

O-581-18

TRADE MARKS ACT 1994

IN THE MATTER OF FIVE APPLICATIONS BY MANPOWER DIRECT (UK) LTD.
TO REGISTER No 3164900:



IN CLASSES 37 AND 45:

AND No 3164894:

Manpower Direct Security

IN CLASSES 37 AND 45:

AND No 3164898:

Manpower Security

IN CLASSES 37 AND 45:

AND No 3193781:



IN CLASSES 37 AND 45:

AND No 3164895:

Manpower Direct

IN CLASSES 37 AND 45

AND OPPOSITIONS THERETO UNDER NOS 407382, 407384,
407386, 408222 AND 407383 BY MANPOWERGROUP INC.

BACKGROUND

1. Manpower Direct (UK) Ltd (the applicant) applied to register the five trade marks on the cover page of this decision. The relevant dates and classes¹ for which registration is sought are as follows:

UKTM: 3164900



Applied for on: 16 May 2016

Published on: 17 June 2016

Classes: 37 and 45

UKTM: 3164894

Manpower Direct Security

Applied for on: 16 May 2016

Published on: 17 June 2016

Classes: 37 and 45

UKTM: 3164898

Manpower Security

Applied for on: 16 May 2016

Published on: 29 July 2016

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

Classes: 37 and 45

UKTM: 3193781



Applied for on: 28 October 2016

Published on: 11 November 2016

Classes: 37 and 45

UKTM: 3164895

Manpower Direct

Applied for on: 16 May 2016

Published on: 17 June 2016

Classes: 37 and 45

2. All five trade marks stand registered for the following services:

Class 37

CCTV installation.

Class 45

Security services for the protection of property and individuals, manned guarding, parking security and management, mobile security controls, events & security management, security control room services, security access control services, door supervisors (managing clubs and bars), barrier & gatehouse security, rail track security patrolling, security foot patrolling, security stewarding and security services for vacant property, CCTV monitoring, key holding and alarm response and lock and unlock services.

3. Following publication of each of the marks ManpowerGroup Inc (the opponent) filed notices of opposition against all of the services in all of the applications.

4. The opponent bases its case on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (the Act). Under sections 5(2)(b) and 5(3) the opponent relies upon the following two trade marks:

Mark details and relevant dates	Goods and services for which the marks are registered
<p>EUTM: 76059</p> <p style="text-align: center;">MANPOWER</p> <p>Filed: 1 April 1996</p> <p>Registered: 13 January 2000</p>	<p>Class 9 Audio cassettes; audio-visual teaching apparatus; audio compact discs; video compact discs; computer software; computer programs; tape recorders; video tapes; video recorders; parts and fittings for all the aforesaid goods.</p> <p>Class 16 Books; printed matter; handbooks; manuals; magazines; printed publications; transparencies; instructional materials; teaching materials; parts and fittings for all the aforesaid goods.</p> <p>Class 35 Employment agency services; temporary personnel services.</p> <p>Class 41 Arranging and conducting of conferences and seminars; rental of movie projectors and accessories; rental of video recordings, audio recordings and cine-films; organisation of exhibitions; production of video and audio tapes; educational, instructional, teaching and training services, all relating to the tuition and assessment of office, industrial, driving and technical staff; information and advisory services, all relating to the foregoing.</p> <p>Class 42 Professional consultancy and expert services, all relating to personnel vocational testing and guidance, personality testing, psychological examination and career advice; personality and psychological testing services; career and vocational counselling; testing individuals to determine employment skills; occupational</p>

	psychology services; computer software design and development; consultancy services relating to the assessment, development and application of human resources; provision of temporary accommodation; information and advisory services and preparation of reports, all relating to the aforesaid; catering services.
<p>UKTM: 1556077</p> <p>MANPOWER</p> <p>Filed: 8 December 1993</p> <p>Registered: 8 September 1995</p>	<p>Class 35: Provision of temporary staff; recruitment of staff for temporary employment; all included in class 35.</p>

5. In its skeleton argument the opponent encapsulates its position with regard to each of its oppositions under section 5(2)(b) of the Act. It submits (as written):

28. The likelihood of indirect confusion – that consumers will recognise the difference between the marks but will assume because of the similarities that the Opponent has opened a specialist security arm – it is submitted very clear, bearing in mind the high degree of similarity between the marks and the very strong reputation of the earlier marks. A specialist arm consisting of the supply of temporary security personnel, is precisely the kind of specialist arm that a business such as the Opponent’s might be expected to set up.

29. There is a likelihood of direct confusion too. In aural use (and on occasion in written usage) the signs the subject of the application in suit are inherently likely to be abbreviated to (simply) MANPOWER, on some occasions at least...”

6. With regard to the opposition under section 5(3), the opponent submits that the opponent has the necessary reputation to engage its claim under this ground and concludes:²

“48. In view of the strength of the reputation of the earlier marks and the high degree of similarity of the marks to be compared, it is submitted that the average consumer will make the necessary link, even in relation to dissimilar goods and services within the Applications, alternatively in relation to all similar goods and services.

...

50. It is submitted that there are ample grounds here for concluding that the objective effect of the use of the marks applied for would take unfair advantage of the substantial reputation of the earlier marks.”

7. The opponent also claims detriment to the reputation and distinctive character of its earlier marks:³

“Customer perception of the Opponent’s mark may be tarnished if services provided by the Applicant, which are not subject to the Opponent’s quality control and careful management, are associated with the Opponent and its well-known MANPOWER brand...

In addition to causing confusion amongst customers, free riding on the Opponent brand's reputation and damaging the reputation of the Opponent's mark, the use of the [Applicant's marks] in relation to the various services applied for will erode the distinctive quality and uniqueness of the Opponent's MANPOWER brand. The use of the [Applicant's Marks] by the Applicant will dilute the distinctive character of the earlier mark by reducing the ability of the earlier mark to identify the goods and services provided by the Opponent. This will affect the economic behaviour of the relevant customers who will be less able to ascertain the origin of goods

² See the opponent’s skeleton argument, pages 10 and 11.

³ The wording in each of the five notices of opposition is the same in respect of this part of the opponent’s statement of case.

and/or services provided under or by reference to the earlier mark. If the brand's distinctiveness is eroded, it will also lose its attractive quality. Thus, the association with the Applicant's services and with the mark applied for will be detrimental to the distinctive quality of the Opponent's famous MANPOWER brand."

8. For the purposes of its oppositions under section 5(4)(a) of the Act, the opponent relies upon the sign MANPOWER which it claims to have used throughout the UK since 1956 for the following:

"A wide range of human resources and other business services, including employment placement, both in temporary and permanent employment, recruitment services, consultancy services, management services, business administration, training of personnel, leadership development, talent assessment services, employment counselling services, career management services, employment outplacement services, accounting and internal business audit services, business investigation services, business advice and information services, educational and training services, computer software and other technical goods and services, recorded media, literature and other materials relating to human resources, business services, staff training, and employment agency services and all other goods and services specified in the Opponent's registered trade marks."

9. In its notices of opposition it submits:⁴

"The Opponent has developed significant goodwill in the MANPOWER brand in the United Kingdom, EU and throughout the world having operated under the MANPOWER brand since 1948. The Opponent places approximately 50,000 people per year in temporary or permanent employment and generates an annual revenue of approximately £1.4

⁴ *The wording in each of the opponent's pleadings under s.5(4)(a) is the same, save for the reference to the specific mark applied for in each case. To avoid duplication, I have replaced the specific reference with the term, 'Applicant's marks' to reflect the claim in all five of the cases at issue.*

billion. More specifically in relation to the United Kingdom, the Opponent has conducted business in the United Kingdom for over 58 years and currently operates through approximately 60 branches across England, Wales, Scotland and Northern Ireland.

The use by the Applicant of the mark[s] applied for will constitute a misrepresentation to the public who would be led to believe that the Applicant's services are those of the Opponent, or that those services are associated with the Opponent. Customers are likely to be deceived to believe that the [Applicant's marks are] a variant of the MANPOWER mark focusing on the provision of security services and related to the Opponent's famous brand.

The misrepresentation will cause harm to the Opponent's reputation and to the value and attractive power of its goodwill and will cause damage to the Opponent's business thereby constituting passing off against the Opponent.”

10. The oppositions initially included a s.3(6) ground on the basis that the applicant had no intention to use its marks in respect of some of its goods and services, such as 'tarot reading services'. At the hearing, the applicant confirmed that some of the goods and services had been included in error and had since been removed.⁵ Consequently, the opponent elected not to continue with the bad faith ground.

11. The applicant filed counterstatements in which it denies the opponent's claims under all of the pleaded grounds. In each of the five cases when asked if the applicant required the opponent to provide proof of use the applicant wrote:

“In relation to trade mark number 76059 held by the Opponent, the Applicant seeks proof of use relating to class 35 (Employment agency services; temporary personnel services), specifically limited to the provision

⁵ TM21b forms, dated 20 July 2016, were filed in respect of all five applications to remove class 9 and limit class 45.

before 17 May 2016 of providing the relevant services of a security nature to the security sector.”

12. The applicant summarised its position in respect of all of the grounds pleaded by the opponent in its skeleton argument:

“5. As already set out in its amended submissions dated 19 July 2017, the arguments of Manpower Direct UK, the Applicant, are as follows:

a. There is not a likelihood of confusion on the part of the public, by reason of any similarity to an earlier trade mark which is protected for similar goods or services for those for which the trade mark is to be registered within the test under s.5(2)(b) of the Trade Marks Act 1994 (“TMA 1994”).

b. There is no prospect of detriment to the reputation of the Manpower Group.

c. Any claim of passing off is subject to estoppel, laches or waiver.

d. Manpower Direct UK’s application for the mark has been in good faith.”

13. In addition, the applicant relies on honest concurrent use of its marks for the last 13 years. In its counterstatement it submits:

“14. The Applicant has been using the word, ‘Manpower’ in its company name for the last 13 years and its company log [sic] for a long period. Indeed, the Opponent has known about the said use for at least 8 years and, between 2008, when it wrote a letter, and 10 May 2016 when it wrote another letter, has done nothing to prevent the Applicant from continuing to use and to grow its business in the security industry, receiving industry and national recognition...”

14. Both sides filed evidence, submissions and skeleton arguments. A hearing subsequently took place before me, by video conference. The opponent was represented by Mr Alan Bryson of Counsel, instructed by Dorsey & Whitney (Europe)

LLP. The applicant was represented by Mr Noel Dilworth of Counsel, instructed by Harris da Silva.

15. Both sides seek an award of costs.

EVIDENCE

Opponent's evidence in chief

Witness statement by Alina Hancorn, dated 29 March 2017 and exhibits AH1-AH6

16. Ms Hancorn is an investigator at Bishop IP Investigations Limited where she has been employed since February 2014. She provides details of a telephone conversation with the applicant's operations manager which I will return to later in this decision.

17. At exhibit AH5 Ms Hancorn provides a print of a photograph from the applicant's *facebook* page showing a member of security staff wearing a jacket with the word MANPOWER on the back of it, as shown below:



18. Mr Whitham is the Commercial Director of Manpower UK Limited, an indirect subsidiary of the opponent and the operating company of the Manpower business in the UK. He has been employed by Manpower since 2005. He describes the opponent's business in the following terms:

"8. The Opponent is a global business in the field of human resources and other business services, including employment placement, both in temporary and permanent employment, recruitment services, management services, business administration, training of personnel, employment agency services and other business activities ('Services').

9. The Opponent operates under its main brand name and trading name 'MANPOWER' throughout the world, including in the United Kingdom ('UK').

10. The Opponent's business was established in the United States in 1948 and it has been operating in the UK, and across the European Union ("EU"), since 1956. It is now one of the world's leading human resources businesses.

11. The Opponent provides access to its Services through offices located globally and through its significant online presence, which includes several websites.

...

26. Since my Company began trading in the UK 60 years ago, and since then as it developed its business across the EU, it has always operated under the brand name MANPOWER and has been trading continuously. The Manpower business and the MANPOWER brand have, as a result, become extremely well-known and built up an established reputation across the UK and across all of the rest of the EU.

...

29. *As at today's date, my Company operates approximately 3,000 MANPOWER branded offices in 80 countries worldwide all branded under the MANPOWER trade mark and all trading as 'Manpower'.*

30. *My Company carries on business and operates branch offices trading under the MANPOWER trade mark in the following EU member states: Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom."*

19. Mr Whitham provides a list of 69 offices, located throughout the UK, which he submits all trade under the MANPOWER trade mark.⁶ In addition, the opponent operates through, *"onsite teams' embedded at client sites."*

20. A page printed from the opponent's website, www.manpower.co.uk, describes the 'onsite teams' as follows:⁷

"We partner with the likes of BT and Jaguar Land Rover to implement multi-skilled workforce solutions. Every year our onsite teams alone manage over 25,000 people who are working on assignment with our clients, so we are skilled at identifying potential areas to add value and driving organisational performance."

The nature of the opponent's business

21. In his witness statement, Mr Whitham describes the services provided by the opponent:

"44. Manpower's main business is in recruitment and in the supply of temporary and permanent workers to its clients, which are businesses,

⁶ See exhibit DW10.

⁷ See exhibit DW11.

public authorities and other organisations. My Company supplies workers to its clients covering a wide range of job categories, some of the main ones being the following...⁸

- *Administrative workers and business support*
- *Apprenticeships*
- *Executive appointments*
- *Driving and logistics*
- *Finance and banking*
- *Manufacturing and production*
- *Public sector*
- *Sales and customer service*
- *Trades and engineering*

46. Among other types of roles, my Company supplies customers with security personnel, security advisers and various other workers in security roles. For example, a search for 'security' roles on my Company's website on www.manpower.co.uk carried out on 23 February 2017 resulted with 193 jobs related to 'security'."

22. In support of this statement a page is provided from the opponent's website, www.manpower.co.uk.⁹ It is not dated. The following mark is shown at the top of the page:



23. The first line reads: "Found 193 jobs using the term 'security'." Two jobs are shown, the first is for, 'Document Security Administrators' and the second is for a 'Head of Information Security'.

24. In addition, Mr Whitham submits:

⁸ *The list of the opponent's 'specialist expertise' services is also shown in exhibit DW21 on a page printed from the opponent's website.*

⁹ *See exhibit DW22.*

“47. More specifically, as an example, between November 2015 and January 2016 Manpower supplied 100 security guards to Securitas (a security firm) in Belgium. Manpower also arranged training to ensure that the candidates met the standards required of security guards under applicable Belgian laws.¹⁰

Relevant pages from my Company's proposal to Securitas for the supply of the security guards and sample invoices (including English translations of these pages) are at Tab DW37 of the Exhibits Bundle.”

25. Mr Whitham provides details of the number of placements made in the UK each year in the following terms:

48...In the UK alone, Manpower helps to place 30,000 job seekers into temporary assignments each year (with an average of 50,000 placements per annum) and places 3,000 individuals per year in permanent jobs.

49. Specifically, in the calendar year 2016, Manpower UK placed workers in 55,712 temporary employment roles and placed employees in 3,045 permanent employment positions. Over that period, Manpower UK provided its services to about 2,500 different corporate customers, private sector organisations and other clients in the UK.

26. He provides a ‘small sample list’ of some of his Company's UK clients:

- Department for International Development;*
- Devon Partnership NHS Trust;*
- Glenmorangie PLC;*
- Lidl;*
- West Sussex County Council;*
- Dropbox;*
- EDF Energy;*

¹⁰ Translations of pages of the proposal with Securitas and samples of invoices are provided at exhibit DW37.

- Ford;
- Royal Mail;
- Sky;
- Talk Talk;
- Unilever;
- American Express; and
- BT.”¹¹

The opponent’s turnover and market share

27. Mr Whitham submits the following with regard to turnover:

“51. Over the years, my Company has grown into a business generating a global turnover of approximately US\$20 billion per annum and the MANPOWER brand has developed a significant presence in the market and extensive reputation among organisations, individual jobseekers and the public.”

28. At paragraphs 52 and 53 of his statement he provides the following turnover figures, showing gross revenues (turnover) for each of the last few years, as follows:

Year-end date:	Manpower UK Limited UK turnover	ManpowerGroup Europe turnover
31 December 2015	£833 million	\$12.325 billion
31 December 2014	£768 million	\$13.558 billion
31 December 2013	£682 million	\$12.976 billion
31 December 2012	£698 million	\$13.025 billion
31 December 2011	£635 million	\$14.371 billion
31 December 2010	£571 million	Not provided

¹¹ See paragraph 50 of Mr Whitham’s first witness statement.

29. These figures are supported by excerpt copies of the audited annual accounts of Manpower UK Limited and ManpowerGroup.¹²

30. Mr Whitham provides additional information regarding the opponent's business in 2003 when the applicant adopted the name Manpower Direct (UK) Ltd:

*"59. MANPOWER was already a very established business and brand name in the UK, achieving a turnover of £489 million in the year ending 31 December 2003 and £504 million in the year ending 31 December 2002."*¹³

31. With regard to the opponent's market share, Mr Whitham provides an article taken from www.onrec.com, 'the online recruitment resource'. It is dated 19 August 2015 and is titled, 'Adecco, Manpower and Randstad the largest staffing firms in the world'.¹⁴

"Adecco has for a few years now been allowed to call itself the largest staffing firm in the world, while Manpower this year took the number two position from Randstad finds research by Vactures.nl which compared the end of year revenue figures of the largest staffing players in the world."

32. Mr Whitham provides prints of recruitment industry reports issued by Agile Intelligence.¹⁵ "The reports track the financial performance of Manpower UK as one of the major industry players in the recruitment industry". They track monthly variations in sales figures in the public and private sectors. Manpower UK is referred to in both reports provided.

33. Mr Whitham submits that the opponent uses its mark on signage outside the company's offices, on posters, promotional material and point of sale material. The following examples are provided by the opponent, though none of them is dated.

¹² See exhibit DW23 and DW24 showing total revenues from services for the UK and Europe (arrived at by adding the figures for Southern and Northern Europe).

¹³ Audited accounts of Manpower UK Ltd are provided at exhibit DW25 in support of these figures.

¹⁴ See exhibit DW34.

¹⁵ See exhibit DW35.

34. Use on the opponent's offices takes the following form:¹⁶



35. Use on the opponent's website and case studies is shown as follows:¹⁷



36. Use of the mark on point of sale material is shown as follows:¹⁸



¹⁶ See exhibit DW12.

¹⁷ See exhibits DW14 and DW15.

¹⁸ See exhibit DW13.

Websites and social media

37. Mr Whitham states that the opponent has two UK websites, www.manpower.co.uk and www.manpowergroup.co.uk. It also uses an address for the EU, www.manpowergroup.com/wps/connect/right-uk-en/home. These websites are used to advertise the opponent's employment agency services and include extensive use of the MANPOWER brand name. The opponent also operates 48 country specific websites throughout the EU, *'promoting the MANPOWER brand in each of these countries'*.

38. The front page of the opponent's website includes a job search function:¹⁹



39. Underneath the search function are sections titled, 'Work for Us', 'Featured employers' and 'UK employment outlook'.

40. Other pages show the range of services offered by the opponent,²⁰ which include temporary resourcing, permanent placements, temp-to-perm placements and apprenticeships. The section headed 'Apprenticeships' reads:

"Approved by the National Apprenticeship Service, we directly employ thousands of apprentices who work for our clients. They work for you, but they're employed by us, with their training funded by the government..."

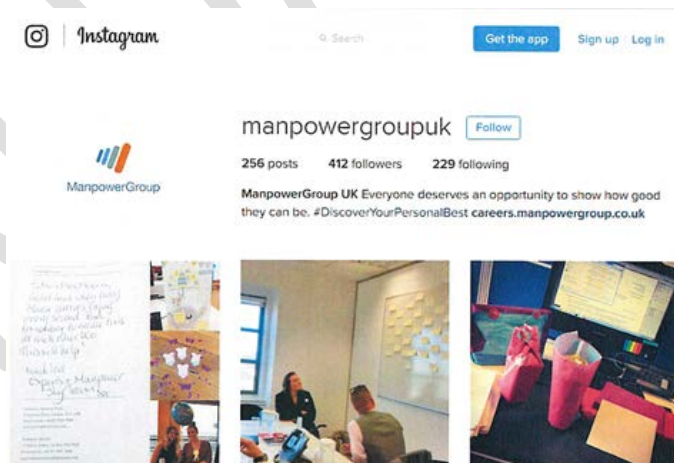
¹⁹ See exhibit DW19

²⁰ See exhibit DW20.

41. The opponent maintains accounts on social media services including *Twitter*, *Facebook*, *LinkedIn* and *Instagram*, on which it promotes the MANPOWER business. The front page of its Twitter account is shown as follows:



42. All of the social media pages were printed after the relevant dates (contemporary with Mr Whitham’s witness statement) and show the same mark as that depicted in the example above. Text in the left column shows that the opponent joined *Twitter* in March 2011. The only variation is the opponent’s *Instagram* account which is a Manpowergroupuk account and appears as follows:



43. Mr Whitham submits:

“39. The average monthly impressions across all of Manpower's social media channels during the second half of 2016 was approximately

1,852,077 impressions per month. In this context, 'Impressions' refers to the total number of times a Manpower post or content feed was displayed on a user's feed (on a smart phone or computer), whether or not they engaged with it."

Press coverage

44. A sample of 'recent press articles' featuring the opponent includes:²¹

- An article from The Guardian, titled, 'British workers want flexible working – but only 6% of job ads offer it'. It is dated 9 June 2015. The third paragraph of the article reads:

"The findings coincide with a separate report from the recruiters Manpower Group, which warns of a 'critical shortfall' of qualified workers."

- An article from The Guardian, titled, 'Corporate initiative can play a major role in anti-trafficking movement'. It is dated 3 April 2013. The article concerns the Global Business Coalition Against Human Trafficking (GBCAT) and includes the following:

"The GBCAT is a business-only coalition that counts some of the world's largest corporations among its founders, including Coca-Cola, ExxonMobil, Ford, Microsoft and ManpowerGroup. Collectively, they pack a serious punch."

- An article from The Guardian, titled, 'UK needs plumbers, builders and engineers as skills crisis hits economy.' It is dated 10 February 2015. The third paragraph reads:

²¹ See exhibit DW31

“The construction industry, a key economic driver, has been particularly hard hit. It accounts for about 7% of GDP and a survey by the recruitment consultant Manpower recently revealed that the outlook for the sector was at its strongest level since 2007.”

45. Mr Whitham provides a copy of a report by Brunswick (a public relations agency) dated 14 June 2016.²² It provides a summary of press references to MANPOWER in the previous three months. There were 26 references to the opponent in six national newspapers and magazines and twenty regional newspapers, including *The Guardian*, *The Daily Mirror* and *The Daily Telegraph*.

46. The opponent has won several industry awards including ‘Best National Recruitment Agency’ from The National Online Recruitment Awards (NORA) 2015 and ‘Top 25 Socially Engaged Companies in the Recruitment Industry’ – LinkedIn 2015.

Applicant’s evidence in chief

Witness statement by Philippe Alain

47. Mr Alain’s statement is dated 20 July 2017. He is the applicant’s operations manager. His statement is made in response to that of the opponent’s witness Alina Hancorn.

Witness statement by Sharjeel Bhatti and exhibits SB1-SB27

48. Mr Bhatti is the managing director of the applicant. His statement is dated 20 July 2017.

49. The first part of Mr Bhatti’s statement is concerned with company name registrations and the categories which companies identify when registering their names. This is not relevant to this case, which is determined under the Trade Marks Act and I do not intend to summarise this part of the applicant’s evidence.

²² See exhibit DW32.

50. The main points arising from Mr Bhatti's evidence regarding the applicant's business are as follows:

On 9 January 2003 – incorporated Elegance Securities (UK) Ltd.

On 30 July 2003 – re-named company to Manpower Direct (UK) Ltd.

51. Mr Bhatti provides the following explanation for the change of company name (as written):

“The decision to rename the company was made to give our services a more colloquial name. The word 'Manpower' has connotations of a powerful man and is a play on words with regards to the workforce services we provide. The word 'direct' is used to draw attention our position as a supplier i.e. the security services are provided directly to the end client. It was in no way influenced by the Opponent who was not and is still not established in the security services industry. Our company logos were also designed to conveying a powerful/strong safe trusted man and accordingly depict a bodyguard, the epitome of security services.”

52. On 12 July 2006 the applicant purchased the domain name 'manpowerdirect.co.uk'.

53. The opponent's website describes its services as follows:²³

“The company 'specialises in providing high quality professional, reliable and cost-effective security guarding services to retail, corporate and healthcare clients as well as to the public sector and industrial organisations.”

54. REDACTED.

²³ See exhibit SB4.

55. In 2008 the applicant received a certificate from the Sunday Times Fast Track 100, ranking it eighth in Britain's private companies with the fastest growing sales.²⁴

56. Mr Bhatti submits that the applicant is, "*registered for alerts with the Tenders-Direct website*".²⁵

57. Examples of tenders and contracts have been provided. These include central and local government contracts as well as those with private organisations.²⁶

58. Mr Bhatti submits:

"Our clients have extremely niche requirements and are aware of our competitors within the industry. The contracts we are awarded are large and primarily with local authorities or large retailers. It follows that we are awarded tenders on the basis of our reputation within the security industry. An association with ManpowerGroup, an employment agency, would be of no advantage when making tenders. Our clients are intelligent and know what they are looking for and would not be confused."

59. With regard to security services, Mr Bhatti submits:

"15. In order to provide security services a company must be approved by the SIA and the directors must have at least a "non-front line licence", or with our Company we have front line licence issued by SIA. The individual guards must also have a licence of varying degrees/level depending on the type of security work. E.g. (1) Door supervisor licence (2) Cash in transit (3) Close Protection i.e. personal bodyguard (4) CCVT Licence or (5) SIA Security Guard licence..."

²⁴ See exhibit SB10.

²⁵ See exhibit SB18.

²⁶ See exhibit SB19.

60. A list of the applicant's security licences and memberships of industry organisations is provided.²⁷ Mr Bhatti concludes:

“16. As such my company has all the required qualifications in the industry that it serves. In contrast I do not see a single certificate exhibited by the Opponent in the security industry. This is irrefutable evidence (by omission) that the Opponent does not and cannot provide security services in the UK since it is not authorised to do so.”

61. The remainder of Mr Bhatti's statement is made up of submissions relating to the merits of the parties' cases under each ground. I will refer to these as necessary throughout this decision.

Opponent's evidence in reply

Second witness statement by Alina Hancorn and exhibit AH7

62. Ms Hancorn's second statement is made in response to Mr Alain's statement, regarding their telephone conversation and provides further details concerning the way in which her investigations were conducted.

Second witness statement by Damien Whitham and exhibits DW38 and DW39

63. In his second statement Mr Whitham reiterates his position with regard to the supply of security guards by his company. He submits:

“16. As described in my first witness statement at paragraph 44, Manpower supplies temporary and permanent workers to clients for a wide range of job categories, from administrative workers, drivers, logistics workers, sales and IT staff through to finance workers, public sector workers and executive appointments. At paragraph 46 of my first statement (and by reference to the documents at Exhibit DW22) I mentioned that Manpower supplies workers for hundreds of specific 'security' roles. No doubt, some of these roles are IT security positions (as suggested by Mr Bhatti in his statement)

²⁷ See exhibits SB12 – SB17.

but Manpower also supplies security guards to its clients, much the same as the Applicant.

17. At paragraph 47 of my first statement (and in response to the Applicant's request that the Opponent provide proof of use of the MANPOWER mark, EU76059, in relation to the supply of security guards to clients) I referred to a contract for the supply of security guards to Securitas in Belgium.

18. As evident from Exhibit DW37 to my first witness statement, the security guards who were supplied to Securitas were supplied as Manpower employees. I refer to pages 2 and 3 of the Exhibit (pages 10 and 11 of the original document entitled "Proposition de Colaboration - Manpower & Securitas") in its English translation, where it is clearly stated that the charges to be invoiced to the client included the salary of the temporary workers, social security costs, holiday allowance etc. At page 3 of the Exhibit, it is also stated that in the event that Securitas recruits any of the security guards, it will be charged a referral fee. Accordingly, both models were envisaged in the contract proposal, depending on whether the client would choose to recruit any of the workers as its own employees. As evident from the sample invoices to Securitas contained in Exhibit DW37, Securitas was charged by the hour for the supply of the security guards, with added charges for pension premium, travel expenses etc. (see pages 6, 8, 10, 12, 14, 17 and 18 of the English translation).

19. In his witness statement, on page 13, sub-paragraph c., Mr Bhatti explains that the security guards supplied by the Applicant are employed by the Applicant which provides 'security services' to its client. As Mr Bhatti explains, these services consist of the supply of security guards to the client.

20. It is clear to me, therefore, that the service offered by the Applicant under the name 'Manpower Direct UK Ltd' and under the MANPOWER DIRECT mark, which is essentially the supply of security guards to clients on a temporary basis, is very similar to the services provided by my

Company as supplier of temporary workers to clients, and identical to my Company's services where my Company supplies temporary staff to clients for similar types of roles, such as security guards, other security personnel or for roles such as drivers, logistics staff and administrative workers."

Additional evidence

64. On 3 November 2017 the opponent submitted a request to file further evidence relating to 'a recent incident of actual confusion'. The request was allowed and on 3 November 2017 the opponent filed a witness statement by Chris Gray, dated 31 October 2017 with one exhibit comprising a copy of an email exchange between him and a customer, which took place on 19 October 2017. Confidentiality was requested for this statement and exhibit. The applicant objected to its admission but proceeded to file a second witness statement by Mr Bhatti in reply to it which was dated 21 November 2017. On 29 November 2017 the opponent filed a further witness statement in response to that of Mr Bhatti, on the basis that Mr Bhatti's second statement went far beyond responding to the additional evidence filed by the opponent. It was a statement by Alina Hancorn and was dated 29 November 2017. I notified the parties that the matter would be determined at the beginning of the hearing.

65. In reaching a finding I referred to the most recent guidance concerning the relevant factors for determining a request to file additional evidence which can be found in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors.*²⁸ These factors can also be found in the Manual of Trade Marks Practice in section 4.8.5, which reads:

"A party may ask to file additional evidence. The Tribunal will consider the reasons for the request, the nature of the evidence and the views of the other party. In considering a request to file additional evidence, the Tribunal will primarily consider the following:

²⁸ [2016] EWHC 3103

- The materiality of the evidence in question to the issues that the Registrar has to determine;
- 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;
- 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
- The fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.”

66. The request was made by the opponent in a timely manner. The incident to which the evidence relates occurred 15 days prior to the request to file the additional evidence. It is material to the matter to be decided and any prejudice to the applicant can be addressed by providing an opportunity for the applicant to respond by filing its own evidence (or in an appropriate award of costs). In fact, this is what occurred. I agree with the opponent that the applicant's reply evidence went well beyond responding to the witness statement of Mr Gray. Mr Bhatti's second statement sought to challenge evidence in chief filed by the opponent and drew inferences concerning its reliability. Having taken all of the relevant factors into account and in the interest of making a decision based on all of the relevant material, I allowed all of the additional evidence to be admitted and will refer to it as necessary below. I also allowed the confidentiality request for Mr Gray's statement, any content of which will be redacted from the public copy of this decision.

Opponent - Witness statement by Chris Gray and exhibit CG1

67. Mr Gray is the managing director of Manpower UK Ltd. His evidence provides an example of actual confusion which occurred in October 2017.

Applicant - Second witness statement of Sharjeel Bhatti and exhibit SB28

68. Mr Bhatti reiterates the importance of security licences which are needed to operate in the security sector. With regard to Mr Gray's evidence he maintains that confusion is not relevant being internal, between pre-existing business partners.

Opponent in reply - Third witness statement of Alina Hancorn and exhibit AH8

69. Ms Hancorn confirms that tapes are kept until reports are written for clients and are then recorded over. She confirms that her account of the conversation outlined in her first statement was accurate.

Preliminary issues

The opponent's standing

70. In his first witness statement, Mr Bhatti questions the opponent's standing in this case. I reproduce his submissions as written:

"5. I should point out that the evidence of the Opponent is being given by Damion Whitham who is a director of Manpower UK Ltd a separate legal entity, which is not the registered owner of the trademarks relied upon in this matter, nor are its shares own by the Opponent, but by Manpower plc. The actual Opponent is a US registered company whose headquarters are in Milwaukee, Wisconsin, USA whose primary services are employment and recruitment agency."

71. Mr Whitham's second statement, dated 20 September 2017, begins by confirming the relationship between Manpower UK Ltd and the opponent, as follows:

"5. As stated in my first statement, Manpower UK Limited is the operating company that is responsible for Manpower's business in the UK and an indirect subsidiary of the Opponent. More precisely, Manpower UK Limited is a wholly owned subsidiary of Manpower PLC (registered in England and Wales with registered number 00565884). Manpower PLC has 500,000 ordinary shares issued. Of those, 499,999 shares are held by Manpower Holdings Limited (registered in England and Wales with registered number

04830153) and one share is held by Manpower Nominees Limited (registered in England and Wales with registered number 02762989). 100% of the shares of each of Manpower Holdings Limited and Manpower Nominees Limited are held by the Opponent, ManpowerGroup Inc. Accordingly, the Opponent is the 100% indirect parent of Manpower UK Limited...

7. I am also a director of Manpower PLC, the direct parent company of Manpower UK Limited.

8. As a director of the company in a position of responsibility and a key member of the management team of the Opponent's business, I have full access to all of Manpower UK Limited's records. I provide my evidence based on my personal knowledge of the business of the group, having been employed by Manpower UK Limited for 12 years, and on Manpower's business records. I was authorised by the Opponent to give this statement (as well as my first statement)."

72. I am satisfied that Mr Whitham has the necessary standing to give evidence in these proceedings on behalf of the opponent.

Proof of use

73. The applicant has not requested proof of use of the opponent's UK mark and accepts use of the mark for the services in class 35.

The applicant has requested proof of use of the opponent's EU mark for, 'the provision before 17 May 2016 of providing the relevant services of a security nature or to the security sector'.²⁹ This is unsatisfactory because the applicant does not identify which services relied upon in the opponent's statement of use it requires proof of use to be shown for. The applicant appears to be requesting that the opponent show use of some of the applicant's services which is not the purpose of the proof of use provision.

²⁹ See question 8 of the applicant's five counterstatements.

This request is not valid and I will give it no further consideration.

The nature of the parties' respective businesses

74. Many submissions have been made in the course of these proceedings concerning the way in which both sides businesses provide staff to their respective customers. This is not relevant. I must determine in which services the opponent's use, reputation and/or goodwill rest and in light of those findings, I must determine whether the use of the applicant's marks, across the full range of services contained within its specifications would cause confusion, damage or take unfair advantage.

75. In addition, the applicant submits that the opponent does not have the necessary licences to operate in the security sector which means that there cannot be any similarity between their respective services. Many trade marks are registered for goods and services which may require licensing for legal reasons, such as, inter alia, pharmaceutical goods, the sale of alcohol and so on. Such licences are not relevant to the decision which it falls to me to make. They may be relevant in the context of running a business, but are not pertinent to matters of similarity between trade marks and the goods and services for which they are registered.

State of the register evidence and company name registrations

76. The applicant draws my attention to other registered trade marks and company names which include the word 'Manpower'.³⁰ The applicant's witness Mr Bhatti states:³¹

"25.c. As regards the assertion that the Opponent has the sole right to use the word 'Manpower', it is evident that it is used within trademarks and protected by a number of companies in a variety of industries".

³⁰ See the witness statement of Mr Sharjeel Bhatti, dated 20 July 2017.

³¹ As above.

77. Prints of six trade marks taken from the UK trade mark register are provided.³² In considering this evidence I bear in mind the guidance in *Zero Industry Srl v OHIM*,³³ when the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

78. The applicant has not provided any information beyond the simple existence of six trade marks on the UK register. It has not given any indication of whether the marks are in use, or if they are, in which fields are they being used. I do not find this ‘state of the register’ evidence helpful and will say no more about it.

79. Mr Bhatti also provides two pages printed from the Companies House website which contain a list of companies which include the word ‘Manpower’ in their names. Company names do not give any intellectual property rights and by their nature can co-exist with only minor differences. In the absence of any indication as to why these company names are relevant to the trade mark matters before me, I will say no more about this submission.

³² See exhibit SB22

³³ Case T-400/06

DECISION

80. I will deal first with the opposition under section 5(3) of the Act which states:

“5(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 European Union trade mark or international trade mark (EC), in the European Union) 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.”

81. 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, *Addidas-Salomon*, [2004] ETMR 10 and 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*).

82. In *General Motors*,³⁴ the CJEU held that:

“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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

83. Under this section of the Act the opponent relies upon its UK and EU trade marks for the mark MANPOWER.

84. The conditions of section 5(3) are cumulative. First, the opponent must satisfy me that its earlier marks have achieved a level of knowledge/reputation amongst a

³⁴ *Case C-375/97*

significant part of the public. Secondly, it must establish that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark(s) being brought to mind by the later mark.

85. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the 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.

86. The applicant has not provided any submissions with regard to either the opponent's reputation or the link which must be established for the 5(3) ground to succeed.

Reputation

87. The applicant appears to accept that the opponent has a reputation for recruitment services. At paragraph 51 of Mr Bhatti's first witness statement he submits:

"(xix) Paragraphs 34 to 42 Damian Whitham has shown the extensive promotion of the Opponent's recruitment services. Again, it is clear that the Opponent is well established uniquely in that field."

88. And at paragraph 52:

"The evidence of Mr Whitham shows the Opponent is a large company specialising in recruitment..."

89. However, for the sake of certainty I will highlight the key parts of the opponent's evidence which support such a finding. The evidence provided by Mr Whitham in his first statement shows that the opponent was ranked the number two 'staffing firm' in the world in 2015.³⁵ It is clear from the content of that article that the opponent was third in the world the previous year. Turnover in the UK has been between £571 million

³⁵ See exhibit DW34.

and £833 million in the years 2010 to 2015. Turnover figures under the MANPOWER marks for 2002 and 2003 were £504 million and £489 million respectively. The opponent operates sixty-nine offices throughout the UK and works with a number of other organisations providing what it describes as ‘on-site’ services. It operates numerous websites and has social media pages which are used to promote its services. Given the level of turnover, press coverage and market share shown, I have no hesitation in concluding that the opponent has established a considerable reputation for its MANPOWER marks. In making such a finding, I have taken account of the fact that some of the opponent’s evidence is dated at or around the time of the witness statement, such as the social media page prints, but the evidence as a whole is consistent with a high level of trade under these marks over a long period of time.

90. I note Mr Bhatti’s submission that the parties’ logos have distinctive characteristics ‘and unique colouring’ and cannot be confused. The opponent relies on its plain word registrations for MANPOWER. The evidence shows the word used with a number of different devices, some of which are in colour and in some cases both the word and device are white, on a coloured background. None of the devices alters the essential and consistent brand message used by the opponent which is MANPOWER and it is in that word that its reputation rests.

91. I find that the earlier marks have a strong reputation in the UK (and therefore in the EU too for the purposes of the EU mark) in relation to recruitment of staff and the provision of staff.

Link

92. In addition to the earlier marks having a reputation, a link must be made between the mark applied for and the earlier marks. In *Intel Corporation Inc v CPM (UK) Ltd*³⁶ (“Intel”) the CJEU provided guidance on the factors to consider when assessing whether a link has been established. It stated:

³⁶ C-252-07

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- The degree of similarity between the conflicting marks;
- The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- The strength of the earlier mark’s reputation;
- The degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- The existence of the likelihood of confusion on the part of the public”.

93. In *Intra-Press SAS v OHIM*,³⁷ the CJEU stated that:



“72...The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. 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 so 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) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the 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

³⁷ *Joined cases C-581/13P & C-582/13P*

judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

94. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.

95. The similarity of signs under sections 5(2) and 5(3) of the Act are assessed in the same way.³⁸ The marks to be compared are as follows:

Opponent's marks	Applicant's marks
MANPOWER	
	Manpower Direct Security
	Manpower Security
	
	Manpower Direct

³⁸ See *Addidas-Salomon*, Case C-408/01

96. The applicant submits that the similarity between the parties' respective trade marks is low as MANPOWER is a common word which is a generic description of personnel resources. I have already outlined why the state of the register evidence and prints taken from the Companies House website are not relevant to this issue.

97. The opponent submits the following with regard to the similarity between the parties' marks:

"25. The applications in suit all feature the word MANPOWER as the dominant element:

a. In the word marks, it is the dominant element because the additional words (DIRECT, SECURITY, DIRECT SECURITY) are either entirely non-distinctive or wholly descriptive of security-related services.

b. In the case of UK00003164900, the bold font and relative size of its font emphasise that it is the central feature of the mark and the other elements are of limited (at best) distinctiveness.

c. The same is true in relation to UK00003164900, save only that the element given emphasis by its presentation is MANPOWERDIRECT, which the average consumer would recognise as being made up of MANPOWER and DIRECT, the latter being of no distinctiveness."

The word marks

98. The applicant's marks 'Manpower Direct Security', 'Manpower Security' and 'Manpower Direct' all begin with the common element 'Manpower' which is the same as the opponent's earlier marks, MANPOWER. The additional words, 'Direct' and 'Security' are, in any combination, descriptive of the services offered by the applicant. In each case, the word 'Manpower' plays the greater role in the overall impression of each of the marks. The overall impression of the earlier marks rests in the word MANPOWER which is the totality of the UK and EU marks.

99. Visually and aurally the earlier marks are similar to 'Manpower Security' and 'Manpower Direct' and 'Manpower Direct Security' to a medium degree. In reaching this conclusion I have considered the fact that the third of these includes both 'Direct' and 'Security', but do not find that it makes a material difference to the conclusion of medium visual similarity overall.

100. Conceptually, 'Manpower' is a known English word which conveys a message of human strength or power in terms of the number of workers available in a particular situation. The additional words 'Direct' and 'Security' in the applications give the consumer the message that the services are provided directly and relate to security services. The essential message is that of 'Manpower' and I find the earlier marks to be conceptually similar to the applications to a fairly high degree.

The stylised marks

101. The first of the applicant's stylised marks comprises the word MANPOWER in black letters with the word DIRECT in smaller orange letters below it. To the left of the words is an orange circle containing the black silhouette of a man in front of a smaller grey silhouette of a man. The stylised element is at the start of the mark and will not go unnoticed by the average consumer but it is ultimately not particularly distinctive. The male figure simply reinforces the word 'MANPOWER'. The word DIRECT being considerably smaller than the word MANPOWER describes the nature of the services and is less noticeable due to relative size and the lighter colour. The word MANPOWER plays the greater role in the overall impression of the mark with the device playing a lesser role.

102. Visually, I find this mark similar to the earlier mark to a slightly lower than medium degree. Aurally, the marks are identical if the consumer does not pronounce the much smaller word 'DIRECT', otherwise, the marks are aurally similar to a medium degree.

103. Conceptually, as before, the essential message of the applicant's stylised trade mark is that of MANPOWER, being understood to mean human strength or power in terms of the number of workers available in a particular situation. The device element

in the application simply reinforces that message and I find these marks to be conceptually similar to a high degree.

104. The second of the applicant's stylised marks comprises the word MANPOWERDIRECT in black letters with the words SECURITY SERVICES in smaller orange letters below it. To the left of the words is an orange circle containing the black silhouette of a man in front of a smaller grey silhouette of a man. The stylised element is at the start of the mark and will not go unnoticed by the average consumer but it is ultimately not particularly distinctive. The male figure simply reinforces the words 'MANPOWERDIRECT'. There is a natural break between the conjoined words MANPOWER and DIRECT with both being known English words with which the average consumer is familiar. The words SECURITY SERVICES describe the nature of the services and will be given little, if any, origin significance.

105. Visually, I find this mark similar to the earlier mark to a low to medium degree. Aurally, the marks are similar to a medium degree, the conjoining of the words MANPOWER and DIRECT meaning that the consumer is likely to pronounce both words.

106. Conceptually, as before, the essential message of the applicant's stylised trade mark is that of MANPOWER, being understood to mean human strength or power in terms of the number of workers available in a particular situation. The device element in the application simply reinforces that message and I find these marks to be conceptually similar to a high degree.

107. With regard to the distinctive character of the earlier marks the applicant maintains that MANPOWER is descriptive. I bear in mind *Formula One Licensing BV v OHIM*,³⁹ in which the CJEU found that:

"41...it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No

³⁹ *Case C-196/11P*

40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

108. In other words, I am not able to conclude that the opponent’s earlier marks are devoid of distinctive character but must consider them to have at least a low degree of inherent distinctive character.

109. On this point the opponent submits, in its skeleton argument:

“27. Regardless of the degree of inherent distinctiveness of MANPOWER for the services in question, the evidence of Mr Whitham clearly establishes that as a result of its extensive use it benefits from an enhanced reputation and that the earlier marks are to be regarded as highly distinctive.”

110. I agree. As I have already found, the earlier marks are registered trade marks and must be afforded a degree of distinctiveness in accordance with such decisions as that in *Formula 1*. However, the level of reputation shown by the opponent in respect of its MANPOWER marks is such that its distinctiveness has been elevated

through use to the extent that the marks are highly distinctive of the opponent's services.

111. For the purposes of detriment and/or unfair advantage under section 5(3) of the Act it is not a requirement that there must be identity or similarity between the respective goods and services, however, the issue remains relevant to the overall analysis. In the current case, the reputation in the opponent's marks is in respect of recruitment and provision of staff in class 35. The applications are made for installation of CCTV in class 37 and a range of security services in class 45.

112. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the Court of Justice of the European Union (CJEU) 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".

113. 27. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case,⁴⁰ where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

⁴⁰ [1996] R.P.C. 281

- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

114. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*,⁴¹ Floyd J. (as he then was) stated that:

“[...] 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”.

115. In *Avnet Incorporated v Isoact Limited*,⁴² Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

⁴¹ [2012] EWHC 3158 (Ch)

⁴² [1998] F.S.R. 16

“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”.

116. With regard to the similarity of the parties’ respective services the opponent submits:

“The category ‘provision of temporary staff’ protected under UK1556077 is not limited to the supply of any particular type of personnel and covers the provision of temporary staff to customers for a wide range of roles. In practice, the Opponent uses the Registered Marks in relation to the provision of staff for a wide range of jobs including construction, industry and agriculture work, office, retail staff and warehouse staff, drivers, healthcare professionals, administrators, lawyers, accountants and finance staff and management staff of miscellaneous categories. The services specified in class 35 of UK1556077 cover all of these categories including the temporary provision of security staff to clients.”⁴³

117. The opponent also refers to the applicant’s description of its retail security services available on its own website:⁴⁴

"Retail Security Services

Manpower Direct specialise in providing high quality licensed security officers to the retail sector.

All our officers are highly trained in the legal requirements for retail security. They also understand electronic security devices (such as Sensormatic tags) and how to utilise such systems to prevent theft or apprehend shoplifters.

⁴³ See the opponent’s submissions dated 13 March 2017, page 7.

⁴⁴ See exhibit AH3.

Manpower Direct security officers are also well-versed in fraud prevention, including credit card fraud and counterfeit money.

We offer a wide range of retail security services including door supervisors, uniformed shop-floor security officers (to deter and apprehend shoplifters), plain clothed store detectives, secret shoppers (to test customer service levels and staff honesty) as well as stockroom and head office security.

All our staff are trained in incident management such as bomb threats, fire alarms and raids as well as with customer services issues such as abusive or potentially violent customers."

118. It concludes:⁴⁵

"The language used in the Applicant's website highlights the fact that the nature of these security services is essentially to provide security guards to customers. This description of the Applicant's services will resonate with customers who are familiar with Manpower and its brand as a provider of human resources services and in particular in relation to the placement or supply of temporary and permanent workers (the services protected under the Registered Marks in class 35). Customers would naturally assume that a service that supplies security guards (for example to retailers) under the marks applied for is connected to the MANPOWER network which is known for supplying temporary and permanent workers for various categories of jobs. The customer is likely to assume that 'MANPOWER DIRECT' is an affiliated business specialising in security staff."

119. In support of its view, the opponent draws my attention to *Spire Healthcare Holdings v E-Spire Group Ltd & Ors*,⁴⁶ in which the supply of medically-qualified individuals on a temporary basis was held to be extremely similar to medical services. The claimant in this case was the provider of a range of hospital and medical services

⁴⁵ As at 43, page 13.

⁴⁶ [2017] EWHC 493 (IPEC)

in class 44. The defendants operated businesses supplying temporary staff, in particular, to care homes:

“18. I should say that on the evidence before me today it appears that the first and second defendants' business do not operate, at present anyway, in the usual manner of an employment agency. Rather than the defendants recruiting personal care workers who are then employed on a temporary basis by, say, a hospital in Shropshire, and the defendants being paid a royalty for recruiting them on behalf of the hospital, what happens is that the defendants directly employ the personal carers; they are then seconded to the corporate clients, Shropshire Council or whoever it happens to be. In other words, the personal carers are providing those services while in the employment of the defendants. It seems clear from the defendant's advertising that they offer to supply the services of not just personal carers, but also medically qualified individuals such as nurses...

20. The first and second defendants appear to be advertising the provision of services which fall within the specification of the claimants' mark. It is not expressly stated however in those advertisements that such individuals would be employed by the defendants at the time of providing those services, so it is at least just arguable that even the advertising of those services does not fall squarely within the scope of the specification of the claimant's marks. Nonetheless, it seems to me on any view the services which Mr Cregan says are offered by the defendants are extremely similar to those in respect of which the claimants' marks are registered.”

120. On first impression the opponent's services in class 35 for the recruitment and provision of staff bear little resemblance to the applicant's security services. However, it is clear from a plain reading of the applicant's specifications that the services include 'man-guarding services', in other words, the supply of security personnel. The opponent's services, given their core meaning, must include the provision and recruitment of staff fulfilling a security role, since its specification as registered is not limited to any particular category of worker. The opponent's own evidence shows opportunities on its website for IT security posts and there are examples of contracts

to supply security staff to a company in Belgium. To this extent, there must be a degree of similarity between the respective services.

121. The applicant's trade marks also include, 'CCTV installation' in class 37. Having considered all of the necessary criteria such as users, uses, nature, trade channels, complementarity and whether or not the services are in competition, I can find no meaningful areas of similarity between these services and those for which the opponent has a reputation.

122. In the case of an opposition under section 5(3), the similarity of goods and services is not a necessary requirement but rather, one of the factors to be considered in establishing whether there would be a link. In this case, the opponent has a strong reputation for services in class 35, a highly distinctive mark which has been enhanced due to the use made of it and the applicant's marks all include the distinctive element MANPOWER, which is distinctive for the opponent's services.

123. I find that when the applicant's marks are encountered, even for the services that are somewhat different to those of the opponent, the opponent's reputation is such that the applicant's mark will cause the opponent's MANPOWER marks to be brought to mind. In other words, the relevant public will make a link between the parties' marks.

Unfair advantage

124. In its skeleton argument the opponent sought to rely on unfair advantage. It submits:

"50...there are ample grounds here for concluding that the objective effect of the use of the marks applied for would take unfair advantage of the substantial reputation of the earlier marks. Moreover, Mr Bhatti's evidence suggests that he is aware of actual confusion, but is unconcerned by it. This evidence together with Ms Hancorn's evidence of how her call to the Applicant was answered ('...welcome to Manpower...'), and exhibiting an image of a jacket bearing just the word MANPOWER, implies not so much a deliberate intent to trade on the Opponent's reputation or to pass off, but

a reckless indifference on the part of the Applicant to the incidence of confusion.”

125. A more detailed explanation of how the opponent envisages the unfair advantage to arise is provided in its initial pleadings in which it submits:

“The likelihood that the public will believe that the services that the Applicant has applied for are in fact provided by the Opponent, or are somehow connected to the Opponent’s services, will reassure customers that the services that the Applicant has applied for come from a well-known and trusted source. The link between the Applicant[‘s] marks and the earlier mark[s] and the association with the well-known MANPOWER brand will allow the Applicant’s business to benefit from the reputation and attractiveness of the opponent’s brand. Customer’s will take notice of the Applicant’s services due to the use of the well-known MANPOWER brand and the positive associations created in their minds and may purchase those services. Thus, customers familiarity with the earlier mark will be reflected onto the Applicant’s services without any effort on the part of the Applicant and the Applicant will free-ride on the reputation of the earlier mark and the perception of the earlier mark in the minds of consumers.”

126. The opponent concludes that it has a strong reputation, operating its business for many years and that such advantage obtained by the applicant would be unfair because it will allow the Applicant to benefit from the goodwill, marketing effort, careful brand management and quality of service provided by the opponent and its reputation.

127. The applicant has not provided submissions which address the opponent’s claim directly but asserts that the opponent has failed to provide evidence of damage. In its skeleton argument it submits:

“33. [The opponent] has adduced no evidence that the use of the later trade mark would be likely to or does take unfair advantage or cause detriment. Rather, it seeks (through its submissions under section 8, p15 – 16) to pin its hopes of establishing unfair advantage and detriment under s.5(3) by

reference to the allegations of conduct said to amount to passing off. That is not a permissible or relevant argument under s.5(3) and it ought to be dismissed...

128. And concludes:

“34. It is submitted that the failure beyond June 2008 of the Manpower Group to pursue any action before May 2016 is illustrative of the facts that (1) there is no risk of confusion; (2) there is no similarity of services offered; (3) there is no perceived unfair advantage; and (4) there is no risk of detriment. It has failed to address this point or to explain its inactivity following 2008. It is clear from case law that evidence of actual damage is not necessary for a party to succeed under this ground. It is sufficient for the opponent to provide evidence which can establish a prima facie case of a risk of future damage providing it is more than hypothetical.”

129. I pause at this point to note that the applicant has contradicted itself with regard to whether or not the opponent has demonstrated any actual confusion. Mr Bhatti appears to accept at least some of the opponent’s evidence. In his second witness statement he submits:

“25. The Opponent with unlimited resources, can only refer to 3 incidences of possible confusion over the 13-year period.

26. I request that the Registrar makes a preliminary finding as to whether the opponent can in fact offer and supply ‘Security Services’ in accordance with the provisions of the PSIA 2001.”

130. The opponent is not required to produce evidence showing that use of the contested mark has resulted in the applicant receiving an unfair advantage. In *Aktieselskabet af 21. november 2001 v OHIM*,⁴⁷ the CJEU stated that:

⁴⁷ Case C-197/07P

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future.”

131. However, in support of its case the opponent has provided examples of actual confusion in the following terms:

Ms Hancorn’s evidence

132. The witness statement of Alina Hancorn provides details of a telephone conversation with Philippe Alain, the applicant’s operations manager. She is a private investigator employed by the opponent to report on the applicant’s business. She provides the following explanation for her witness statement:

“3. Bishop was instructed by Manpower Group Inc. (‘ManpowerGroup’) in 2016 to investigate the business activities of Manpower Direct (UK) Ltd (the ‘Company’) including its use of the brand names ‘MANPOWER’ and ‘MANPOWER DIRECT’.

4. *Our instructions by ManpowerGroup followed an incident where a reporter, Phoebe Cooke, contacted ManpowerGroup having mistakenly believed that it was connected to a news item that she was following which in actual fact concerned the [Manpower Direct UK Ltd], not ManpowerGroup.”*

133. Ms Hancorn’s statement outlines her investigation into the applicant’s business and concludes with a description of a telephone enquiry she made to the applicant:

“14. On 9 March 2016 I placed a telephone call to the Company to make enquiries about its business. I was greeted by the person who answered the phone with the following words:

‘Good afternoon, welcome to Manpower, how can I help you?’

15. During the call, the person on the other side of the line introduced himself as Philippe Alain, operations manager of the Company.

16. I asked Mr. Alain if there was any connection with the ManpowerGroup. He said there was no connection and that ‘they are an agency’ (referring to ManpowerGroup). He tried to explain that ManpowerGroup provided workers for hospitals, cleaners and ‘do like general people’ (in his words) whereas Manpower Direct (the Company) ‘only do security’.

17. I asked Mr. Alain further on the call if there was ever any confusion between ManpowerGroup and the Company. He answered:

‘Oh yes, of course. A lot of people call us and they say ‘we send our CV to you, looking for a job in hospital’ and we say ‘you are calling Manpower Security, you are not calling the agency. But we are Manpower Direct, that’s the difference. We are not together.’”

134. Mr Alain submits that he is not able to recall the telephone conversation referred to by Ms Hancorn. He states that telephone calls to the applicant would be answered by an operator and not by him directly. He concludes:

“7...The conversation recalled in the Amended Witness Statement dated 29 March 2017 appears unnatural and I suggest that it is because the conversation, if it did occur, I have no reason to say and have no recollection of ever having said what I am alleged to have said, such that I believe it to have been either fabricated or mistaken. I further note that Alina Hancorn has failed to detail the pretext on which she managed to get the controller to transfer the call to me which to me suggests that it was deceitful.”

135. Ms Hancorn’s second witness statement, dated 30 August 2017, confirms that, as an investigator, she did not use her own name to contact the applicant. She provides the telephone number she used to make the call and submits that she would have asked to speak to a manager. She confirms that her first witness statement was a transcript of the recording of that telephone conversation.

136. In Mr Bhatti’s second statement he made the following submissions in respect of Ms Hancorn’s evidence (reproduced as written):⁴⁸

“14...I would have expected a private investigator to keep a detailed record and attendance notes of any telephone conversations. Accordingly I can only infer that if the alleged conversation took place the Opponent has failed to disclose the full attendance note because it contains evidence that it is unfavourable to them. In view of the narrow corridor of disclose I request the Registrar to either reject the evidence or make an adverse inference as to its accuracy and cogency to this case.”

137. Ms Hancorn’s third statement, dated 28 November 2017 includes the following:

⁴⁸ Mr Bhatti’s second statement should have responded only to the additional evidence of Mr Gray. As a consequence of its admission, I allowed the third witness statement of Ms Hancorn.

“8. The call I made to the Company and the conversation with Mr Philippe Alain were taped in accordance with our usual practice. Those tapes were used to transcribe the conversation for the purpose of the report we prepared for ManpowerGroup. In line with our usual practice, the tapes were later reused.

9. Copies of pages 18 to 24 of our investigation report to ManpowerGroup in which my enquiries with the Company and my conversation with Mr Philippe Alain were set out are at Exhibit AH8 enclosed with this statement. The account of the conversation and the quoted passages in the report were taken directly from the recording of the telephone call and were accurate. No other record or transcript of the conversation was created.”

138. The applicant returned to Ms Hancorn’s evidence again in its skeleton argument in which it submitted the following:

“23. Alina Hancorn’s hearsay evidence has turned into a debacle, despite having had three bites of the cherry. She now admits to having destroyed the only recording of the alleged conversation she had with Mr Alain... This does not accord with even minimal standards of competent private investigators. She has not disclosed full notes of the alleged conversation. She had been in communication with Mr Alain under both an alias name and a fictitious company style... Ms Hancorn withheld from her first statement information relating to a follow-up email exchange (possibly in the misguided hope to trap Mr Alain). In any event, Mr Alain’s email address contains ‘manpowerdirect’ and the attached company literature is consistent with that name. Furthermore, the accuracy and credibility of her evidence raises serious question marks. It appears likely that Ms Hancorn did have a conversation with Mr Alain, but that the contents of it as related at paragraphs 14 – 17 of her first statement simply do not resonate with the truth. She has sacrificed the ring of authenticity for implausible embellishment; the fact that the recording was not retained is not just a convenient coincidence, but compounds the incredibility of her evidence.”

139. Ms Hancorn's evidence provides full details of the nature of her telephone conversation with the applicant's operations manager. She also provides details of the way in which her investigations were conducted and has answered all of the criticisms brought by the applicant. If the applicant wanted to directly challenge Ms Hancorn's evidence it should have asked to cross examine her. Instead it suggests that her access to Mr Alain was obtained deceitfully and that the lack of original telephone recording points to evidence which goes against the opponent or is in some way underhand. I disagree. Ms Hancorn is a professional investigator, nothing in her evidence is incredible, on the contrary, her responses to criticisms from the applicant are entirely reasonable. I accept her evidence.

Mr Gray's evidence

140. REDACTED.

141. In addition, in his first statement for the opponent, Mr Whitham refers to two instances of actual confusion:

"18. Over time, the Opponent became aware of incidents where the Applicant's trading name led members of the public to confuse the Applicant or its security guards with the Opponent.

19. In one case, Phoebe Cooke, a journalist from the Archant media group, approached Manpower in connection with a story that she was covering relating to the dismissal of one of the Applicant's security officers. Ms Cooke approached Manpower UK on 25 February 2016 to make enquiries about the matter, wrongly assuming that the security officer in question was an employee of the Opponent or supplied by Manpower."

142. A copy of the email sent from the opponent to Ms Cooke is provided, as follows:⁴⁹

From: Jones, Ruth [<mailto:ruth.jones@manpowergroup.com>]
Sent: 25 February 2016 12:02
To: Cooke, Phoebe
Subject: RE: Flat 25, Thaxted House, Siviter Way, Dagenham RM10 9ST

Hi Phoebe,

I was certainly intrigued by the details you shared with me this morning as the circumstances surrounding Jamal's suspension sounded very unusual. However, upon looking into this, I cannot find any record of Jamal being employed by Manpower and none of my colleagues can recall supplying workers to Barking and Dagenham Council.

A misunderstanding has perhaps been made with regards to who Jamal's employer is. I would suggest instead you query his employment with a firm called Security Manpower UK (<http://securitymanpoweruk.co.uk/node/1>) as it seems possible someone may confuse them with Manpower.

I intend to contact the Enquirer to request they amend their story to remove reference to Manpower as I believe this is misleading. I would be grateful if you could share any information you obtain regarding Jamal's employer as, if a company is misrepresenting themselves as Manpower, that is naturally of concern to ourselves.

I hope you find the answers you, Jamal and the residents are looking for.

Thank you,
Ruth

143. The second incident referred to by Mr Whitham occurred in May 2012, when an invoice intended for the Applicant was wrongly sent to the opponent.⁵⁰

144. There is some debate as to whether the judgment of the CJEU in *L'Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The Court of Appeal has considered this matter three times. Firstly, in *L'Oreal v Bellure*,⁵¹ when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood*.⁵² Thirdly, in *Specsavers v Asda Stores Limited*.⁵³ On each occasion the court appears to have interpreted *L'Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage.⁵⁴

⁴⁹ See exhibit DW6.

⁵⁰ *Ibid.*

⁵¹ [2010] RPC 23

⁵² [2010] RPC 2, paragraph 136.

⁵³ [2012] EWCA Civ 24, see paragraph 127.

⁵⁴ See the opinion of Advocate General Kokott in Case C65/12 *Leidseplein Beheer and Vries v Red Bull*, paragraph 36.

145. In *Jack Wills Limited v House of Fraser (Stores) Limited*⁵⁵ Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

146. I also bear in mind that the extent of the opponent's reputation will have a bearing on the matter. In *Mäurer + Wirtz GmbH & Co KG v OHIM*,⁵⁶ the GC held that:

“40. It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non-hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article 8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be

⁵⁵ [2014] EWHC 110 (Ch)

⁵⁶ Case T-63/07

established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 Sigla v OHIM –Elleni Holding (VIPS) [2007] ECR II-711, paragraph 48).”

147. In effect, the opponent’s complaint is that the applicant is taking unfair advantage of the communication and quality functions of its MANPOWER trade mark as a reliable and well-trusted brand. I agree. I find that *prima facie* there is a risk, which is not hypothetical, that use of the contested mark will make it easier for the applicant to sell its security services to a section of the relevant public. Therefore, use of the contested mark is likely to affect the economic behaviour of such consumers in the applicant’s favour.

148. The examples of actual confusion provided by the opponent, support my finding that the risk here is more than hypothetical, particularly the evidence of a former customer of the opponent being confused as to the potential supplier of security personnel.

149. Furthermore, the evidence indicates that the applicant has done little to alleviate possible confusion. Ms Hancorn’s evidence shows a senior member of the applicant’s staff answers the telephone to external callers using the company identity MANPOWER. The applicant provides some of its personnel with jackets branded simply MANPOWER. Neither of these points to a business keen to assert its own identity.

150. I therefore accept the claim of unfair advantage with regard to all of the services, in classes 37 and 45 applied for by the applicant.

151. The opponent relied on detriment to reputation and detriment to distinctive character in its initial pleading, neither of which was pursued at the hearing. Even if they had been, where the opponent’s claim to unfair advantage has succeeded I would not have gone on to consider the other two heads of damage, and given my conclusions regarding the applicant’s services, it would be in no better position.

152. Having concluded that the opponent has succeeded in its 5(3) ground of opposition, I will consider the defences relied upon by the applicant.

The applicant's defence relying on laches, waiver and estoppel

153. In its counterstatements the applicant submits:

“18. Given that the Opponent had knowledge of the Applicant's name and trading style at least as early as 2008 and a fortiori would or ought to have been aware of the increasing growth of the Applicant's business (e.g. by virtue of its prominence in the Sunday Times Fast Track awards 2008 and 2009) and given that the Opponent sent a letter and failed thereafter to take any steps to require the Applicant to change its name or otherwise to inhibit the Applicant's use of its trading style, the Opponent is now subject to an estoppel preventing it from opposing the Applicant's application for use within the specified categories. Further, or alternatively, the Opponent has waived the Applicant's use of its trading style and of the mark for which application for registration is sought. Further, or alternatively, no relief would be available to the Opponent by virtue of the application of the equitable doctrine of laches.”

154. The opponent submits that it has given repeated notices to the applicant through its own representatives:

“...protesting against the Applicant's use of the word MANPOWER as part of its trading name and of the marks applied for and demanding the change of the Applicant's name. The Opponent did not encourage the Applicant's continued infringements and has in fact taken positive actions to dissuade the Applicant from continuing its use of the Opponent's mark. The fact that the Opponent has not so far taken legal action against the Applicant to force it to discontinue the infringements, does not give rise to estoppel or laches...”

155. It is clear from cases such as *Fisher v Brooker*⁵⁷ that a laches defence can only bar equitable relief. A trade mark opposition seeks legal remedy meaning that a laches defence is not available to the applicant here. Furthermore, it is clear from Neuberger LJ in that same judgment that, if a laches defence were applicable, the applicant would have to show some prejudice suffered by it, as a result of the opponent's delay and no such claim has been made.

156. In addition, guidance on the application of these defences to trade mark proceedings can be found in *Kerly's Law of Trade Marks and Trade Names*.⁵⁸

“17-107 The issue was considered by the English High Court, sitting as a EU trade mark court, in *Marussia Communications Ireland Ltd v Manor Grand Prix Racing*,⁵⁹ in which Males J relied on the decision of the CJEU in *Martin y Paz*⁶⁰ in coming to the conclusion that defences of estoppel and acquiescence were not available to defendants under the EUTM. The defendant in that case did not argue that substantive national defences were not available to defeat infringement claims, but instead contended that estoppel and acquiescence were procedural matters which fell within art.129(3) of the EUTM Regulation. That contention was rejected by the court. As the law stands in the UK therefore, national defences of estoppel and acquiescence are not available to defendants in trade mark matters.”

157. I do not intend to give these defences any further consideration. The applicant has filed five applications. They were published for opposition purposes and have been opposed, in time, by the opponent in these proceedings.

The applicant's defence of honest concurrent use

158. Throughout its pleadings, evidence and submissions the applicant has sought to rely on absence of confusion and a lack of unfair advantage due to its use of its marks

⁵⁷ [2009] UKHL 41

⁵⁸ *Mellor, Llewelyn, Moody-Stuart, Keeling & Berkeley, 16th Ed., Sweet & Maxwell 31 December 2017*

⁵⁹ [2016] R.P.C. 20

⁶⁰ *Martin y Paz Diffusion SA v Depuydt* [2014] ETMR 6

since the incorporation of its company in 2003. In Mr Bhatti's first statement he submits:

"44. With respect to the allegations of taking unfair advantage of and detriment to the reputation of the Opponent's brand, the Applicant relies on and repeats the history set out above.⁶¹ It has started, developed and grown its business without any confusion on the part of its clients in central and local government as to the nature of the services that it offers, which are fundamentally different from those offered by the Opponent."

159. Guidance on this particular issue of reliance on the absence of confusion in the marketplace can be found in Tribunal Practice Notice (TPN) 4/2009, which states:

"6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

7. In Compass Publishing BV v Compass Logistics Ltd [2004] RPC 41 Laddie J held:

'22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to

⁶¹ See paragraph x.

be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.'

8. (In *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

'99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...')

9. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

'Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.'

160. The opponent's evidence and submissions suggest that it has used the trade marks the subject of its applications since 2003. Evidence is provided of an award from the Sunday Times in 2008 and details of a number of tenders and contracts have been provided. However, it is not clear to what extent these contracts were performed,

if at all. I have no turnover figures in evidence nor indication of the amount spent on marketing and advertising in respect of the marks applied for, nor do I have any examples of the applicant advertising its services, its share of the market or its geographic reach. Consequently, the evidence falls a long way short of allowing me to conclude that by the date of the application for registration, the average consumer had become exposed to the competing trade marks to such an extent that they are able to distinguish between them. Furthermore, the absence of sales and marketing information makes it difficult to judge whether the applicant's business has continued at the same level since 2008, or whether the business has grown in a way that does not appear to be consistent with marketing spend (and which could, therefore, suggest that the applicant's mark has been boosted by the reputation of the opponent's mark).

161. It is not clear to me whether the applicant is seeking to rely on the exceptional circumstances of the type outlined in *Budejovicky Budvar NP v Anheuser-Busch Inc.*⁶²(*Budweiser*). However, given that the papers make reference to honest concurrent use under a number of grounds, and more generally, I will consider the point. In *Budweiser*, the CJEU held:

“75. In the present case, it is to be noted that the use by Budvar of the Budweiser trade mark in the United Kingdom neither has nor is liable to have an adverse effect on the essential function of the Budweiser trade mark owned by Anheuser-Busch.

76. In that regard, it should be stressed that the circumstances which gave rise to the dispute in the main proceedings are exceptional.

77. First, the referring court states that Anheuser-Busch and Budvar have each been marketing their beers in the United Kingdom under the word sign 'Budweiser' or under a trade mark including that sign for almost 30 years prior to the registration of the marks concerned.

⁶² Case C-482/09

78. Second, Anheuser-Busch and Budvar were authorised to register jointly and concurrently their Budweiser trade marks following a judgment delivered by the Court of Appeal (England & Wales) (Civil Division) in February 2000.

79. Third, the order for reference also states that, while Anheuser-Busch submitted an application for registration of the word 'Budweiser' as a trade mark in the United Kingdom earlier than Budvar, both of those companies have from the beginning used their Budweiser trade marks in good faith.

80. Fourth, as was stated in paragraph 10 of this judgment, the referring court found that, although the names are identical, United Kingdom consumers are well aware of the difference between the beers of Budvar and those of Anheuser-Busch, since their tastes, prices and get-ups have always been different.

81. Fifth, it follows from the coexistence of those two trade marks on the United Kingdom market that, even though the trade marks were identical, the beers of Anheuser-Busch and Budvar were clearly identifiable as being produced by different companies.

82. Consequently, as correctly stated by the Commission in its written observations, Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that, in circumstances such as those of the main proceedings, a long period of honest concurrent use of two identical trade marks designating identical products neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services."

162. The opponent submits the following in its skeleton argument:

"51. The Applicant has pleaded that its use of its company name for 13 years amounts to honest concurrent use of the marks applied for such that there is no unfair advantage. However, the Applicant was on notice from

March 2008 that the Opponent objected to the name and thus proceeded at its own risk. In view of that and the matters referred to in the preceding paragraph, it is submitted that the use cannot be regarded as honest concurrent use or as justifying a finding of no unfair advantage.”

163. Mr Whitham’s evidence provides the following history with regard to its contact with the applicant and the use of its marks after it became aware of the applicant in 2008:

- 20 March 2008 – The opponent’s representative sent a letter to the applicant outlining its MANPOWER business and requesting the applicant change its company name, otherwise the opponent may take the matter further.⁶³
- 12 June 2008 – The opponent sent a letter to Mr Bhatti requiring Manpower Direct (GB) Ltd and the applicant change their names to not include MANPOWER or a confusingly similar word.⁶⁴
- No response was received to either letter.
- 10 May 2016 – Dorsey & Whitney (the opponent’s representative) sent a cease and desist letter demanding the applicant stop using MANPOWER and MANPOWER DIRECT or the opponent may initiate infringement and passing off proceedings.⁶⁵
- 9 June 2016 – a further letter was sent, no response received.⁶⁶
- 16 May 2016 – the first of the applications, the subject of these proceedings were filed by the applicant.

⁶³ See exhibit DW1.

⁶⁴ See exhibit DW2.

⁶⁵ See exhibit DW7.

⁶⁶ See exhibit DW8.

- 15 July 2016 – Dorsey & Whitney (the opponent’s representative) wrote to the applicant notifying of its intention to oppose.⁶⁷

164. It is clear from the file in this case that the relationship between these parties is far from peaceful.

165. In *Victoria Plum Ltd v Victorian Plumbing Ltd*,⁶⁸ Carr J. considered the CJEU’s judgment in *Budejovicky Budvar NP v Anheuser-Busch Inc.* and the Court of Appeal’s judgments in that case and in *IPC Media Ltd v Media 10 Ltd*,⁶⁹ and stated that a defence of honest concurrent use could, in principle, defeat an otherwise justified claim of trade mark infringement. Having reviewed the case law the judge stated that:

“74. The case law to which I have referred establishes the following principles:

i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.

ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant’s trade mark is not impaired by the defendant’s use, because the trade mark does not denote the claimant alone.

iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant’s goodwill.”

166. In assessing whether the defendant had acted honestly the judge directed attention to the following factors:

⁶⁷ See exhibit DW9.

⁶⁸ [2016] EWHC 2911 (Ch)

⁶⁹ [2014] EWCA Civ 1403

“i) The defendant has a duty to act fairly in relation to the legitimate interests of the trade mark proprietor.

ii) All circumstances must be considered when ascertaining whether or not the use by the defendant is honest, including whether the defendant can be regarded as unfairly competing with the trade mark proprietor.

iii) However, the question is not simply whether use of the sign complained of gives rise to consumer deception, as such deception may have to be tolerated. Similarly, the defendant may well be aware of the existence of such confusion, having lived with it for a considerable period.

iv) The question is whether the defendant has taken steps which exacerbate the level of confusion beyond that which is inevitable and so has encroached upon the claimant’s goodwill.

v) Whether the defendant ought to be aware that such steps will exacerbate confusion is a relevant factor.”

167. The *Budweiser* case shows that honest concurrent use may also be relevant in trade mark opposition and cancellation proceedings. Consequently, Carr J.’s guidance in *Victoria Plum* must also be kept in mind in proceedings of this kind.

168. Whether or not *Budweiser* type exceptional circumstances are present in the current case is a jury question and one which the Tribunal must decide based on the facts of the case. Given my findings above with regard to lack of confusion in the marketplace it is obvious that I do not have sufficient evidence to determine to what extent the parties have co-existed and I certainly do not have the evidence before me which would be necessary to establish facts as exceptional as those in *Budweiser* in which the parties showed 38 years of coexistence on a large scale, or *IPC Media*

Limited v Media 10 Limited,⁷⁰in which the parties' *IDEAL HOME* businesses had coexisted since 1920.

The applicant's fall-back position

169. In a letter dated 6 December 2017, the applicant provided the following fall-back position:

- "1. The removal of **Class 37** in respect of all 5 trade mark applications;*
- 2. The wording of the specification (description) of **Class 45** be limited in respect of the following applications:-*
 - (i) 'Manpower Direct' UK00003164895,*
 - (ii) 'Manpower Security' UK00003164898,*
 - (iii) 'Manpower Direct Security' UK00003164894*

And the words in red be wholly or partly redacted by the Hearing Officer at his/her discretion as follows:-

"Security services for the protection of property and individuals, manned guarding, parking security and management, mobile security controls, events & security management, security control room services, security access control services, door supervisors (managing clubs and bars), barrier & gatehouse security, rail track security patrolling, security foot patrolling, security stewarding and security services for vacant property, CCTV monitoring key holding and alarm response and lock and unlock services."

The reason we have omitted the two figurative Applications (UK00003164900 and UK00003193781) is because equivalent

⁷⁰ [2014] EWCA Civ 1439

Applications were filed in EU IPO and granted and are therefore enforceable in all 27 member states including the UK.”

170. The opponent responds as follows:

“The letter of 6 December does not explain why the Applicant’s fall-back position should make any difference in relation to the grounds of opposition.

It is submitted that the grounds of opposition will continue to apply against the remaining categories of services. It is noted that the Applicant did not propose a fall-back position in relation to its application Nos 3164900 and 3193781. The explanation offered by the Applicant is that these applications are ‘equivalent to EU trade mark registrations obtained by the Applicant.’ The explanation, it is submitted, is irrelevant to the present proceedings.”

171. I have found the opposition to succeed under section 5(3) in respect of all of the services in classes 37 and 45. Clearly, the services remaining after the proposed limitation suggested by the applicant would still be objectionable. The proposed limitation does not assist the applicant.

CONCLUSION

172. The oppositions succeed in respect of all five applications 3164900, 3164894, 3164898, 3193781 and 3164895 for all of the services for which they were applied.

173. With regard to the remaining grounds, the opponent has shown a reputation for services in class 35. The use shown for the purposes of the 5(2)(b) ground and the goodwill necessary for the opposition based on section 5(4)(a) go no further than those services. This is because of the dissimilarity of the remaining services (s.5(2)(b)) and the absence of a misrepresentation to the public (s.5(4)(a)).

COSTS

174. Both parties have asked for an award of costs in their favour. However, at the hearing a request was made and agreed by both sides, to reserve submissions on costs. I agreed.

175. Therefore, I invite the parties to provide, within 28 days of the date of this decision, submissions with regard to costs.

176. A final decision on costs will follow receipt of the proprietor's submissions and any response from the applicant. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision on costs.

Dated this 20th day of September 2018

**Ms Al Skilton
For the Registrar,
The Comptroller-General**