

**O/482/17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3153492**

**BY HUDSON GLOBAL, INC**

**FOR THE TRADE MARK**

**PULSE  
MINDSET**

**IN CLASSES 9, 16, 35 AND 41**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER 407287**

**BY PULSE HEALTHCARE LTD**

## Background

1. Hudson Global, Inc (“the applicant”) applied for the trade mark shown below on 7 March 2016 (number 3153492) for the following goods and services:

PULSE  
MINDSET

Class 9: *Electronic publications (downloadable); visual, audio and audio-visual recordings; none of the above being in the fields of health, medicine or medical practice; computer software; downloadable software; magnetic, optical and digital storage media; software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development.*

Class 16: *Printed matter, periodical publications, magazines, brochures, pamphlets, catalogues, newsletters, handbooks; books, lecture notes; product and system operating services and maintenance manuals; instructional and teaching materials; none of the above being in the fields of health, medicine or medical practice; printed matter relating to the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development.*

Class 35: *Employment hiring, recruiting, placement, and staffing services; human resources; business management; personnel management; information, advice and consultancy services relating to the aforesaid.*

Class 41: *Educational services; conducting training programs, seminars, lectures, conferences, and workshops; conducting training programs, seminars, lectures, conferences, and workshops in the field of recruitment, talent management, organisational effectiveness and employee performance; publication and distribution of printed matter; publication and distribution of educational materials; non-downloadable publications.*

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 3 June 2016. Pulse Healthcare Limited (“the opponent”) opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act (“the Act”). For sections 5(2)(b) and 5(3), the opponent relies upon the following two earlier UK trade mark registrations:

(i) 3064388

PULSE

*Class 35: Recruitment services; outsourcing services [business assistance]; business management assistance; personnel management consultancy.*

Filed 15 July 2014; completed the registration procedure on 5 December 2014.

(ii) 3049892

**Pulse**  
**Pulse**

(series of 2 marks)

*Class 35: Recruitment services; outsourcing services [business assistance]; business management assistance; personnel management consultancy.*

Filed 3 April 2014; completed the registration procedure on 22 August 2014.

3. The opponent claims under section 5(2)(b) that there exists a likelihood of confusion owing to the similarities between the marks and the identical or similar goods/services. Under section 5(3) of the Act, the opponent claims that the earlier marks have a reputation in the services relied upon, as set out above, such that use of the applicant’s mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier marks.

4. The opponent's claim under section 5(4)(a) of the Act is based upon use of the signs corresponding to the earlier registered marks (as detailed above), since 5 April 1996, throughout the UK, in relation to recruitment services in the health and social care sectors. The opponent claims that the use of the applicant's mark would constitute a misrepresentation and damage to its goodwill and use is therefore liable to be prevented under the law of passing off.

5. The opponent's earlier trade mark registrations had not been registered for five years or more on the date on which the opposed application was published. They are not, therefore, subject to proof of genuine use under section 6A of the Act.

6. The applicant denies the grounds of opposition.

7. Both parties are professionally represented. Only the opponent filed evidence. The matter came to be heard on 8 June 2017, by video conference. Mr Malcolm Chapple, of Counsel, instructed by Longmores Solicitors, represented the opponent. Mr Aaron Wood, of Wood IP Limited, represented the applicant.

## **Evidence**

8. The opponent's evidence comes from Richard McBride in the form of two witness statements. The second of these was the subject of an application to file further evidence, which I allowed at the hearing. I will say more about this below.

9. Mr McBride has been a director and the chief financial officer of the opponent since 16 May 2011. He states that he is competent and authorised to make his statement on behalf of the opponent. Some of his evidence is subject to a confidentiality order. This includes confidential paragraphs 6, 7, 8 and part of 17 and associated exhibits RB1, RB2, RB3 and RB11. These refer to activity some twelve to twenty years prior to the relevant date in these proceedings (7 March 2016), so I will not summarise them here but will concentrate on evidence which is nearer in time to the relevant date and which I consider to be more pertinent to the matters I have to decide.

10. Exhibit RB7 is a copy of the opponent's Directors' Report and Accounts for the year ending 2007. I note that, under the heading 'Principal Activity', the report says that the principal activity of the opponent is the provision of staffing services to the UK healthcare sector and that, on 30 July 2007, the opponent changed its name to Match Healthcare Limited to reflect the rebranding of the business under the name of Pulse. Turnover was reported as £34,469,000, with a note explaining that "all turnover relates to flexible staffing and is derived from the United Kingdom except for £10,000 generated in Australia, £47,000 from the Middle East and £10,000 from the Republic of Ireland".

11. I quote here the contents of paragraph 15 of the witness statement because they are relevant to my decision to allow the opponent's further evidence to be admitted to the proceedings (to which I refer later in this decision):

"The Opponent operates across the whole of the United Kingdom, and in 2015 PULSE branded revenue was circa. £253m."

12. Exhibit RB9 contains screen shots from various incarnations of the opponent's website between March 2000 and October 2015. The format of the mark altered twice prior to the form which matches the stylised earlier mark relied upon in these proceedings. However, all the forms of the mark clearly contain the word PULSE, and the home pages refer to "PULSE staffing", "Register with PULSE", "Welcome to PULSE", and "5 good reasons to join PULSE".

13. Exhibit RB16 contains two press releases, both dated 3 July 2006. The press releases say that Pulse is a specialist recruitment agency, working with more than 400 NHS Trusts to provide agency staff, with regional branches around the UK. Exhibit RB18 is a copy of an article from a website called rec-con.co.uk, reporting that the opponent was one of five companies shortlisted as finalists for the best national recruitment agency website in the 2008 National Online Recruitment Awards.

14. Exhibit 21 comprises invoices and timesheets for staff dated 7 April 2010. These are confidential owing to the identification of individuals and their earnings. The invoices are addressed from the opponent to various hospitals and a local authority in

the UK, in respect of pharmacists, doctors, an occupational therapist, a midwife, a theatre nurse, an intensive care nurse and a care worker.

15. Exhibit RB24 comprises copies of archived advertisements and advertorials from 2006, 2007, 2010, 2011, 2012, 2013, 2014 and 2015. The 2006 and 2007 adverts for care workers appeared in the press in Gloucester and south London. The April 2014 advert was aimed at psychiatrists (this shows the stylised earlier mark), and the two adverts from 2015 were for nurses and speech therapists. The 2012 advert indicates that health sector staff from overseas can gain UK employment via PULSE.

16. Confidential Exhibit RB26 comprises a copy of the opponent's response to the Francis Report, which was commissioned by the Mid Staffordshire Foundation Trust Public Enquiry, in 2013.

17. Exhibit RB27 provides copies of email shots which were sent out in the UK in 2016. Mr McBride states that almost two million emails were sent promoting "the brand" in 2016. The relevant date was in March of that year. Exhibit RB28 comprises copies of pages from the opponent's social media websites; these date from 2016 and 2017.

18. Exhibit RB29 comprises copies of specialist recruitment press coverage from 2008, 2009 and 2010. One article, dating from May 2009, reports that the opponent is diversifying into the engineering sector. This is the only exhibit which mentions engineering and it refers to the launch of the engineering division. An article in the 14 April 2010 edition of 'Nursing Standard' says "Pulse, which provides 10,000 agency nursing shifts a week in the UK, told Nursing Standard demand for agency nurses is up 11 per cent on last year." An article dated 28 September 2010 in [recruiter.co.uk](http://recruiter.co.uk) refers to the healthcare staffing market as having an annual revenue estimated at £1billion.

19. The following statement by Mr McBride is relevant to the issue of the request to file further evidence:

“Sales of services under the PULSE mark before the date of filing of application No. 3153492 PULSE MINDSET, namely 7 March 2016, were:

CY2011	£119,443,603
CY2012	£138,095,921
CY2013	£162,928,700
CY2014	£210,587,710
CY2015	£252,518,062
CY2016 F	£192,371,214”

20. Advertising figures, shown in paragraph 19 of Mr McBride’s witness statement, are subject to a confidentiality order. They are substantial and are specified as relating to the UK.

21. Mr McBride states that the opponent has thousands of job adverts running under the Pulse brand on many job sites and job aggregator sites, such as Nursing Agencies List, Reed, Indeed, CV Library and Community Nursing Jobs, as well as on its own website where there were 2,609 job vacancies advertised at the date of Mr McBride’s witness statement (6 January 2017). Some examples from after the relevant date are shown in Exhibit RB31.

22. Mr McBride states that the opponent engages with 1,500 to 2,000 delegates at the annual Royal College of Nursing event, handing out literature about the opponent, examples of which are contained in Exhibit RB32.

The application to file further evidence

23. On 31 May 2017 (about a week prior to the hearing), the applicant made a request to file a second witness statement from Mr McBride, which was dated the same day.

24. The second witness statement is short. The purpose of it was stated to be to clarify an oversight in paragraph 18 of the first statement, whereby the words “in the United Kingdom” were stated to be missing from the statement as to sales, which I have reproduced verbatim in my paragraph 18, above. Mr McBride states:

“For the avoidance of doubt, I can clarify that although the wording in paragraph 18 does not expressly state this, the sale of services figures listed are wholly derived from United Kingdom revenue (as per the reference at paragraph 19) [the advertising figures] and do not include sales derived from Australia, New Zealand, the Middle East, or anywhere else.”

25. Mr Chapple said that the opponent did not want the applicant to submit that the absence of the wording was significant, without the opponent having tried to clarify the matter. He said that the missing wording was an oversight. Mr Wood resisted the application, referring to prejudice to the applicant (for example, in preparing its case for the hearing). Whilst possible prejudice to the applicant must be considered, so too must possible prejudice to the opponent. In making my decision and the directions which followed, I bore in mind *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors [2016] EWHC 3103 (Ch)*, in which Carr J stated:

“In my judgment, the Registrar should primarily consider the following factors when deciding on the admissibility of late evidence, although the weight to be attached to each of them will vary from case to case:

- i) The materiality of the evidence in question to the issues that the Registrar has to determine;
- ii) The justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
- iii) Whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (e.g. excessive delays); and



iv) The fairness to the applicant [in this case the opponent] of excluding the evidence in question, including prejudice to the applicant [opponent] if it is unable to rely on such evidence.”

26. The evidence is material to the issues of reputation and goodwill. The extra work for the applicant can be compensated for in costs. I allowed the evidence to be admitted to the proceedings. I decided that the context provided by other evidence corroborated the figures as more than likely being UK figures. In particular, paragraph 15 of Mr McBride’s first statement (reproduced in paragraph 10 of my decision) states that:

“The Opponent operates across the whole of the United Kingdom, and in 2015 PULSE branded revenue was circa. £253m.”

Mr Wood submitted that this sentence could be read two ways; the other way being that a distinction (represented by the comma) was being made between where the opponent operates, and what its overall revenue is. I think this is reading too much into the sentence structure. I also bear in mind that the 2007 directors’ report which I refer to above states that “all turnover relates to flexible staffing and is derived from the United Kingdom except for £10,000 generated in Australia, £47,000 from the Middle East and £10,000 from the Republic of Ireland”. So there is clearly a way of carving out the UK figures from the overall revenue. However, to meet Mr Wood’s point and to be fair to the applicant, I allowed it 14 days to make a request to cross-examine Mr McBride on this single point, if it wished, and/or to file any evidence and/or submissions in reply to the second witness statement. I received written submissions from the applicant on 13 June 2017, but no evidence or request for cross-examination. The opponent filed submissions in reply on 16 June 2017. I have taken all the submissions into account.

## **Decision**

27. 5(2)(b) of the Act states:

“(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.”

28. 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;

(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.

#### Comparison of goods and services

29. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the Court of Justice of the European Union stated at paragraph 23 of its judgment:

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary.”

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

31. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

32. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

33. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

34. The goods and services to be compared are:

Earlier marks	Application
	<p>Class 9: <i>Electronic publications (downloadable); visual, audio and audio-visual recordings; none of the above being in the fields of health, medicine or medical practice; computer software; downloadable software; magnetic, optical and digital storage media; software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs,</i></p>

<p>Class 35: <i>Recruitment services; outsourcing services [business assistance]; business management assistance; personnel management consultancy.</i></p>	<p><i>developing job holders and job evaluation and personal development.</i></p> <p>Class 16: <i>Printed matter, periodical publications, magazines, brochures, pamphlets, catalogues, newsletters, handbooks; books, lecture notes; product and system operating services and maintenance manuals; instructional and teaching materials; none of the above being in the fields of health, medicine or medical practice; printed matter relating to the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development.</i></p> <p>Class 35: <i>Employment hiring, recruiting, placement, and staffing services; human resources; business management; personnel management; information, advice and consultancy services relating to the aforesaid.</i></p> <p>Class 41: <i>Educational services; conducting training programs, seminars, lectures, conferences, and workshops; conducting training programs, seminars, lectures, conferences, and workshops in the field of recruitment, talent management, organisational</i></p>
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	<p><i>effectiveness and employee performance; publication and distribution of printed matter; publication and distribution of educational materials; non-downloadable publications.</i></p>
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35. The specifications of the two earlier marks are the same. Although the evidence is focussed upon the provision of recruitment services for the healthcare and social care sectors, there is no requirement for proof of genuine use (reputation and goodwill are separate matters). Therefore, for the purposes of the comparison between goods and services for section 5(2)(b), the opponent may rely upon the full width of its specification on the basis of notional and fair use.

Class 35

36. The law requires that goods and services be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's descriptions (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC. Consequently, the applicant's *employment hiring, recruiting, placement, and staffing services* are identical to the opponent's *recruitment services*, and the applicant's *business management* is identical to the opponent's *business management assistance*.

37. *Human resources* is another term for *personnel management*, both of which appear in the applicant's specification. The opponent's specification contains the term *personnel management consultancy*. These are complementary services and they share trade channels with the applicant's services. There is a close connection; if a business outsources its personnel or human resource management, it would expect that personnel management consultancy services are provided by the same undertaking. They are similar to a good degree.

38. The applicant's *information, advice and consultancy services relating to the aforesaid* refer back to all the services in its class 35 specification. As these include

human resources and personnel management, they must be identical to the opponent's *personnel management consultancy*.

### Class 9

39. The applicant's class 9 specification covers both wide terms and terms which are limited to subject matter. Some of the wide terms exclude the fields of health, medicine or medical practice. However, this exclusion has no effect in distancing the goods from the services of the opponent because the opponent's services are not limited to the fields of health, medicine or medical practice. Further, the terms which are limited to subject matter (*software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development*) cover the subject matter of the services covered by the opponent's specification. The users will be the same: businesses looking for personnel, recruitment and business management services and advice. They may obtain this via services, or from software and electronic publications. There is an element of competition. There is also a convergence in trade channels in that personnel consultants may provide software for personnel management (such as recordal of employee information). Software and other recorded media for organisational effectiveness and training share a common purpose, are complementary with and in competition with the opponent's *outsourcing services [business assistance] and business management services*. There is a good degree of similarity between the applicant's specified goods and the opponent's services.

40. It is therefore logical that there is also a good degree of similarity between the opponent's services and the applicant's wide terms *computer software; downloadable software* which cover goods of the same subject matter as that identified later in the applicant's specification: *software, downloadable software... for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development*.



41. For the reasons given above, the exclusion to the applicant's *Electronic publications (downloadable); visual, audio and audio-visual recordings; none of the above being in the fields of health, medicine or medical practice* does not assist because the opponent's services are not limited to these fields of activity. The opponent's services cover all sectors. On the same logic as already applied, there is a good degree of similarity because, for example, the opponent's services could cover the engineering sector, a field which has not been excluded from the subject matter of the applicant's goods.

42. There is no similarity between the opponent's services and the applicant's *magnetic, optical and digital storage media*. These goods are unrecorded; i.e. blank. The opponent has not explained why they are similar. They do not share nature, purpose, method of use, channels of trade and are not in competition or complementary with each other.

#### Class 16

43. The applicant's goods in class 16 include *printed matter relating to the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development*. These are the printed versions of the goods in class 9, which I have already compared to the opponent's class 35 services. There is a good deal of similarity between them.

44. The other goods in the applicant's class 16 specification are subject to the same exclusion already discussed: *printed matter, periodical publications, magazines, brochures, pamphlets, catalogues, newsletters, handbooks; books, lecture notes; product and system operating services and maintenance manuals; instructional and teaching materials; none of the above being in the fields of health, medicine or medical practice*. With the exception of *product and system operating services and maintenance manuals*, the goods cover the same goods as those which have their subject areas limited, as discussed in the previous paragraph. They could all relate to recruitment, business management, and personnel management and be provided as

part of a personnel management consultancy service. There is a good deal of similarity between these goods and the opponent's services.

45. There is no similarity between the opponent's services and the applicant's *product and system operating services and maintenance manuals*. This term is vague and also it includes services, which are not proper to a goods class. The parties' respective services do not appear to share any of the criteria from the authorities cited above.

#### Class 41

46. The applicant's *conducting training programs, seminars, lectures, conferences, and workshops in the field of recruitment, talent management, organisational effectiveness and employee performance* are complementary to the opponents' services. They cover the same subject matter. They share channels of trade and will share the same users, such as businesses looking for external personnel consultancy services and for training in these areas for in-house human resources departments. They are similar to a good degree.

47. By the logic already explained above, these are a subset of the wider terms *educational services; conducting training programs, seminars, lectures, conferences, and workshops; publication and distribution of printed matter*, which could all relate to recruitment, talent management, organisational effectiveness and employee performance. There is a good deal of similarity between these services and the opponent's services.

48. This leaves *publication and distribution of educational materials; non-downloadable publications*. The latter term describes goods and is not proper to this class, in which case I have already covered the level of similarity in class 16 above. *Publication and distribution of educational materials*: these are the services of a publisher. Publication and distribution services do not share the same nature or purpose as recruitment, personnel and business management services. They will not share the same trade channels, they are not in competition and are not complementary. People who are looking for a job or looking to fill a vacancy will not consider publishing services to be a substitute or think that the responsibility for the

services lies with the same undertaking. *Publication and distribution of educational materials* are not similar to the opponent's services.

#### The average consumer and the purchasing process

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

50. The average consumer for recruitment services will be individuals who are job-hunting and businesses who have outsourced their recruitment, e.g. to an employment agency. Individuals are more likely to be interested in the job rather than the recruitment service; they will pay an average degree of attention. Businesses are likely to pay an above average level of attention to the selection of recruitment services because there will be considerations such as the commission rate payable to the service provider. The same is true of the other services in the parties' class 35 specifications, which are business-to-business services.

51. The applicant's goods and its class 41 services cover a wide range of subjects, aimed at individuals and businesses. There will be range in the level of attention paid to selection, but not less than an average level of attention, owing to considerations such as price, content, duration and location (for the services).

52. Whilst I do not discount the potential for an aural aspect to the purchasing process, such as word of mouth recommendation or radio advertisements for recruitment services (e.g. employment agencies), the selection of all the goods and services is likely to be primarily visual. Books, magazines and software will be researched and selected from a website or a shop shelf, and the services will be procured after research on websites, and consideration of marketing material.

#### Comparison of marks

53. 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 CJEU 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.”

54. 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.

55. I will concentrate on the opponent’s word mark, since this is the opponent’s strongest case under section 5(2)(b) (the specifications for both earlier marks being the same and neither being subject to proof of use).

56. The opponent’s mark is:

PULSE

57. The applicant’s mark is:

PULSE

MINDSET

58. The presentation of the later mark on two separate lines emphasises the word PULSE as this is what will be read first. The eye then has to travel to the next line to read the second component in the mark. PULSE is the dominant and distinctive element in the overall impression of the later mark, even though the second word, MINDSET, is two letters longer. The earlier mark consists of the single word PULSE. Its overall impression and its distinctiveness lie in the totality of the mark.

59. Half of the later mark is identical to the earlier mark whilst the other half of the later mark contains an element which is absent from the earlier mark. The marks are visually similar to a medium degree, and also aurally similar to a medium degree as MINDSET is likely to be verbalised.

60. Pulse means the regular beat of blood moving through the heart, or a musical beat, a food such as lentils, or a colloquialism describing anything which is current (e.g. keep your finger on the pulse of popular opinion). The marks both share this word. Mindset means someone's general attitude. The applicant's mark has no overall meaning because the words do not link together. They remain as separate elements with their own meanings. There is a medium level of conceptual similarity owing to the common presence of PULSE.

61. There is a medium level of overall similarity between the parties' marks.

#### Distinctive character of the earlier marks

62. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>1</sup> 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

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<sup>1</sup> Case C-342/97

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 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).”

63. I have given the meanings of PULSE above. The applicant submits that it is low in distinctive character. I do not agree. Even assuming the average consumer for hospital recruitment services might have a particular response to the physiological meaning of pulse, that meaning does not describe or allude to any characteristics of the opponent’s services. PULSE, a dictionary word, has an average degree of distinctive character for the registered services.

64. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. With this in mind, I need to assess whether the use made of the earlier marks has improved the distinctiveness levels to any meaningful degree. The relevant date for this assessment is the application date, 7 March 2016. At that date, UK turnover was substantial, business had been consistently growing since 1996, and the opponent (and its mark) was recognised as a leader in the industry. It had a large chunk of the £1 billion UK healthcare staffing market: some 25% in the year prior to the filing of the applicant’s mark. I do not agree with the applicant that the business is conducted overseas. The opponent, primarily located in the UK, acts as an intermediary or agency between NHS trusts and others in the UK looking to recruit,

whether that is overseas candidates or UK candidates, and those looking for jobs in the healthcare sector. The 2007 directors' report differentiates between turnover generated in the UK, as opposed to that from other countries, which is proportionately much less. It seems very unlikely that the opponent would have been asked to contribute to the Mid Staffordshire Foundation Trust Public Enquiry in 2013 without a significant presence in the relevant UK market.

65. I find that the evidence supports a high level of distinctive character in relation to recruitment services for the health sector. For other sectors, and for the other registered services, it has an average degree of distinctive character.

#### Likelihood of confusion

66. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

67. A likelihood of confusion presupposes that there is some level of similarity between goods and services (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, paragraph 22). I found no similarity between the opponent's services and the following goods and services of the application:

Class 09: *magnetic, optical and digital storage media*

Class 16: *product and system operating services and maintenance manuals*

Class 41: *publication and distribution of educational materials*

68. There is, therefore, no likelihood of confusion; the opposition under section 5(2)(b) fails in relation to these goods and services.

69. In *Bimbo*, the CJEU stated (my emphasis):

“19. As to the merits, according to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Case C-334/05 P *OHIM v Shaker* EU:C:2007:333, paragraph 33, and Case C-193/06 P *Nestlé v OHIM* EU:C:2007:539, paragraph 32).

20. The existence of a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* EU:C:1997:528, paragraph 22; *OHIM v Shaker* EU:C:2007:333, paragraph 34; and *Nestlé v OHIM* EU:C:2007:539, paragraph 33).

21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the



basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37)."

70. In *Deakins*, BL O/421/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

"24. It is not correct to proceed on the basis that an element of a composite mark retains an independent distinctive role if, together with the other component or components of the mark, it *'forms a unit having a different meaning as compared with the meaning of those components taken separately'*: *Bimbo SA v. OHIM* C-591/12P, EU:C:2014:305 at paragraph [25]. And even if a component of a composite mark is found to be sufficiently 'unitary' to retain an independent distinctive role, it still remains necessary for any assessment of '*similarity*' to be made by reference to the composite mark as a whole in the manner summarised in *Bimbo SA* at paragraphs [34] and [35]:

[34] Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, 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.

[35] The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.”

71. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion*. In that case, Arnold J. considered the registrability of a composite word mark - JURA ORIGIN - which included the opponent's earlier trade mark – ORIGIN. The latter was registered for similar goods – wine – to those of the applicant – whisky. The opponent also had an earlier CTM consisting of the word ORIGIN and a device made up of vine leaves. This mark was registered for alcoholic goods at large and therefore covered identical goods to whisky. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark

contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

72. The judge found that the mark JURA ORIGIN formed a unit having a different meaning to those of the individual components. I have found the opposite in these proceedings; PULSE MINDSET does not form a unit having a different meaning to those of the individual words. PULSE retains an independently distinctive role, especially presented above MINDSET.

73. The earlier mark is inherently distinctive to an average degree and highly distinctive for recruitment services in the healthcare sector. As far as the applicant's services in class 35 notionally cover this sector, I think that confusion is certain. It will be of the indirect type, described by Mr Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 (paragraph 17(a) is particularly relevant to these proceedings):

“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:

(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).”

74. I have found that there is a medium overall level of similarity between the marks, and that the goods and services (other than those listed in paragraph 67 of my decision) are either identical or similar to a good degree. Balancing the interdependency principle, the varying levels of attention of average consumers, the distinctiveness of the earlier mark and the visual dominance of PULSE in the overall impression of the later mark, I consider that there will be a likelihood of indirect confusion in relation to the rest of the applicant’s goods and services. The opposition under section 5(2)(b) succeeds in relation to:

*Class 9: Electronic publications (downloadable); visual, audio and audio-visual recordings; none of the above being in the fields of health, medicine or medical practice; computer software; downloadable software; software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development.*

*Class 16: Printed matter, periodical publications, magazines, brochures, pamphlets, catalogues, newsletters, handbooks; books, lecture notes; instructional and teaching materials; none of the above being in the fields of health, medicine or medical practice; printed matter relating to the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development.*

*Class 35: Employment hiring, recruiting, placement, and staffing services; human resources; business management; personnel management; information, advice and consultancy services relating to the aforesaid.*

*Class 41: Educational services; conducting training programs, seminars, lectures, conferences, and workshops; conducting training programs, seminars, lectures,*

*conferences, and workshops in the field of recruitment, talent management, organisational effectiveness and employee performance; publication and distribution of printed matter; non-downloadable publications.*

75. The opposition fails under section 5(2)(b) in relation to:

Class 9: *magnetic, optical and digital storage media;*

Class 16: *product and system operating services and maintenance manuals;*

Class 41: *publication and distribution of educational materials.*

### **Section 5(3) of the Act**

76. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

77. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

78. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

79. The first condition is reputation. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the



product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

80. As the opponent has been successful against the majority of the goods and services under section 5(2)(b) of the Act, I will restrict my assessment under section 5(3) to the goods and services for which the opponent was unsuccessful under section 5(2)(b).

81. When I assessed the distinctive character of the earlier marks under section 5(2)(b) of the Act, I said that the evidence was sufficient to find that the inherent distinctive character of PULSE had been enhanced through use, but only in relation to recruitment services for the healthcare sector. For the reasons I gave earlier, I find that the evidence is sufficient to support a claim to a *General Motors* standard of reputation, but only in relation to this narrow area.

82. The second requirement is that the relevant public will make a link between the marks. Although I have found that there is no likelihood of confusion against *magnetic, optical and digital storage media; product and system operating services and maintenance manuals; and publication and distribution of educational materials*, no

likelihood of confusion does not preclude a link, as stated by the CJEU in *Ferrero SpA v OHIM*, Case C-552/09 P:

“53 It is true that those provisions differ in terms of the degree of similarity required. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue such that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) may be the consequence of a lesser degree of similarity between the earlier and later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see, to that effect, *Adidas-Salomon and Adidas Benelux*, paragraphs 27, 29 and 31, and *Intel Corporation*, paragraphs 57, 58 and 66).

54 On the other hand, it is not apparent either from the wording of those provisions or from the case-law that the similarity between the marks at issue must be assessed in a different way, according to whether the assessment is carried out under Article 8(1)(b) of Regulation No 40/94 or under Article 8(5).”

83. In my view, no link would be made between mark(s) with a reputation attached to recruitment services for the health sector and the application in relation to the surviving goods and services. There is too much distance between the respective goods and services. Even if the marks were brought to mind, it would be too fleeting a link to have the effects envisaged in the three heads of damage. There would be no link strong enough to convey any advantage to the applicant or to cause any detriment to the opponent. The section 5(3) ground fails.

#### **Section 5(4)(a) of the Act**

84. Section 5(4)(a) states:

“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)...

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.”

85. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury’s Laws of England* 4th Ed. as being that:

i) the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant’s goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant’s misrepresentation.

86. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is

doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

87. As for section 5(3), I will confine my analysis to the goods and services which have survived the section 5(2)(b) and 5(3) grounds: *magnetic, optical and digital storage media; product and system operating services and maintenance manuals; and publication and distribution of educational materials*. Section 5(4)(a) does not appear to take the opponent any further forward for the reasons identified earlier in this decision in relation to the section 5(2)(b) ground. There is no reason why customers of the opponent's recruitment services for the health sector, which is where the goodwill lies, would be deceived into buying *magnetic, optical and digital storage media; product and system operating services and maintenance manuals; and publication and distribution of educational materials*, believing these goods and services to emanate from the opponent. The section 5(4)(a) ground fails.

### **Overall outcome**

88. The opposition succeeds in relation to:

Class 9: *Electronic publications (downloadable); visual, audio and audio-visual recordings; none of the above being in the fields of health, medicine or medical practice; computer software; downloadable software; software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development.*

Class 16: *Printed matter, periodical publications, magazines, brochures, pamphlets, catalogues, newsletters, handbooks; books, lecture notes; instructional and teaching materials; none of the above being in the fields of health, medicine or medical practice; printed matter relating to the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development.*

Class 35: *Employment hiring, recruiting, placement, and staffing services; human resources; business management; personnel management; information, advice and consultancy services relating to the aforesaid.*

Class 41: *Educational services; conducting training programs, seminars, lectures, conferences, and workshops; conducting training programs, seminars, lectures, conferences, and workshops in the field of recruitment, talent management, organisational effectiveness and employee performance; publication and distribution of printed matter; non-downloadable publications.*

The application will be refused for these goods and services.

89. The opposition fails in relation to:

Class 9: *magnetic, optical and digital storage media;*

Class 16: *product and system operating services and maintenance manuals;*

Class 41: *publication and distribution of educational materials.*

The application may proceed to registration for these goods and services.

## **Costs**

90. The opponent has been largely successful and is entitled to a contribution towards its costs, based upon the scale of costs (the scale in Tribunal Practice Notice 2/2016 applies). I will make a reduction to take account of the goods and services for which the opposition failed and also for the extra work caused to the applicant by the opponent's late evidence. The award breakdown is as follows:

Opposition fee	£200
Preparing a statement and considering the applicant's statement	£300

Preparing evidence	£700
Preparing for and attending the hearing	£600
Less 15%	-£270
<b>Total</b>	<b>£1530</b>

91. I order Hudson Global, Inc to pay Pulse Healthcare Limited the sum of £1530 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

**Dated this 05<sup>th</sup> day of October 2017**

**Judi Pike**  
**For the Registrar,**  
**the Comptroller-General**