



PlanetArt Wins UK Trademark Infringement Case against Photobox

CALABASAS, CALIF., March 25, 2020 — PlanetArt® announced today that it has won its claim of trademark infringement in a case against Photobox after a trial before the High Court of Justice of England and Wales.

Among other things, PlanetArt® LLC and its UK subsidiary PlanetArt Limited contended that in naming their app “Photobox Free Prints,” defendants Photobox Limited and Photobox Free Prints Limited were likely to lead prospective customers to confuse their mobile application with PlanetArt’s original FreePrints app. This is an argument that the High Court accepted, ruling that Photobox had infringed PlanetArt’s mark pursuant to both sections 10(2) and 10(3) of the UK Trade Marks Act of 1994.

PlanetArt launched its FreePrints photo printing app in the United Kingdom in January 2014. Since that time it has become the undisputed leader in its space, downloaded by roughly one in every six Britons. The brand has become a household name through advertising that has made more than 3 billion impressions in the time since, or roughly 45 impressions for each person in the UK.

Evidence in the case showed that in July 2017 Photobox commissioned a study that determined that it had fallen behind in the app market, ceding growth to new entrants with innovative offerings and identifying PlanetArt in particular. Evidence also showed that, in the months and years that ensued, Photobox placed PlanetArt in its crosshairs, building an app and marketing scheme that would be very similar in scope and business model to PlanetArt’s FreePrints app.

The High Court noted, “Given that the Defendants’ were trying to emulate the success of the Claimants, it seems inconceivable that these similarities were the product of chance.” Indeed, members of Photobox’s executive team were shown at the trial to have undertaken numerous transactions in PlanetArt’s FreePrints app while they built their own app with a substantially similar marketing scheme, bolstering the conclusion that Photobox’s actions were part of a pattern of obsession with FreePrints.

PlanetArt holds multiple registered trademarks for its FreePrints family of apps, including a UK registration for the app’s icon which features a combination of the word *FreePrints* and the brand’s butterfly logo. In the litigation, PlanetArt claimed that Photobox infringed its mark through the use of an icon of virtually the same hue with text underneath of virtually the same letters—different only by Photobox’s inclusion of a space character.

Ultimately, the High Court held, “The extent of similarity between the Photobox Free Prints App’s name, icon and marketing materials and those for the [PlanetArt] FreePrints App is such that a reasonable inference can be drawn that the Defendants deliberately set out to cause confusion with the FreePrints Icon and to trade off the Claimants’ goodwill and reputation in

the FreePrints Icon above regarding the interest taken by the Defendants' in the Claimants' FreePrints App.”

About PlanetArt

PlanetArt is a leading technology platform in the personalized products industry. Founded in 2010, the company develops and operates more than a dozen ecommerce sites and mobile apps for iOS and Android, including FreePrints™, Personal Creations®, SimplytoImpress® and Gifts.com®. All of the company’s brands support the vision of allowing consumers to forge closer, more meaningful relationships with family and friends. PlanetArt is unique in its space with a large emphasis on mobile transactions and a presence in 11 countries.

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