

O-092-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2431357
BY RIGHT RECRUITMENT GROUP LTD TO REGISTER A TRADE MARK
IN CLASS 35**

AND

**IN THE MATTER OF OPPOSITION NO. 95077
BY RMC OF ILLINOIS, INC.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2431357
By Right Recruitment Group Ltd
To register a trade mark in Class 35**

And

**IN THE MATTER OF Opposition No. 95077
By RMC of Illinois, Inc.**

BACKGROUND

1. On 31 August 2006 Right Recruitment Group Ltd applied to register the following mark:



for a specification of services in Class 35 that reads:

“Permanent and temporary recruitment services”

I note that the mark was published with the clause “The colours shown in the mark are green Pantone 382C and black Pantone 7547C”. The mark was not, however, limited to colour.

2. On 15 March 2007 RMC of Illinois, Inc. filed notice of opposition to this application citing grounds under section 5(2)(b) and 5(4)(a) of the Act.

3. The earlier trade marks relied on in relation to the first of these grounds are as follows:

No	Mark	Date of registration	Class	Specification
4974614 (CTM)	RIGHT MANAGEMENT	11 October 2007 (filing date 22 March 2006)	16	Reports and printed instructional materials featuring articles about employment outplacement, retirement counseling and planning.
			35	Employment counselling

			41	<p>services; career management consultation services; employment outplacement services; provision of employee evaluation and employee selection services.</p> <p>Providing training in the field of job searching, career development, self marketing, interview skills and research workshops; training services for personnel.</p>
3847373 (CTM)		6 September 2005 (filing date 22 May 2004)	16 35	<p>Printed matter.</p> <p>Business consultation services, career management services, career placement services, career recruiting services, employment counseling services, employment outplacement services, human resource consultation services, personnel management consultation services, and personnel retention consultation.</p>
4363107 (CTM)		25 April 2006 (filing date 30 March 2005)	16 35	<p>Printed matter.</p> <p>Business consultation services, career management services, career placement services, career recruiting services, employment counseling services, employment outplacement services, human resource consultation services, personnel management consultation services, and personnel retention consultation services.</p>

4. In the case of the ground based on section 5(4)(a) the opponent relies on use of RIGHT COUTTS and RIGHT MANAGEMENT CONSULTANTS in the UK from at least as early as 2002 and RIGHT ASSOCIATES and RIGHT in

the UK from at least as early as 1982. In each case the use is said to have been in connection with the provision of “career transition services, providing of training in relation to job search, career development, self marketing, interview skills, research workshops and the training of human resource personnel in employment separation issues.”

5. The applicant filed a counterstatement requesting to see proof of use of the opponent’s marks and signs and generally denying the grounds of opposition.

6. Both sides filed evidence. For the record this consists of the following:

Opponent’s evidence in chief

Affidavit by Theodore A Young with exhibits TAY1 to 12. Mr Young is Director and Executive Vice President of the opponent company.

Applicant’s evidence in support

Witness statement by John Cameron Ford with exhibits CF-1 to 20. Mr Ford is Director and Secretary of the applicant. In addition there are witness statements from:

Paula Jane Baker – a receptionist and administrator with the applicant company;

Barbara Cooper – an accounts administrator with the applicant company;

Graham Curson, Alex Doy, Natalie Fox, Louise Parker and Catherine Wilson – all of whom are Recruitment Consultants with the applicant company;

John Clifton – Human Resources Director of Rototek Ltd, a company that uses the services of the applicant;

Katrina Clarke – Human Resources Advisor of NSK Europe Ltd, another company that uses the services of the applicant.

Opponent’s reply evidence

Affidavit by Theodore A Young with exhibits RTA1(a) and (b), RTA2(a) to (d) and RTA3(a) to (g).

Opponent’s further evidence

Witness statement by Louis Pittertou, a partner of Barker Brettell LLP, the opponent’s professional representatives in this matter.

7. The matter came to be heard on 18 March 2009 when the applicant was represented by Mr T Marshall of Brandsworth IP Law and the opponent by Mr A Bryson of Counsel instructed by Barker Brettell.

The opponent's trade

8. The marks RIGHT RECRUITMENT, RIGHT, RIGHT ASSOCIATES, RIGHT COUTTS and RIGHT MANAGEMENT CONSULTANTS have been used in the UK via the opponent's sister company Right Associates Limited, subsequently Right Coutts Limited, and Right Management Consultants Limited under licence from the opponent itself. The companies make a quarterly royalty payment to the opponent. A copy of the licence agreement between the opponent and Right Management Consultants Limited is exhibited at TAY1.

9. The opponent controls use of the RIGHT trade mark and all RIGHT prefixed marks. Hence the name Coutts Holdings Limited was changed to Right Coutts Holdings on acquisition. This is a worldwide practice as evidenced by screenshots exhibited at TAY2 taken from various websites of subsidiaries around the world.

10. Trade literature showing the nature of the services and the marks used is exhibited at TAY3. Right Management Consultants is described as "the world's leading career transition and organizational consulting firm". This appears to embrace the delivery of a range of services at both corporate and individual level including the process of managing reductions in workforces by assisting key executives to find alternative employment, outplacement services, career development etc. The organisational consultancy side of the business also covers the management of change, leadership development etc.

11. The various exhibits at TAY4 contain material obtained via the 'wayback machine' archiving website illustrating the content of the www.right.com and www.rightcoutts.co.uk websites over the years 1997 to 2003.

12. Approximate turnover relating to the provision of services under the marks RIGHT, RIGHT ASSOCIATES and RIGHT MANAGEMENT CONSULTANTS is given for the years 1987 to 2001. It will suffice to give figures for the last five years as indicative of the volume of trade:

Year	Turnover £000s
1997	2,552
1998	4,621
1999	4,023
2000	4,048
2001	7,572

13. Approximate turnover figures relating to the provision of services under the marks RIGHT, RIGHT MANAGEMENT and RIGHT COUTTS following the acquisition of the Coutts Group is given as follows:

Year	Turnover £000s
2002	29,110
2003	32,158
2004	26,690
2005	27,091
2006	29,447

14. Approximate advertising expenditure figures are given as follows:

Year	Expenditure £000s
2002	202
2003	284
2004	244
2005	216
2006	300

15. Mr Pittertou's evidence subsequently confirms that all the above figures pertain to the UK. In addition to the literature and website material referred to above the marks have been promoted at trade shows. A presentation entitled 'Whose career is it anyway?' given at The Personal Development Show in 1999 is exhibited at TAY5. The services have been provided at major towns and cities in the UK. A selection of invoices is exhibited at TAY6. A list of major clients of Right Coutts Ltd as at March 2006 is provided at TAY7. The list itself has been made the subject of a confidentiality order (dated 12 February 2008). Suffice to say that the list is a lengthy one and includes a large number of household name companies.

16. Two further exhibits contain details of awards won by Right Coutts Ltd in 2004 and 2005 and details of the two CTMs relied on for this opposition.

The applicant's trade

17. The first part of Mr Ford's witness statement deals with certain background matters that do not need to be recorded at this point but I will return to them as necessary below. The applicant first used the applied for mark on 7 July 2006 when a web page was first posted on the internet. Copy e-mails and a screenprint are exhibited at CF-7 along with what is described as 'the first invoice' issued on 6 October 2006. Various promotional items including an advertisement for staff are exhibited at CF-8. It is company policy that staff refer to the company as 'Right Recruitment Group' (and not Right on its own), a point that is set down in the written company policy document exhibited at CF-9.

18. The applicant provides permanent and temporary recruitment services in the fields of administration, industrial, call centre, warehousing, accounting,

human resources, secretarial, legal, finance, sales and marketing, manufacturing, reception, driving, customer services and technical. A print out taken from the company's website showing listings of job types and sectors is exhibited at CF-10.

The nature of the respective services

19. Part of the evidence filed in this case addresses the parties' views on the similarities and differences in the services as registered and applied for respectively along with the features and circumstances of their actual trade. As might be expected the opponent contends that the services are overlapping and similar whereas the applicant argues that the two sides are in distinct areas of business. It will be convenient, therefore, to bring together at this point those parts of the evidence and submissions that are directed at the competing views of the position.

20. Mr Young, for the opponent, provides three pieces of evidence addressing what he sees as the perceived overlap between the parties' services. Exhibit TAY10 contains material from the www.adecco.co.uk website intended to show that recruitment and employment agencies will often provide the same services as career transition agencies such as offering advice on CV preparation and interview skills.

21. Exhibit TAY11 contains details of a partnership arrangement between The Ministry of Defence and Right Management offering both career transition and recruitment services to service leavers.

22. Exhibit TAY12 contains material from the www.e-penna.com website illustrating that the providers of career transition services and permanent/temporary recruitment services are in close contact with the same personnel within their client companies, namely human resource personnel who will appreciate that certain agencies/companies will provide both services.

23. Mr Ford regards his company as a 'normal recruitment service' that provides its employer clients with suitable job applicants for their job vacancies. The website enables potential employers to enter vacancies and job applicants to enter their CVs. Both employers and job applicants can browse existing job applicants and vacancies respectively.

24. The applicant does not assist employer clients with employee issues arising as a result of institutional change, nor does it provide 'career transition services', 'training in relation to job search', 'career development', 'self-marketing, interview skills, research workshops' or 'the training of human resources personnel in employment separation issues' (these being services the opponent provides). Furthermore, it is said that the applicant operates at 'a relatively low level in the market place'. Most of the permanent positions it seeks to fill are in the £11,000 to £16,000 range and most of the temporary positions have hourly rates of between £5.52 (minimum wage) and £10.00. Exhibits CF-12 and 13 have been filed to support this claim.

25. Mr Ford goes on to suggest that neither the opponent nor its affiliates has a reputation in the word RIGHT (or in combinations incorporating that element) in relation to the provision of recruitment services as that term is generally described and understood. He seeks to distinguish outplacement services which, in his view, do not actually extend to finding the employee employment with other employers but provides the employee with the tools to help them find a job such as assistance with preparing CVs, interview techniques and identifying jobs that may suit them.

26. Finally, Mr Ford exhibits (CF-19) printouts from the website of the Recruitment and Employment Confederation, the main industry body for recruitment businesses and consultancies showing that it is a member but the opponent and/or its affiliates are not. The position is the same in relation to membership of the Gangmaster Licensing Authority (Exhibit CF-20).

The applicant's supporting evidence

27. Seven of the nine supporting witness statements are from employees of the applicant. Of these, two (Ms Baker and Ms Cooper) have administrative roles. In terms of the substance of their statements they write in similar terms to the effect that, prior to the current proceedings, they were unaware of the opponent or its affiliate companies and their marks; that they have not been the recipients of misdirected telephone calls or other forms of communication; and that they abide by company policy by always referring to their employer as Right Recruitment Group.

28. The other five 'internal' witnesses (Mr Curson, Mr Doy, Ms Fox, Ms Parker and Ms Wilson) are recruitment consultants. Again, in terms of the substance of what they have to say, they express themselves in near identical terms strongly suggesting that the statements have been drafted for them. They make the same points as Ms Baker and Ms Cooper but also add that they routinely ask their employer clients and job applicants whether they are in touch with other employment agencies or recruitment consultants. They claim, as a result, to have developed a knowledge of other businesses in the field but at no time have the opponent or its affiliates been mentioned.

29. The two external witnesses (Mr Clifton and Ms Clarke) are employed in relevant disciplines in companies that use the services of the applicant. They too write in near identical terms leaving little room for doubt that the statements have been drafted for them. Prior to their being requested to give evidence in these proceedings they were unaware of the opponent, its affiliates or use of the marks relied on. They go on to give their understanding of the opponent group's business (given their purported lack of awareness of the opponent and its affiliates this cannot have been information within their knowledge). Finally, they say that from their own experience in human resources they do not consider that the opponent's services are the same as, or similar to, permanent and temporary recruitment services. They would not expect the same company, firm or business to provide both sets of services. Furthermore, if the respective services were supplied under the same or

similar trade marks they would not think that they originated from the same source.

Opponent's reply evidence

30. Both sides' evidence also contains submissions. I bear these in mind in coming to my own view of the matter below but do not propose to summarise the comments at this point. I should however record certain additional material filed by Mr Young by way of reply evidence dealing with the points taken by the applicant. The relevant exhibited material is as follows:

RTAY2(a) - a page from the opponent's website offering "access to unadvertised and advertised job vacancies" to counter the applicant's claim that ouplacement services are not similar to recruitment services

RTAY2(b) - a page from the opponent's website inviting employers (as part of an employment placement service) to search for employees fitting their job vacancies. Mr Young points to a similar service being referred to in paragraph 14 of Mr Ford's witness statement

RTAY2(c) - an excerpt from the opponent's website allowing companies to peruse resumés or CVs and post job vacancies

RTAY2(d) - an excerpt from the opponent's website in which applicants can peruse job leads and research career development tips

RTAY3(a) - Mr Young suggests that, contrary to the applicant's claim, recruitment and employment agencies will often provide the same services as those offered by career transition agencies. The exhibit contains an extract from the British Nursing Association website offering both recruiting services and consulting services aimed at helping employers cope during times of employment shortages

RTAY3(b) - other examples of website material showing to (g) businesses offering recruitment services along with services provided by the opponent suggesting that both parties' services are offered through one business. The sites covered are www.brightteachers.com, www.brightred.com, www.brookstreet.co.uk, www.office-angels.com, www.adecco.co.uk and www.manpower.com and www.manpower.co.uk. In relation to the latter Mr Young explains that both Brook Street and the opponent are owned by Manpower Inc. and that Manpower purchased these companies because of the

complementary nature of their businesses. The companies identified above offer a range of employment services ranging from job placement to training, to outplacement, to consulting and share the same target customers namely job seekers and employers.

31. That completes my review of the evidence.

DECISION

Preliminary matter

32. It was apparent from Mr Bryson's skeleton argument and submissions in the early stages of the hearing that part of the opponent's case was based on a family of marks claim under section 5(2)(b). No such claim had been foreshadowed in the statement of grounds and, whilst three earlier trade marks were relied on, Mr Bryson's submissions were not restricted to these marks. Furthermore, a number of those marks were not registered. The claim thus embraced both earlier trade marks and earlier rights. That in turn raised a point of law as well as the underlying pleadings issue.

33. Mr Bryson indicated that, if I did not consider that the pleaded case was broadly enough based to accommodate a family claim (which I did not), then he wished to apply for an amendment to the pleadings. I, therefore, heard submissions on this point as a result of which I decided that I was not prepared to allow an amendment to the pleaded case under section 5(2)(b). I indicated at the hearing that my decision would set out more fully my reasons for reaching this view. This I now do.

34. Mr Bryson's submission was that consumer perception of individual earlier trade marks can be influenced by the impact of a family including of 'Right' prefixed marks including non registered ones; that his skeleton argument had identified the other marks on which he intended to rely (in addition to the marks pleaded under section 5(2)(b) there is indeed reference in the skeleton to the additional marks relied on for 5(4)(a) purposes along with 'Right Corecare', 'Right-from-Home' and 'Right Job'); that no further evidence needed to be filed; and that consequentially, there was no reason why the hearing could not proceed on the basis of a suitably amended statement of grounds. The application to amend was resisted by Mr Marshall on behalf of the applicant.

35. My reasons for rejecting the request are in summary as follows:

-appeal tribunals have repeatedly emphasised the need for statements of grounds to set out fully the case which the other party is being asked to face (see to this effect *Demon Ale Trade Mark* [2000] R.P.C. 345 at page 357 line 16 et seq along with similar statements in *Club Europe Trade Mark* and *Julian Higgins Trade Mark Application* reported in Issue 9 of the 2000 R.P.C.

-the statement of grounds had not clearly foreshadowed a claim under section 5(2)(b) based on a family of marks

-whilst Mr Bryson claimed that his skeleton identified the marks that were to be relied on as part of the family claim I was far from convinced that this was the case. I accept that some were referred to as identified above ('Right Corecare', 'Right-from-Home' and 'Right Job') but others only surfaced during the course of submissions or were identified in the evidence without being referred to in the skeleton (for instance 'Right Advantage', 'Right Access', 'Right's People Brand'). The effect of this is that the applicant would not have had a clear understanding of the marks ranged against it let alone the use claimed in relation to each of them.

-the authorities support the proposition that it is permissible to consider the effect of a family marks where there has been use of members of that family (*Il Ponte Finanziaria SpA v OHIM*, Case C-234/06P and *The Infamous Nut Company Ltd's Trade Marks* [2003] R.P.C. 7). Neither of these cases supports the proposition that earlier rights as distinct from earlier trade marks can be brought into the equation. To do so would involve an (in my view impermissible) elision of earlier trade marks with common law rights.

-the basis for Mr Bryson's claim that the above view of the matter is too limiting is an observation of the Advocate General in *Il Ponte Finanziaria* referring to previous (pre-Directive) UK practice going back to *Beck Koller* (1947) 64 R.P.C. 76 which appears from the headnote to contemplate consideration of a family (referred to in that case as a series) in relation to both 'registered or unregistered' marks. However, that case involved both section 11 and 12 of the preceding law and the discussion in relation to the position under section 12 appears to relate to registered marks only. Accordingly I do not think it is safe to assume that the Advocate General in *Il Ponte Finanziaria* was suggesting a broadening of the scope of a family claim and the ECJ judgment itself gives no support to such a claim

-it follows that the 'mixed family' point that Mr Bryson wished to argue would be a novel one. Whilst that goes to an issue of law rather than a pleadings point as such, it would have been unreasonable for the applicant to have to deal with it for the first time at the hearing.

Section 5(2)

36. The relevant part of the statute reads as follows:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods

or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Proof of use regulations

37. In opposition proceedings, earlier marks for which the registration procedure was completed before the end of the five year period ending with the date of publication of the applied for mark may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use). As none of the three marks relied on completed its registration procedure before the end of the five year period ending 15 December 2006 (the date of publication of the applied of mark) the proof of use regulations do not apply. The earlier marks will, consequently, be considered for their specifications as registered.

Preliminary indication

38. Mr Marshall’s skeleton argument made reference to the Preliminary Indication that had been issued in this case. I indicated at the hearing that I did not consider it appropriate to receive submissions on this point in the light of the following clear guidance in *esure Insurance Ltd v Direct Line Insurance PLC*, [2008] R.P.C.6:

“17 As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR , argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. The Registrar's view was arrived at before there was any evidence on either side, before there was any argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar's preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”

The leading authorities

39. I was referred at the hearing to the European Court of Justice’s reasoned Order handed down in Case C235/05P, *L’Oreal SA v OHIM*. The relevant legal principles, drawn from the Court’s earlier judgments in *Sabel v Puma*, [1998] R.P.C. 199, *Lloyd Schuhfabrik Meyer* [2000] F.S.R. 77 and *Canon*, [1999] R.P.C. 117 are set out in that Order, the relevant part of which is reproduced below:

- “34 It is settled case-law that likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 18; and order of 28 April 2004 in Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657, paragraph 28).
- 35 That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Thus, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. Accordingly, it is necessary to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the assessment of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services covered (see *Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19).
- 36 In that regard, as the more distinctive the earlier mark, the greater the risk of confusion (*SABEL*, paragraph 24), marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20).
- 37 It has therefore been held that there may be a likelihood of confusion, notwithstanding a low degree of similarity between the marks, where the similarity of the goods or services covered is high and the earlier mark possesses a strong distinctive character (see, to that effect, *Canon*, paragraph 19, and *Lloyd Schuhfabrik Meyer*, paragraph 21).
- 38 In the present case, having held that the earlier mark was only of weak distinctive character and that the products concerned were identical or similar, the Court of First Instance compared the signs in question in order to determine whether they were similar. At paragraph 83 of the contested judgment, it held that, notwithstanding the weak distinctive character of the earlier mark, there was a likelihood of confusion between the signs and, accordingly, between the marks covered by them.
- 39 In that regard, the Court of First Instance cannot be criticised for not having disregarded, in its examination of the similarity of the signs in question, the element ‘FLEX’, which is common to the marks, on the ground that the earlier mark is only of weak distinctive character.

- 40 In the first place, it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer*, paragraph 27).
- 41 In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (see *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and the order in Case C-3/03 P *Matratzen Concord v OHIM*, paragraph 29)."

Comparison of services

40. The leading authorities on how to go about determining similarity between goods and services are accepted to be the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) 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;
- (f) 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.

41. These criteria are, of course, intended to be of general applicability but not all are equally relevant in all circumstances ((e) above being an obvious example of an inapplicable criterion where services are concerned). I also bear in mind that it was held in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 that:

“.... definition of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as “boots and shoes.”

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”.

42. However, in construing specifications words must not be given “an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor” (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] F.S.R. 267. I must therefore give full effect to the scope of the words contained in the specifications of the earlier trade marks and the application in suit.

43. At the hearing Mr Bryson put his case on the basis of four particular services contained within the opponent’s specifications. It is fair to say that if the opponent cannot succeed on the basis of these items it is unlikely to do so on the basis of the balance of the goods and services. For convenience, I will set out the competing specifications on this basis.

Applicant’s services

Permanent and temporary recruitment services

Opponent’s services

Career recruiting services
Career placement services
Employment counselling services
Employment outplacement services

44. I should just add that the last two of the opponent’s services set out above are contained in each of the three earlier trade marks relied on. The first two, however, do not feature in the specification of No. 4974614 (RIGHT MANAGEMENT).

45. Submissions at the hearing tended to focus on the parties’ actual activities. Mr Marshall sought to distance the applicant’s business from that of the opponent. His main arguments were that:-

-the opponent operates primarily as a management consultancy

whereas the applicant is a traditional recruitment agency with a high street 'shop front' presence

-to the extent that the opponent is engaged in employment matters it is at a different stage in the employment lifecycle. By this he meant that the applicant is engaged in matching job seekers to employment opportunities whereas the opponent deals with managing people who are already in work along with the process of moving such people into new areas (outplacement etc services)

-furthermore he considered that the opponent's services were aimed in the main at senior personnel or executives in the client companies or organisations

-thus it is said that the parties have different target customer groups

-the applicant does not engage in the sort of services offered by the opponent and is positioned towards the lower end of the market in the sense that most of the positions it seeks to fill carry salaries in the range of £11,000 to £16,000 or are temporary positions at relatively low hourly wage rates

-it was said to follow that the applicant's business did not result in any long term relationship between recruiter and recruited unlike the more long term involvement with the client that would be likely to characterise the opponent's services

46. Mr Bryson for the opponent rejected the suggestion that there was such a clear cut distinction. He pointed to Exhibit TAY11 where the 'career transition partnership' between the Ministry of Defence and Right Management offers a recruitment service for armed forces personnel including an on-line job finding service. Mr Young's evidence also gave a number of examples of organisations that offered both recruitment services along with placement, career transition, training programmes and support services such as the preparation of CVs.

47. It is not in principle inappropriate to approach the matter with the parties' actual trade in mind. That trade can help to shed light on the nature of the services and the issues before me but I bear in mind that the comparison I have to make must, in the final analysis, take account of what it is notionally open to the parties to do within the context of their specifications. That may embrace, but is not necessarily limited to, what they are doing at present. In particular I note that neither party's specification is cast in terms that restrict activity to any particular segment of the market (if such a restriction were possible at all). Thus, although the applicant may at present operate at the lower end of the market, it would be free to extend its activities to other areas. It could, for instance, offer an executive recruitment service.

48. As I have already indicated, it was part of Mr Marshall's submission that the opponent is essentially a management consultancy organisation and that

the services offered and described in the registered specifications should be interpreted with this in mind. It was in any case, he said, far from obvious what some of the opponent's services were.

49. I will start with 'career recruiting services'. It was put to me by Mr Marshall that this describes what used to be called (and perhaps still is) the milk-round that is to say the sort of visits made by recruiting officers from large organisations to universities. Hence, it is argued that it refers to career guidance rather than the process of placing individuals in jobs. I comment in passing that this latter point is not in my view an entirely fair way to characterise the so-called milk-round which was about recruitment as much if not more than general career guidance. Also such activity was generally recruiting for the organisations themselves rather than offering such a service to others (the inclusion of the term in the opponent's specification must be in contemplation of offering that service to others).

50. Even if one reading of 'career recruiting services' is in the way Mr Marshall suggests, I am by no means convinced that it is the only, or most natural, interpretation to be placed on the term. It is equally plausible that the words would describe the process of recruiting individuals into particular career paths such as any specialist employment agency might do (in the field of computing or accountancy say).

51. From the perspective of the *Canon/Treat* tests, the nature, intended purpose and users would be the same. So far as the users are concerned they must be taken to include both the organisations and businesses wishing to recruit and the individuals who are seeking employment. The recruiting/recruitment service is the means by which the two are brought together. As regards means of delivery (channels of trade) this could be either by means of a conventional high street presence, an internet based business or through the medium of a publication containing job advertisements. On that basis a career recruiting service would be, if not identical, a directly competing and very closely similar service to the applicant's recruitment services.

52. There is some force to Mr Marshall's submission that 'career placement services' suggests a rather more specialist activity possibly conducted as a more personal or tailored transaction. It is a term that is more likely to be used in the context of the placement of executives. It arises in the opponent's business in the context of organisational change and the provision of a career transition service for executives. It is not in my view the same as a recruitment service though it may be said to be complementary in the sense that an individual might either take advantage of a career placement service or approach a conventional recruitment agency to find work. The nature of the respective services is slightly different as is their method of operation but the users could be the same and they are undoubtedly complementary. The similarity is less strong than is the case with 'career recruiting services'.

53. 'Employment counselling services' would, I accept, be unlikely to feature in the services offered by a high street recruitment agency. But, as I have already said, the applicant's specification is wide enough to encompass

executive recruitment towards the upper end of the market where employment counselling can be expected to form part of the package offered. That does not make the services identical and, as Mr Marshall submitted, employment counselling does not involve placing candidates in jobs but it does point to a degree of overlap and at least a low level of similarity within the meaning of the tests.

54. 'Employment outplacement services' feature as part of the opponent's career transition services. Exhibit TAY3 describes outplacement services as including "...Internet-based resources, resumé software, research tools, job banks, and eLearning modules". The career transition partnership material in Exhibits TAY8 and 11 confirms that this includes a no-cost recruitment service. The final page of TAY11 refers to a job matching and notification service and access to Right Job an on-line job finding service. This does not mean that a recruitment service and an outplacement service are one and the same thing but it does suggest that a job bank may be one of the ingredients of an outplacement operation. There is a measure of complementarity and overall similarity but not at a particularly high level.

55. In reaching the above view of the respective services I have considered the supporting evidence provided by both sides. Two of the applicant's witnesses, John Clifton and Katrina Clarke express the view that they do not regard the opponent's services as being the same or similar to permanent and temporary recruitment services. However, as noted in paragraph 29 above, they did not start with any knowledge of the opponent's business but instead were led to understand that the opponent was involved in "management consultancy services that deal with career transition, training in relation to job searching, career development, self marketing, interview skills, research workshops and the training of human resources personnel in employment separation issues". That is not a full and fair reflection of what the opponent actually does nor, importantly does it reflect the full scope of the opponent's specifications (in fact most of the services that Mr Clifton and Ms Clarke were reacting to appear to have been taken from the Class 41 specification of No. 4974614 rather than the (more relevant) Class 35 services. Accordingly I have not found this evidence to be of assistance.

56. The opponent for its part has filed evidence to show that some recruitment agencies offer assistance in drafting CVs as does the opponent. I accept that this is the case but, as Mr Marshall submitted, a common facility does not make two services similar. Taken on its own, the point does not advance the opponent's case.

57. The opponent has also filed evidence to show that it does offer some recruitment services (TAY11 and RTAY2(a) to (d) – albeit that some of this material is after the relevant date); that other organisations are involved in both career transition services and recruitment/placement (TAY12 and RTA3(a) to (g)). The collective force of this material adds some slight reinforcement to the opponent's case on similarity of services.

The average consumer

58. I referred briefly above to the average consumer. The services in issue on both sides involve two sets of consumers. Firstly there are the organisations wishing to procure the employment-related services and secondly there are the individuals who are to benefit from those services. Mr Marshall suggested that the relationship with the service provider was more ephemeral in the case of a recruitment agency. In other words once an individual had secured employment the relationship with the employment agency ceased. He contrasted this with the opponent's services which in his view involved a longer term relationship. Mr Bryson did not accept that this was the case.

59. I am not convinced that these distinctions are so clear cut. I would for instance expect a business using a recruitment agency to do so on a regular or long term basis as and when the need arose providing it was getting good service. I accept that the relationship is likely to be a short term one for the individual being assisted in the sense that once he or she has secured a job the organisation that was instrumental in achieving that end will cease to be of particular relevance. These considerations are relevant when bearing in mind the potential for imperfect recollection.

60. HR departments are likely to be key users of both parties' services. Some organisations will have regular recruiting needs and have a consequentially close and regular relationship with their preferred recruiting agency. In so far as the opponent's services deal with career transition issues the need for such services may be more sporadic linked on occasions to times of corporate upheaval or restructuring.

61. Generally corporate entities purchasing these sorts of services will be knowledgeable and exercise some care in the purchasing process. Individuals by contrast may not have the same degree of knowledge though they are likely to take reasonable care in important issues to do with employment.

Comparison of marks

62. The principles are clear from paragraph 40 of the *L'Oreal* case quoted above. I must have regard to visual, aural and conceptual similarities, bearing in mind the overall impression given by the respective marks and taking into account their distinctive and dominant components.

63. Identification of the distinctive and dominant components was a key area of disagreement at the hearing with Mr Bryson taking the view that the element Right was dominant and Mr Marshall arguing that that word had a low capacity to distinguish and that it was only the combination of word elements that was distinctive.

64. Thus, on the latter view of the applicant's mark, the mirror image letters R were distinctive. In so far as the words Right Recruitment Group were concerned the elements were considered to be individually weak and relied on the combination for their distinctiveness. By implication the same logic

applied to the opponent's marks where, in the case of Nos. 3847373 and 4363107, there was a distinctive device in addition to the word combination and, in the case of No. 4974614, Mr Marshall submitted that it would be wrong to excise the word Management and treat it as if it were simply a Right mark.

65. Taking the applied for mark first, the mirror image letters R make a significant visual contribution to the mark and must be one of the distinctive components. I also agree with Mr Marshall that one must be wary of dismissing too easily words that appear to be descriptive. The point can be illustrated by the following passage from Jacob LJ's analysis in *Reed Executive PLC v Reed Business Information Ltd* [2004] R.P.C. 40 dealing with whether or not there was identity of signs:

“37 It was over "Reed Business Information" that battle was joined. The composite is not the same as, for instance, use of the word "Reed" in the sentence: "Get business information from Reed." In the latter case the only "trade-marky" bit would be "Reed". In the former, the name as a whole is "Reed Business Information." The use of capital letters is of some visual significance--it conveys to the average user that "Business Information" is part of the name. If the added words had been wholly and specifically descriptive--really adding nothing at all (e.g. "Palmolive Soap" compared with "Palmolive") the position might have been different. But "Business Information" is not so descriptive--it is too general for that.

38 So is "Reed Business Information" identical to "Reed"? I think not. "Reed" is a common surname. The average consumer would recognise the additional words as serving to differentiate the defendant from Reeds in general--this one calls itself "Reed Business Information" because it supplies information to businesses in some unspecified way or ways.

39 Putting it another way, I do not think the additional words "Business Information" would "go unnoticed by the average consumer." In all uses of the phrase complained of they are as prominent as the word "Reed".

40 In so holding I am not saying that in some circumstances the average consumer could not assume that "Reed Business Information" is connected with Reed Employment or an organisation called "Reed." But these would be cases of similarity of mark and sign, not identity."

66. How then do the words Right Recruitment Group stand? Firstly, it was held in *Shaker di L. Laudato & C. Sas v OHIM* Case C-334/05P that "it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element". The words Right Recruitment Group are clearly not negligible and must be held to constitute an important part of the applied for mark.

67. I am unable to accept Mr Marshall's submission that Right necessarily has a low capacity to distinguish because it has laudatory connotations. He gave

as examples that the consumer “has made the “right” (read “correct”) choice by buying the services so branded or that the service is “right” (read “suitable”) for the consumer”. Clearly such usages employ the word ‘right’ in a laudatory fashion. But context is important. The average consumer is not so unresponsive to the context in which a word appears that he or she is unable to differentiate between outright descriptive usage and the use of ‘Right Recruitment Group’ or ‘Right Management Consultants’ in the manner in which those combinations are presented in the marks in issue here.

68. It is in any case arguable in the context of the discussion in the *Reed* case above whether the words Recruitment Group are ‘too general’ to count as descriptive use. They are in my view more specifically descriptive of an entity offering recruitment services than the words Business Information in *Reed* (and therefore closer to the Palmolive soap analogy drawn in that case).

69. There are further reasons why I consider that the element Right contributes in a materially distinctive way to the mark applied for. The word Right is picked out on a separate line and in a different colour in a way that is calculated to draw attention to its significance. Also the applicant’s own witnesses confirm that they refer to the company as Right Recruitment Group. That is in turn consistent with the applicant company’s written policy (at CF-9) which states that “The Company is to be referred to at all times in writing and verbally as ‘Right Recruitment Group’”. It is not realistic to think that consumers will regard Right in this context to be merely a descriptive appellation. On the contrary it is the only, or at least principal, distinctive contributor to the combination Right Recruitment Group and a key component of the mark taken as a whole.

70. It was held in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04, that:

“ 30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.”

71. That case involved the use of a company name as part of a composite mark (THOMSON LIFE) but it was held in *Rousselon Frères et Cie and Horwood Homewares Limited* [2008] EWHC 881 (Ch) (since reported at [2008] R.P.C. 30) that the reasoning of the decision applied to other types of composite marks (paragraph 89 of the judgment).

72. It follows from all this that I have little hesitation in concluding that the element Right has, and indeed is intended to have, independent distinctive character within the applied for mark when that mark is considered as a totality.

73. The logic of that position also applies to earlier trade marks Nos. 3847373 and 4363107. That is not to deny the distinctiveness of the device but the word Right is picked out in the marks and is at least as prominent as the device (and arguably more so). The descriptive words 'Management Consultants' and 'Managing the human side of change' are clearly visually subordinate and lacking in distinctive character compared to the word Right. The opponent's third mark RIGHT MANAGEMENT is also heavily weighted towards the first element in terms of its distinctive character.

74. Turning to the comparison itself, I will firstly take the opponent's two marks incorporating the globe device. On a side by side comparison the applicant's and opponent's marks have a number of clear differences. The device elements, on the one hand the mirrored Letters R and on the other the globe device, have nothing in common and their positioning in relation to the accompanying words is also different. However, the marks also give prominence to the word Right and accompany that word with elements (Recruitment Group and Management Consultants/Managing the human side of change) that will be seen as being supporting descriptive text or a strap line. The overall effect of this is to create a moderate degree of visual similarity between the marks.

75. Aurally, the position favours the opponent rather more for the simple reason that it is unlikely in the extreme that the devices will be mentioned in oral references to the marks, a point that is reinforced by the evidence of the applicant itself in relation to how its own mark is referred to as noted above. Furthermore, although the applicant instructs its staff to refer to it as Right Recruitment Group, it is not clear whether consumers would consider it necessary to use the latter two words given that they do little more than describe the nature of the undertaking offering the service. I have not been given information on how the opponent presents its marks in oral use and in particular whether it refers to all the word elements or simply the word Right. I will assume for present purposes that it is the former (though the prominence given to the word Right leaves me in some doubt as to whether consumers would consider it necessary to refer to the other word elements). That still points to a reasonably high degree of oral/aural similarity.

76. Conceptually, the respective marks converge on the word Right which would be recognised as being a dictionary word (or conceivably a surname). That point is counterbalanced to an extent by the very different devices

though the mirror image letters would probably be seen as picking up the initial letters of the words Right Recruitment and hence derived from the words themselves. The opponent's more abstract globe device does not make an obvious conceptual contribution to the marks unless it is to suggest a business of global scope. In my view the existence of the recognisable word Right in the marks is likely to carry more weight in conceptual terms than the devices. There is a reasonable degree of conceptual similarity.

77. Mr Marshall's submissions at the hearing suggested that he considered the opponent's third mark, No 4974614, RIGHT MANAGEMENT to be the high point against him. It is true that this mark is not accompanied by a device to serve as an additional point of differentiation. On the other hand the word Right is not picked out to quite the same effect with the result that RIGHT MANAGEMENT appears as more of a composite expression (rather like Reed Business Information in the example referred to above). It therefore gives rise to somewhat different considerations. However as the specification of this registration is more limited in scope (it does not cover career recruiting services and career placement services) it does not offer as broad a basis of attack as the other two earlier trade marks. In view of this I do not propose to say anything more about this registration other than that, applying the normal tests, the applied for mark must be held to be similar albeit for slightly different reasons.

Likelihood of confusion

78. This is a matter of global appreciation taking all relevant factors into account. Part of that process involves reaching a view on the inherent and any acquired distinctive character of the earlier trade marks. I have already indicated that I do not accept Mr Marshall's submission that 'Right' is no more than a laudatory word. In the context in which it appears in the earlier trade marks I would not expect consumers to react that way. That said it is a dictionary word and has no particularly high claim to distinctiveness within the context of the composite earlier trade marks based on its inherent qualities.

79. The opponent has however filed evidence of use that is of some duration (commencing 1987), geographical extent (the towns and cities listed in paragraph 15 of Mr Young's affidavit) and size (the turnover figures given). The latter calls for further comment. Turnover between 1987 and 2001 was running at material but not overwhelmingly high levels. There was a step change in turnover in 2002 following the acquisition of Coutts Group which subsequently traded under the name Right Coutts. It is clear that the acquisition of this company gave the opponent a significantly enhanced presence in the UK market. However, it is important to note that no earlier Right Coutts trade has been pleaded so I cannot take into account use of this mark on its own.

80. It is clear from the evidence that the opponent through its various operating companies is active in a number of service areas and under a number of marks. Unfortunately, the evidence does not show what trade has been conducted under which mark (see paragraphs 12 and 13 above where

aggregated turnover etc figures have been supplied). Nor does it give a breakdown as between the various services on offer (the turnover figures are simply said to relate to “the provision of services”). Mr Marshall did not accept that the opponent’s marks benefited from an enhanced level of distinctiveness in relation to career transition services. He characterised the opponent’s business as being that of a management consultancy.

81. The thrust of the evidence is that the opponent group is engaged in the business of career management, career transition and organisational consulting. The respective services are not easily disentangled. My sense of the position from the opponent’s brochures is that it sees advantage in creating awareness of the whole range of services it offers. Thus the global services brochure in TAY3 is split between ‘Career Transition’ (including for instance career centres) and ‘Organizational Consulting’ with the latter focussing on issues such as organisational performance and leadership development. Other exhibits tell a similar story. It follows that customers’ awareness of the opponent’s capabilities is also likely to go beyond the particular service or services being engaged at any particular point in time. Consumers will be aware that the opponent offers a range of services.

82. It is also clear from the evidence that the opponent does not compartmentalise the use of its brands. Thus, the first brochure in TAY3 shows use of the 3847373 mark, the strap line (Managing The Human Side Of Change), the plain words Right Management Consultants, Right Advantage, Right and Right’s People Brand. But, the 3847373 mark appears to be the one that is most consistently used, certainly in the period prior to the acquisition of Coutts. After that date Right Coutts came to be more widely used but not to the exclusion of the 3847373 composite mark (see, for instance, TAY2 and the second part of TAY5 which can be dated to sometime in 2004 (that is after the acquisition of Coutts)).

83. However this profusion of branding creates something of a problem in establishing the level of recognition of individual brands. Also, more importantly in the context of section 5(2)(b) I can only consider the matter on the basis of the three earlier trade marks relied on. On that basis, by the relevant date of 31 August 2006 there had been claimed use of the core mark (No. 3847373) since 1987. The web archive material illustrates use dating from 1997 (including UK office locations). I consider that by the relevant date it is reasonable to conclude that the core mark had an established reputation in relation to the provision of career transition services. At the heart of that service are career management, career placement, employment counselling and outplacement.

84. I have found it more difficult to determine whether the opponent could legitimately claim an enhanced reputation in relation to career recruiting services by the relevant date. The opponent’s services (the ones identified in the previous paragraph) are in the main personalised ones that is to say tailored packages aimed at equipping the individuals concerned with the skills needed to support career transition. The process includes coaching, learning and managing the job search process and appears to be skewed towards the

executive end of the market. A recruiting service is not an altogether natural fit with such services.

85. Nevertheless, there are indications that the opponent's activities have extended beyond the sort of core services I have identified above. Thus, the first of the brochures in TAY3 (which has a copyright date of 2002) refers on page 9 to the company's 'job banks'. The Career Transition Partnership with the MoD shows Right Management Consultants dealing with large numbers of armed forces leavers. That service has been ongoing since 1998 and according to TAY8 over 17,000 people leave each year. That takes the opponent outside the purely executive resettlement area. Exhibit TAY11 records that "A central database enables us to provide a job matching and notification service wherever you are looking for work. Additionally you will have access to Right Job, our on-line job-finding service. It is an easy way for Service Leavers registered with CTP to search and apply for any of the thousands of live vacancies on the database." Something similar appears to have been undertaken with Barclays as part of the latter's off-shoring agenda (TAY8).

86. There is other material in a similar vein in Exhibits RTAY2(a) to (d) though where copyright notices are evident they relate to 2008 which places this part of the evidence beyond the relevant date.

87. I conclude that there is some evidence that the opponent has offered services that are in the nature of a recruiting service and have the features (or some of them) of a conventional recruitment agency. But in the main this has been done as an adjunct to its career transition/resettlement services. I am not persuaded that it would be safe to infer that the opponent had an enhanced reputation for such services at the relevant date.

88. There are a number of other factors that call for brief comment as part of the global appreciation. The applicant's evidence has referred me to state of the register material showing that there is no registration of Right per se in Class 35 (CF-5) and that Right is commonly used as part of a company name. This evidence is intended to weaken the credentials of the word to function as a trade mark. State of the register evidence (companies or trade marks) is rarely of assistance for the reasons given in the two cases referred to in paragraph 7 of Mr Young's reply evidence. Principally, this is because it is what has been shown to be happening in the marketplace that is of importance in shaping consumer perception not the position on registers.

89. The applicant has also filed evidence to show that the opponent is not a member of certain trade bodies (CF-19 and CF-20). The point does not go anywhere in as much as membership of these bodies is either optional or unnecessary given the nature of the opponent's business. The underlying claim is, of course, that the opponent operates in a somewhat different segment of the market to the applicant. On the basis of their respective historical trades I accept that this is almost certainly the case. But it does not directly address the question of similarity having regard to notional fair use.

90. There is also the evidence of the applicant's own recruitment consultants who say none of the people they deal with (employer clients or job applicants) have mentioned the opponent or its affiliates. Nor have they received communications intended for the opponent. Their evidence is in near common form format. In *Re Christiansen's Trade Mark* [1886] 3 R.P.C. 54 it was said:

“Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say ‘I think that affidavit right’ and they put their names to the bottom.”

91. I cannot give weight to this evidence. Quite apart from the format of the evidence, it is not altogether surprising that they may not have come across the opponent given the segment of the market they each occupy. But the specifications are without limitation as to the sector or segment of the market to which the services are addressed.

92. To summarise, I have held that the opponent's ‘career recruiting services’ are either identical or closely similar to the applicant's recruitment services; that there is a moderate degree of visual and conceptual similarity and a rather higher degree of aural similarity between the applied for mark and the opponent's composite word and device marks; that Right has independent distinctive character within those marks; that that element has some enhanced distinctive character in relation to career transition services though I am not persuaded that the same can be said for career recruiting services on their own (it is not entirely clear that the latter would be considered part of the normal range of career transition services and the evidence is not conclusive in demonstrating that the opponent has been offering such services to an appreciable extent over a period of time); that consumers fall into two categories, the entity commissioning the services and the individuals to whom the services are delivered; and that consumers are most likely to encounter the marks as a result of visual contact through a high street shop front presence, promotional brochures or internet sites (though, as the applicant's evidence suggests, there is also likely to be some telephone contact).

93. Taking all relevant factors into account, this is not a case where I can say with confidence that there is a likelihood of direct confusion between the marks in the sense that the applied for mark will be mistaken for any of the opponent's marks. The presence of the different devices and the other elements of the marks including the overall configuration of the elements is sufficient to avoid that happening. I consider that to be the case even in relation to the identical or very closely similar career recruiting services.

94. Nevertheless, the presence of the common element Right will not go unnoticed and will in my view result in an association being made. Taking into

account the proximity of the services, that calls for consideration of the nature and consequences of such an association. Whilst the applicant may be correct to say the parties have, hitherto, operated at different stages of the employment cycle and in different areas of the employment market that does not deal with what each is notionally free to do. Nor in any case is it clear that the divisions in the marketplace (as reflected in the activities of traders in this field) are as clearly delineated as the applicant would have me accept.

95. Individuals who are recipients or potential recipients of the services will not bring to bear the sort of market knowledge that HR departments of larger entities may have. It is in my view inevitable that the association that individual consumers would make would be more than purely ephemeral or inconsequential in nature. It has not been shown that such consumers have become used to seeing, and distinguishing between, marks incorporating Right as a distinctive element in this area of trade. Furthermore, even if their recall of the first seen mark was sufficiently clear to avoid direct confusion, they would think that the later mark was a development of the brand and service with which they were already familiar (particularly in the case of the career recruiting services) or a service from an economically linked undertaking that is now using the Right brand in a related area of the employment field. On that basis the opposition succeeds under section 5(2)(b).

Section 5(4)(a)

96. My above finding decides the matter in the opponent's favour. But in view of the fact that I received submissions on the passing off claim (and the fact that it raises somewhat different issues) I will deal briefly with the ground. The relevant part of the statute, Section 5(4)(a), reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b).....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

97. The requirements for a passing off action can be summarised as being:

(1) that the opponent's services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that

services offered by the applicant are services of the opponent; and

(3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

98. The opponent has relied on four marks as a basis for its claim, these being RIGHT COUTTS, RIGHT MANAGEMENT CONSULTANTS, RIGHT ASSOCIATES and RIGHT. The marks and issues are therefore somewhat different to section 5(2)(b). In his skeleton argument and submissions at the hearing Mr Bryson put his case principally on the basis of the collective force of these marks as a family. Given that the opponent has already succeeded under section 5(2)(b) I will confine my consideration of the position to this narrow point.

99. Mr Marshall's position was summarised in his skeleton argument as follows:

"The evidence provided by the Opponent establishes that it has a reputation in the unregistered trade marks in relation to management consultancy, not recruitment services. Indeed, the award conferred by Management Consultancies Association says it all – the Opponent has a reputation in management consultancy, possibly in relation to career transition and organizational change. That is, the Opponent's reputation is not in the same field as the services of the Applicant. There is no common field of activity....."

100. He acknowledged that passing off does not require a common field of activity but said the burden of proving misrepresentation was 'extremely high and onerous' where there is none.

101. For reasons that I have already touched on, it is not correct to regard the opponent as simply a management consultancy. The clear picture that emerges from the evidence is that it is involved in offering a range of what can for convenience be termed career transition services. The above-quoted extract from Mr Marshall's skeleton appears to grudgingly acknowledge as much.

102. The acquisition of Coutts (which then became Right Coutts) in 2002 produced a significant increase in UK turnover. Coutts was described at the time as "Europe's largest career transition and organisational consulting firm" (article of 25 March 2002 in TAY4(h)). I was unable to take into account use of Right Coutts in relation to section 5(2)(b) as no earlier trade mark was pleaded. I am required to do so for section 5(4)(a) purposes. There can be no doubt that this business acquisition represented a material enhancement to the pre-existing goodwill under various Right marks. It is also worth recording that Right Coutts is used with other Right branding. For instance the brochure in TAY3 and the 2003 rightcoutts.co.uk webpages in TAY4(i) show use of Right Corecare, Right Management Consultants and Right-*from-Home*.

103. The position under section 5(4)(a) is that the opponent can call on a larger stock of marks and lay claim to a significant goodwill in relation to career transition services and organisational/human resource consultancy services under signs based on or incorporating the word Right . The relevant public will be used to seeing such services provided under the range of marks referred to above and will understand that Right is the distinguishing, and recurrently used, common identifier.

104. The applicant's business is that of a recruitment agency. Although the applicant has operated as a conventional high street recruitment agency specialising in the lower end of the market, there is, as I have already said, no reason why it could not extend its operations within the terms of its existing specification to other segments of the market either in terms of specialising in particular career areas or to target more highly paid positions including executive recruitment. Nevertheless, given my view that recruiting services have not been at the heart of the opponent's trading activities to date (as distinct from appearing as a discrete item in its trade mark specifications) there is a distinction to be drawn between the services that underpin the opponent's goodwill and the applicant's recruitment services. Even though the opponent offers some recruitment services most of the evidence is that this is a more recent development and that this part of the opponent's business does not operate on conventional employment agency lines.

105. That leads on to consideration of whether use of the applied for mark would be a misrepresentation. Mr Marshall drew my attention to Kerly's Law of Trade Marks and Trade Names (Fourteenth Edition) at 15-046 and 15-047 setting out a number of general considerations on 'Common field of activity'. The main points I draw from this are that there is no rule that the parties must operate in the same field of activity; but an examination of the respective fields of activity is not irrelevant; the more remote the areas of activity, the stronger the evidence needed to establish a misrepresentation leading to damage; to the point where if the fields of trade are quite different the burden on a claimant is a very heavy one. Examples of cases at the further reaches are *Lego System A/S v Lego M Lemelstrich Ltd*, [1983] F.S.R. 155 (toys and irrigation equipment) and *Harrods Ltd v Harrodian School Ltd*, [1996] R.P.C. 694 (the well known department store v preparatory school services). The first of these cases demonstrates that even substantial differences between products is not a bar to success.

106. The applicant made the point in relation to section 5(2) that in terms of their actual trade to date the parties operate at different stages of the employment cycle, target different customers and thus that their services are complementary but not in competition with one another. It is suggested in essence that the opponent deals with more senior staff/executives for larger client companies or organisations and enjoys a more enduring relationship with those customers. Whereas the applicant targets smaller/local concerns, jobs at lower wage rates/salary levels and has a more fleeting relationship with its clients.

107. The distinctions between the businesses and their clients are not as stark as this. The applicant could equally target more senior positions/executives within the scope of its specification; the HR departments it deals with for routine appointments may also have occasion to employ the opponent's services; the opponent's field of activity is not restricted to executive positions and appointments as its resettlement service work for armed forces personnel and Barclays shows (TAY8); the opponent's client list (the confidential document at TAY7) contains smaller/local concerns as well as the names of larger corporate entities; and there is some evidence from other trading entities suggesting that the lines of demarcation are often blurred (see TAY12 and the material in RTAY3). Furthermore, an individual who has been offered assistance with job finding as part of a corporately-offered scheme may also wish to use other more conventional recruitment firms to increase the chances of finding employment. In overall terms of proximity of trade, there is less distance between the parties' areas of trade (allowing for the notional scope of the applicant's trade) than the applicant would have me accept.

108. The correct test on the issue of deception or confusion is whether on the balance of probabilities a substantial number of members of the public would be misled into purchasing the applicant's services in the belief that they were the opponent's services, *Neutrogena Corporation and Anr. v Golden Limited and Anr.* [1996] R.P.C. 473. Mr Bryson's submission was that human resources personnel familiar with the opponent's services conducted under a family of Right marks would, on encountering the applied for mark where Right is also a distinctive element, assume that the opponent had extended its activities and was now offering a recruitment service or that the latter service was connected with the opponent in some way. There is force in that submission. I would add that the relevant public must also include those individuals who are or would be candidates for the services in issue. They would be expected to bring less knowledge of the trade to bear. Use of the applied for mark would in my view amount to a misrepresentation to this group.

109. If I am right that use of the applicant's mark would cause a substantial number of people to think that the opponent had extended the range of services it offered, then damage by means of loss of trade would be a consequence. Mr Bryson also submitted that, if it is right to say that the applicant operates at the lower end of the employment market and the opponent at or towards the top end then there will also be damage resulting from the belief that the opponent has changed the focus of its activities. There is some force to that submission. It is not that the applicant's services themselves may be of inferior quality (I have no reason to suppose that they are) but that the opponent's reputation for supplying services in its chosen area of the market would be diluted by the wrongful association with services provided to a different segment of the market.

110. The outcome is that the opposition also succeeds under section 5(4)(a).

COSTS

111. The opponent has succeeded and is entitled to a contribution towards its costs. There was agreement at the hearing that my award should be based on the published scale. Mr Marshall reminded me that the applicant had not resisted the late clarificatory evidence from Mr Pittertou nor the late addition of No. 4974614 to the earlier trade marks relied on. I accept that the applicant behaved reasonably in relation to these issues. On the other hand, these issues did not require lengthy consideration and did not involve the applicant in any additional expense.

112. I order the applicant to pay the opponent the sum of **£2000** as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against this decision is unsuccessful.

Dated this 6th day of April 2009

**M REYNOLDS
For the Registrar
The Comptroller General**