

O/172/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2352901
BY CHRISTOPHER BERRY
TO REGISTER A TRADE MARK
IN CLASS 45**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 92528
BY VERISIGN INC.**

BACKGROUND

1) On 8 January 2004, Christopher Berry of Home Farm House, School Lane, Normanton Le Heath, Leicestershire, LE67 2TH applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) The mark was sought to be registered in respect of “Monitoring of Security CCTV systems” in Class 45.

3) On 27 May 2004 Verisign Inc., of 21355 Ridgetop Circle, Mail Stop LS3-3-4, Dulles, Virginia 20166, USA filed notice of opposition to the application. The grounds of opposition, amended in October 2005, are in summary:

- a) The opponent is the proprietor of the Community Trade Mark (CTM) 2689032 which is registered for goods and services in Classes 9, 16, 35, 36, 38, 40, 41 & 42. The opponent’s mark is as follows:



- b) The mark in suit is similar to the opponent’s trade mark, and the services applied for in Class 45 are identical or similar to the opponent’s services in Class 42. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent’s claims.

5) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 13 June 2006 when the opponent was represented by Mr Edenborough of Counsel instructed by Messrs Taylor Wessing. The applicant represented himself.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 23 December 2004, by Christopher James Benson, the opponent’s Trade Mark Attorney. At exhibit CJB1 he provides an extract from the CTM Office website which shows details of the opponent’s CTM registration No. 2689032.

7) That concludes my review of the evidence. I now turn to the decision.

DECISION

8) The only ground of opposition is under section 5(2)(b) which 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.”

9) An “earlier trade mark” is defined in section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

10) The opponent is relying upon CTM 2689032 which has an effective date of 8 May 2002 and is clearly an earlier trade mark.

11) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *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 *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

12) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the services covered within the respective specifications.

13) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*,

EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

14) I also have to consider whether the mark that the opponent is relying upon has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The opponent has made no claims regarding reputation, therefore the opponent cannot benefit from an enhanced reputation. In my opinion, the opponent’s mark is inherently distinctive for the goods for which it is registered.

15) I shall now consider the specifications of the two parties. Although the opponent’s mark is registered for a number of goods and services it was confirmed at the hearing that its strongest case is under the services in Class 42, the full specification of which is as follows:

“Computer services, providing authentication of identity; issuance and management of digital certificates for authentication or encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication over the Internet and other computer network; computer services, providing digital identity certification and the development, design, implementation, testing, analysis, and consulting services in the field of security, access, authorization, authentication encryption, and identification systems for computers, computer hardware and computer networks; development, integration and operation of computer systems to support issuance and management of digital certificates; creation and implementation of procedures and practices for issuance and management of digital certificates; computer related services, managed computer network and Internet security services, public key infrastructure ("PKI") verification, authentication, distribution and management, digital certificate issuance, verification, and management, and enterprise software integration; computer services, providing online information, news, and assistance in the field of domain name disputes; computer services, enabling users of the Internet to deliver information about themselves and, if applicable, their businesses, products or services to, and to register their universal resource locators with on-line catalogues, directories, search engines and web sites, via the Internet and other computer networks; services for identifying, acquiring and registering domain names; information services relating to the ownership rights of domain names, domain name management services, Domain Name System ("DNS") management and maintenance, domain name directory management and maintenance, Domain Name System ("DNS") infrastructure services, domain name and Domain Name System ("DNS") information propagation, and resolution of Domain Name System ("DNS") requests; computer related services, network, computer, database and directory services that convert an existing telephone number or assigned number sequence into an Internet Protocol ("IP") address or uniform

resource locator ("URL") for the purpose of enabling access, selection and display of online content via a wireless network; computer services, monitoring domain names for change in status and after-market availability; computer services, website designing, hosting and maintaining sites for others; providing templates for design of websites via electronic communication networks; computer services, providing customized reports, search tools and online help; computer consultation regarding computer networks and internal computer networks, security services for computer networks and internal computer networks, designing fire walls for others; consulting services for the development of software applications; designing and programming computer controlled communications systems; registration and tracking of domain names on the Internet and other computer networks; consulting relating to the issuance and management of digital certificates; technical and customer support for entities using digital certificates; computer network address management services, providing services enabling entities to access, add, modify or delete information relating to their computer network addresses; computer systems management services, providing search engines for obtaining data on the Internet and other computer networks, registering and tracking data on the Internet and other computer networks, registering and tracking addresses on the Internet, providing a directory of organizations, individuals, addresses, and resources accessible through the use of the Internet; design of customized goods, customized printing, silk screen printing and embroidery of company names and logos for promotional advertising purposes on the goods of others.”

16) The applicant’s specification in Class 45 is “Monitoring of Security CCTV systems”.

17)) In carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. 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.”

18) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

19) The opponent contends that “the central thrust of the services for which the Mark is registered is focussed on security issues, and in particular the identification of a person. This is identical to the central theme of the services for which registration is sought for the Application, namely security systems, and in particular those concerned

with the visual identification of people. Clearly, these services, even though not identical are similar”.

20) I agree that the opponent’s specification is concerned with the identification of the individual in order to permit transactions and/or secure communications via a computer system and/or network. Whilst the overall “thrust” could be said to be security it is security with regard to use of a computer system. It does not relate to general security of persons or property. The applicant’s specification is concerned with monitoring CCTV systems which, broadly, are used for two purposes. They are used by various authorities to monitor public areas to ensure that breaches of the law are dealt with. This can involve the identification of individuals or vehicles but is more widely used to identify potential problems and either prevent them or nip them in the bud. The other major use is with regard to the protection of property. Here their use can be to identify or verify that a problem is occurring such as a break-in or a fire and alert the necessary authorities. A by-product may be the identification of the perpetrators but this is somewhat secondary to the reduction of loss due to theft or damage of property and goods.

21) In its simplest form the services offered under the applicant’s trade mark could involve nothing more than a person sitting in front of a monitor watching images from a CCTV system. Even if one considers the computerised version of such a service it is significantly different to that offered by the opponent. Utilising the formula set out in paragraph 17 above it is clear that the nature of the services, their end users and method of use are all significantly different. I do not believe that they are in competition with each other nor are they complementary. Therefore, the services are not similar.

22) I now turn to the marks of the two parties. For ease of reference I reproduce them below.

Applicant’s mark	Opponent’s mark
	

23) The opponent contends that “the beginnings of the marks are identical with respect to (a) the first four letters, (b) the first two syllables, and (c) the use of the same device motif of transforming the initial letter “v” into a tick. The first part of the mark is prominent visually, aurally and conceptually”.

24) I agree that the two marks both have a tick device instead of the letter “v” at their start. I also accept that the average consumer is used to seeing such devices used instead of the letter “v” and would therefore both view and pronounce the mark as though it started with a letter “v”. The opponent is also correct in that the first four letters are identical and that the first two syllables are identical.

25) However, there are notable visual and aural differences between the marks. The applicant's mark is significantly longer than the opponent's mark, 14 letters and 8 letters respectively. Aurally the applicant's mark is made up of five syllables, VER-I-FIED-AL-ARMS, whereas the opponent's mark is only three syllables, VER-I-SIGNS. Other than the first four letters there is no visual or aural similarity between the marks. Whilst I accept that the beginnings of marks have prominence the average consumer views marks as wholes.

26) The opponent claims that the marks have a conceptual similarity. This is based on the average consumer viewing the first four letters of each mark "VERI" as the word "very". I accept that with the increasingly lax standards of grammar used, particularly by the advertising industry, the substitution of the letter "I" for the letter "Y" is one which would be all too readily accepted by the average consumer, if indeed they even noticed that the spelling was incorrect. However, I do not accept that the average consumer would be so willing to overlook the fact that the first part of the applicant's sign is in fact a standard English word which has a very clear dictionary meaning that I believe would be known to the average consumer. The word "Verified" has a meaning of "prove to be true; checked to be correct" whereas the word "Very" is used to add emphasis to adjectives that are able to be graded such as "very good" or "very tall" or it is used with nouns to give emphasis to the significance, appropriateness or relevance of a noun e.g "the very back of the room".

27) The applicant's mark would, I believe, be seen as being correct or true alarms, it also has the ring of official confirmation or certification. The opponent's mark does not, in my view, have any conceptual meaning as the word "very" does not add emphasis to the word "signs".

28) Taking account of the above, and taking into account the dictum of imperfect recollection, it is my opinion that the differences between the marks far outweigh the similarities.

29) Taking account of all of the above when considering the marks globally, I believe that there is not a likelihood of consumers being confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

30) As the applicant is successful he is entitled to a contribution towards his costs. In line with the normal practice of the Registry this has been reduced as the applicant is a litigant in person. I order the opponent to pay the applicant the sum of £1,000. 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 21st day of June 2006

**George W Salthouse
For the Registrar
the Comptroller-General**