

O-322-16

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3101417
BY INGENIO RECRUITMENT LTD
TO REGISTER THE TRADE MARK**

Ingenio

**IN CLASS 35
AND
OPPOSITION THERETO (UNDER NO. 404629)
BY
HOLBORN TECHNOLOGY INVESTMENTS LIMITED**

BACKGROUND

1) On 27 March 2015, Ingenio Recruitment Ltd ('the applicant') applied to register the following trade mark for the services listed below:

Ingenio

Class 35: Consultancy of personnel recruitment; Personnel placement and recruitment; Personnel recruitment services; Recruitment and placement services; Recruitment consultancy services; Recruitment services; Staff recruitment services; Advertising services relating to the recruitment of personnel; Advisory services relating to personnel recruitment; Assistance relating to recruitment and placement of staff; Business recruitment consultancy; Consultancy relating to personnel recruitment; Employment recruitment; Executive recruitment services; Interviewing services [for personnel recruitment]; Management advice relating to the recruitment of staff; Office support staff recruitment services; Permanent staff recruitment; Personnel recruitment advertising; Personnel recruitment agency services; Personnel recruitment consultancy; Professional recruitment services; Provision of advice relating to the recruitment of graduates; Provision of information relating to recruitment; Recruitment (personnel-); Recruitment advertising; Recruitment consultancy for lawyers; Recruitment consultancy for legal secretaries; Recruitment consultants in the financial services field; Recruitment of computer staff; Recruitment of executive staff; Recruitment of personnel; Recruitment of temporary technical personnel; Recruitment services for sales and marketing personnel; Staff recruitment; Staff recruitment consultancy services; Personnel recruitment services and employment agencies; Dissemination of information relating to the recruitment of graduates; Personnel recruitment; Recruitment (Personnel -).

2) The application was published on 17 April 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by Holborn Technology Investments Limited ('the opponent').

3) The opponent claims that the application offends under Section 5(1) of the Trade Marks Act 1994 ('the Act'). It relies upon the UK Trade Mark ('UKTM') shown in the table below:

UKTM details	Services relied upon
UKTM No: 3101317 Ingenio Filing date: 26 March 2015 Date of entry in the register: 26 June 2015	Class 35: Recruitment and placement services.

4) The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act, and as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

5) The applicant filed a counterstatement in which it denies the ground of opposition, stating that the applicant started trading under the name before the opponent and pointing out that the parties do not provide the same services.

6) Both parties filed submissions; only the applicant filed evidence. Neither party requested to be heard. I now make this decision on the basis of the papers before me.

PRELIMINARY ISSUES

7) The applicant's evidence consists of a very short witness statement from Gemma Goodacre, Managing Director of the applicant. Exhibited to Ms Goodacre's statement is an extract from the opponent's website purporting to show that the opponent did not start conducting business under the name 'Ingenio' until January 2015. Ms Goodacre states that this was after the date on which the applicant started using its mark and consequently, the opposition should fail. This evidence and arguments relating thereto cannot have any bearing on my decision for the reasons set out in Tribunal Practice Notice 4/2009 entitled "Trade mark opposition and invalidation proceedings—defences"¹ which states:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the Appointed Person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.”

¹ This Tribunal Practice Notice can be found on the website of the Intellectual Property Office at the following link:
<http://webarchive.nationalarchives.gov.uk/tna/20140603093547/http://www.ipo.gov.uk/pro-types/pro-tm/t-law/t-tpn/t-tpn-2009/t-tpn-42009.htm>

In the absence of an application to invalidate the earlier mark, any prior right which the applicant may have is irrelevant to the matter before me.

8) For the avoidance of doubt, the opponent's assertions to the effect that their mark has been "more visible and publicly accessible for a longer period of time" than the applicant's mark are also irrelevant.

9) Turning to the applicant's comments regarding the parties providing different services, this is also not something that I can take into account. I am required to assess the matter objectively rather than subjectively. That is to say, it is simply a question of looking at the respective terms within the parties' specifications, exactly as they appear before me, and deciding, from a notional perspective, whether they are identical. The manner in which either party may actually be operating in the marketplace is irrelevant to that assessment.

DECISION

10) Section 5(1) of the Act provides:

"5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

Comparison of marks

11) In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

"54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

Both parties' marks consist of the word 'Ingenio'. They are clearly identical.

Comparison of services

12) The services to be compared are:

Opponent's services	Applicant's services
<p>Class 35: Recruitment and placement services.</p>	<p>Class 35: Consultancy of personnel recruitment; Personnel placement and recruitment; Personnel recruitment services; Recruitment and placement services; Recruitment consultancy services; Recruitment services; Staff recruitment services; Advertising services relating to the recruitment of personnel; Advisory services relating to personnel recruitment; Assistance relating to recruitment and placement of staff; Business recruitment consultancy; Consultancy relating to personnel recruitment; Employment recruitment; Executive recruitment services; Interviewing services [for personnel recruitment]; Management advice relating to the recruitment of staff; Office support staff recruitment services; Permanent staff recruitment; Personnel recruitment advertising; Personnel recruitment agency services; Personnel recruitment consultancy; Professional recruitment services; Provision of advice relating to the recruitment of graduates; Provision of information relating to recruitment; Recruitment (personnel-</p>

);Recruitment advertising; Recruitment consultancy for lawyers; Recruitment consultancy for legal secretaries; Recruitment consultants in the financial services field; Recruitment of computer staff; Recruitment of executive staff; Recruitment of personnel; Recruitment of temporary technical personnel; Recruitment services for sales and marketing personnel; Staff recruitment; Staff recruitment consultancy services; Personnel recruitment services and employment agencies; Dissemination of information relating to the recruitment of graduates; Personnel recruitment; Recruitment (Personnel -).
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13) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05), the General Court held:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

The opponent's mark is registered in relation of all types of recruitment and placement services. As such, it notionally covers all of the services the applicant wishes to register. The services must therefore be considered identical.

Outcome

14) As I have found that both the marks and the services are identical, the requirements of section 5(1) of the Act are made out. **The opposition is successful.**

COSTS

15) As the opponent has been successful, it is entitled to a contribution towards the costs it has incurred in these proceedings. Using the guidance in Tribunal Practice Notice 4/2007, but bearing in mind that the opponent has not incurred the expense of legal representation, I award the opponent costs on the following basis:

Official fee (for filing the Notice of Opposition)	£100
Preparing the notice of opposition and considering the counterstatement	£100
Written submissions	£150
Total:	£350

16) I order Ingenio Recruitment Ltd to pay Holborn Technology Investments Limited the sum of **£350**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of July 2016

**Beverley Hedley
For the Registrar,
the Comptroller-General**