

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3153492  
IN THE NAME OF HUDSON GLOBAL INC**

**AND IN THE MATTER OF OPPOSITION No. 407287 THERETO  
BY PULSE HEALTHCARE LIMITED**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE APPLICANT  
AGAINST A DECISION OF MRS JUDI PIKE  
DATED 5 OCTOBER 2017**

---

**DECISION**

---

**Background**

1. This is an appeal against a decision of Mrs Judi Pike, acting for the Registrar, BL O/482/17, dated 5 October 2017. In that decision, Mrs Pike partially allowed an opposition brought by Pulse Healthcare Limited (“the Opponent”) against UK Application number 3153492 standing in the name of Hudson Global Inc. (“the Applicant”).
2. On 7 March 2016, the Applicant sought registration of the designation PULSE MINDSET under number 3153492 for use as a trade mark in the UK in respect of the following goods and services:

Class 9

Electronic publications (downloadable); visual, audio and audio-visual recordings; none of the above being in the fields of health, medicine or medical practice; computer software; downloadable software; magnetic, optical and digital storage media; software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development

Class 16

Printed matter, periodical publications, magazines, brochures, pamphlets, catalogues, newsletters, handbooks; books, lecture notes; product and system operating services and maintenance manuals; instructional and teaching materials; none of the above being in the fields of health, medicine or medical practice; printed matter relating to the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development

## O-322-18

### Class 35

Employment hiring, recruiting, placement, and staffing services; human resources; business management; personnel management; information, advice and consultancy services relating to the aforesaid

### Class 41

Educational services; conducting training programs, seminars, lectures, conferences, and workshops; conducting training programs, seminars, lectures, conferences, and workshops in the field of recruitment, talent management, organisational effectiveness and employee performance; publication and distribution of printed matter; publication and distribution of educational materials; non-downloadable publications

3. The application was published in the Trade Marks Journal on 3 June 2016. On 1 September 2016, the Opponent filed Notice of opposition and statement of grounds against the application. The responses to the relevant questions on Form TM7, and the Opponent's attached statement of grounds indicated that the opposition was against all the goods and services in Application number 3153492.
4. The grounds of opposition were under Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.
5. For the purposes of Section 5(2)(b) and 5(3) the Opponent relied on its 2 earlier trade mark registrations detailed below, neither of which was subject to proof of use:

Number	Mark	Filing/registration date	Services
UK 3064388	PULSE	15.07.14/05.12/14	Recruitment services; outsourcing services [business assistance]; business management assistance; personnel management consultancy
UK 3049892 (series of 2)		03.04.14/22/08.14	Recruitment services; outsourcing services [business assistance]; business management assistance; personnel management consultancy

6. Regarding Section 5(4)(a) the Opponent relied on its earlier unregistered rights in the UK in the marks shown above.
7. The Applicant took issue with the grounds of opposition in a Defence and counterstatement filed on 7 November 2016. The Opponent accepted that certain of its services in Class 35 were identical to those of the Opponent but called upon the Opponent to explain the bases for the Opponent's claims that: (1) the remaining goods and services applied for were similar to services of the Opponent (Section

5(2)(b)); and (2) detriment would likely be suffered to the Opponent's trade marks through registration and use of the Applicant's trade mark (Section 5(3)).

8. The Opponent filed evidence chiefly as to its reputation and goodwill in its trade marks in the UK. Further late evidence, essentially clarifying that the sales figures for the Opponent's services provided under the trade marks related to the UK, was admitted by the Hearing Officer into the proceedings. I did not understand the Applicant to be challenging that decision to admit late evidence on appeal. The opposition came to a hearing on 8 June 2017 where Mr. Malcolm Chapple of Counsel who has since retired, instructed by Longmores Solicitors LLP, appeared for the Opponent and Mr. Aaron Wood of Wood IP Limited appeared for the Applicant.

### **The Hearing Officer's decision**

9. At the outset, it is clear that the Hearing Officer was misinformed as to the representation of the Applicant's trade mark which she reproduced in her decision as being on 2 lines rather than 1, that is:

PULSE  
MINDSET

instead of PULSE MINDSET.

10. Her comparison of the Applicant's trade mark with the Opponent's trade marks was therefore based on the word PULSE appearing above the word MINDSET in the Applicant's trade mark.
11. Other than that, which forms the first ground of appeal and which the Opponent does not deny, the Hearing Officer's decision was as follows, in brief:

#### **Section 5(2)(b)**

##### Applicable law

12. The Hearing Officer would be guided in her application of Section 5(2)(b) by the Registrar's usual statement of principles gleaned from the case law of the Court of Justice of the European Union. There was no question but that the Hearing Officer stated the law correctly.

13. Again, on the comparison of goods and services, the Hearing Officer stated the law correctly in referring to the tests for comparison in Case C-39/97, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* [1998] ECR I-5507, Case C-50/15 P, *Kurt Hesse v. OHIM* EU:C:2016:34, Case T-325/06, *Boston Scientific Ltd v. OHIM* EU:T:2008:338, and *British Sugar plc v. James Robertson & Sons Ltd* [1996] RPC 281, and the interpretation of specifications in *Avnet Incorporated v. Isoact Limited* [1998] FSR 16 and *YouView TV Limited v. Total Limited* [2012] EWHC 3158 (Ch).

##### Comparison of goods and services

###### Class 35

14. The Applicant's *employment hiring, recruiting, placement, and staffing services* were identical to the Opponent's *recruitment services*, and the Applicant's *business management* was identical to the Opponent's *business management assistance*. The

## O-322-18

Opponent's *personnel management consultancy* services were complementary to, shared the same trade channels and were similar to a good degree to the Applicant's *human resources and personnel management*. The Applicant's *information, advice and consultancy services* referred back to all the services in the Applicant's Class 35 specification and were identical to the Opponent's *personnel management consultancy*.

### Class 9

15. The Applicant's *software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development* [my underlining] covered the subject matter of the Opponent's services and were similar to a high degree.
16. The first part of the Applicant's Class 9 specification was widely worded although certain fields were excluded (*electronic publications (downloadable); visual, audio and audio-visual recordings; none of the above being in the fields of health, medicine or medical practice*). Those and the Applicant's *computer software; downloadable software* would include the goods found to have a good degree of similarity with the Opponent's services specified above. Since the Opponent's services were unlimited by field the respective goods and services could coincide, for example, in the engineering recruitment/personnel field. There was, therefore, a good degree of similarity between the Applicant's above wide terms in Class 9 and the Opponent's services.
17. There was no similarity between the Opponent's services and the Applicant's *magnetic, optical and digital storage media* because the latter were unrecorded, that is, blank.

### Class 16

18. For similar reasons the Applicant's *printed matter relating to the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development* [my underlining] bore a good degree of similarity to the Opponent's services. This was also true of the Applicant's other goods in Class 16 (again despite the fields of use exclusion) because they could equally well relate to recruitment, business management and personnel management (in other fields) with the exception of *product and system operating services and maintenance manuals* where there was no similarity.

19. Class 41

The Applicant's *conducting training programs, seminars, lectures, conferences, and workshops in the field of recruitment, talent management, organisational effectiveness and employee performance* [my underlining] were complementary to the Opponent's services. These were a subset of the Applicant's wider terms in Class 41, *educational services; conducting training programs, seminars, lectures, conferences, and workshops; publication and distribution of printed matter*, which could all relate to recruitment, talent management, organisational effectiveness and employee performance, and were similar to a good degree to the Opponent's services. *Non-*

## O-322-18

*downloadable publications* in the Applicant's Class 41 specification were goods, not services and were improperly included in that class. *Publication and distribution of printed matter* referred to the services of a publisher and were not similar to the Opponent's services.

### Average consumer

20. The average consumer for recruitment services in Class 35 included jobseekers and businesses. In selecting recruitment services, the former would pay an average level of attention and the latter an above average level of attention. An above average level of attention was likely to be paid by the average consumer in relation to the purchase of the remaining business to business services in the parties' respective Class 35 specifications.
21. The Applicant's goods, and services in Class 41 covered a wide range of subjects aimed at individuals and businesses. The average consumer's level of attention would vary but would not fall below average.

### Comparison of marks

22. The overall impression of the trade marks was paramount, taking into account their dominant and distinctive elements and giving due weight to non-negligible features.
23. The Hearing Officer would concentrate on the Opponent's word trade mark PULSE versus the Applicant's trade mark [sic]:

PULSE  
MINDSET

24. On the basis of that comparison:

“58. The presentation of the later mark on two separate lines emphasises the word PULSE as this is what will be read first. The eye then has to travel to the next line to read the second component in the mark. PULSE is the dominant and distinctive element in the overall impression of the later mark, even though the second word, MINDSET, is two letters longer. The earlier mark consists of the single word PULSE. Its overall impression and its distinctiveness lie in the totality of the mark.

59. Half of the later mark is identical to the earlier mark whilst the other half of the later mark contains an element which is absent from the earlier mark. The marks are visually similar to a medium degree, and also aurally similar to a medium degree as MINDSET is likely to be verbalised.

60. Pulse means the regular beat of blood moving through the heart, or a musical beat, a food such as lentils, or a colloquialism describing anything which is current (e.g. keep your finger on the pulse of popular opinion). The marks both share this word. Mindset means someone's general attitude. The applicant's mark has no overall meaning because the words do not link together. They remain as separate elements with their own meanings. There is a medium level of conceptual similarity owing to the common presence of PULSE.

61. There is a medium level of overall similarity between the parties' marks."

Distinctive character of the earlier marks

25. PULSE had an average level of inherent distinctiveness in relation to the registered services and an enhanced level of distinctiveness on the evidence at the filing date (7 March 2016) in relation to the Opponent's recruitment services for the health sector.

Likelihood of confusion

26. There was no likelihood of confusion in respect of the Applicant's goods and services found to be dissimilar because the cumulative condition for similarity of goods/services was missing.
27. The Applicant's trade mark did not form a composite unit with a different meaning to that of its individual elements. PULSE retained an independent distinctive role within the Applicant's trade mark "especially presented above MINDSET".
28. Confusion was certain in Class 35 which covered recruitment services in the healthcare sector where the Opponent's mark was highly distinctive. Indirect confusion was also likely in relation to the Applicant's other goods and services still in the equation:

"74. I have found that there is a medium overall level of similarity between the marks, and that the goods and services (other than those listed in paragraph 67 of my decision) are either identical or similar to a good degree. Balancing the interdependency principle, the varying levels of attention of average consumers, the distinctiveness of the earlier mark and the visual dominance of PULSE in the overall impression of the later mark, I consider that there will be a likelihood of indirect confusion in relation to the rest of the applicant's goods and services ..."

29. The mark would therefore be refused registration under Section 5(2)(b) for all, but the goods and services found to be dissimilar in respect of which the application would be allowed to proceed, namely:

Class 9

Magnetic, optical and digital storage media

Class 16

Product and system operating services and maintenance manuals

Class 41

Publication and distribution of educational materials

**Section 5(3) and 5(4)(a)**

30. Since the Opponent was largely successful under Section 5(2)(b), the Hearing Officer would restrict her assessment to the above goods and services in respect of which the opposition under Section 5(2)(b) had failed.

## O-322-18

31. However, under Section 5(3) there was too much distance between the said goods and services for the requisite link to be made, and/or for the relevant misrepresentation to occur for the purposes of Section 5(4)(a).

32. The opposition under Section 5(3) and 5(4)(a) therefore failed.

### Costs

33. The Opponent was largely successful and would be awarded its costs in the opposition in the sum of £1,530.

### The appeal

34. On 31 October 2017, the Applicant filed Notice of appeal to the Appointed Person under Section 76 of the Act.

35. The grounds of appeal were insofar as I understood, 3-fold:

- (1) The Hearing Officer erred in her appreciation of the trade mark applied for and consequently in its comparison with the Opponent's trade marks.
- (2) With the exception of the services in Class 35 found to be identical and similar, the Hearing Officer was not entitled to make findings in relation to the similarity or otherwise of the Applicant's other goods and services because of the failure of the Opponent better to particularise its case and adduce evidence/submissions as to the alleged similarities between the goods and services so particularised, which prevented the Applicant from defending the case.
- (3) The Hearing Officer failed to take into account the high level of attention of the average consumer paid to the purchase act put forward by the Applicant and the Opponent especially in relation to the Class 35 services.

36. The Opponent submitted a Respondent's Notice on 22 November 2017. This essentially stated that the Hearing Officer's decision under Section 5(2)(b), 5(3) and 5(4)(a) should be upheld. The Opponent conceded that the Hearing Officer was mistaken as to the mark applied for (i.e., on 2 lines rather than 1, see para. 9 above) but argued that the 5(2)(b) case was same (if not stronger) for PULSE MINDSET written on a single line.

37. Mr. Wood continued to represent the Applicant in the appeal. Ms. Fiona Clark of Counsel newly represented the Opponent. At the hearing on 18 April 2018, I permitted Mr. Wood to send to me and the Opponent, the name of and a link to the authority that the Applicant had belatedly sought to rely on at the hearing (but no further submissions) concerning the general onus of proof in litigation proceedings. In an email dated 19 April 2018, Mr. Wood directed me to numerous other authorities from the EU and UK case law on trade marks, intellectual property generally and other areas of law with specific paragraph references. Given that circumstance, I permitted the Opponent, as it were so minded, to provide me (copies to the Applicant and the Registrar) with very brief written submissions regarding these.

**Standard of review**

38. The parties were agreed that the correct approach to the appellate function was summarised by Mr. Daniel Alexander QC sitting as the Appointed Person in *TALK FOR WRITING Trade Mark*, BL O/017/17 at paragraph 52 (approved by Arnold J. in *inter alia Apple Inc. v. Arcadia Trading Ltd* [2017] EWHC 440 (Ch)). Mr. Alexander’s summary is well-known, and I will not repeat it here. However, I have borne those principles in mind.

**Merits of the appeal**

**Ground 1 – the Applicant’s mark**

39. It is clear from the decision (para. 1) that the Hearing Officer was under a misapprehension as to the representation of the Applicant’s trade mark, that is, that it comprised the words PULSE and MINDSET on separate lines as shown below:

PULSE  
MINDSET

when instead, as was patent on the face of the Register and the pleadings, evidence and submissions of the parties, the trade mark applied for consisted of the words PULSE and MINDSET in sequence, that is, PULSE MINDSET.

40. It is equally clear (or at least open to valid criticism) that the Hearing Officer based her comparison of the marks and her findings of likelihood of confusion upon that misapprehension as to the representation of the Applicant’s mark.
41. Thus, at paragraphs 58 – 61 (reproduced at para. 24 above) she proceeded to make her findings that the marks were visually, aurally and conceptually similar to a medium degree on the premise that: “The presentation of the later mark on two separate lines emphasises the word PULSE as this is what will be read first”.
42. At paragraph 72, her further finding that PULSE retained an independent distinctive role within the Applicant’s trade mark was said by her specially to flow from the positioning of PULSE above MINDSET.
43. None of this was disputed by the Opponent who instead sought to argue that the error was immaterial because the Hearing Officer would have arrived at the same result (arguably even more so) if the words had been positioned in her appreciation in 1 line.
44. That may or may not have been the case but in my judgment the error makes the decision unsafe and justifies my interference.
45. However, before I undertake my own assessment under Section 5(2)(b), I will investigate the merits of the second and third grounds of appeal.

**Ground 2 – goods and services**

46. Ground 2 proved to be the most contentious between the parties.

## O-322-18

47. Mr. Wood relied on the Convention right to a fair trial embodied in Article 6 of the European Convention on Human Rights, 1950, which as Mr. Wood correctly pointed out, applies in Registry proceedings pursuant to Section 6(1) and (3) of the UK Human Rights Act 1998.
48. Mr. Wood appeared to be contending that since the Opponent had allegedly failed to: (a) particularise its claims to similarity of goods and services as demanded by his letter to the Registrar dated 7 November 2016; and (b) adduce evidence/submissions as to the similarity of the opposed goods and services (other than the services in Class 35 that the Applicant admitted were identical and (at least for the purposes of this appeal) similar) the Hearing Officer was unable to make findings on the claimed similarity of the goods and services, and in fact did so erroneously on her own volition unsupported by any evidence or submissions of the parties to the prejudice of the Applicant, who was therefore denied the opportunity to rebut any notion of similarity with its own evidence and, or submissions.
49. I reject the Applicant's complaints under this second head of appeal for the following reasons (in no particular order of importance).
50. First, Form TM7 Notice of opposition and statement of grounds made clear in answers to the relevant questions on the form that the opposition was being maintained against all the goods and services applied for<sup>1</sup>.
51. Second, the grounds of opposition stated that the application covered *recruiting* and *business management* which were identical to the Opponent's *recruitment services* and *business management assistance* (para. 13). That was accepted by the Opponent (as it had to be) on the face of the wording of the parties' specifications.
52. Third, the statement of grounds of opposition identified goods and services in Classes 9, 16 and 41 of the application that were limited by their very wording to use in the fields of human resources, personnel and recruitment, including training and development, and which the Opponent contended were similar to the Opponent's registered services. The Opponent cited in support recognised factors for assessing the similarity of the goods and services such as: "nature, end users, method of use, competitive/complementary, intended purpose, manufacture, distribution channels, retail outlets" (paras. 14 – 17).
53. Fourth, the skeleton argument of the Opponent reiterated the above by underlining the circumscribed by fields of use goods and services in the Applicant's Classes 9, 16 and 41 specifications<sup>2</sup>. The Opponent further argued that the other goods and services in Classes 9, 16 and 41 of the application were couched in wide terms, which was capable of indicating in my view that that the latter were also open to objection under Section 5(2)(b) because the specified limited terms dealt with beforehand, fell within their wider terms.

---

<sup>1</sup> This was specifically confirmed by Mr. Chapple for the Opponent in answer to a question by the Hearing Officer (transcript, p.31, l.3).

<sup>2</sup> In similar fashion to as I have done at paras. 15, 18 and 19 above The Opponent's skeleton argument also underlined all the Applicant's Class 35 services. The latter was likely because the Applicant at least early on in the proceedings appeared only to acknowledge identity of services in Class 35.

54. Fifth, the Act and the Rules are silent as to the onus of proving similarity of goods and services. In the equivalent EU trade marks system, the General Court held in Case T-88/16, *Opko Ireland Global Holdings Ltd v. EUIPO* EU:T:2017:32, paragraphs 54 – 61 that the Opponent was under no obligation to adduce evidence of similarity of the goods/services concerned. I accept Ms. Clark’s submission that, whilst the Opponent acknowledged that the overall burden of proving the opposition lay with the Opponent, the Applicant’s real complaint was that the Opponent filed no evidence in support of its claim of similarity of goods and services (which Ms. Clark did not accept, see below).
55. Sixth, in any event, as Ms. Clark convincingly pointed out, the Opponent did put in evidence as to the extent/range of goods and services supplied in connection with or related to the registered recruitment, outsourcing, business management and personnel management consultancy services. Admittedly this evidence was concerned in the main with the activities of the Opponent and directed chiefly to establishing the Opponent’s goodwill and reputation. Nevertheless, it also mentioned goings on of competitors in the recruitment agency field, and showed *inter alia* training, hard and soft resources and materials, and consultancy and advice services all being offered by the Opponent’s recruitment agency. Ms. Clark noted that there was no claim by the Applicant that the Opponent’s recruitment agency was out of the ordinary in that regard. Ms. Clark’s point here was that the Hearing Officer did not embark on a frolic of her own unsupported by the parties’ evidence/submission as alleged by the Applicant but arrived at her findings after due consideration of the Opponent’s extensive evidence.
56. Mr. Wood levelled special complaint against the Hearing Officer’s following findings in Class 9, which he contended were unsupported and unfair:
- “39. ... the terms which are limited to subject matter (*software, downloadable software, downloadable publications and audio, visual and audiovisual recordings for use in the field of human resources, organisational effectiveness, training activities, team management, team building, setting up jobs, developing job holders and job evaluation and personal development*) cover the subject matter of the services covered by the opponent’s specification. The users will be the same: businesses looking for personnel, recruitment and business management services and advice. They may obtain this via services, or from software and electronic publications. There is an element of competition. There is also a convergence in trade channels in that personnel consultants may provide software for personnel management (such as recordal of employee information). Software and other recorded media for organisational effectiveness and training share a common purpose, are complementary with and in competition with the opponent’s outsourcing services [business assistance] and business management services. There is a good degree of similarity between the applicant’s specified goods and the opponent’s services.”
57. I disagree. Ms. Clark took me to several instances in the Opponent’s evidence which provided support for the above, if such were needed.

## O-322-18

58. Seventh, and linked to the above, it is well established that a hearing officer is entitled to bring his or her own experience (provided this is not idiosyncratic) to bear on the question of similarity of goods and services (*esure Insurance Limited v. Direct Line Insurance plc* [2008] EWCA Civ 842, para. 56, *Marks & Spencer Inc. v. Interflora Inc.* [2012] EWCA Civ 1501, para. 50).
59. Eighth, the task of the Hearing Officer was to decide the opposition on the basis of the papers and submissions before her. This, and the previous point, was encapsulated in the following observation by Patten J. in *COCO DE MER Trade Mark* [2004] EWHC 992 (Ch) at paragraph 20 (albeit in relation to likelihood of confusion):
- “If one has to characterise this in terms of burden of proof, then undoubtedly [the Hearing Officer] had to be persuaded, from the material and submissions before him, that on the balance of probabilities the Opponent had established the necessary likelihood of confusion. That analysis is, however, largely meaningless when applied to a specialist tribunal like the Trade Marks Registry, where the Hearing Officer is entitled to apply his own knowledge and experience to determining the ground of opposition. The absence of factual evidence is never a bar to such a determination, although the absence of it may make it more difficult to make out the grounds of opposition. In the end, however, it is a matter for the judgment of the Hearing Officer, on the material before him, as to whether a likelihood of confusion exists ...”
60. For the above reasons, I reject the Applicant’s submission that the proceedings below were not conducted in accordance with Article 6 of the European Convention on Human Rights. In my judgment, the Hearing Officer’s findings of similarity of goods and services were principled, consistent with the evidence and her own experience, and those which she was entitled and obliged on the balance of probabilities to make. I see, therefore, no basis for me to interfere with those findings.
61. I also note that the Applicant has put forward no substantive challenge to the Hearing Officer’s findings of similarity of goods and services. In other words, the Applicant appears to accept – putting to one side the alleged procedural/administrative errors on the part of the Hearing Officer/Registry – that the Hearing Officer did in fact rightly conclude that many of the goods and services in the application shared a good degree of similarity with the services in the earlier trade marks.
62. Finally, I should record that at no stage including on this appeal did the Applicant seek to put forward a “fall-back” position, that is, seek to limit its goods and services to avoid conflict with the Opponent’s earlier trade marks.
63. I find it difficult to avoid the impression that the Applicant, for whatever reason, simply refused to engage with the opposition. I agree with Ms. Clark that devising a fall-back position, if this was ever of interest to the Applicant, has simply been left too late.

**Ground 3 – average consumer’s attention level**

64. The third ground for appeal was that the Hearing Officer allegedly failed to take into account the high level of attention that would be paid by the relevant consumer to the purchase act.
65. At one point, Mr. Wood appeared to be suggesting that because both parties had argued that the average consumer would pay a high level of attention it was not open to the Hearing Officer to disagree, a contention which I reject.
66. The Hearing Officer made a finding that the average consumer of the goods and services in question comprised individuals and business to business users (undisputed). Individuals were likely to pay an average degree of attention to recruitment services in Class 35. Businesses were likely to pay an above average level of attention to the selection of the parties’ business to business services in Class 35. As to the Applicant’s goods and services in Classes 9, 16 and 41, these were various, and the level of attention would likewise vary although it would not fall below average.
67. These were clearly findings that were open to the Hearing Officer, and accordingly I see no justification for the third ground for appeal.
68. For the record, it is well established that where there are a variety of goods and services in suit with more than 1 type of consumer and attention level, any conflict is to be judged by the lowest level of attention.

**Reappraisal of the marks and interdependent overall reassessment of confusion**

69. I pause at this point to note that no challenge was made by the Applicant not only to the identity of “recruiting” in the Applicant’s mark (indeed this was accepted) but also regarding:
  - (1) the average inherent distinctive character of the Opponent’s earlier trade marks for the registered services; and
  - (2) the enhanced and accordingly high distinctive character of the Opponent’s earlier trade marks for recruitment services in the healthcare sector; and
  - (3) the predominance of the visual impact in the overall assessment of likelihood of confusion.
70. Turning now to the trade marks themselves, I agree with the Hearing Officer that the Opponent’s best case lies with the earlier PULSE word trade mark, and I will undertake the comparison and overall assessment of the likelihood of confusion on that basis.
71. It is incontrovertible that: (a) the dominant and distinctive element of the Opponent’s PULSE earlier trade mark is the word PULSE; and (b) the earlier trade mark is wholly contained within the Applicant’s later PULSE MINDSET trade mark.

## O-322-18

72. I understood Mr. Wood to accept that on that basis there must be some similarity between the trade marks.
73. The principles governing the assessment of similarity in relation to a composite mark containing as 1 of its elements, the same or a similar sign to an earlier trade mark, were expounded by the Court of Justice of the EU in Case C-591/12 P , *Bimbo SA v. OHIM* EU:C:2014:305, the relevant passages of which were set out by the Hearing Officer at paragraph 69 of her decision. Those principles were in turn reviewed by Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *DEAKINS Trade Mark*, BL O/421/18, Arnold J. in *Whyte and Mackay Ltd v. Origin Wine UK Ltd* [2015] EWHC 1271 (Ch) and myself sitting as the Appointed Person in *BARKERS BREW Trade Mark*, BL O/476/14. The authorities stress that the paramount consideration with composite marks is no different from the norm and is the overall impression of the marks in the perceptions of the relevant consumer in the particular circumstances of the case.
74. Looking at the Applicant's trade mark standing as applied for, that is, PULSE MINDSET in a single line, I agree with the Hearing Officer that PULSE is a dominant and distinctive element within the Applicant's trade mark. Nevertheless, in my estimation, MINDSET likewise constitutes a dominant and distinctive element within the Applicant's trade mark. That said, since the word PULSE appears at the beginning of the Applicant's trade mark and the average UK consumer reads from left to right, PULSE will figure first if not more prominently in the consumer's perception of the Applicant's trade mark. Neither element, in my view, qualifies the other in relation to the goods and services in question, so that both elements, in my judgment, retain an independent distinctive role within the Applicant's trade mark. I tend therefore to agree with the Hearing Officer (despite her misconception as to the representation of the applied for trade mark) that there is a medium degree of similarity between on the one hand PULSE and on the other hand PULSE MINDSET in this case.
75. Factoring in the other circumstances in the global assessment of likelihood of confusion namely the identity and good degree of similarity in the goods and services (i.e. those not found to be dissimilar about which there was no appeal), the medium degree of similarity between the trade marks, the at least average inherent distinctiveness of the earlier trade marks (high distinctiveness in relation to recruitment services in the health sector) and the average to above average level of attention paid by the average consumer to the purchase act which would primarily be visual, and taking into account the principle of imperfect recollection, in my judgment the differences between the trade marks are insufficient to preclude the risk of confusion be that direct (because consumers tend to see what they want to see) or more likely indirect (i.e., another offering within the range of the Opponent's products).
76. I have therefore come to the same conclusion as the Hearing Officer, but of course on a different representation of the mark in suit.

**Conclusion and costs**

77. In the result the appeal has failed.
78. The Hearing Officer ordered the Applicant to pay to the Opponent costs of the opposition in the sum of £1,530. I will order the Applicant additionally to pay to the Opponent a contribution towards the Opponent's costs of this appeal in the sum of £900, the total sum of £2,430 to be paid within 28 days of the date of this decision<sup>3</sup>.

Professor Ruth Annand, 24 May 2018

Mr. Aaron Wood of Wood IP Limited appeared for the Appellant/Applicant

Ms. Fiona Clark, instructed by Longmores Solicitors LLP, appeared for the Respondent/Opponent

---

<sup>3</sup> I did not consider Ms. Clark's reference to the observation of Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *ONLINE PALLET Trade Mark*, BL O/427/11, para. 13 to be apposite to the circumstances of this case.