

**O-118-03
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2235125
BY ORBIS PROPERTY PROTECTION LIMITED
TO REGISTER A TRADE MARK IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 90417
BY CORBIS CORPORATION**

AND

**IN THE MATTER OF APPLICATION No. 2235134
BY ORBIS PROPERTY PROTECTION LIMITED
TO REGISTER A MARK IN CLASSES 9, 37 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 90419
BY CORBIS CORPORATION**

AND

**IN THE MATTER OF APPLICATION No. 2235141
BY ORBIS PROPERTY PROTECTION LIMITED
TO REGISTER A MARK IN CLASSES 9, 37 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 90418
BY CORBIS CORPORATION**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2235125
by Orbis Property Protection Limited to register
a Trade Mark in Class 42**

and

**IN THE MATTER OF Opposition thereto under No. 90417
by Corbis Corporation**

and

**IN THE MATTER OF Application No. 2235134
by Orbis Property Protection Limited to register
a mark in Classes 9, 37 and 42**

and

**IN THE MATTER OF Opposition thereto under No. 90419
by Corbis Corporation**

and

**IN THE MATTER OF Application No. 2235141
by Orbis Property Protection Limited to register
a mark in Classes 9, 37 and 42**

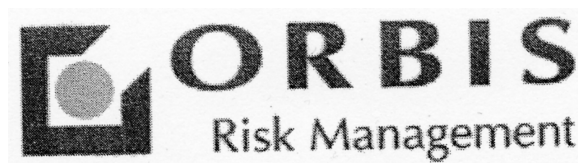
and

**IN THE MATTER OF Opposition thereto under No. 90418
by Corbis Corporation**

Background

1. On 7 June 2000 Orbis Property Protection Limited filed three applications. The marks and goods and services are as follows:

No. 2235125
Mark

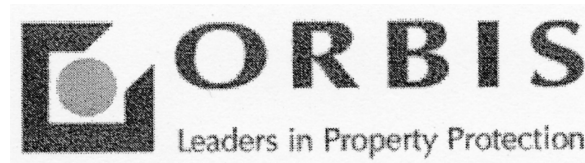


Services

“Advisory services relating to provision of security and assessment of risk, and security inspections of property.”

No. 2235134

Mark



Goods and services

Class 09:

“Alarm systems, intruder smoke detectors, panic button systems, radio personal attack system, surveillance equipment (including closed-circuit television and security cameras), remote detection units, anti-tamper devices.”

Class 37:

“Installation, repair, maintenance and upgrading and removal of security screens, door locking devices, steel security doors, intruder screening, anti-vandal screens, safes and strong boxes, security gates, door and window screens, alarm systems, intruder smoke detectors, panic button systems, surveillance equipment (including closed-circuit television and security cameras), remote detection units, anti-tamper devices, radio personal attack systems.”

Class 42:

“Security patrols of vacant premises, provision of security monitoring and security call centre services; provision of security response teams, estate patrols and security call-out patrols, provision of security guards, municipal gardening; advisory services relating to potential security risks and levels of security required.”

No. 2235141

Mark



Goods and services

Class 09:

“Electrical security products, alarm systems, smoke detectors, panic button alarms, surveillance equipment (including closed-circuit television and security cameras), anti-tamper devices, remote detection units, radio personal attack systems.”

Class 37:

“Installation, maintenance, repair, upgrading and removal of security screens, anti-vandal screens, metal window and door screens intruder screening, including safes and strong boxes, door-locking devices, security doors and gates, and other metal security products, alarm systems, intruder smoke detectors, panic button alarms, surveillance equipment (including closed-circuit television, security cameras and remote detection units), anti-tamper devices, radio personal attack systems.”

Class 42:

“Supply of security guards, mobile security patrols, call-out security patrols, security patrols of vacant premises; municipal gardening.”

2. In each case I note that the publication of the marks in the Trade Marks Journal indicates that “the applicant claims the colours yellow and blue as an element of the mark.”

3. On 13 September 2001 Corbis Corporation filed notices of opposition against each of the three applications. The grounds are in substantially the same terms in each case. Corbis Corporation are the proprietors of the following UK trade mark registrations:

No.	Mark	Class	Specification
2005802B	CORBIS	35	Provision of information and digital data; storage and retrieval services all for use in relation to information, images, audio material and text; wireless and on-line information services; information and advisory services; all relating to business.
		41	Provision of information and digital data; storage and retrieval services all for use in relation to information, images, audio material and text; wireless and on-line information services; information and advisory services; all relating to entertainment.
		42	Licensing of information and of digital data; provision of access to a computer database; provision of information and digital data; storage and retrieval services all for use in relation to information, images, audio material and text; wireless and on-line information services; information and advisory services; all relating to education or for personal use.
2188667	CORBIS	09	Interactive multimedia products, computer software and CD-ROMs containing still, digital and motion video images, stock photographs, archival photographs, photographic prints, reproductions of works of art, illustrations, graphic designs, screen savers, greeting cards and posters.
		16	Books, pamphlets, computer software manuals, photographic prints, posters and greeting cards.

4. They contend that the respective sets of goods/services are similar and that the positioning of what they call the “C” graphic before the word ORBIS results in a mark that so closely resembles the opponents’ marks as to be likely to cause confusion (given also that the other

words present are non-distinctive in character). Objection is, therefore, taken under Section 5(2)(b).

5. Furthermore it is said that the opponents have made considerable use of the mark CORBIS in the UK (since December 1994) and on the Internet and are the owners of the domain name www.corbis.com. Objection is also taken under Section 5(4)(a). From the terms in which the objection is framed I take this to be a claim based on the law of passing off.

6. The applicants filed counterstatements denying the above grounds. They say they are the proprietors of both the word ORBIS and the device mark under registrations Nos. 2149339 and 2149363. Furthermore they are the proprietors of registrations Nos. 2235146, 2235149 and 2235150 which contain the same main elements as the marks now under attack along with other (largely) descriptive matter. They exhibit details of these registrations. They further submit that "... The Opponent operates in the specific business of supplying "digital images to both the consumer and creative professional markets, using Internet technology to allow consumers to quickly and conveniently access and purchase images" (Source: Corbis website www.corbis.com). The Applicant submits that it is involved in the highly specialised business of property security, mainly dealing with Local Authorities and Property Developers, the Applicant does not generally sell to members of the general public and does not operate in the same business as the Opponent. Accordingly, the goods to which the Applicant's and Opponent's marks are applied to are highly dissimilar and there is no likelihood of confusion on the part of the public or association with the Opponent's mark."

7. Both sides ask for an award for costs in their favour.

8. Both sides filed evidence. The parties were invited to say whether they wished to be heard or to file written submissions. Neither side has requested a hearing. Written submissions have been received on behalf of the applicants from Hammond Bale solicitors, their representatives in these proceedings. I will, therefore, give a decision based on the papers filed.

9. It is clear that the issues at the heart of each of these cases are the same. Not surprisingly this has been reflected in near identical pleadings and evidence and a composite set of written submissions on behalf of the applicants. The cases have not been formally consolidated but I see no need to issue separate decisions. Instead a single composite decision is being issued. Where it has been necessary to deal with specific issues that are not common to each of the cases (notably the different services of No. 2235125) this is made clear in the body of the decision. It is, of course, open to either side to appeal the decisions on individual cases if they so wish.

Opponents' evidence

10. The opponents filed a statutory declaration by Martin Ellis of Corbis UK Ltd. He says that Corbis Corporation is a privately owned company founded in 1989 by Bill Gates, the Chairman of Microsoft. It is the world's leading provider of digital still images. In support of this he exhibits copies of Companies House documentation relating to Corbis UK Ltd (Exhibit ME1) and pages from the opponents' website including a corporate profile of Corbis dated 11 June 1999 (Exhibit ME2).

11. Mr Ellis says that the CORBIS trade mark has been used by or on behalf of the opponents in the United Kingdom since 19 December 1994. The goods and services for which the CORBIS mark has been used since this date include digital images that are available in computer readable media, such as a CD-Rom or downloaded digital images from the Internet.

12. Most sales and promotions of CORBIS branded goods and services are made through the website. The goods and services are also promoted in catalogues, via direct mail and adverts and trade shows. Examples are shown at Exhibit ME4.

13. The total preliminary sales by Corbis UK Limited in the UK for the year 2000 is US\$12,865,000. The term 'preliminary' is not explained and no breakdown is provided to show sales prior to the material date of 7 June 2000. Further sales figures are given in Exhibit ME5 for the period July to December 2000 but again this is after the material date.

14. Some £110,731 was spent on advertising between September 1999 and December 2000. Exhibits ME6 to ME8 show the amounts spent on advertising/promotion, copies of advertisements and a CORBIS IMAGES calendar dated 1998.

Applicants' evidence

15. The applicants have filed a witness statement by Patrick F Emery, the Group Company Secretary of Orbis PLC and its wholly owned subsidiary, Orbis Property Protection Ltd. Corporate details are exhibited at PFE 1-3 including material downloaded from Companies House records. The applicants are said to be one of the largest void protection specialists in Europe securing empty properties for local authorities and commercial property landlords. They have operations throughout the UK employing over 550 staff.

16. Turnover in recent years has been as follows:

	£
1996/1997	5,395,039.00
1997/1998	5,721,000.00
1998/1999	10,132,000.00
1999/2000	24,514,000.00
2000/2001	33,591,000.00

17. The majority of the applicants' sales are on a tender basis with local authorities and housing associations. The majority of promotional information is provided via trade press within the housing and/or construction industry. The applicants also attend and exhibit at relevant events, including the annual Chartered Institute of Housing Exhibition in the UK. Marketing brochures are used widely and examples of past and current brochures are exhibited at PFE 4.

18. Mr Emery goes on to confirm details of the other registrations owned by the company and referred to in the counterstatement. These marks are said to have been used in relation to surveillance equipment, closed-circuit television, video cameras, remote detection units, security screens, door-locking devices, steel security doors, door and window screening, security gates, safes and strong boxes, anti-vandal screens and intruder screens, and for services including

installation, maintenance, repair and upgrading of closed-circuit television, video cameras and remote detection units, monitoring and call centre services with regard to surveillance equipment.

19. Mr Emery concludes by saying that he is not aware of any instances of confusion between the parties' goods and services despite the use of marks which are substantially similar in format to the marks now opposed.

Opponents' evidence in reply

20. The opponents have filed a witness statement by Rebecca Weeks of Olswang, their professional representatives in this matter. Her evidence is in essence submissions in relation to Mr Emery's evidence and a chronology showing the dates of incorporation (and name changes) of the companies involved together with their trade mark registrations.

21. That completes my review of the evidence.

Section 5(2)(b)

The Section reads:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

22. Sub-paragraph (b) applies here.

The case law

23. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and will draw on these cases in what follows.

Distinctive character of the opponents' earlier trade marks

24. The distinctive character of the earlier trade mark is a factor that must be taken into account. Furthermore I must take account of both the inherent and acquired qualities of the mark, *Sabel v Puma* paragraph 24.

25. In the absence of evidence to the contrary I take CORBIS to be an invented word. It has no obvious meaning, overt or covert, in relation to the goods and services for which it is registered. As such it seems to me to possess a relatively high degree of distinctive character. The evidence suggests that CORBIS had a not insignificant level of sales in the UK in the year 2000. No previous year figures are given and no breakdown is provided. The opponents are suppliers of visual content, principally in the form of digitised images, to creative professionals and consumers. A number of the supporting exhibits are either undated or after the material date. Exhibit ME6 is of assistance in showing a regular and sustained programme of advertising in publications such as Creative Review, Design Week and Marketeer. However, the totality of the evidence is rather thin in advancing the opponents' claim to distinctive character to the sort of household name level envisaged in the *DUONEBS* case BL O/048/01. Nevertheless the opponents are entitled to point to the inherent strength of their mark.

Similarity of marks

26. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel v Puma* paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23, the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik v Klijsen Handel*, paragraph 27.

27. The tests require me to base my considerations on the average consumer for the goods or services in question. It would seem from the opponents' evidence that the average consumer for their core goods and services are creative professionals and individuals who have a need for digital images. In practice a number of different formats and methods of accessing and transmitting such images may be employed and are reflected in the specifications of Nos. 2005802B and 2188667. I also bear in mind that I must consider the notional breadth of the opponents' specification and not just what they have done to date.

28. The average consumer for the applicants' goods and services is said to be local authorities, commercial property landlords, housing associations etc. Again, however, that statement of the applicants' primary existing customer base must not be substituted in my consideration for the specifications applied for and the full potential range of users of the goods and services contained therein. The applicants' goods and services, particularly those in Class 9 and 37 are not restricted to commercial outlets and could equally be made available to individuals as well as the corporate and institutional clients referred to above. Even so I do not discern any appreciable overlap in the parties' respective sets of average consumers. Both in the main target their own knowledgeable and discerning customer base.

29. With those considerations in mind I go on to consider the visual, aural and conceptual similarities between the marks. The opponents' case relies heavily on their view that each of the trade marks applied for consist of a "C" graphic and the word ORBIS along with what are by common consent non-distinctive or descriptive supplementary indicators. It is contended that the positioning of the "C" graphic before the word ORBIS will result in recognition and pronunciation of the mark as CORBIS.

30. The colour representations of the applied for marks show that the outer border of the device element is coloured blue and the circle contained within it is yellow. Although it is placed before the word ORBIS the immediate impact is of a self contained device rather than a letter C. As the consumers for both parties' goods and services are likely to be knowledgeable, discerning and reasonably observant individuals I find it improbable that there is a significant risk that the applicants' mark will be viewed in the way the opponents fear. There remains the fact that the word/element ORBIS is common to both but it would require a consumer to be abnormally inattentive to fail to notice the initial letter of the opponents' mark. Furthermore I understand from Ms Weeks' evidence that the opponents' concern is with the applicants' composite mark rather than the word and device separately.

31. Similar considerations are likely to apply in relation to oral/aural usage. I note that the opponents' goods and services are offered on-line though maybe not exclusively so. Clearly a visual appreciation of the images offered by the opponents is particularly important so I would expect visual contact with their mark to be rather more important than oral usage though word of mouth recommendation should not be ruled out.

32. Conceptually neither mark yields any obvious meaning which might help consumers to distinguish between them – equally they do not have any obvious conceptual similarity. I doubt that conceptual similarities or differences play a significant part in consumer recognition of marks of this kind.

33. I conclude that there is some similarity between the respective marks arising from the common word/element ORBIS. I do not accept that there is an appreciable risk that the applied for marks will be read as CORBIS particularly bearing in mind the characteristics of the average consumer for the goods/services in question.

Similarity of goods/services

34. The guidance provided by the ECJ in the *Canon* case is as follows:

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

35. In *British Sugar Plc v James Robertson & Sons Ltd* (TREAT), [1996] RPC 281 Mr Justice Jacob also considered that channels of trade should be brought into the reckoning. Also in the TREAT case it was said that:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

36. Finally, the particular considerations to be borne in mind in relation to services was referred to in *Avnet Incorporated v Isoact Limited* [1998] FSR 16:

“... Definitions of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as “boots and shoes”.

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.”

37. The opponents have not been particularly forthcoming about which of the applicants’ goods/services they consider to be similar to their own and for what reason. I note the following from the statements of grounds:

In relation to No. 2235125:

“... the services in respect of which registration is sought are similar to the goods/services of the Opponent’s trade marks.”

In relation to No. 2235134:

“... a number of the goods/services in respect of which registration is sought are similar to the goods/services of the Opponents’ trade marks, for example, the surveillance equipment (including closed-circuit television, security cameras and remote detection units).”

In relation to No. 2235141:

“... a number of the goods/services in respect of which registration is sought are similar to the goods/services of the Opponent’s trade marks, for example, the electrical security products, surveillance equipment (including closed-circuit television, security cameras and remote detection units).”

38. The specification of No. 2235125 is restricted to “advisory services relating to provision of security and assessment of risk, and security inspections of property” in Class 42. I am left to speculate on what similarity the opponents think there is with their own goods and services. The high point of their case may be that their own Class 42 services cover “advisory services; all relating to education or for personal use”. Given Jacob J’s observations in *Avnet v Isoact* to the effect that specifications for services should not be given a wide construction but, rather, confined to the core of the possible meanings I do not find any similarity unless the opponents’ services (for personal use) were interpreted to mean personal security. In practice I believe that if that had been the intention the meaning would not have been so heavily disguised. It remains, therefore, a marginal and largely theoretical point of similarity.

39. The specifications in the other two applications are in substantially similar terms. Although the opponents have identified electrical security products and surveillance equipment as merely being examples of where they see similarity with their own goods/services I infer that they see such goods as offering them their best chance of success. They have not identified goods or services in their own specifications which give rise to the claim to similarity. For my part I am at

a loss in trying to identify points of similarity save on the most strained reading of the respective sets of specifications. If there is similarity it is hard to find.

Likelihood of confusion

40. The likelihood of confusion must be appreciated globally taking account of all relevant factors, *Sabel v Puma* paragraph 22. In *Raleigh International Trade Mark* [2001] RPC 11 Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences.”

41. I have found that the opponents’ mark has a high degree of distinctive character; that the applied for marks are unlikely to be seen or referred to as CORBIS; that in other respects there is a low level of similarity between them and the opponents’ marks; that consumers are likely to be relatively knowledgeable and discerning; and that there is a low to negligible degree of similarity between the respective sets of goods and services. I have little hesitation in concluding that there is no likelihood of confusion, a view that is not displaced by making due allowance for imperfect recollection. The opposition fails under Section 5(2)(b).

Section 5(4)(a)

42. The Section reads as follows:

“5.- (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

43. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents, and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

44. This is a case where the opponents' position under Section 5(4)(a) can be no stronger and is almost certainly weaker than under Section 5(2)(b). Even if I accept for present purposes that the evidence establishes goodwill it can only be in relation to the particular business that is described in Mr Ellis' evidence which in my view is contained within the boundaries of the specifications already considered above. Furthermore the opponents' statement of grounds makes no claim to use of a mark other than the one already considered. They would be unable on the basis of the material before me to establish misrepresentation or damage. The opposition fails under this head as well.

Costs

45. The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £800 in respect of each set of proceedings, that is to say £2400 in total. In arriving at that figure I have taken into account the fact that the cases have not been consolidated but that there have been economies resulting from the evidence being substantially the same in each case. This sum is to 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 25th day of April 2003

**M REYNOLDS
For the Registrar
The Comptroller-General**