

O/300/13

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO. 2599028**  
**BY PAUL JOHNSON**  
**TO REGISTER THE TRADE MARK**

**CView**

**IN CLASSES 35 & 45**

**AND:**

**OPPOSITION THERETO UNDER NO. 103386**  
**BY RMC OF ILLINOIS, INC.**

## **BACKGROUND**

1. On 21 October 2011, Paul Johnson applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 23 March 2012 for the following services:

**Class 35** – Personnel recruitment services.

**Class 45** – Preparation and creation of Curricula Vitea.

2. On 22 May 2012, RMC of Illinois, Inc. (“the opponent”) filed a notice of opposition directed against all of the services in Mr Johnson’s application. The opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which the opponent relies upon all the services in the following trade mark registration:

**CTM no. 8136962** for the trade mark: **IVIEW** applied for on 4 March 2009 and registered on 28 September 2011 for:

**Class 35** - Employment agency services; temporary and permanent employment agency services; employee leasing; employment related services, namely, providing job placement, career development, employment recruitment, and general employment information to others; business management and consulting services, namely, assisting businesses in managing workforce changes, namely, mergers, acquisitions, amalgamations, downsizing, and expansion; personnel management, human resources management; employment outplacement consultation services for personnel affected by workforce changes; employment agency services, namely, supplying to others on a temporary and permanent basis engineers, computer programmers, draftsmen, and skilled technical personnel; personnel management, namely, providing and managing contract personnel programs; analyzing and consulting on personnel needs; employment agency, namely, providing contract, temporary, and permanent personnel staffing services; personnel management, namely, arranging for and managing the provision of temporary contract personnel; personnel management and consultancy services; providing information and consultancy services on the procurement of temporary, contract, and permanent personnel; computer on-line ordering via a global information network, and providing computer on-line reports via a global information network, all in the field of personnel procurement; human resources consulting on recruiting and testing of employees to determine employment skills; contract and permanent staffing agency services featuring staff professionals in finance, information technology, engineering, scientific and technical personnel, as well as office administrative staff, factory staff, industrial staff and call center staff; serving as a human resource department for others; employment outplacement services; testing to determine employment skills; employment counseling and recruiting; workforce development services, namely, personnel management services. providing career information via a website on a global information network; providing

information on jobs via a website on a global information network; providing an on-line computer database in the fields of contract and permanent personnel staffing; providing employee screening and assessment tools via a website on a global information network; providing a website featuring resume listing services and resume matching services; employee relocation services for people and groups of people who are being transferred by their employers from one geographical area to another, international and domestic, namely, providing information and counseling on finding a new home, providing pre-decision destination information, providing information and counseling for family members' job search, providing destination area information; employee relocation services for individuals, international and domestic, namely, providing information and counseling on finding a new home, providing pre-decision destination information, providing information and counseling for family members' job search, providing destination area information; in class 35.

**Class 41** - Career counseling in the field of combining personalized career transition coaching and mentoring with computer network based access to and management of candidate-related information and communication between the candidate, coaches and mentors; providing training in business and job skills and office technology; providing on-line courses of study in the following information technology, software use, job and business skills via a website on a global information network; career counseling services; education and training services, namely, providing training in relation to job search, career development, self-marketing, interview skills, research workshops and training of human resource personnel in employment separation issues; conducting classes, workshops and seminars in the fields of business management, human resource management and corporate and organization training; workshops, seminars and training in the field of business and personal improvement; in class 41.

3. On 28 August 2012, Mr Johnson filed a counterstatement in which he denies the opponent's claims. Mr Johnson points to what he considers to be the: "clearly different names", the different actual services upon which the competing trade marks are used, and the existence of a trade mark registration of IVIEW in class 35 in the name of a third party which predates that of the opponent; I will return to these points later in this decision.

4. Only Mr Johnson filed evidence. Whilst neither party asked to be heard, the opponent filed submissions in lieu of attendance at a hearing. I will refer to these submissions as necessary below.

### **Mr Johnson's evidence**

5. This consists of a witness statement from Mr Johnson accompanied by six exhibits. Whilst I have read this evidence, it is not necessary for me to summarise it here. Mr Johnson explains that the purpose of his statement is to show:

“1...the distinct, different & clearly unrelated “products” that CView and IVIEW represent.”

6. However, as the opponent’s trade mark is not subject to the proof of use requirements (see below), what I must do is conduct a notional comparison of all the services applied for and registered and not a comparison of the actual services upon which the competing trade marks are currently being used. As a consequence, Mr Johnson’s evidence is not germane to the issues before me.

## **DECISION**

7. Section 5(2)(b) of the Act reads as follows:

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

(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, or

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

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which Mr Johnson’s application was published and the date on which the opponent’s registration completed its registration procedure, its earlier trade mark is not subject to proof of use, as per section 6A of the Act.

## **Section 5(2)(b) – case law**

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

### **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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer and the nature of the purchasing process**

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services and then to determine the manner in which these services will be selected by the average consumer in the course of trade. The services at issue in these proceedings are, broadly speaking, those relating to human resources and in particular those relating to employment. The average consumer for such services will be, for example, a member of the general public looking for employment opportunities or a business requiring new staff or assistance with the management of existing staff. While such services are, I think, most likely to be selected having encountered the trade mark in, for example, specialist publications and websites (indicating that visual considerations will play an important part in the selection process), that does not mean that aural considerations can be ignored. Given the importance of employment/employee decisions to either an individual or a business, one would expect both sets of average consumers to pay a fairly high degree of attention to the selection of the services at issue.

### **Comparison of services**

12. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU 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.

13. In reaching a conclusion, I will also keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

14. Finally, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 are also relevant:

“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.”

15. I have reproduced the competing specifications above. I agree with the opponent that Mr Johnson's services in class 35 i.e. "Personnel recruitment services" are identical to, at least, "employment related services, namely...employment recruitment..." in class 35 of its earlier trade mark. In addition, given the similarity in the nature of the services, their users, intended purpose and method of use, I also agree with the opponent that Mr Johnson's services of "Preparation and creating of curricula vitae" in class 45 are similar to, inter alia, "providing career information via a website on a global information network", "providing employee screening and assessment tools via a website on a global information network" and "providing a website featuring resume listing services and resume matching services" in the opponent's specification in class 35, and, in my view, similar to a high degree.

### **Comparison of trade marks**

16. The competing trade marks are as follows:

| <b>The opponent's trade mark</b> | <b>Mr Johnson's trade mark</b> |
|----------------------------------|--------------------------------|
| IVIEW                            | CView                          |

17. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective trade marks.

18. In its submissions, the opponent refers to a decision of the Opposition Division of the Office for Harmonisation in the Internal Market ("OHIM") in *eView v IVIEW* (case no. B1456807). In that decision, the Opposition Division found the trade marks at issue to be visually and aurally highly similar and conceptually identical insofar as the VIEW element of the competing trade marks was concerned. Whilst I have noted the views of the Opposition Division, they are, of course, not binding upon me; I must reach my own conclusions.

19. The opponent's trade mark consists of the word IVIEW presented in upper case. As no part of the trade mark is highlighted or emphasised in any way, there are no distinctive and dominant components; the distinctiveness lies in the trade mark as a whole.

20. Turning to Mr Johnson's trade mark, this consists of the letters CV presented in upper case accompanied by the letters i-e-w presented in lower case. In his evidence Mr Johnson explains that his trade mark was chosen as a play on the abbreviation CV "whilst communicating the watchable, viewing, talking nature of a video". Given their positioning as the first two letters of Mr Johnson's trade mark and as they are presented

in upper case, the letters CV are, I think, unlikely to go unnoticed by the average consumer. However, even if these letters are considered to be a dominant element of the trade mark, as they relate to the services for which registration is sought, they are not a distinctive element. Because the letter V is capitalised and the letters which follow it are presented in lower case, and as the average consumer will be familiar with the meaning of the well known English word View, the presence of this word in Mr Johnson's trade mark is also unlikely to go unnoticed. However, as this word is apt to describe services which facilitates the viewing of something (a CV for example), it must, (if it has any), have a very limited degree of distinctive character. In those circumstances, the distinctiveness of Mr Johnson's trade mark lies in its totality i.e. as a single word in which the shared letter V is used to form the abbreviation CV and the word View.

21. Both parties' trade marks consist of five letters the last four of which are identical (although the presentation of these last four letters differs). Although the word VIEW forms an integrated element of the opponent's trade mark, as I mentioned above, as the word VIEW is a well known English word its presence in the opponent's trade mark is, in my view, unlikely to go unnoticed. The first letters of the competing trade marks differ and the letters CV in Mr Johnson's trade mark are presented in upper case with the remaining letters presented in lower case. Both trade marks will, in my view, be pronounced as two syllable words i.e. as I-VIEW and C-View. Considered overall, I think the competing trade marks are visually similar to a reasonable degree and aurally similar to a high degree.

22. In its submissions, the opponent states that neither parties' trade marks "have a meaning per se in the English language..."; in his counterstatement, Mr Johnson suggests that the opponent's trade mark is derived from the word INTERVIEW. Whilst the presentation of the letters CV in upper case in Mr Johnson's trade mark are, I think, likely to suggest a connection with curriculum vitae, and whilst the presence of the word VIEW in both parties' trade marks is likely to trigger similar conceptual images in the average consumers' mind, when considered as totalities, neither parties' trade marks are, in my view, likely to convey any concrete conceptual message; the conceptual position is, I think, neutral.

### **Distinctive character of the opponent's earlier trade mark**

23. I must now assess the distinctive character of the opponent's earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As far as I am

aware (and there is no evidence to the contrary), the opponent's trade mark is neither descriptive of nor non-distinctive for the services for which it stands registered. It is, in effect, an invented word and as such is possessed of a high degree of inherent distinctive character.

### **Likelihood of confusion**

24. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the opponent's earlier trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has retained in his/her mind. Earlier in this decision I concluded that: (i) whilst the average consumer is either a member of the general public or a business who is likely to acquire the services at issue by primarily visual means, aural considerations must not be ignored, (ii) the average consumer will pay a fairly high degree of attention when selecting the services at issue, (iii) the services at issue are identical or highly similar, (iv) the competing trade marks are visually reasonably similar, aurally similar to a high degree and conceptually neutral, and (v) the opponent's earlier trade mark is possessed of a high degree of inherent distinctive character.

25. Whilst visual considerations are, in my view, likely to be to the fore, I remind myself that aural considerations must not be overlooked. Considered overall, I find that notwithstanding the fairly high degree of attention that will be paid to the selection of the services at issue, the degree of visual and aural similarity between the competing trade marks is, in circumstances where the services at issue are identical or highly similar and the earlier trade mark highly distinctive, sufficient to lead to a likelihood of confusion; the opposition succeeds.

26. In reaching this conclusion, I have not overlooked Mr Johnson's comments regarding the existence of an earlier registration of the trade mark IVIEW in class 35 in the name of an unrelated third party, or that the competing trade marks appear to be in use (the latter of which I have commented upon above). As to the first point, as each case must be determined on its own merits, the existence of the earlier registration is, as the opponent points out, "irrelevant."

### **Overall conclusion**

27. The opposition succeeds in full.

## **Costs**

28. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

|   |             |
|---|-------------|
| Preparing a statement and considering Mr Johnson's statement: | £200        |
| Opposition fee:   | £200        |
| Written submissions:  | £300        |
| <b>Total:</b>   | <b>£700</b> |

29. I order Paul Johnson to pay RMC of Illinois, Inc the sum of **£700**. 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 this case if any appeal against this decision is unsuccessful.

**Dated this 29 day of July 2013**

**C J BOWEN  
For the Registrar  
The Comptroller-General**