

**O-428-15**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 043 249 IN  
THE NAME OF HAYS PLC TO REGISTER IN CLASS 35 THE TRADE  
MARK: POWERING THE WORLD OF WORK

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER  
402441 BY RANDSTAD HOLDING N.V.

## Background and pleadings

1. Hays Plc (the applicant) applied to register the trade mark POWERING THE WORLD OF WORK in the UK on 19 February 2014. It was accepted and published in the Trade Marks Journal on 23 May 2014 in respect of the following services in Class 35:

*Permanent, temporary and contract recruitment services; recruitment and employment agency services; specialist recruitment services; personnel and human resources management services relating to recruitment; recruitment process management and human resources (HR) outsourcing services relating to recruitment; assessment and development of candidates, such services being in the field of recruitment; employee talent management relating to recruitment; salary surveys for recruitment purposes.*

2. Randstad Holding N.V. (the opponent) opposes the trade mark on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier Community Trade Mark SHAPING THE WORLD OF WORK. The following services in Class 35 are relied upon in this opposition:

*Personnel recruitment; providing of personnel; temporary personnel services; staff placement services; information in the field of personnel affairs; administration, in particular salary and personnel administration; employment agency services and consultancy regarding personnel and personnel management; careers guidance; employment screening services; personnel selection using psychological methods; out-placements; careers counselling; interim business management; business project management; business organisation and business economics consultancy; vocational guidance; including the aforesaid services via telecommunication channels, including the Internet.*

3. The opponent argues that the respective services are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provide proof of use of its earlier trade mark relied upon).
5. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
6. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. A Hearing took place on 14 July, with the opponent represented by Mr Dan McCourt Fritz of Counsel instructed by Abel & Imray and the applicant by Mr Phillip Harris of Counsel instructed by Rouse IP Limited.

**Preliminary issue**

7. In the days prior to the hearing, the applicant sought leave to file additional evidence. This is described in further detail below. The opponent did not object to this request and so the evidence was admitted into the proceedings.

**Evidence filed**

**Opponent**

8. The opponent's evidence is a witness statement from Judith Franssen, attached to written submissions. Ms Franssen explains that she is the Director of International Marketing for the opponent, a position she has held since 2007. The following points are included:
  - According to Ms Franssen, the opponent is the second largest recruitment and HR services company globally and is engaged in the supply of recruitment services in all sectors and industries.
  - In 2012, the opponent had a 5.4% market share; higher in the EU (Netherlands – 20% and Spain 13%).
  - Turnover figures are provided:

Year	Approximate Amount in €000'000
2009	12,400
2010	14,179
2011	16,225
2012	17,087
2013	16,568

- According to Ms Franssen, SHAPING THE WORLD OF WORK has been used extensively throughout the EU on a variety of marketing materials including brochures, TV commercials, adverts, client communications, annual reports and industry/research reports. Exhibit JF2 includes: annual reports; photos from events such as job fairs in the Czech Republic; market surveys; graduate training scheme brochures; general brochures; publications on workplace trends; "world of work" reports; worldwide brochures and service banners. By and large these are all dated between 2009 and 2012/13 with some being earlier.
- Exhibit JF3 shows examples of screenshots for a marketing campaign consisting of TV commercials in the UK in 2010. These were shown on ITV, SKY, Channel 4 and Channel 5 over the course of four weeks in September/October.
- Ms Franssen claims that SHAPING THE WORLD OF WORK is almost always used in isolation, independently from its house mark RANDSTAD.

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9. There is another witness statement on behalf of the opponent from Rebecca Atkins, a Trade Mark attorney representing the opponent. This statement explains that attached are the results of a Google search for SHAPING THE WORLD OF WORK. The results appear to connect the phrase with Randstad. This point will be returned to later below if necessary.

### **Applicant**

10. This is a mixture of evidence and submissions with two witness statements (and accompanying exhibits) being annexed to submission documents. The submissions will not be summarised here. Rather, they have been taken into account in reaching this decision. The witness statement of Sholto Douglas-Home provides details of the applicant's background. The remainder of the witness statement concentrates on the term THE WORLD OF WORK asserting that it is commonly used in relation to the labour market. Exhibits are attached showing the results of Google searches in this regard, together with a "world of work" report from the International Labour Organisation. The witness statement of Mark Roland Foreman attaches as an Exhibit (MRF-9) a copy of a letter showing the UK IPO's decision not to maintain a citation for the earlier trade mark against the trade mark applied for. Finally, Exhibit MRF-10 is a copy of a decision of the OHIM showing that the opposition to SHAPING THE WORLD OF WORK was rejected in its entirety.
11. The additional (late) evidence filed by the applicant and admitted into the proceedings is a witness statement from Ms Janette Hamer. The point of the witness statement is to introduce as exhibits material which, according to the applicant, demonstrate that the earlier trade mark has been used in a descriptive sense. These are comprised of extracts from documents available on the opponent's website. One entitled "Mission and Core Values" includes a paragraph entitled "Our Mission: shaping the world of work" and includes the sentence: "In short, our mission is to take the lead in shaping the world of work". The remaining examples are along the same lines.

### **Proof of use**

12. The earlier trade mark is subject to proof of use. As such the following is relevant:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

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(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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13. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

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(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

14. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

15. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or

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services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

The court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

16. At the hearing, the thrust of Mr Harris's argument centred on use in conjunction with the essential function of a trademark, i.e. use which is performing in such a manner as to guarantee origin of the services in question. The argument is in essence, that the use made of the earlier trade mark has been descriptive in nature, is always in conjunction with Randstad (thus further supporting the descriptiveness line of argument) and so is not in keeping with the essential function of a trade mark and so cannot constitute genuine use.

17. As regards use in conjunction with the element Randstad, the following guidance is helpful: In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.



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32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

18. *Castellblanch SA v OHIM, Champagne Louis Roederer SA* [2006] ETMR 61 (General Court) is a further acceptable example of a registered mark being used in conjunction with another mark. Bearing in mind the foregoing, it is considered that the use of SHAPING THE WORLD OF WORK in conjunction with Randstad does not hinder the opponent in that it does not present a barrier to successfully demonstrating genuine use.
19. The descriptiveness argument is based on web pages from the opponent’s website collected by the applicant as already described above in the evidence summary. Mr Harris asserts that this provides evidence that the earlier trade mark has been used in a descriptive manner which is not in keeping with the type of use required in order to demonstrate genuine use. That is, use which is consistent with a trade mark’s essential function, namely to act as a guarantee of origin. It is considered that the matter is not as straightforward as Mr Harris suggests as mission statement documents are, by their very nature, written in an exaggerated promotional style, where the use of slogans and strap lines in the headings and main text is common place. This does not preclude such use from being consistent with the essential function of a trade mark as mission statements aim to inform respective consumers about the ethos of a company and to illustrate how this sets them apart from others. It is considered that this is quite in keeping with the notion of guaranteeing origin. Further, there are numerous examples in the evidence of SHAPING THE

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WORLD OF WORK being used on trade stands, documentation and advertisements in numerous relevant countries. The nature of the use presented is therefore considered capable of being regarded as use consistent with the essential distinguishing function of a trade mark and so Mr Harris's descriptive argument is rejected.

20. It is true that the market share figures and other figures provided are not particularly helpful as it is unclear whether or not they refer to the house mark Randstad mark alone. However in any case, the evidence filed clearly demonstrates that there has been genuine use of SHAPING THE WORLD OF WORK.

21. However, the evidence filed by the opponent does not show genuine use of the trade mark in connection with all the services covered by the earlier trade mark. As such, one must arrive at a fair specification that reflects the use made. In this regard, the following guidance is helpful:

i) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

ii) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the

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context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered."

22. It is considered that the use shown has been in respect of personnel recruitment and specific examples of activities that fall within such a term but not in respect of business management services and the like. As such, the opposition will be considered in respect of the following earlier services:

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*Personnel recruitment; providing of personnel; temporary personnel services; staff placement services; information in the field of personnel affairs; administration, in particular salary and personnel administration; employment agency services and consultancy regarding personnel and personnel management; careers guidance; employment screening services; personnel selection using psychological methods; out-placements; careers counselling; vocational guidance; including the aforesaid services via telecommunication channels, including the Internet.*

### DECISION

#### Section 5(2) (b)

23. Sections 5(2) (b) of the Act is as follows:

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

(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”.

#### Comparison of services

24. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

The earlier services are:

Class 35:

*Personnel recruitment; providing of personnel; temporary personnel services; staff placement services; information in the field of personnel affairs; administration, in particular salary and personnel administration; employment agency services and consultancy regarding personnel and personnel management; careers guidance; employment screening services; personnel selection using psychological methods; out-placements; careers counselling;*

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*vocational guidance; including the aforesaid services via telecommunication channels, including the Internet.*

The later services are:

Class 35:

*Permanent, temporary and contract recruitment services; recruitment and employment agency services; specialist recruitment services; personnel and human resources management services relating to recruitment; recruitment process management and human resources (HR) outsourcing services relating to recruitment; assessment and development of candidates, such services being in the field of recruitment; employee talent management relating to recruitment; salary surveys for recruitment purposes.*

25. Though expressed differently, all of the respective services are in respect of recruitment. The earlier personnel recruitment can include all of the later services which merely express the different types of recruitment activities that can fall within the earlier term. They are considered to be identical.

### Comparison of marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in *Case C-591/12P, Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. The respective trade marks are shown below:

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SHAPING THE WORLD OF WORK	POWERING THE WORLD OF WORK
Earlier trade mark	Contested trade mark

29. The assessment to be made must take into account the distinctive and dominant components of each of the marks. In terms of dominance, there is no stand alone element in either of the marks. As regards distinctiveness, the opponent argues that each of the trade marks should be considered as a unit as each is comprised of a phrase that hangs together. Conversely the applicant considers that it is the elements SHAPING and POWERING within which the distinctive character of each mark lies and so the comparison should be made on this basis of these elements alone as the remainder is descriptive in respect of the services in issue.
30. It is considered that this matter is not as clear cut as the applicant suggests. In respect of the earlier trade mark SHAPING is unremarkable in respect of the relevant services here, as is THE WORLD OF WORK. Together, these elements hang together as a complete unit and it is within this phrase as a whole that any spark of distinctiveness lies. The same is also true for the most part in respect of the later mark, though POWERING is a relatively more unusual idea in the context of such services and so may attract a more memorable status within the phrase as a whole. In any case, the correct comparison to be made is as between the marks as wholes.
31. Visually there are obvious points of similarity in that each contains the words THE WORLD OF WORK. On the other hand, SHAPING and POWERING are fairly significantly different and do have a visual impact. Bearing in mind that the correct comparison is to be made between the marks as a whole, it is considered that there is a low degree of visual similarity.
32. Aurally, the matter is similar. They are similar to the extent that each contains identical words and different in their respective beginnings. There is a low degree of aural similarity.
33. Conceptually, it is considered that both marks convey a message of making a positive contribution to or having a positive impact upon the world of work and also that they are each innovative in some way. They are conceptually similar to a moderate degree

### **Average consumer and the purchasing act**

34. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the

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likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

35. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. The services in question are in respect of recruitment which is aimed at both the business sector wishing to sub contract such a function and also jobseekers within the public at large. For a business, the employ of such a function is likely to be a considered decision, possibly involving a tender process. Even if not, the stakes are high in ensuring the correct supplier is chosen in order to obtain the correct personnel. Further, such a service is likely to be relatively expensive. For a business therefore, it is considered that a high degree of attention is likely to be displayed during the purchasing process. Likewise a jobseeker will wish to ensure that a recruitment company represents the best fit for him/her so that the best and most suitable employment opportunities are facilitated. Such a consumer is also likely to display a high degree of attention.

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

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV, Case C-342/97* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

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registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

38. There is no claim from the opponent’s that the earlier trade mark has acquired an enhanced distinctive character through use. Rather, it contends that its mark is of normal or average distinctiveness. Conversely the applicant’s position is that the earlier trade mark is very weak as regards distinctiveness.
39. The evidence in so far as it relates to the UK is mixed. For example, there is evidence of a television advertising campaign but no real detail as to its impact. As such, the matter must be judged on a prima facie basis. As already described above the phrase SHAPING THE WORLD OF WORK conveys a message of having a positive impact on or making a positive contribution to the world of work. There is also evidence on file demonstrating fairly convincingly that THE WORLD OF WORK is a commonplace phrase used to refer collectively to the workplace. The services in question are of course, recruitment services. A registered trade mark should be assumed to have at least some degree of distinctive character<sup>1</sup>. However bearing in mind the meaning that SHAPING THE WORLD OF WORK will convey in respect of recruitment services it is considered that it must be accorded only a low degree of distinctive character.

## GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

40. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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<sup>1</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P



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(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

41. The services have been found to be identical. This can be important as the interdependency principle can come into play. Further, the marks have been found to share points in common visually, aurally and conceptually. While it is true each of the respective trade marks hang together as a complete phrase, this does not alter the view that, bearing in mind the nature of the services here, that POWERING in the later mark is on balance, likely to be the most memorable word providing a spark of distinctiveness. This has the effect of providing the positive and more unusual concept which is then placed into context by the remaining words and thus transformed into a complete phrase.

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That it appears at the start of the later mark supports this assessment. So the situation here is that the earlier mark is comprised of words, all of which are pretty unremarkable but which hang together as a complete phrase of which the whole has a low degree of distinctiveness. Then there is the later mark which also hangs together as a complete phrase but which includes a more unusual word at its beginning and which is, importantly, different from anything which appears in the earlier mark.

42. At the hearing Mr McCourt Fritz sought to argue that the applied for trade mark is exactly the kind of mark that the earlier trade mark should be able to prevent being registered; that the penumbra of protection that the earlier trade mark enjoys must extend to include such later marks otherwise what is the point of registration? I do not agree with this argument. If the later mark had been SHAPES THE WORLD OF WORK, then the matter may have been assessed differently. As such the use of POWERING in the later mark is enough to render them sufficiently distinct. This finding, coupled with the high degree of attention that is likely to be displayed during the purchasing process is considered to negate against any imperfect recollection occurring. Further, the earlier trade mark is considered to have only a low degree of distinctive character (though this of course, of itself, does not preclude a finding of confusion<sup>2</sup>).

43. It is concluded therefore that there is no likelihood of direct confusion.

44. However this is not the end of the matter as the likelihood of indirect confusion must also be considered. In this regard the following guidance is helpful:

In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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<sup>2</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

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(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

45. The common element here is THE WORLD OF WORK which cannot be seen as even approaching being distinctive let alone being strikingly so. Further, there has been no non-distinctive element added to the later mark in the sense described by Mr Purvis. Finally, the marks in question here are not on the same playing field as the FAT FACE/BRAT FACE example where the distinctive identity is retained in a logical brand extension. In the proceedings here, there are elements which differ, with POWERING in the later mark being a more unusual (and therefore) distinguishing feature. Further, the elements in common are very weak. It is difficult to see how the later mark would be seen as a variation or as a brand extension. There is therefore considered to be no likelihood of indirect confusion.

## COSTS

46. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: - £200  
Preparing evidence and considering and commenting on the other side's -  
£500  
Preparing for and attending a hearing - £500  
TOTAL: £1200

47. I therefore order Randstad Holding N.V. to pay Hays Plc the sum of £1200. 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.

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**Dated this 10<sup>th</sup> day of September 2015**

**Louise White**

**For the Registrar,**