neither authority provides any further guidance as to how to distinguish between "purpose and intended use of the goods or services" on the one hand, and "the nature of the goods at issue and their characteristics" or "particular market segment" on the other.

30. Overall, I respectfully agree with the following summary of the law as provided by the editors of Kerly at 7-031:

> "*Restriction of the specification by reference to the exclusion of goods or services which have a "specific characteristic" is not permissible. The precise scope of this principle is difficult to define and has led to apparently conflicting and inconsistent decisions as to whether exclusions are of categories (allowable) or characteristics (not allowable) of goods or services*".

31. Given that greater minds than mine (not least Sir Richard Arnold and Geoffrey Hobbs KC) have been unable to reconcile the various authorities, I shall not attempt to propose a definitive test for distinguishing between characteristics and sub-categories. Rather, I shall limit myself to the following review of the Hearing Officer's choice of fair specification:

- Does it meet the requirement that it "*fairly reflects the use of the mark as it would be described by the average consumer*" (Birss J, as he then was, in *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) at §53, citing with approval Arnold J, as he then was, in *Stichting BDO v BDO Unibank* [2013] EWHC 418 (Ch) at §55)? This requirement was cited by the Hearing Officer at §30 of the Decision.

- Does it fall, by analogy, into the acceptable or unacceptable sections of the abovementioned Manual of Trade Mark Practice and Tribunal Practice Notice 1/2024?

32. Looking at the first issue above, I have no doubt that a restriction to documentaries corresponds to how it would be described by the average consumer. I agree in that respect with the Respondent's submission that:

> "Documentaries are, plainly, a well-established sub-category of film media. For example, they have their own category at the Oscars (and many other awards ceremonies); there are many dedicated documentary film festivals; there are many dedicated documentary TV channels (e.g. BBC Earth, Sky Crime, and the Opponent's own PLANETE+ (albeit it is not available in the UK)); and there are dedicated documentary production companies. Consumers are entirely accustomed to referring to documentaries as an objective sub-category of film media".

33. With regard to the second issue, it is tolerably clear to me that limiting services by reference to "documentaries" falls within the Registry's acceptable category. I consider that limiting services to documentaries is analogous to limiting goods to "historical printed matter" or "soft toys" (both of which would be acceptable), rather than "Bags, all displaying images of cartoon characters" or "Clothing, all of the aforesaid being merchandise", both of which would be unacceptable. Furthermore, in relation to the mischief countered by *POSTKANTOOR*, whereas there may be "edge cases", such as so-called docudramas, in the vast majority of instances it will be straightforward to determine whether a service does or does not relate to documentaries.

34. I therefore consider that the Hearing Officer's fair specification is in accordance with the law, and dismiss this second ground of appeal.

(3) The Hearing Officer made findings which were inconsistent and contradictory, and erred in arriving at a specification which is insufficiently clear and precise

35. The Appellant relies on two sub-grounds under this head:

a. Firstly, in light of *ACTC*, "documentaries" is not permissible subcategory as it goes to a characteristic of the services, and not the intended nature and purpose. As such there was an error of law.

b. Secondly, the fair specification is insufficiently clear and precise. The way that the specification was initially drafted - "*Production of shows, films and television films, of television broadcasts, of documentaries, of debates, of video recordings and sound recordings*" - means that what was initially protected was "*production of television broadcasts*" and separately "*production of documentaries*". The way that it is now drafted - Production of television broadcasts, of documentaries – does not make sense with reference to the original specification and it is ambiguous as to what is intended.

36. I have already addressed and dismissed sub-ground (a). As for (b), I agree with the Appellant that there appears to be an error in the Hearing Officer's specification "*Production of television broadcasts, of documentaries*". This could be taken to mean either "i) production of television broadcast of documentaries or (ii) production of television broadcasts (at large) and, separately, production of documentaries. However, it is clear to me that this is a simple typographical error which can easily be corrected. Specifically, it is abundantly clear from e.g. §§19, 21 and 28 that the Hearing Officer's finding was that use had been shown in relation to *broadcasting of*

documentaries and *production of documentaries*, and that no use had been shown of broadcasting of anything else. The Hearing Officer started with "*Production of shows, films and television films, of television broadcasts, of documentaries, of debates, of video recordings and sound recordings*" and excised passages – in doing so, she appeared to make a mistake, and in my view it is clear she meant "*Production of documentaries*". Should it be necessary for me to revisit her assessment of likelihood of confusion, that is the specification I shall use.

37. Subject to the above, I dismiss this third ground of appeal.

Grounds relating the assessment of a likelihood of confusion

(4) Given that the comparison of services was made in respect of the limited specification, it was made on a flawed basis for the reasons set out above.

38. This ground is contingent on any of grounds 1-3 succeeding. I shall if necessary use the corrected specification set out in paragraph 36 above, but unless any of the subsequent grounds succeed it is not necessary for me to reconsider the Hearing Officer's analysis of the likelihood of confusion.

(5) The Hearings Officer's overall assessment of the marks and findings on distinctiveness are inconsistent, contradictory and in some instances contrary to the evidence

39. The Appellant relies on five sub-grounds, as follows:

a. When considering the distinctiveness of the Earlier Mark at §§67-71, the Hearing Officer did not make any conclusion on the mark as a whole, making findings only on the verbal element "PLANETE". Whilst at §59, the Hearing Officer found that the word element "PLANETE" was the most distinctive element, she did not find the other elements were negligible. Indeed, she found that the + contributed to the overall impression, and that the combination of the rectangular background and two semicircles had some distinctiveness.

b. Further in paragraph 83 it reads: "*the word PLANET in the application is allusive in relation to inflight television broadcasting, as it clearly alludes to the television services being available whilst travelling around the world, i.e. our planet*". This was not considered in §58, or §§67-71 when considering distinctiveness.

c. Paragraph 58 also states: "*the words TURKISH AIRLINES are not descriptive of the services in question, which are not related to air transportation and so are distinctive*". This is inconsistent with the later paragraph [83] where the Hearing Officer considered "*if the average consumer were to understand the words TURKISH AIRLINES in the application as indicating that the television services are provided inflight, the same average consumer would still perceive the words TURKISH AIRLINES as a sign denoting the origin of the services, i.e. the name of an airline company providing the flights*".

d. Paragraph 58 states "*The rectangular background is banal and has little or no distinctiveness*" in relation to the mark applied for. However, that mark has a lozenge/oval background. It is the Earlier Registration that has the rectangular background with the text;

e. Paragraph 70: the finding that "PLANET" is of a below level of distinctiveness was justified by the statement "*the word PLANET is at least allusive in relation to the production and broadcasting of documentaries, as documentaries are aimed at educating the audience*

about our natural world and our planet." This is a finding that no reasonable tribunal could make as not all documentaries are about the natural world and the planet. This is not something that needed evidence, but in any event there was evidence - by way of quick example - CHP3 listed documentaries on Edgar Hoover, WW2 and cooking.

40. Dealing with each sub-ground in turn, I do not agree that the Hearing Officer failed to consider distinctiveness of the Earlier Mark as a whole. Indeed, it is clear she did. At §59, under the heading "Overall impression", she said:

> "*The opponent's mark consists of the word PLANETE presented in white and bold standard letters, and placed within a grey rectangular background next to a plus sign. The evidence indicates that the word PLANÈTE is a French word meaning PLANET and that it spelt in French with an accent on the first letter E; consequently, those consumers who recognise PLANÈTE as a word of French origin might also notice that the accent on the letter E in the mark is a flat line that has been nearly absorbed by the letter itself, though it is hardly noticeable. Behind this element is a circular device that is partially superimposed by the grey rectangular background, so only the half top and half bottom of the circle can be seen. In my view, the rectangular background and the two semicircles have little distinctiveness on their own, being two banal shapes; the way these shapes are combined adds to their distinctiveness; however, they remain less distinctive than the word PLANETE which is the more distinctive element of the mark. The plus sign is defined by the Collins English dictionary as indicating addition or positive quantity, so it has a laudatory connotation, and although it contributes to the overall impression, it does so to a lesser extent than the word PLANETE.*"

41. Furthermore, at §§60-66, when considering similarity, she looked at the Earlier Mark as a whole. It is true that at §§67-71, when considering distinctive character of the Earlier Mark, she focused on the word element, but that is because issues of descriptiveness/allusiveness most clearly relate to the word PLANETE (where recognised as a foreign word for 'planet'), rather than to the figurative aspects of the Earlier Mark.

42. Sub-ground (b) is effectively a submission that the Hearing Officer failed to repeat herself sufficiently. I do not agree that she needed to repeat, elsewhere in the Decision, her finding that the word PLANET in the application is allusive in relation to inflight television broadcasting.

43. With regard to sub-ground (c), I consider that the Appellant is taking the Hearing Officer's comments at §83 out of context. At §§81-83 she said:

> "*81. I now turn to the scenario whereby the average consumer will be aware of the French origin of the word PLANÈTE or guess that PLANETE is a foreign word meaning PLANET.*
>
> *82. At its highest point, the opponent's case is that the average consumer will confuse the element PLANETE and PLANET and consider the term TURKISH AIRLINES as descriptive of the services, and providing an indication as to where the user would be able to use the class 38 and 41 services, i.e. television when a user travel on a Turkish airline, with the similar impressions created by the figurative elements of the marks reinforcing the perception of a common trade origin.*
>
> *83. Even if I were to accept that the average consumer is inclined to believe that traders might use their mark in multiple languages, the difficulty with the opponent's argument is that even if the average consumer were to understand the words TURKISH AIRLINES in*

the application as indicating that the television services are provided inflight, the same average consumer would still perceive the words TURKISH AIRLINES as a sign denoting the origin of the services, i.e. the name of an airline company providing the flights, similarly to the company names British Airways or Air France."

44. It is clear, therefore, that whilst she held at §58 that the words TURKISH AIRLINES are not descriptive of the services in question, her comments at §83 were addressing the Appellant's contention to the contrary, and finding no likelihood of confusion even on the Appellant's best case. There is accordingly no inconsistency between §58 and §83.

45. As for sub-ground (d), the Hearing Officer's description (at §58) of the Application as having a rectangular background must be read in conjunction with §62, where she said:

"*In addition, the words PLANET and PLANETE are incorporated in grey rectangular backgrounds and each mark contain a red circle. However, the layout of the rectangular backgrounds and the red circles are different and are combined in a different way. The rectangular background in the applicant's mark has rounded borders, whereas the rectangular background in the applicant's mark has corners*."

46. It is clear therefore that she was considering the Application, and not the Earlier Mark, at §58.

47. Finally, in sub-ground (e) the Appellant challenges the Hearing Officer's finding that the word PLANET is allusive of documentaries. I consider there is something in this point. Whereas many documentaries may concern the natural world and planet earth, many do not, and I accept that the evidence submitted below included documentaries such as "Despot Housewives" and "Ewan McGregor: Mission Royal Air Force", for which the word PLANET could not in any way be said to be allusive. The Hearing Officer went too far in saying that the word PLANET is allusive of the services – she should have held that it may be allusive. As such, for the subset of average consumers who will understand the word PLANETE/PLANÈTE as meaning PLANET or for which the word PLANETE evokes the word PLANET, the Earlier Mark is distinctive to an average degree in the context of the services for which the mark has been used.

48. Accordingly, other than in relation to sub-ground (e), I dismiss this fifth ground of appeal.

(6) The Hearing Officer erred in her assessment of the aural and conceptual similarities between the Contested Mark and the Earlier Mark. She should have held aurally and conceptually, the marks are identical or at least highly similar

49. At §§63-64 the Hearing Officer said:

"*63. Aurally the applicant's mark will be pronounced as PLANET TURKISH AIRLINES. This pronunciation will be obvious to the average consumer. However, the average consumer is likely to pronounce the word PLANETE in the opponent's mark with a degree of hesitation, because although it resembles the English word PLANET it has an additional E at the end. The most likely pronunciations of PLANETE will be, in my view, as PLANEE-TE with the final E being pronounced like an E.*

64. There is therefore a clear difference between the word PLANEE-TE in the application and PLAA-NET in the earlier mark."

50. The Appellant relies on the Earlier Decision, in which the Hearing Officer said at §49:

"*Turning now to the aural comparison, I find that the opponent's mark is likely to be pronounced as PLAN-ETT PLUS as the word "plus" is commonly verbalised in place of the mathematical symbol. Although the earlier mark contains an additional letter E, I do not think it would make a difference to the pronunciation.*"

51. However, as set out at §§18-19, the Earlier Decision was not binding on the Hearing Officer, and in any case she was not invited to follow it in relation to pronunciation.

52. The Appellant further contends also that the Hearing Officer ignored the fact that both parties submitted that PLANETE would be pronounced with two syllables. The Respondent's submission on aural similarity (§16 of its submissions to the Hearing Officer) was that "The Application consists of six syllables, meanwhile the Earlier Trade Mark consists of three syllables". It is not clear, though, whether the Respondent contended that the + element would be verbalised, and accordingly the Hearing Officer may have understood the Respondent to be contending that PLANETE would be pronounced with three syllables, i.e. as PLANEE-TE. In any case, in the absence of witness evidence on the topic, pronunciation of the marks was a matter for the Hearing Officer to decide, and it cannot be said that her finding was rationally insupportable.

53. As for conceptual similarity, the Appellant contends:

- By reason of the errors on aural similarity, the Hearing Officer proceeded on a false basis in respect of conceptual similarities; and
- She also made findings relating to conceptual meaning which are inconsistent with and contrary to her findings on distinctiveness which are referred in relation to ground 5.

54. As explained above, I do not believe she erred in relation to aural similarity, and save for one point which I will consider below I have rejected ground 5.

55. I dismiss this sixth ground of appeal.

(7) The Hearings Officer's overall assessment of the likelihood of confusion was made on a flawed basis, being found on the erroneous assessments set out above. The assessment of a likelihood of confusion is ultimately inconsistent, contradictory and in some instances contrary to the evidence.

56. In relation to direct confusion, the Appellant contends that the Hearing Officer's assessment was wrong for all the reasons previously identified. Whereas I have concluded that the word PLANET is not necessarily allusive of documentaries, that error alone is insufficient to overturn her finding of no likelihood of direct confusion. Given the substantial differences between the marks, it is unlikely that consumers would directly mistake them for one another.

57. As for the Hearing Officer's analysis of likelihood of indirect confusion at §83, the Appellant relies on eight sub-grounds, as follows:

a. She did not consider imperfect recollection in relation to indirect confusion, she only considered this in relation to direct confusion at §77.

I disagree – in fact, the Hearing Officer considered direct and indirect confusion together, as is clear from the final sentence of §77: "*As I have found that there are two groups of consumers, I will explain my reasoning for finding that there is no likelihood of direct or indirect confusion in relation to both scenarios*". §§78-80 then deal with the sub-group of

average consumers who understand the word PLANETE as an invented word. §§81-83 deal with the subset who are aware of the French origin of the word PLANÈTE or guess that PLANETE is a foreign word meaning PLANET. The reference to imperfect recollection at §77 therefore relates to both types of confusion in both sub-groups.

b. She appears to also have based the assessment at §83 on the assumption that TURKISH AIRLINES has acquired distinctiveness by referencing marks like British Airways. There was no evidence to support this.

I do not agree. The Hearing Officer said at §83 that "*even if the average consumer were to understand the words TURKISH AIRLINES in the application as indicating that the television services are provided inflight, the same average consumer would still perceive the words TURKISH AIRLINES as a sign denoting the origin of the services, i.e. the name of an airline company providing the flights, similarly to the company names British Airways or Air France*". Each of the names Turkish Airlines, British Airways and Air France are directly suggestive of an airline, irrespective any acquired distinctiveness. There is no error in the Hearing Officer's conclusion.

c. The Hearing Officer did not properly consider the likelihood of association, or confusion as to a commercial link. She considered only (at §83) whether "TURKISH AIRLINES" indicated that services were provided in flight, and in doing so she made findings which were not supported by evidence. The implication of her finding was that consumers would consider that "PLANET" in combination with "TURKISH AIRLINES" indicated that "TURKISH AIRLINES" provided the services to the exclusion of any other provider. There was no evidence for this, and it is submitted that given this is inherently unlikely, evidence was required before making an assumption that an airline had actually produced the broadcasting content available on a flight. It is far more likely for an airline to partner with an experienced producer or broadcaster, or obtaining third party services for example by partnering with an established channel such as "Disney+" or "Planete+".

Following on from the excerpt from §83 cited by me above, the Hearing Officer went on to say at §83: "*In such circumstances, the word PLANET in the application is likely to be perceived as a secondary mark belonging to the same undertaking providing the airline services and used in relation to its inflight broadcasting services, rather than as an indication of co-branding with the opponent as a provider of broadcasting services under the earlier mark. I say this because (1) there is no evidence that providers of flights have converged in the market with providers of broadcasting services to offer inflight television services under both marks; and (b) the word PLANET in the application is allusive in relation to inflight television broadcasting, as it clearly alludes to the television services being available whilst travelling around the world, i.e. our planet, (c) the word PLANETE/PLANÈTE in the earlier mark understood as PLANET or evoking the English word PLANET is not particularly distinctive in the context of the services for which I found genuine use, all of which relate to television broadcasting of documentaries, meaning that the average consumer is less likely to be surprised when seeing similar marks being used by different undertakings*".

Given that there was no evidence before her that providers of flights adopted co-branding practices, she had to do her best to work out the reaction of the average consumer upon seeing the words PLANET TURKISH AIRLINES. Her finding that the average

consumer would believe PLANET is a sub-brand of the airline used in relation to its inflight broadcasting services was one that was open to her in the circumstances.

d. The consideration of the mark as indicating that it referred to services provided in flight amounted to an impermissible limitation of the services to be considered. The full range of services applied for needed to be considered.

I consider that this is a misreading of the Decision. The Appellant submitted below that "the term TURKISH AIRLINES is descriptive of the services, providing an indication as to where you would be able to use the class 38 and 41 services, i.e. television when you are on a Turkish airline". The Hearing Officer was simply addressing this contention, as indeed she was required to do.

e. The "+" should have been considered in the context of indirect confusion at §83. By its nature, it is likely to indicate an additional or extra element and is therefore more likely to lead to a likelihood of confusion compared to a highly similar mark which does not include "+".

f. The stylised elements should also have been considered at §§82-83.

As stated above, the Hearing Officer considered direct and indirect confusion together. At §80, in the context of average consumers who understand the word PLANETE as an invented word, she said "*The conceptual differences between the dominant and distinctive elements of the marks, PLANETE and PLANET, are such as to counteract to a large extent the low to medium visual and phonetic similarities I found between the marks; the high degree of distinctiveness of the earlier mark cannot assist in this case, as it only reinforces the conceptual gap between the invented word PLANETE and the dictionary word PLANET. This is sufficient to exclude any likelihood of direct or indirect confusion, especially when the other differences introduced by the plus sign, the words TURKISH AIRLINES and the figurative elements of the marks are factored into the assessment*". It is not credible for the Appellant to suggest that she failed to account for the "+" or the stylised elements when she came to consider the other sub-group of average consumers at §§82-83.

g. When considering visual similarity at §64 (the first §64 - there are two paragraphs numbered 64) the Hearing Officer incorrectly referred to the earlier mark as being pronounced "PLAA-NET", and the Contested Mark to be pronounced "PLANEE-TE". This is the wrong way round according to her previous assessment. Whilst potentially a typographical error, given sub-ground 5(d) it is questionable as to whether the Hearing Officer correctly distinguished the marks at all stages of her analysis.

I have already concluded at §45 above that sub-ground 5(d) does not reveal any error. The Hearing Officer's mixing up of the pronunciations of the words at §64 is clearly a typographical error and reveals no error of principle.

h. The Hearing Officer failed to give adequate consideration to the interdependence principle, instead focussing on narrow issues relating to the similarities of the marks. By way of example, at §§81-83 the Hearing Officer set out her analysis of indirect confusion specifically in relation to consumers understanding the pronunciation of "PLANETE" to be the same as "planet", but made no reference to whether she was considering services which had been found to be identical or merely similar.

I disagree – the Hearing Officer expressly cited the interdependency principle at §34(g), and her findings of identity of services were expressly referred to when considering likelihood of confusion at §74 and §80.

58. Although I have rejected each of the sub-grounds, I have reached a different conclusion than that of the Hearing Officer in relation to the allusiveness of the word PLANET to documentaries. I must therefore consider whether this has any impact on her assessment of likelihood of confusion. For the subset of average consumers who understand the word PLANETE in the Earlier Mark as an invented word, it can plainly make no difference, as they would not associate the words PLANET and PLANETE, irrespective of the degree of distinctive character of the word PLANETE in the Earlier Mark.

59. For the subset who are aware of the French origin of the word PLANÈTE or guess that PLANETE is a foreign word meaning PLANET, I cannot see that my conclusion as to allusiveness makes it any more likely that the average consumer would believe that the word PLANET in the Application is an indication of co-branding with the Appellant. The word PLANET, used in the Application in conjunction with TURKISH AIRLINES, would still be regarded as allusive in relation to inflight television broadcasting. The more likely reaction of the average consumer would be to assume that TURKISH AIRLINES has chosen the name PLANET for its inflight broadcasting service.

Conclusion

60. The appeal is dismissed. The Application will proceed to registration for all services applied for in classes 38 and 41.

Costs

61. Clearly, the Respondent has been the successful party. I order that the Appellant should pay the Respondent £1,200 by way of costs of this appeal, comprising:

- Preparation of skeleton argument: £600; and
- Attendance at hearing: £600.

62. The Hearing Officer's order that the Appellant shall pay the Respondent the sum of £700 still stands. The total costs award to the Respondent is accordingly £1,900, payable within 21 days of this decision.

Dr. Brian Whitehead

2 December 2024

Representation

Stephanie Wickenden of Counsel, instructed by D Young & Co for the Appellant/ Opponent

Sam Carter of Counsel, instructed by Oracle Solicitors and Consultants Limited for the Respondent/Applicant

Annex 1 – Excerpt from the TM Registry's Manual of Trade Mark Practice

Characteristics versus sub-categories

However, there is still a place for exclusions provided they are in respect of categories or sub categories of goods or services and not in respect merely of their characteristics. A characteristic is a specific quality, attribute or trait, whilst a category is a group or sub-group of the item. The term "characteristic" includes not only obvious descriptions, such as "pink" for shirts, but also covers when, where, why and how the goods or service may be supplied and their intended purpose. It would not therefore be acceptable to exclude, for the mark "Post Office", postage stamps provided they are not connected with a post office.

When considering employing exclusions, regard must be had to whether the exclusion will render the mark deceptive or whether it is likely that the applicant intends to use the mark on goods or services for which it is not descriptive (otherwise, it may be open to a bad faith objection (section 3(6)).

The following are examples of acceptable and unacceptable exclusions:

Acceptable:

Mark: **TUTANKHAMUN**

Specification: "Printed matter; but not including educational, archaeological or historical printed matter.

This is acceptable because printed matter can be sub-categorised; books on history etc would be a sub-category rather than a characteristic. An exclusion merely in relation to books about Tutankhamun would be too narrow as the applicant would then have cover for similar goods (such as books about Egyptology).

Mark: **VELVET BUNNY**

Specification: "Toys, games and playthings; but not including soft toys".

This is acceptable because soft toys can be regarded as a subcategory of toys and the mark would not be descriptive of other types of toys.

Mark: **FISH**

Specification: "Cleaning preparations; cosmetics; preparations for the hair; but not including soaps."

This overcomes the problem with novelty soaps, novelty soaps being a sub-category in this class. It would be insufficient simply to exclude soaps in the form of fish.

Unacceptable:

Mark: **ROSE**

Specification: "Cosmetics, perfumes, toiletries; but not including any such goods scented to smell like roses."

This exclusion does not overcome the descriptiveness objection because the exclusion relates simply to goods bearing the characteristic described by the mark.

This objection cannot be overcome for this type of goods.

Mark: **DAFFODIL**

Specification: “Chinaware; glassware; ornaments, statuettes and figurines; but not including any such goods in the form of or decorated with flowers”.

This would not overcome the descriptiveness objection because the mark describes a characteristic of the goods; and it is common in the trade for goods of this type to be decorated florally.

Mark: **FROG**

Specification: “Footwear; but not including footwear in the form of frogs”. This exclusion does not overcome the descriptiveness objection. The exclusion covers only a specific characteristic of the goods rather than a sub-category. The objection could be overcome by excluding “novelty footwear.”

Mark: **BROADBAND GLOBAL**

Specification: “Telecommunications; provision of telecommunications information; transmission of messages and images; broadcasting services; but not including any such services provided by or about the internet.”

The exclusion does not overcome the descriptiveness objection. “Broadband” is a characteristic of telecommunications services, usually, although not exclusively, associated with internet use. Internet services are not a sub-category of a broadband telecommunications service. The mark describes a specific characteristic of a telecommunications service, i.e. a broadband telecom service providing global access.

The descriptiveness objection cannot be overcome. Broadband services are a subcategory of telecommunications services, but it is implausible that the applicant would apply for a mark like this in respect of non-broadband services. Consequently, a proposal to exclude “broadband telecommunication services” would give rise to further objections under section 3(3) (b) - because other use would be deceptive - and Rule 8(2) because there is no real intention to use other than for broadband services.

Note that the use of exclusions to overcome objections is covered in the Trade Marks Examination Guide. Further information about exclusions can be found in Tribunal Practice Notice 1/2024.

Annex 2: Excerpt from Tribunal Practice Notice 1/2024

Restrictions should be clear and precise

8. Restrictions should be drafted with sufficient clarity and precision to enable the Registrar and third parties to identify what is and is not covered by the specification (see *IP Translator*, C-307/10 at paragraphs 49, 53 and 64).

9. In this regard, restrictions which have multiple layers can result in a lack of clarity. Parties should consider whether this can be avoided.

Example: The applicant sells game software for mobile phones. The opponent sells a range of financial software, including software for the purpose of tracking financial investments, but also general banking software. The parties are trying to reach an agreement as to how the applicant's specification can be restricted to enable the opposition to be withdrawn. However, the applicant is concerned that any restriction for financial software at large might prevent it from having an in-app purchase facility, which is essential for its gaming software. With the opponent's agreement, the applicant proposes the following restriction:

"Software; none of the aforesaid relating to financial services, including but not limited to investment services, investment advice, online trading with financial instruments, financial brokerage services; none of the aforesaid relating to electronic payments or banking, but not including software for in-app purchases as part of gaming software."

In this case, the use of a primary negative restriction excluding financial services at-large, coupled with further additional restrictions and a conditional exclusion relating to electronic payments and banking, results in an opaque specification that fails to meet the requirements for clarity and precision. A more appropriate restriction would be:

"Software; all of the aforesaid being game software for mobile phones."

10. The restriction itself should be sufficiently clear and precise (see *Gap (ITM) Inc v Gap 360 Ltd* [2019] EWHC 1161 (Ch) at paragraph 41, referring to principles set out by Sales J (as he then was) in *Total Ltd v YouView TV Ltd* [2014] EWHC 1963). For example, the following would not be acceptable because the term 'ancillary services' is ambiguous in its scope:

"…; all of the aforesaid being business and ancillary services."

Restrictions should identify sub-categories of goods/services, not a characteristic

11. A characteristic may be present or absent without changing the nature, function or purpose of the specified goods/services (see *Croom's Application* [2005] R.P.C. 2 at paragraph 30). For this reason, the following would not be acceptable:

"Bags, all displaying images of cartoon characters."

12. The way in which the applicant intends to market their goods/services is not a sub-category and will not be accepted. For this reason, the following would not be acceptable:

"Clothing, all of the aforesaid being merchandise."

13. For goods, restrictions describing the intended recipient are unlikely to be acceptable. For example, the restricted specification "Tee shirts, all of the aforesaid being for use by mountain climbers" would not be acceptable because the goods themselves will remain unchanged, irrespective

of the intended recipient. The exception to this is where the function of the product is defined by reference to its user (for example, “Diver’s masks”).

14. This can be contrasted with the position in relation to services, which can more readily be defined by their recipient i.e. where a service is targeted at a particular sector (see *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch) at paragraph 49 referring to earlier reasoning set out in *MERLIN Trade Mark* BL O/043/05 [1997] R.P.C. 871 at paragraph 29). However, care will still need to be taken to ensure that it is appropriate for the particular services to be limited by recipient.