

EIP

YouView facing a re-brand after High Court ruling on trademark infringement

In the latest decision of a long-running battle over use of the trademark “youview”, the High Court issued a decision, this week, that may require the £100 million internet television service to change their name.

Total Limited, a Cheltenham-based firm with the trademark “Your View”, provides bespoke telecommunications services to individuals and businesses, and adopted “Your View” as the name for its interactive billing platform, in 2007. They registered the trademark in the UK, in 2009, for goods including “databases” and services including “telecommunications”.

YouView is an internet television service with shareholders consisting of a mix of broadcasters and telecommunications companies. The service was launched on the market in May 2012 and advertising and marketing spend from launch until the year ending 2013 was approximately £29 million.

The UK Intellectual Property Office will not automatically refuse trademark applications on the basis of the existence of earlier similar rights. In 2010, Total were alerted to the application to register youview as a trademark, and they successfully opposed the trademark. The application to register youview was brought to Total’s attention because they had asked their trademark attorneys to provide a monitoring service.

Despite a lack of success before the UK Intellectual Property Office, youview continued to market their set top boxes and associated programming service. In this week’s decision, the High Court agreed that Total’s trademark had been infringed by this continued use. Youview unsuccessfully counterclaimed that Total’s trademark Your View was invalid.

The judge found that there was a strong likelihood of consumer confusion between the marks Your View and youview. It was highly significant that the commercial partners behind youview included the telecommunications companies BT, Talk Talk and Arqiva, against whom Total compete. 95% of youview set top boxes are supplied to customers as part of bundled services from the telecommunications companies which have invested in youview. The judge found that this supported a general convergence of the television and telecommunications industries. All this contributed to his finding that the marks were "confusingly similar".

YouView have indicated that they wish to appeal this decision.

Comments:

Registered trademarks offer powerful protection to applicants seeking to protect their own legitimate interests, regardless of the size of the applicant. In the judgment, it was the goods and services specified in Total's trademark registration that were compared against youview's use, and how Total had used Your View in practice, as an online billing platform, was not relevant.

The test for a successful trademark infringement action is whether there is a likelihood of confusion on the part of the public, rather than actual instances of confusion in the market, and whether there is a real possibility that the companies could compete.

This is a decision that very much looks to the future and the judge mentioned the convergence of the telecommunications and broadcasting industries a number of times. It was highly significant that large communications companies had invested in developing the youview service. In the internet age, services that were once very far apart are now being brought together.

Co-existing brands that were once operating in seemingly separate industries are now at risk of being used in a way that could lead to a risk of confusion amongst consumers. The decision refers to the likely continuing convergence of telephone, telecommunications, data transmission and video and TV streaming services and brand owners in these industries would be advised to review their protection and ensure it covers their future intentions.

The decision reminds us that the onus is on brand owners to actively police their brands and ensure they remain exclusive. The decision also highlights the importance of conducting trademark clearance searches in all relevant markets prior to investing in and launching new brands. It is far more expensive and inconvenient to rebrand after a product has been launched.

By Sharon Daboul.