

O-031-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3001522
BY CAREER LOOP LTD
TO REGISTER THE TRADE MARK**



IN CLASS 35

AND

**THE OPPOSITION THERETO UNDER NO. 401059
BY LOOPED PTY LIMITED**

Background and pleadings

1. Career Loop applied for the trade mark shown below on 10 April 2013, for a range of recruitment services in class 35.



2. Following the filing of a Form TM21 on 19 December 2014 to correct the name in which the trade mark application was filed, the name of the owner on the register is now recorded as Career Loop Ltd (“the applicant”). The application was published on 19 July 2013. It was subsequently opposed by Looped Pty Ltd (“the opponent”) on the basis that there is a likelihood of confusion, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent’s earlier International Registration designating the EU for the trade mark shown below:

1104574

THE LOOP

Class 35: Advertising services; marketing and promotional services; recruitment services; business management, administration and office functions; information distribution services; advertising services provided via a data base; classified advertising; providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; direct market advertising; personnel recruitment advertising; providing information, including online, about advertising, business management and administration and office functions; provision of advertising information; provision of advertising space; provision of information relating to advertising; recruitment advertising; advertising services provided over the Internet; compilation and management of on-line computer databases and on-line searchable databases; compilation of directories for publishing on the Internet; rental of advertising space on the Internet; business recruitment consultancy; executive recruitment services; permanent staff recruitment; personnel recruitment; personnel recruitment advertising; professional recruitment services; recruitment advertising; recruitment of personnel; staff recruitment services; compilation and provision of online directories; online advertising on a computer network; online promotion on a computer network; employment recruitment; compilation of advertisements for use as web pages on the Internet; resume compilation for personnel seeking employment; advisory, consultancy and information services in respect of the aforesaid services.

Date protection requested: 23 September 2011

Date protected: 11 December 2012

3. The opponent claims that, owing to the similarities between the marks and the high similarity or identity between the parties' services, there is a likelihood of confusion on the part of the relevant public. The applicant¹ denies the ground of opposition, stating:

The opponents registered trade mark represents the words "TheLoop", as one word. Their Logo does not place extra importance on the Loop element, the font and the size of both "the" and "loop" is the same.

The Look of our "Career Loop" logo is clearly different from that of "TheLoop", shown by the use of different Font, Size, Color and the Layout of the words. The only similarity being the use of the word "Loop". I assume the opponent does not have the sole right to use of the word Loop.

Across the web there are several uses of the word Loop for Job portals, Job boards, Social media, Networking, Marketing and the general recruitment industry. Loop is a descriptive word which has conjunctions with connectivity, grouping, completed processes, infinity and fashion and thus is commonly used in several similar industries.

Even the presentation of the common word "Loop" hugely differs between the two logos. The opponent represents the Two "O's" as clearly separate but interlocking letters. Whereas as our O's is presented as a slight variation of the infinity sign. As such i strongly disagree with the opponents statement and believe there is no infringement of the Opponents registered TM.

4. The opponent is professionally represented, whilst the applicant represents itself. The opponent filed written submissions, but no evidence. The applicant filed evidence and written submissions. The parties were asked if they wished to be heard or for a decision to be made from the papers. Neither replied and neither filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by both parties.

Evidence

5. The applicant's evidence comes from Jigar Patel, the applicant's director. I will not summarise the statement in any great detail as (i) much of the content consists of submission (which has been borne in mind) and (ii) a good part of it does not have any bearing on the issues I have to decide. Although Mr Patel states that the trade mark was first used in the UK in 2011, he goes on to say that the applicant "has yet to monetise the service". Mr Patel gives dictionary definitions for the word 'loop', in particular "an inner circle of advisers: "He's no longer in the loop"" and "aware (or unaware) of information known to only a privileged few". Mr Patel states that several recruitment websites or companies use the word Loop to describe their services, and that this word, is therefore, generic in the recruitment industry. He gives some examples of the word used in everyday speech to reflect the definitions. Mr Patel also states that it is common practice to link the 'oo' in Loop.

¹ The name of the applicant on the counterstatement is Career Loop Ltd.

Decision

6. Section 5(2)(b) of the Act states that:

“(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.”

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of services

8. The parties' competing specifications are shown in the table below.

Earlier mark	Application
<p>Class 35: <i>Advertising services; marketing and promotional services; recruitment services; business management, administration and office functions; information distribution services; advertising services provided via a data base; classified advertising; providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; direct market advertising; personnel recruitment advertising; providing information, including online, about advertising, business management and administration and office functions; provision of advertising information; provision of advertising space; provision of information relating to advertising; recruitment advertising; advertising services provided over the Internet; compilation and management of on-line computer databases and on-line searchable databases; compilation of</i></p>	<p>Class 35: <i>Consultancy of personnel recruitment; Personnel placement and recruitment; Personnel recruitment services; Recruitment and placement services; Recruitment consultancy services; Recruitment services; Staff recruitment services; Advertising services relating to the recruitment of personnel; Advisory services relating to personnel recruitment; Assistance relating to recruitment and placement of staff; Business recruitment consultancy; Consultancy relating to personnel recruitment; Employment recruitment; Executive recruitment services; Interviewing services [for personnel recruitment]; Management advice relating to the recruitment of staff; Office support staff recruitment services; Permanent staff recruitment; Personnel recruitment advertising; Personnel recruitment agency services; Personnel recruitment consultancy; Professional</i></p>

<p>directories for publishing on the Internet; rental of advertising space on the Internet; business recruitment consultancy; executive recruitment services; permanent staff recruitment; personnel recruitment; personnel recruitment advertising; professional recruitment services; recruitment advertising; recruitment of personnel; staff recruitment services; compilation and provision of online directories; online advertising on a computer network; online promotion on a computer network; employment recruitment; compilation of advertisements for use as web pages on the Internet; resume compilation for personnel seeking employment; advisory, consultancy and information services in respect of the aforesaid services.</p>	<p>recruitment services; Provision of advice relating to the recruitment of graduates; Provision of information relating to recruitment; Recruitment (personnel-); Recruitment advertising; Recruitment consultancy for lawyers; Recruitment consultancy for legal secretaries; Recruitment consultants in the financial services field; Recruitment of computer staff; Recruitment of executive staff; Recruitment of personnel; Recruitment of temporary technical personnel; Recruitment services for sales and marketing personnel; Staff recruitment; Staff recruitment consultancy services; Personnel recruitment services and employment agencies; Dissemination of information relating to the recruitment of graduates; Personnel recruitment; Recruitment (Personnel -).</p>
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9. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court (“GC”) stated that:

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

The opponent has cover for *recruitment services*, which covers all the terms in the application. The parties’ services are therefore identical. Additionally, the applicant’s services are identical to all the other terms which I have highlighted in the opponent’s specification.

Average consumer

10. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

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

12. There are two relevant publics for the parties’ services; those seeking to recruit and those looking for employment. The level of attention paid will vary according to the type of work, salaries etc, such as whether the services are provided by an agency found on any UK high street, or a specialist agency recruiting highly skilled, professional or executive staff. Overall, a reasonable level of attention will be paid during the selection of the services, which will, mostly, be a visual selection through websites and premises signage. However, this is a business which features word-of-mouth recommendations and telephone contact, so the aural aspect to the purchasing process is also to be borne in mind.



Comparison of marks

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

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

It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

14. The respective marks are:

Opponent	Applicant
 The logo consists of the words "THE LOOP" in a bold, black, sans-serif font. The two 'O's in "LOOP" are stylized to interlock.	 The logo features the word "career" in a small, black, sans-serif font above the word "loop". The "loop" is rendered in a blue, stylized font where the two 'O's are interlocking.

15. The overall impression of the opponent's mark is of the combination of the words THE LOOP, conjoined, in letters reminiscent of stencilling. The OO in loop has been further stylised so that the two Os interlock; this element has some but less relative weight in the overall impression of the mark. The overall impression of the applicant's mark is of the words career loop, but the size and general impact of the word loop means that it has a much greater relative weight than the word career.

16. Visually, the lettering is different in the two marks. The only point of visual similarity is the presence of the word loop in the two marks. Although both contain stylised double Os, the stylisation is different. There is a moderate degree of visual similarity between the marks. Aurally, the marks are reasonably similar, the second word being identical.

17. The conceptual significance of the opponent's mark is that of 'loop' plus the definite article: THE LOOP. At its most basic, loop means a closed circle or oval. Mr Patel has given some dictionary definitions in his evidence as to the meaning of loop, which changes depending on context; for example, in a colloquial, business sense it means to stay informed. The concept of loop in the context of career(s) is not obvious, certainly not as obvious as staying in the career loop, even if that is to what the applicant intends to allude, as suggested by aspects of Mr Patel's evidence. Therefore, I conclude that the marks share the basic concept of a loop, but that the applicant's mark has the added meaning of career. There is a good deal of conceptual similarity between the marks.

18. In relation to the colour aspect of the applicant's mark, I note that Kitchin LJ stated in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96]:

"A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours."

This means that the opponent's mark is registered in respect of all colours and could be used in any colour, including blue (but notional use would not extend to contrived colour splits, such as putting the double O in blue and retaining black for the rest of the opponent's mark).

Distinctive character of the earlier marks

19. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*² the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

20. The earlier mark consists of the conjoined words THELOOP, with the intertwined OO adding some distinctive character of its own. The mark consists of dictionary words, but they are not directly descriptive of the opponent’s services, despite Mr Patel’s evidence. THE LOOP has a good level of distinctive character. The opponent has not filed evidence, so has not shown that any use it might have made of its mark has increased that level of inherent distinctive character.

Likelihood of confusion

21. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the services are identical and that there are varying degrees of visual, aural and conceptual similarity between the marks. In the applicant’s mark, the dominant distinctive element is the word LOOP; career is much smaller and, in the context of recruitment services, is descriptive. Whilst marks are perceived as

² Case C-342/97

wholes, the focus will naturally fall more upon LOOP. This will also be the case for the opponent's mark, as 'the' is simply the definite article. Loop is the conceptual hook which consumers will recall. Additionally, the aural aspect of the purchasing process is a factor in the recruitment sector, where the visual differences will not come into play. The common element Loop, and the fact that the OO in each mark has been stylised will, in relation to the identical services, cause a likelihood of confusion.

22. The applicant points to the fact that it has been using the mark in the UK since 2011, although its evidence is internally inconsistent in this regard. Even if that were the case, i.e. before the opponent's mark was applied for, the system of trade mark registration in the UK is 'first past the post'. An opposition raised under Section 5(2) operates on the basis of the 'first to file' UK trade mark registration system. The opponent got there first. It is also not relevant that the opponent has not yet used its mark in the UK. This is because the opponent's earlier mark had not been registered for five years or more at the date on which the applicant's mark was published and so it does not have to prove that it has used its mark: trade mark registration owners have five years in which to make genuine use of their marks before they become liable to proof of use. The test in this case is whether there is a likelihood of confusion 'notionally', i.e. whether all the factors I have discussed throughout this decision combine to lead to a conclusion that there is, or is not, a likelihood of confusion, on the part of the average consumer, between the marks.

Outcome

23. The opposition succeeds. The application is to be refused.

Costs

24. The opponent has been successful and is entitled to a contribution (rather than compensation) towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. The breakdown is as follows:

Preparing a statement and considering the counterstatement	£200
Official opposition fee	£100
Considering applicant's evidence and filing submissions	£350
Total:	£650

25. I order Career Loop Ltd to pay Looped Pty Limited the sum of £650 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 21st day of January 2015

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