

O/0736/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004153643

IN THE NAME OF

ATLAS RECRUITMENT TECHNOLOGY LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000454131

BY CITATION LIMITED

Background and pleadings

1. On 28 January 2025, atlas recruitment technology ltd (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 28 February 2025 in respect of services in class 42.¹ However, during the course of the proceedings these services were limited,² as set out in paragraph 22 of this decision.
2. On 12 May 2025, Citation Limited (“the Opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all services in the application. The Opponent relies upon the following two marks:



UK Registration no. UK00004042182 (“the ‘182 mark”)

Filing date: 22 April 2024

Date of registration: 26 July 2024

Relying upon the services set out in paragraph 22 of this decision.

ATLAS

UK Registration no. UK00004082206 (“the ‘206 mark”)

Filing date: 31 July 2024

Date of registration: 22 November 2024

¹ See the Annex to this decision.

² On 08 August 2025, the applicant filed a Form TM21B requesting a limitation to the specification of services claimed in their application.

Relying upon the services set out in Annex 2 of this decision.

3. By virtue of their earlier filing dates, the above registrations constitute earlier marks within the meaning of section 6 of the Act. As the Opponent's marks had not completed their registration process more than five years before the filing date of the application in issue, they are not subject to the use provisions contained in section 6A of the Act. In view of this, the Opponent can rely upon all of its services without having to demonstrate use.
4. The Opponent submits that the marks are highly similar and that the services at issue are identical or similar.
5. The Applicant filed a counterstatement within which it denies the grounds of opposition.
6. Only the Applicant filed evidence, however both parties filed written submissions during proceedings. Neither party requested a hearing, and only the Opponent filed submissions in lieu of the same. This decision is taken following careful consideration of the papers.
7. The Applicant is self-represented; the Opponent is represented by Wilson Gunn.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Preliminary issues

9. The Applicant raised several points in its counterstatement and written submissions that I intend to address as preliminary issues. Before going any further into the

merits of this opposition it is necessary to explain why, as a matter of law, the points raised will have no bearing on the outcome of this opposition.

State of the register

10. The Applicant submits that there are 33 trade marks incorporating the word “atlas” already on the register, so this cannot be an issue.³ Although I acknowledge these comments, the existence of other trade marks on the register is not relevant to the decision I must make. The outcome of this opposition will be determined based on the merits of the case and the assessment of similarity between the marks and their respective specifications at issue, amongst other considerations. Thus, this argument is of little assistance to the Applicant.

Other grounds

11. It is noted that the Applicant makes reference to goodwill and sections 1(1), 3(1)(b), 3(1)(c) and 3(1)(d) of the Act in its written submissions.⁴ However, it should be noted that the opposition is based on section 5(2)(b) only. Accordingly, I will say no more on the matter of goodwill or other sections of the Act.

Prior decisions

12. In its written submissions, the Applicant refers to several prior decisions. Whilst I note the contents and findings of those decisions, I am not bound by them and will proceed to conduct a full comparison, having regard to the relevant case law and all the relevant factors.

Target markets

13. The Applicant submits that their services are aimed at executive search and agency (third party) recruiters, while the Opponent’s services are health and safety

³ Applicant’s TM8 and counterstatement, point 1.

⁴ Applicant’s written submissions, page 2 and 3.

compliance software.⁵ However, differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from each party's specification. It is the services relied upon by the Opponent, and the services applied for by the Applicant that I will be comparing in this decision. The assessment I must make between the services is a notional and objective assessment, rather than a subjective one.

14. Furthermore, marketing strategies, including the targeting of specific sectors or consumers, are temporary and may change over time.⁶ As such, it is not appropriate to take such factors into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer could be for the services at issue.

Evidence and submissions

15. The Opponent filed written submissions on 08 August 2025.
16. The Applicant filed written submissions on 06 November 2025. At the same time, the Applicant filed evidence in the form of the witness statement of Jordan Shlosberg dated 08 August 2025, accompanied by 14 exhibits (RCE1-RCE6 and RCF1-RCF8).
17. The Opponent filed written submissions in lieu of a Hearing on 02 April 2026.
18. I have given due consideration to all of the documents filed but will refer to them only to the extent that I consider it necessary in this decision.

My Approach

19. The Opponent relies upon two earlier rights under Section 5(2)(b). I am of the view that the services within the specification of the '182 series of marks represent the Opponent's strongest case. Accordingly, I will consider the opposition on the basis

⁵ Applicant's TM8 and counterstatement, point 3 and Applicant's written submissions, page 4.

⁶ *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

of that mark, in the first instance, returning to the '206 mark only to the extent that it is necessary to do so. For ease of reference, going forward, I will refer to the Opponent's '182 series of marks simply as, "the Opponent's mark".

Decision

Section 5(2)(b)

20. The opposition is based upon Section 5(2)(b) of the Act, which reads as follows:

"5(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".

21. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of services

22. The services for comparison are as follows:

Opponent's services	Applicant's services
Class 42: Providing temporary use of non-downloadable software, software platforms and software applications; provision of software as a service (SaaS) and platform as a service (PaaS); provision of software as a service (SaaS) and platform as a service (PaaS), all in relation to health and safety, legal matters, employment matters, human resources, employment and pre-employment screening and vetting, employee health and wellbeing, occupational health, testing services, quality assurance, quality certification, accreditation, safety evaluation, food hygiene, food safety, risk assessments, cyber, data and IT security, e-learning and training, and compliance with laws and regulations; design, development and implementation of software, software platforms and software applications; installation, setting up, maintenance, repair and updating of software, software platforms and software applications; computer software technical support services; information, advisory and consultancy services in relation to all of the aforesaid.	Class 42: Software as a service [SaaS], namely customer relationship management (CRM) and applicant tracking software for recruitment agencies and executive-search firms.

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23. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, 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 für 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.”

24. The Opponent submits that the Applicant’s services are identical to their “*providing temporary use of non-downloadable software, software platforms and software applications*” and “*provision of software as a service (SaaS) and platform as a service (PaaS)*”.

25. The Applicant’s services fall within the Opponent’s wider unrestricted term “*provision of software as a service (SaaS) [...]*”. The services are therefore identical on the principle set out in *Meric*.

Average consumer and the purchasing act

26. As the case law above indicates, it is necessary to determine who the average consumer is for the services at issue. I must then determine the manner in which the services are likely to be selected by the average consumer.

27. 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 services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

28. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

29. The average consumer for the services will be businesses and professional users, including, for example, recruitment agencies and executive-search firms. Various

factors will be taken into consideration during the purchasing process, such as security, ease of use and suitability for the consumer's needs. Due to the impact that the services may have on recruitment, data security or the reputation of a business, I consider that a medium to high degree of attention will be paid during the purchasing process.

30. The services are likely to be obtained by visiting the service provider's website or reviewing advertising material. Visual considerations are, therefore, likely to dominate the purchasing process. However, given that word-of-mouth recommendations may also play a part, I do not discount that there will also be an aural component to the purchase of the services.

Comparison of the marks

31. The respective trade marks are shown below:

Opponent's mark	Applicant's mark
	

32. The Applicant's mark comprises figurative device elements followed by the word "ATLAS". The figurative elements, positioned to the left of the word "ATLAS", consist of a solid black circle and a solid black four-sided shape resembling a rectangle with the top line angled to the left. Although the parties submit that the

shapes form a highly stylised letter 'A',⁷ I do not consider the average consumer will perceive them in that way. I consider that the figurative elements will merely be perceived as two independent shapes. The word "ATLAS" is presented in a standard uppercase typeface. Bearing in mind that the eye is naturally drawn to the parts of the mark which can be read,⁸ I consider that the word "ATLAS" plays the greatest role within the mark, with the figurative shape elements playing a lesser role.

33. The Opponent's mark is a series of two marks, consisting of a figurative triangular-shaped device and the word "Atlas". The device consists of a triangular shape formed from a single line, which overlaps to the left-hand side and extends to points. In the first mark in the series, this device is presented in a pink-to-orange gradient, while in the second mark is presented in a dark-to-light grey gradient. I do not consider the colour/grey variants between the series of marks materially affect the assessment and therefore will consider them together. Both parties submit that the device element consists of a stylised letter 'A'.⁹ While some consumers may perceive the mark as a stylised letter 'A', it is my view that the device will more likely be viewed merely as a figurative triangular shape. To the right of the device is the word "Atlas" presented in a lightly stylised title case typeface. Bearing in mind that the eye is naturally drawn to the parts of the mark which can be read, I consider that the word "Atlas" plays the greatest role within the mark, with the triangular-shaped device playing a lesser role.
34. Visually, the marks coincide in the word 'Atlas'/'ATLAS', which is also positioned in the same place within the marks. I do not consider the distinction in letter case or font to be points of significant difference between them. However, the figurative elements in the marks are points of visual difference. Nevertheless, I find that the marks are visually similar to a medium degree.
35. Aurally, the marks coincide in the word 'Atlas', which will be pronounced in the ordinary way. The device element in the Applicant's mark will not be articulated. As

⁷ Applicant's TM8 and counterstatement, point 2 and Opponent's written submissions, paragraph 5.

⁸ *MigrosGenossenschafts-Bund v EUIPO*, T-68/17.

⁹ Applicant's TM8 and counterstatement, point 2, and Opponent's written submissions, paragraph 5.

set out in paragraph 33 the device element in the Opponent's mark may be perceived as a stylised letter 'A', although I consider it more likely it will be seen as a triangular device. If perceived as a letter 'A', it would likely be articulated as 'AY', if pronounced. However, I am of the view that it is unlikely to be articulated and will merely be perceived as a figurative triangular device. Therefore, I consider the marks to be aurally identical.

36. Conceptually, the marks share the concept of 'Atlas', which will be understood by a significant proportion of average consumers to be a book of maps. The device within the Applicant's mark has no concept beyond being simple geometric shapes. The device within the Opponent's mark will be seen as a triangular shape with no concept. However, for consumers which see the device as a stylised letter 'A', it has no concept beyond being a letter of the alphabet. Overall, I consider the marks to be conceptually similar to a very high degree.

Distinctive character of the earlier trade mark

37. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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)."

38. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.
39. The Opponent has not filed any evidence to support that its mark's distinctive character has been enhanced through use, nor was it required for them to do so. Consequently, I have only the inherent position to consider.
40. The Opponent's mark (series of two) consists of the ordinary dictionary word 'Atlas' and a device element.
41. The Applicant submits that the Opponent's mark is low in inherent distinctiveness due to it being a dictionary term and being used in various other trade marks.¹⁰ However, considering the word 'Atlas' has no obvious descriptive or allusive qualities in relation to the services at issue, I disagree that its inherent distinctiveness is low.
42. The device element (which will be perceived either as a stylised letter 'A', or simply as a triangular shape) also contributes to the mark's distinctiveness, although to a lesser extent than the word 'Atlas'.
43. Overall, I consider that the mark is inherently distinctive to a medium degree.

¹⁰ Applicant's written submissions, page 1.

Likelihood of confusion

44. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

45. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

46. Earlier in this decision, I found that:

- The services are *Meric* identical.
- The average consumer for the services will be businesses and professional users who will pay a medium to high degree of attention during the purchasing process.
- The purchasing process for the services is predominantly visual, although I do not discount an aural component.
- The marks are visually similar to a medium degree, aurally identical and conceptually similar to a very high degree.
- The earlier mark is inherently distinctive to a medium degree.

47. Taking all of the above into account, I consider that the marks are likely to be mistakenly recalled or misremembered as each other. This is particularly the case

given that the marks are applied for/registered in relation to identical services. Even allowing for the medium to high degree of attention paid during the purchasing process, I consider that the average consumer will pin their recollection on the shared word 'Atlas', which plays the greatest role in the overall impression of both marks. With regards to the device elements present in the marks, while not negligible, I do not find them to be particularly striking or memorable, and as such they will likely be mistakenly recalled, overlooked or forgotten by the average consumer. Taking all the above factors into account, I consider there to be a likelihood of direct confusion.

48. I now proceed to consider whether there exists a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- a. where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are

quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

- b. where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- c. where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

49. Furthermore, in *Liverpool Gin*,¹¹ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

50. Even if the differences between the marks are identified by the average consumer, I consider that the marks will be viewed as coming from the same or economically linked undertakings. I am of the view that the additional figurative elements and slight stylistic differences present in the marks would simply be perceived as variants of the same 'Atlas' brand. Accordingly, I consider there to be a likelihood of indirect confusion.

51. Given that I have found a likelihood of confusion based on the Opponent's '182 earlier mark, I do not consider it necessary to consider the remaining mark on the basis that doing so will not improve the Opponent's position.

¹¹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

Conclusion

52. The opposition based upon 5(2)(b) is successful. Therefore, subject to any successful appeal against my decision, the application shall be refused.

Costs

53. The Opponent has been successful and is therefore entitled to a contribution towards its costs. I base the costs awarded on the scale contained in TPN 1/2023. In the circumstances, I award the Opponent the sum of £850 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing a statement and considering the other side's counterstatement	£250
Preparing written submissions and considering the Applicant's evidence	£300
Preparing written submissions in lieu of a hearing	£200
Total:	£850

54. I therefore order atlas recruitment technology ltd to pay Citation Limited the sum of £850. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of August 2026

Emma Rees

For the Registrar

Annex 1

Class 42:

Software as a service [SaaS].

Annex 2

Services relied upon by the Opponent under the UK00004082206 (“the ‘206 mark”):

Class 42:

Provision of software as a service (SaaS) and platform as a service (PaaS), all in relation to health and safety, legal matters, employment matters, human resources, employment and pre-employment screening and vetting, employee health and wellbeing, occupational health, testing services, quality assurance, quality certification, accreditation, safety evaluation, food hygiene, food safety, risk assessments, cyber, data and IT security, e-learning and training, and compliance with laws and regulations; design, development and implementation of software, software platforms and software applications; computer software technical support services; information, advisory and consultancy services in relation to all of the aforesaid.