

O-359-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2440265  
BY GUY BATTLE  
TO REGISTER IN CLASSES 35, 36 & 42 THE TRADE MARK:**



**AND**

**IN THE MATTER OF OPPOSITION 95315 BY  
AFRICAN FOREST LTD**

## TRADE MARKS ACT 1994

**In the matter of application 2440265 by Mr Guy Battle  
to register a trade mark in classes 35, 36 & 42**

**and**

**in the matter of opposition 95315 by African Forest Ltd**

### The background and the pleadings

1) On 1 December 2006 Mr Guy Battle applied to register the following trade mark for the following services:



**Class 35:** Business management, consultancy and advisory services.

**Class 36:** Financial services; carbon credit trading services.

**Class 42:** Environmental consultancy services; energy auditing; energy auditing in relation to carbon offsetting; advice, information and consultancy in relation to carbon offsetting.

2) On 2 July 2007 African Forest Ltd ("Forest") opposed the registration of Mr Battle's trade mark under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). Forest relies on a single trade mark of which it is the proprietor, namely UK registration 2433143. Forest's mark was filed on 20 September 2006 (so making it an earlier mark under the provisions of section 6 of the Act) and it completed its registration procedure on 14 December 2007. The earlier mark and the services for which it is registered are set out below:



**Class 35:** Advice and assistance to businesses on how to reduce their carbon footprint, and how to offset their remaining carbon emissions through investing in a fund to promote forestry and related agro-forestry services, done in a sustainable manner to assist in poverty reduction and preserving and enhancing bio-diversity, whilst acting as a carbon sink to help reduce global warming, and trading in voluntary carbon credits generated from this investment activity.

**Class 36:** Investment fund in forestry and related agro-forestry services, done in a sustainable manner to assist in poverty reduction and preserving bio-diversity, whilst acting as a carbon sink to help reduce global warming, trading in voluntary carbon credits generated from this investment activity.

**Class 44:** Forestry and related agro-forestry services, done in a sustainable manner to assist in poverty reduction and preserving bio-diversity, whilst acting as a carbon sink to help reduce global warming, voluntary carbon credits generated from this investment activity.

3) As the earlier mark completed its registration procedure within (as opposed to before) the five year period prior to the publication of Mr Battle's trade mark, the proof of use provisions contained in section 6A<sup>1</sup> of the Act do not apply. Therefore, Forest's earlier trade mark can be taken into account in these proceedings for its specification as registered.

4) Mr Battle filed a counterstatement denying the grounds of opposition. His defence is based, in summary, on the following:

- That PLANET POSTIVE is commonly used as a generic adjective for goods and services that have a positive effect on the planet and the environment.
- That no party can have an exclusive right in such a term which, even if the "+ve" element was discerned as the word "positive", cannot constitute the distinctive element of the mark.
- That against that context, the respective marks are visually very different in view of the distinctive logo elements of the respective marks and their general layout.
- That some of the goods are identical or similar [although Mr Battle does not identify which ones] whereas others are unrelated. Nevertheless, that all the services are aimed at businesses or knowledgeable and concerned individuals who would know of the meaning of the term PLANET POSITIVE and will select the services after careful consideration.

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<sup>1</sup> Section 6A was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004

5) Both sides filed evidence. The matter then came to be heard before me on 2 July 2010. Mr Simon Bentley of Abel & Imray represented Mr Battle. Ms Helen Thornton attended on behalf of Forest in her capacity as a company director.

### **The evidence**

#### **Forest's primary evidence – witness statement of Helen Frances Thornton dated 9 December 2008.**

6) Ms Thornton is one of Forest's company directors. Her evidence provides information about:

- a) The timing and filing of Forest's applications<sup>2</sup>, including information about the examination of its earlier mark, its initial refusal and subsequent acceptance.
- b) The "vision" for the trade mark and its planned future use.
- c) The use of the term "Planet positive" that had been made by the time of Forest's application(s).
- d) Why the application was made for "Planet +ve" rather than "Planet Positive".
- e) The multi-discipline use of the symbol "+v" for the word "positive".
- f) Forest's response to Mr Battle's counterstatement claims regarding i) the alleged generic use of the term "Planet Positive" and ii) the claim that the "+ve" symbol is only used in the field of electronics – Forest believes that the term is used in wider fields.

7) In relation to a), it is not necessary to repeat this in any more detail than I have already set out in the background to this decision. In terms of b), it is clear that the use of the mark (and its proposed future use) relates to what is described as a "branding mark" for businesses which are "really making a difference to ensure the peaceful, sustainable, and harmonious future of this planet, its people and its eco-system". Carbon-offsetting appears to be a key component of this. It is conceded that the business is only at start-up stage in the UK, but in terms of literature demonstrating use of the mark, it includes text such as:

"African Forest is establishing a voluntary carbon offset system, Planet Positive organisations who invest in AFI can brand their company as Planet Positive to show that they have offset some or all of their company's emissions..."

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<sup>2</sup> I have expressed this in the plural because Forest applied for the mark at an earlier date but it was abandoned due to non-payment of the filing fee.

“Our nursery and all associated businesses adhere to strict Planet Positive code of conduct for improving the environment and climate...”

“A Planet Positive Air Freight Product”

“THAT is what the Planet Positive Brand will give you.”

8) In relation to d) – why the mark was applied for as “Planet +ve” rather than Planet Positive, Ms Thornton states that:

“Whilst reading through all the rules on trade mark registration especially the need for a trade mark to be distinctive in nature, I felt that the words “Planet positive” could possibly be construed as being not distinctive or could be interpreted as generic, so we decided instead to use the commonly used annotation +ve as a more distinctive (and therefore rendering it more likely to be trade-markable) representation of the word positive. We actually thought the words Planet Positive, whether with a distinctive logo or not would not be trade-markable, otherwise that would have formed part of our trade mark application in the first place.”

9) In relation to c), e) and f), I will come back to Ms Thornton’s evidence, along with the evidence filed on behalf of Mr Battle, when assessing the merits of the points to which the evidence relates.

*Mr Battle’s primary evidence – witness statement of Mr Guy Battle dated 10 August 2009*

10) Mr Battle is the applicant for the trade mark the subject of these proceedings. Mr Battle sets out his own personal history. I do not need to repeat it all but I note his statement that over the last 16 years he has been credited with developing an innovative approach to sustainable environmental master-planning. In 2006 Mr Battle set up a company called dcarbon8, a business specializing in carbon management and sustainable business consultancy. In 2007 he says that he was the inspiration behind the setting up of Planet Positive Limited to provide a new global standard for carbon measurement and management. He also says that a not-for-profit company was recently set up called Planet Positive Foundation Limited which aims to encourage businesses and people to take action on climate change.

11) Mr Battle provides some information about the current projects on which dcarbon8 are working. He also explains that Planet Positive (whether this is the limited company or the foundation is not clear) have developed an accreditation system to signify that an organization, product or individual has committed to taking responsibility for their carbon footprint. He sums up by stating that the “aim of the process is to ensure that the certified organisation or individual is planet

positive, that is to say that their actions provide a positive benefit to the environment”.

12) The remainder of the evidence focuses on the term PLANET POSITIVE and whether it is generic/descriptive. As with Ms Thornton’s evidence on this, I will deal with this later.

Mr Battle’s primary evidence – witness statement of Amanda Little dated 31 July 2009

13) Ms Little is a reporter on environmental and energy issues and works for Grist Magazine based in Seattle. She has written articles for a number of publications including Vanity Fair, Rolling Stone, The New York Times Magazine, Wired, Outside and New York Magazine. As her evidence also deals with the term PLANET POSITIVE, I will come back to this shortly.

Forest’s reply evidence

14) Ms Thornton filed reply evidence. Much of this is submission which I will, of course, bear in mind. Rather than summarise here the factual evidence it does contain, I will draw from it, to the extent relevant and necessary, later in this decision.

**Section 5(2)(b) of the Act**

15) This section reads:

“5.-(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 of association with the earlier trade mark.”

16) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

17) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective services are similar, other factors are relevant including:

The nature of the average consumer of the services in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

18) It is clear from the claims, counterclaims and the evidence that whilst there are a number of relevant factors to consider, two crucial aspects that need to be considered in this case are: i) whether the average consumer of the services will recognize the "+ve" symbol, in the context of Forest's mark, as denoting the word "positive" and ii) whether the phrase PLANET POSITIVE has distinctive character in the respective trade marks<sup>3</sup>. However, before coming to these questions, I must assess who the average consumer is given that matters must be judged through such a person's eyes.

### **The average consumer**

19) Both parties' services in class 35 are, by their very nature, ones provided to businesses rather than individual members of the public. Mr Battle's services in class 42 and Forest's services in class 44 also strike me as ones predominantly used by businesses. Whilst it may be possible for an individual member of the public to engage a service provider in this field, the nature of the services means that this will be the exception rather than the rule. In class 36, financial services (Mr Battle's term) are used by businesses and members of the public, they are both therefore average consumers. That being said, given that the term financial

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<sup>3</sup> Such an enquiry is, of course, only relevant to Forest's mark if the average consumer approximates PLANET +VE to PLANET POSITIVE.

services would include within its ambit financial services which involve carbon trading etc. and that this (as will be seen later) represents the primary conflict in this class, such services are, again, more likely to be business orientated.

20) Either way, and whether the average consumer is a business or a member of the public, the decision to engage a service provider in the various fields is not a casual one. It is a more considered decision than the norm (although perhaps not of the highest possible degree). In terms of how a service provider is selected, Mr Bentley referred to the possible requirement to tender, the necessity to trawl for service providers, and for meetings to take place before a decision is made. There is, though, no evidence of the typical method of service engagement. Therefore, whilst I do not say that Mr Bentley is wrong on what he says (I am sure that on occasion the process he described may be applicable), whether this is typical is not clear. That being said, having already found that the purchasing act is a considered one, I do not need to say any more than that.

21) In terms of the characteristics of the average consumer, Mr Bentley felt that the average consumer will have a better knowledge of environmental issues (so that they will know of the type of terminology used in the field) than the norm. I reject this submission. Whilst the average consumer will have a reasonable degree of knowledge, there is no reason why they should have a better degree of knowledge on environmental issues than the norm. Even though a decision to engage an appropriate service provider may suggest a particular interest in the field, it is the expertise of others that they are wishing to use. Some large businesses may have a specialist in-house person who deals with such issues, but this may not apply to many of the businesses who use such services, so, any enhanced degree of knowledge cannot be generally attributed to the average consumer.

**Will the words PLANET +VE in Forest's mark be perceived as PLANET POSITIVE?**

22) A lot can depend on the context of use. Forest's mark is represented thus:



23) It is clear from the evidence that Forest intends the "+ve" element of its mark to be perceived by the average consumer as the word POSITIVE. Forest's marketing materials refer to the words PLANET POSITIVE and this is what its mark is meant to stand for. However, the fact that Forest may market in this way is not decisive because I must consider how the mark will be taken without



supporting hints as to meaning. The question is simply whether the mark, as depicted above, and used in relation to the services sought, will be perceived by the average consumer as Planet Positive.

24) To support its contention, Forest filed evidence showing what it describes as multi-discipline use of “+ve” for “positive”. The evidence was initially sent to the Intellectual Property Office at examination stage of the earlier mark in order to demonstrate that the mark as a whole had a concept (Planet Positive) so as to overcome citations based on the word PLANET alone. The evidence was re-filed in these proceedings. It consists of:

- I. An extract from a GCE "O" level physics book. In a section relating to electric cells and with reference to contacts on such cells, the expressions “+ve” and “-ve” are used.
- II. An extract from [www.stagebeat.co.uk](http://www.stagebeat.co.uk) relating to the power supply voltage and polarity of replacement power supply units in musical apparatus. The extract includes the text “The kind of information you require may include standard electronic symbols to indicate polarity. Polarity identifies which of the two contacts is positive, (+), (+ve), or negative, (-), (-ve)”. I note that the rest of the page, when identifying positive or negative in diagrams, uses the (+) symbol rather than +ve.
- III. An extract from [www.cs.ubc.ca](http://www.cs.ubc.ca) relating to a statistical theory called Bayes' Rule. An example of part of the theory can be seen whereby “T=+VE” denotes a positive test.
- IV. An extract from [www.hgl.nhs.uk](http://www.hgl.nhs.uk) relating to the HIV disease where the terms HIV+ve (presumably to represent the term “HIV Positive”) is used.
- V. An extract from [www.glanclwyd.demon.co.uk](http://www.glanclwyd.demon.co.uk) about Conwy & Denbighshire NHS Trust. It relates to tests conducted on hearing. It contains the text: “Reduce the level in the worst ear again in 10Db steps until 2 +ve responses occur. It also refers to giving reliable +ve responses and reliable -ve responses.
- VI. A reference was also made in an accompanying email at examination stage to a website at [carbonpositive.net](http://carbonpositive.net) where +ve is being used. Nothing, though, was supplied in the evidence. Ms Thornton states in her evidence that it was very difficult to see on a print although, she says, it is very clear in the top right hand corner of the website.
- VII. An extract from some blogs produced by Mr Battle relating to his Planet Positive business which contain graphs which use the words “+ve impact” and “-ve impact” which are clearly meant to represent positive and

negative impacts. The blogs appear to date from around November/December 2008.

25) The final extract above was filed in response to the denial in the counterstatement which reads:

“It follows that no party can claim, absent evidence of acquired distinctiveness, exclusive rights in the term “planet positive”. It follows that it cannot be said to be, in the absence of any evidence to the contrary, the distinctive element of the earlier either [sp] mark, **even if the relevant public were able to discern the term “positive” within the mark of Registration No. 2433143 by reference to the annotation “+ve” derived from the field of electronics.**

26) Mr Battle did not file any evidence addressed to this point, but on his behalf at the hearing Mr Bentley stated that it was not at all clear that the average consumer would immediately and unambiguously see the PLANET POSITIVE meaning. He highlighted that the mark was originally captured as PLANET with +VE being recorded, effectively, as a device element, and that this meant that the earlier mark was not cited against Mr Battle’s application. He also highlighted that no independent evidence or survey evidence had been filed to show the way in which the average consumer would perceive it.

27) Whilst it is true that no independent or survey evidence has been filed as to consumer perception, this is not a pre-requisite. I must come to a view, based on the balance of probabilities, as to whether the average consumer will perceive Forest’s mark as denoting the words PLANET POSITIVE. Forest’s evidence could certainly have been more substantial, nevertheless, it demonstrates that the “+ve” symbol is used to denote the word “positive” in a number of fields and that it has come to be used not just in the field of electronics. This is clearly demonstrated by the use in healthcare and by the use in the term HIV POSTIVE/+VE (the later expression, and the use of the +VE symbol, is one that I have personally encountered). That the term is one likely to be understood by the average consumer is supported by the fact that the applicant himself has used the +ve symbol on blogs relating to his business. If it is Mr Battle’s position that the average consumer may not perceive +ve as the word positive then it seems a strange choice for him to use such a symbol in his own material. The matter, as stated earlier, must be based on the perception of the average consumer - based on the evidence filed, I come to the view that the average consumer will perceive the use of PLANET +VE in Forest’s mark as denoting the words PLANET POSITIVE. There is no alternative explanation for the adoption of the +ve symbol.

**Does PLANET POSITIVE play a distinctive (trade mark) role in the respective marks?**

28) The material date to make this assessment is the date of application of Mr Battle's trade mark, namely 1 December 2006. This is the point in time at which a likelihood of confusion must be established. To put this factor into context, it was submitted at the hearing that Mr Battle's mark would be akin to a mark (for wine or wine retailing) consisting of the words WINE VENDORS and device, and that the average consumer would not regard the words WINE VENDORS as playing a distinctive trade mark role. By extension, any distinctiveness in Forest's mark (even if the mark would be perceived as the words PLANET POSITIVE) lay in its particular form of presentation and not in the words themselves.

29) In the annex to this decision I have included a table summarising the evidence filed on behalf of Mr Battle demonstrating the use of the expression PLANET POSITIVE (or similar expressions). As can be seen, the vast majority of the uses are from outside of the UK, mostly from US centric websites. Of these, there is a mixture of pre- and post- dated material. There are, though, some that originate from UK sources, these include:

(i) A website extract (dated 21 September 2007) from roadtransport.com which uses the words planet-positive descriptively;

(ii) an extract (with a handwritten date of 2007) from a website entitled "The Waterworks Museum" referring to a Planet Positive Water Meter;

(iii) an extract from a website called 4ecotips.com (dated 23 January 2007) which refers to a "Planet Positive" day;

(iv) an extract from Google Groups (from 2008) showing that a group exists called Planet Positive;

(v) a website extract from Metro.co.uk (dated July 2008) using the words planet positive in a descriptive manner;

(vi) a website extract of unknown provenance relating to Ewan McGregor's global motorcycle trip which uses the words "he's planning to travel "planet positive"".

30) In terms of descriptive use in the UK, (i), (v) & (vi) show descriptive use, but all from after the material date<sup>4</sup>. Ms Thornton also highlighted in her evidence that in relation to (vi), the television program referred to in this article was produced by Russ Malkin, who is the brother of one of dCarbon8's directors, Steve Malkin, and that in relation to (i), the company referred to in the article is a customer of

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<sup>4</sup> In relation to 6, Mr Thornton's evidence contains a more detailed version of the web extract showing that it is dated 30 April 2007.

dCarbon8. I also note that the uses in (ii), (iii), & (iv) do not necessarily constitute use in a descriptive manner, (ii) refers to what could be a particular product, (iii) refers to the name of a campaign day and (iv) refers to the name of a particular group – these are also from after the material date.

31) Whilst Mr Bentley highlighted the UK use, he also submitted that the overseas use should not be ignored as the Internet is a global tool and, also, that it is inevitable that the Internet is made up of a greater amount of US references than UK ones. He also highlighted the evidence of Ms Little in which she says:

“I have used the term “planet positive” in multiple articles that I have written. That term is a normal, everyday kind of construction and simply a different way to express the idea “eco-friendly”. I do not believe that anyone should be able to monopolize that term”.

32) Mr Bentley also highlighted Ms Thornton’s own evidence where she states:

“Whilst reading through all the rules on trade mark registration especially the need for a trade mark to be distinctive in nature, I felt that the words “Planet positive” could possibly be construed as being not distinctive or could be interpreted as generic, so we decided instead to use the commonly used annotation +ve as a more distinctive (and therefore rendering it more likely to be trade-markable) representation of the word positive.”

and

“We decided to register the annotation +ve instead of the whole word positive, in order for the term to be trade-markable and distinctive, and not to look generic.”

and

“I believe that the term “Planet Positive” in the sense of meaning something which is beneficial to the planet is the key message of my registered mark and of Mr Battle’s mark application.”

33) Is clear from the evidence that the term PLANET POSITIVE was not a commonly used term in the UK at the material date. Neither can it be assumed that the average consumer in the UK had encountered the term in parlance or in written form at that point in time. Whilst Internet references from outside the UK are capable of being accessed by anyone, there is nothing to suggest that this has happened. In the field of environmental issues it is common for certain phrases (eco-friendly, green, climate change etc.) to become popular and this may have happened, to a degree, in the US in respect of the phrase PLANET POSITIVE. This is clearly the experience of Ms Little. However, she is a journalist

working in the US so this does little to take matters further forward. I also note Ms Thornton's evidence that a number of the Internet references set out in the annex were authored by Ms Little. There is, therefore, little evidence to suggest that at the material date the words have travelled so as to become familiar to the UK average consumer.

34) Mr Bentley conceded that the term may not have been in common use in the UK, but argued that the average consumer would still simply see a descriptive message in the words themselves. Whilst I agree that the words PLANET POSITIVE have a fairly clear suggestive quality, when used alone in the context of the respective marks the suggestive quality, is not one, in my view, that will be seen as an out and out description. It will strike the average consumer as an unusual term even though they may see the suggestive message. The language used does not strike me as ordinary use of language and has a somewhat jarring quality. Whilst there may be other terms that the average consumer may know of consisting of similar constructions, they are ones which may have become popular in parlance. Absent evidence to suggest that the term PLANET POSITIVE was already known and used at the material date, I take the view that it is capable of sending a trade mark message. A trade mark (or in this case an element of it) can send an informative message but, at the same time, may also be capable of being understood as having trade mark meaning. In other words, a trade mark may play a dual role. An analogous finding can be seen in the judgment of the ECJ in *Audi AG v OHIM* (Case C-398/08 P). This is what I consider to be the case here.

35) I have not ignored what Mr Thornton said in her evidence about the words and her reasons for applying for Forest's trade mark in the form in which it is registered. However, it seems to me that what Ms Thornton has said is more to ensure that Forest's trade mark was registerable and to add to its distinctiveness. She (or Forest) have not conceded that the words will be seen by the average consumer as a simple description. Indeed, she stressed at the hearing that the marks did not fall into Mr Bentley's WINE VENDOR category, and that PLANET POSITIVE (regardless of the spelling) was intended to be her "brand". Her view is supported (even though I accept that this has little relevance to the average consumer) by Forest's own marketing materials where PLANET POSITIVE (spelt in this way) is promoted as a brand.

36) In view of the above, I consider that in the context of Mr Battle's mark, the words PLANET POSITIVE have distinctive character and will play a trade mark role within its overall context. The words are not highly distinctive, I consider them to be fairly low in distinctive character, but they are distinctive none the less. The words have, at the least, an equal degree of dominance in comparison to the other element of the mark. This finding follows through to Forest's mark in that the average consumer will regard the PLANET +VE element as distinctive based not just on its style of presentation, but also in relation to the semantic content of the words themselves.

## Comparison of the marks

37) When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23).

38) Given my findings that the words PLANET POSITIVE are distinctive, albeit only to a low degree, and that the average consumer will perceive Forest's mark as PLANET POSITIVE, I come to the clear view that the marks are identical from an aural perspective. This is based on: i) the perception of Forest's mark so that it will be pronounced as PLANET POSITIVE and, ii) that the device element in Mr Battle's mark and the stylization in Forest's mark will not form part of any verbalization. Furthermore, I come to the view that the marks are identical from a conceptual perspective, both having the same evocative<sup>5</sup> meaning.

39) In terms of the visual comparison, there are a number of differences (the hand gesture in Mr Battle's mark, the stylization in Forest's mark, the use of the word POSITIVE as opposed to +ve) but such differences do not outweigh all of the similarities. The degree of visual similarity must, though, be pitched at the lower end of the spectrum.

40) Overall, considering the visual, aural and conceptual similarities, I consider there to be a reasonably high degree of similarity. The ECJ has held on a number of occasions<sup>6</sup> that conceptual dissonance can counteract visual and aural similarities – I see no reason why the reverse should not also be true. This is an important factor which has been borne in mind. The conclusion I have reached on overall similarity is not, in my view, inconsistent with the case-law regarding distinctive character as it is still a question of similarity<sup>7</sup> (subject, of course, to bearing in mind the distinctive and dominant components of the respective marks).

## Comparison of the services

41) When comparing the respective services I note the judgment in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* where the ECJ stated:

“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*,

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<sup>5</sup> Evocative meanings are relevant in the analysis as per T-189/05 *Usinor SA v OHIM*.

<sup>6</sup> See, for example, *Claude Ruiz-Picasso and others v OHIM, DaimlerChrysler AG* (Case C-361/04 P).

<sup>7</sup> Case C-235/05 P *L'Oréal SA v. OHIM* [2006] ECR I-57

their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

42) Guidance on this issue also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 (“*British Sugar*”) where he also highlighted the respective users and trade channels as being relevant.

43) In construing a word used in a trade mark specification, one is concerned with how the product or service is, as a practical matter, regarded for the purposes of the trade<sup>8</sup>. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>9</sup>. In relation to services, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

44) Finally, when comparing the respective services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be held to be in play<sup>10</sup> even if there may be other services within the broader term which are not identical.

45) I will consider Mr Battle’s specifications class by class, firstly looking at his class 35 specification which reads:

Business management, consultancy and advisory services.

46) Forest’s earlier mark is registered in class 35 for a specification which reads:

Advice and assistance to businesses on how to reduce their carbon footprint, and how to offset their remaining carbon emissions through investing in a fund to promote forestry and related agro-forestry services, done in a sustainable manner to assist in poverty reduction and preserving and enhancing bio-diversity, whilst acting as a carbon sink to help reduce global warming, and trading in voluntary carbon credits generated from this investment activity.

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<sup>8</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>9</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 (“*Beautimatic*”).

<sup>10</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05* (“*Gérard Meric*”).

47) At the hearing, Mr Bentley conceded that there was some overlap with business advisory services given that Forest's specification covers advice to businesses in class 35, albeit relating to carbon footprints etc and was, therefore a subset of advisory services. He did, however, argue that all of the class 35 terms were far wider in scope than the limited advisory services covered by Forest's specification, some of which may be completely unrelated. That may be so, but given that Mr Battle has not restricted his specification (be it unconditionally or otherwise) then Mr Bentley's point is academic, particularly in the face of the GC's judgment in *Gerard Meric*. In terms of Mr Battle's advisory services, identical services are in play as Forest's specification also covers advisory services. The same finding applies to Mr Battle's consultancy services as I see no real difference between a consultancy service and an advisory service – if there is a difference then it must be paper thin and the services still highly similar.

48) That leaves "business management" to consider. No evidence has been filed by either party to demonstrate what a business management service would consist of. I must, therefore, come to my own view (but bearing in mind the guidance set out earlier). Whilst I must guard against giving a service an overly broad interpretation, it is a term that nevertheless strikes me as a broad one covering a range of services whereby a business management professional would work with a business on one or a variety of issues. I have no reason to suppose that such a service could not focus on the environmental aspects of a business and how it should be run to maximise its environmental friendliness. For this reason, I come to the view that a business management service (which could potentially cover environmental issues) is similar to a reasonable degree to business advisory services relating to environmental issues. To the extent that both cover environmental business management/advisory services, there is likely to be little difference in the nature, intended purpose or method of use and they are likely to compete in the marketplace. These services are similar to a reasonably high degree.

49) Mr Battle's services in class 36 are:

Financial services; carbon credit trading services.

50) Forest's earlier mark covers, in class 36:

Investment fund in forestry and related agro-forestry services, done in a sustainable manner to assist in poverty reduction and preserving bio-diversity, whilst acting as a carbon sink to help reduce global warming, trading in voluntary carbon credits generated from this investment activity.

51) At the hearing, Mr Bentley conceded that carbon credit trading services were, effectively, identical to the services covered by Forest's specification. Mr Bentley, though, highlighted the much broader scope of the term financial



services. As I stated in paragraph 44, the broader scope is academic in the absence of a fall-back specification. As, in my view, Forest's services are a type of financial service, identical services must also be in play in here.

52) Mr Battle's services in class 42 are:

Environmental consultancy services; energy auditing; energy auditing in relation to carbon offsetting; advice, information and consultancy in relation to carbon offsetting.

53) Mr Bentley conceded that some degree of overlap between the above services existed, particularly with the services of Forest in class 35. There is certainly some overlap as both will be aimed at providing advice/consultancy on environmental issues, alongside such advice an energy audit may also be undertaken. The nature, intended purpose and method of use are all similar. I consider there to be a reasonably high degree of similarity between these services.

#### ***Distinctive character of the earlier trade mark***

54) The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it) the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No real use of the earlier mark has been made in the UK (Forest's evidence refers to it as being a start-up company) so I have only the inherent characteristics of the mark to consider.

55) I have already dealt with the distinctiveness of the words PLANET POSITIVE. This impinges on the discussion as to the distinctive character of the earlier mark. I found the words PLANET POSITIVE to be distinctive but only to a low degree, but not lacking altogether. Given that I have found that the average consumer will perceive the mark as PLANET POSITIVE, this means that the earlier mark is also of low, but not negligible distinctiveness. The earlier mark is made more distinctive by its stylisation and its use of +ve rather than the word POSITIVE (although this factor does not detract from its perception as PLANET POSITIVE) so that it is a mark of low to average distinctiveness.

#### ***Likelihood of confusion***

56) It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer(s) and determining whether they are likely to be confused.

57) I have found the marks to be similar to a reasonably high degree and the services to be identical or, at the least, also similar to a reasonably high degree. I have found that the average consumer will approach the selection of an appropriate service provider in a considered way. This point reduces the potential for imperfect recollection to play a significant part in the assessment. Nevertheless, I have found that the average consumer will perceive both marks as PLANET POSITIVE marks and that this term will have some distinctive trade mark impact. Even though PLANET POSITIVE is low in distinctiveness, it still plays a trade mark role and, in any event, the degree of distinctiveness is but one of a number of factors which must be borne in mind when making the assessment. As was found by the GC in Case T-134/06 (*Xentral LLC v OHIM*), even if a mark has weak distinctive character a likelihood of confusion cannot be ruled out. Ultimately, the key question is whether the visual differences are sufficient to render confusion unlikely. In my view they do not. I consider that the average consumer, even though they are likely to recognize the differences between the marks, will put the common inclusion of PLANET POSITIVE (or a word and symbol representative of it) down to economic connection rather than co-incidence. There is a likelihood of confusion. The opposition therefore succeeds.

### **Costs**

58) Forest have been successful and are entitled to a contribution towards its costs. Forest have not, though, been professionally represented in these proceedings and it is the registrar's practice to award costs to litigants-in-person at half the rate (save in respect of expenses) that he awards them where a party has had professional representation. I hereby order Mr Battle to pay African Forest Ltd the sum of £1150. This sum is calculated as follows:

Expenses (official fee for filing the opposition)  
£200

Preparing a statement and considering the other side's statement  
£200

Filing evidence and considering Mr Battle's evidence  
£500

Attending the hearing  
£250

Total  
£1150

59) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 19 day of October 2010**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

## Annex

<b>Webpage</b>	<b>Relevant text</b>	<b>Analysis</b>
1) peopleandplanet.net	Regarding global corporations it is said that they wield “enormous power and influence that can be either planet-positive or planet-negative”	Copyright date from 2004. Possibly Canadian.
2) grist.org	Regarding a building project in Brooklyn using salvage materials it is said “.hopes that this project will be recognized for its planet- positive ingenuity..”	Dated June 2004. Brooklyn, so US use.
3) dir.salon.com	An article entitled “Hollywood goes green” refers to producers who are “spearheading planet-positive media projects”	Dated April 2005. US use.
4) lime.com	An article about an eco-friendly building which will incorporate a “number of planet-positive technologies”	Dated November 2005. US use.
5) lime.com	When giving advice about “green” cars it is stated “so if you’re in the market for a climate-saving, planet-positive vehicle...”	Dated April 2006. US use.
6) victoria-e.com	A reference to supporting “planet-positive and local businesses”	Dated November 2006. US use.
7) bytheplanet.com	“Small planet-positive changes make a difference”	No clear date. US use
8) cottoninc.com	“Cotton emerges as a planet-positive option for Earth Day..” and “..makes cotton a planet-positive fiber”	April 2007. US use.
9) off-grid.net	Regarding Ewan McGregor’s global motorcycle trip: “he’s planning to travel “planet positive”	No clear date. No clear origin.
10) dianovo.com	“Only those items that communicate kid-positive and planet-positive messages”	No clear date. No clear origin
11) projectgood.gaia.com	Regarding eBay Marketplace: “this trusted platform will feature people- and planet-positive items..”	No clear date. Location Emeryville, CA.
12) roadtransport.com	“it is one thing to have a carbon-zero or planet-positive building”	21 September 2007. Reference is made in the text to a site in Leeds so possibly use in the UK.
13) hirshfileds.com	“...from environmentally friendly and “planet positive” products...”	No clear date. US use.
14) Movie Star Blog	Similar text to 3) above.	April 2004. Appears to be US use.
15) Planet positive du Coeur	A French website using planetpositive in	French origin. Given the

dans l'information	the heading. A user added post dated November 2006 includes: "This book is excellent in giving practical suggestions for PLANET POSITIVE actions..". This appears to be a review of a book that was sold on the website.	post, clearly before November 2006.
Go Green Gals	"Be planet positive when choosing office supplies"	No clear date. No clear origin
Four world's shopping	A description of a book (the one referred to in 15) above) it reads "Small planet-positive changes make a BIG difference"	Last modified date is 12/01/2008. US use.
The Waterworks Museum	A catalogue record reads "Guest & Chrimes Spare Parts List for Planet Positive Water Meter"	No clear date, handwritten 2007. Print obtained in July 2009. The Museum is in Hereford.
4ecotips.com	An article entitled: "Planet Positive" – a day of wishful thinking on climate change.	Published on 23 January 2007. UK use.
Toronto Sprouts	"our food production is planet positive"	No clear date. Canadian use.
Nynow	"..along with a tempting array of planet-positive goods"	July 2007. Relates to New York so US use.
Ecopreneurist	"wanting to do business in a planet positive way"	Hand written date of 27/12/2007. No clear origin but appears to be US use.
World of good	"shopping destination for people and planet positive products"	Date unclear but the text contains a link to a 2007 social impact report. 2008 copyright notice. Origin unclear but has a US bias.
Original good	As above	2008 copyright. US bias.
World of good	As above	As above
The TH Interview	An interview with an employee of eBay relating to a collaboration with World of Good (see above) which uses the same or similar text to the above.	Hand written date of 13 February 2008. Exact source unclear. Interview conducted by a person in New York.
Spark blog	A blog which also references the above relationship. Text states ".. a trusted platform for planet-positive products"	The blog was posted on 3 March 2008. Not specifically UK use.
Dailymantra.com	A reference to a new program to be aired on Planet Green which is to show	Appears to be US based (the program is to be

	how “planet positive change can have a low impact on lifestyle”	aimed on a US channel). The extract is dated 17 May 2008.
The Oregonian	An extract about a new project which provides two bicycle paths. The article does not mention the word planet positive but one person posts a response saying that “we need to continue to promote planet-positive modes of transportation..”	The response is dated 22 June 2008. US (Oregon) related.
Gap adventures.com	This extract references a “Planet Positive Project” and contains the text “Our environmental commitment to becoming impact neutral is made possible with our ambitious Planet Positive Project!”	The article refers to a tree planting programme in 2008. It appears North American based.
Google Groups	This is an extract from the Google Groups website where one such group is called Planet Positive.	The earliest date is from July 2008. It appears to be a UK based group.
Ecoble	An article from the Internet about going green with your computer. Text states “here are a few ways you can do you computing in a more planet-positive way”	Dated November 5 2008. Geographical source not clear but reference is made to the EU.
Planet Green	An article about Greensburg which refers to people coordinating “local events to support their planet positive lifestyle”	No date. Origin not clear but the article is about Greensburg which does not appear to be a UK location.
Planet Green	An article about green laundry which states “you will be surprised at the amount of choices you have to create a planet positive laundry experience.	Hand written date of July 2008. Origin not clear.
Metro.co.uk	An article entitled “The Big Tent Festival” which states “The Big Tent aims to inspire lasting, planet positive change from the grass-roots up”.	Dated 24 July 2008. UK based.
DIGITAL Burn	Another article about the eBay/World of Good collaboration with similar text.	Dated 3 September 2008. Geographical origin not clear.
Fashion Grail	As above	30 September 2008. Geographical origin not clear.
Synovation – the journal of the EDS AGILITY ALLIANCE	A publication which, in an editorial, refers to “integrating an impressive list of planet-positive initiatives”	Handwritten date of 2008. Geographical origin unclear but appears more

		US centric.
Nextbook	An article about giving presents to people. The article itself does not contain the word planet positive but a blogged response states “rare to get such goods with solid, planet-positive content..”	The response is dated 22 December 2008. Geographical origin unclear but more US centric.
Oakland Magazine.	Another article about the eBay/World of Good collaboration with similar text.	US publication. Dated November 2008.
Mlive.com (everything Michigan)	Text states that the latest issue “includes a planet-positive holiday guide”.	Dated December 2008. US (Michigan) based.
The Sierra Club 0 The Green Life	Carries the text “Planet-positive appliances and installations include low-flow or water free toilets”.	Dated May 2009. Geographical origin not clear but no UK references.
Planet Positive Organics	A company based in the US using Planet Positive in their name.	Copyright date of 2009. US based.
GAP adventures	A reference to a Planet Positive Project.	Copyright date of 2009. Geographical origin not clear.
San Antonio Craigslist	A job advertisement for World of Good containing similar text to its other references.	US based. The advertisement is from 2009.
Footprint friends. Com	A post on a message board stating “..any thoughts about 2009 and changes you could make in your household that are planet positive”.	January 2009. Geographical origin not clear.

Climate Neutral/Neutrality – 9 references. 2003 (unclear possible US use), 2005 (US use), 2004 (unclear, possible US use), 2003 (unclear, possibly US use), 2009 (unclear), 2009 (possible European use), 2009 (UK use), 2007 (origin not clear – an article about Holland written in English), 2007 (origin not clear but reference made to Climate Neutral being a registered trade mark in Australia and New Zealand).

Climate Positive – 7 references. 2002 (origin unclear), 2003 (refers to “Biz climate positive” so not really on a par. In any event, the origin unclear as it relates to Indian businesses), 2005 (source and origin unclear), 2005 (origin unclear), 2009 (US centric), 2009 (US centric), 2009 (US centric).

Climate negative – 3 references. 2001 (origin unclear), 2001 (origin unclear), 2004 (origin unclear but relates to a French research service).

Planet-neutral – 1 reference. 2008 (US centric),

Planet-negative – 1 reference. 2005 (origin unclear but appears US centric).

Earth neutral – 1 reference. 1998 (Indian source).

Earth positive – 1 reference (unknown date or origin – appears US centric).