

O/0537/25

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER
WO0000001741816**

BY ALTUS ASSESSMENTS INC.

TO REGISTER THE FOLLOWING TRADE MARK:

ACUITY INSIGHTS

IN CLASSES 35, 41 AND 42

AND

AN OPPOSITION THERETO UNDER NUMBER OP000445727

BY BLOOJAM CONSULTING LIMITED

Background and pleadings

1. Altus Assessments Inc. ("**the Holder**") is the holder of international registration number WO0000001741816 ("**the IR**") consisting of the sign shown on the cover page of this decision. The IR is registered with effect from 26 October 2022 and has a priority date of 15 July 2022 based on the Canadian registration number 2198336 ("**the Contested Mark**"). On the 26 October 2022, the Holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement.
2. The Holder seeks protection for the IR in relation to the following services:

Class 35: Business and employment recruiting services, namely providing customized candidate recruitment consulting for businesses, government agencies and health care agencies.

Class 41: Conducting of seminars, congresses and educational conferences in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies; providing training through courses, seminars, conferences and providing training via a website portal in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies; educational and institute admission consulting services, namely providing educational consulting for admission to educational institutions; providing educational and training information in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses,

government agencies and health care agencies via a website featuring blogs and non-downloadable publications in the nature of articles, brochures and e-books; providing educational information in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies.

Class 42: Scientific research in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants, admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies; providing on-line non-downloadable software for use in the field of applicant and candidate screening and testing for personal and professional characteristics, competency, skills, knowledge, interests and values; providing on-line non-downloadable software for administering tests, determining test score results and generating reports for use by educational institutions, businesses, government agencies and health care agencies to assess competency, skills, traits of character, knowledge, interests and values of applicants and candidates, which is used for curriculum development, hiring processes program evaluation, accreditation, preparation for licensing and professional certification, management, applicant assessment, and student learning outcomes assessment; providing on-line non-downloadable software for assessing competency, skills, traits of character, knowledge, values and interests of applicants featuring interview scripts and recording and transcribing of interviews; providing on-line non-downloadable software for analyzing and compiling data and providing reports related to test score results for educational institutions, businesses, government agencies and health care agencies to assess competency, skills, traits of character, knowledge, interests and values of applicants and candidates, which is used for curriculum development,

hiring processes program evaluation, accreditation, preparation for licensing and professional certification, management, applicant assessment, and student learning outcomes assessment; providing on-line non-downloadable software for screening and ranking applicants and candidates, namely administering tests and determining test score results by comparing the values of the applicant and candidate with the values of the programs from educational institutions, businesses, government agencies and health care agencies; software as a service (saas) services, namely, hosting computer software for use by educational institutions in applicant performance tracking, in student evaluation tracking, in student response tracking, in student reporting, in student performance flagging, in student procedure logging, in scheduling student schedules, in scheduling student clinical rotations, in scheduling academic half days, and in scheduling student hospital rounds; software as a service (saas) services, namely, hosting computer software for use by businesses, government agencies and health care agencies in candidate performance tracking.

3. The IR was published for opposition purposes on 10 November 2023. On 06 February 2024, BlooJam Consulting Limited (“***the Opponent***”) opposed the IR in the UK on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“***the Act***”).
4. The Opponent relies upon the mark detailed below (“***the Earlier Mark***”):

ACUITY

UK trade mark registration no: UK00003251299

Filing date: 18 August 2017

Registration date: 17 November 2017

5. For the purpose of these proceedings, the Opponent is reliant upon all of the services for which the Earlier Mark is registered:

Class 35: Interviewing/assessment for the selection of personnel; Business/occupational psychology assessments and consultancy; psychometric testing and assessments for the selection of personnel.

Class 41: Psychometric testing, interviewing and assessment for the development of personnel; Coaching and training services for personnel.

Class 44: Psychometric assessment services.

6. Due to its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the services it has identified without having to demonstrate use.
7. Under section 5(2)(b), the Opponent claims that the services are identical or highly similar, and that the marks are similar to a very high degree leading to a likelihood of confusion on the part of the relevant public. The Opponent requests for the application to be rejected in its entirety and for an award of costs to be made in its favour.
8. The Holder filed a defence and counterstatement denying all the grounds of the opposition and requested for the opposition to be dismissed and for an award of costs to be made in its favour.
9. The Holder is represented by Arcacious IP Limited and the Opponent is represented by Sonder & Clay.

Relevance of EU law

10. 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.

Evidence and submissions

11. Both parties filed evidence during the evidence rounds. The Opponent filed its evidence in the form of the witness statement of James Bloomfield, director and founder of Bloojam Consulting Limited, signed and dated 11 June 2024. The witness statement is accompanied by Exhibits JB1 – JB17. The Holder filed its evidence in the form the witness statements of Alana Hamilton, a Legal Contract Manager at Acuity Insights Inc., signed and dated 14 August 2024. The witness statement is accompanied by Exhibits AH1 – AH22. The Opponent filed evidence in reply, in the form of the witness statement of Matthew Sammon, of Sonder & Clay IP (the Opponent's representative), signed and dated 13 September 2024. The witness statement is accompanied by Exhibits MS1 – MS6. All the witnesses are duly authorised to provide evidence on behalf of their respective parties.
12. Neither party requested a hearing, however both parties filed written submissions in lieu.
13. The evidence and submissions will not be summarised here, but I have given due consideration to all of the documents filed by both parties and they will be referred to as and where appropriate during this decision.

Preliminary matters

No actual confusion in the market

14. The Opponent argued in its submissions in lieu that “[the evidence provided] show[s] a range of results from the internet search engines Google and Bing for the term ‘acuity’ accompanied by descriptive terms for the services provided by both the Applicant and the Opponent. Such descriptive terms include, ‘assessment,’ ‘sales assessment,’ ‘personnel assessment.’ All of these search terms are typical of the terms customers of the Opponent will enter to find the services of the Opponent.

[the evidence] demonstrate[s] that the services of the Applicant are revealed within the first two pages of results, when searching for the services of the Applicant, despite no use of the term ‘Insights.’ This is clear evidence that the consumer is

*likely to be confused as to the origin of identical and highly similar services offered under the trade marks ACUITY and ACUITY INSIGHTS”.*¹

15. Also, the Holder provided market considerations contending the absence of likelihood of confusion between the parties in the relevant market. It is submitted that *“the evidence filed by the parties does not show any instances of actual confusion or association or any likelihood of confusion or association, direct or indirect despite the Applicant and Opponent having used their respective marks alongside each other in different fields in the UK for several years”*

16. Whilst I acknowledge the parties’ comments, I must clarify that the absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the Holder’s mark and the Opponent’s mark. The absence of confusion in the marketplace is rarely significant.² This is because the absence of confusion may be attributable to the earlier mark having only been used to a limited extent, in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being mistaken for the other.³ Conversely, evidence of actual confusion may be persuasive where it exists. To this regard, according to the Opponent’s submissions above, it seems that potential market confusion may arise from the parties’ use of the word ‘acuity’ since an internet search conducted by the Opponent showed that references to both parties’ businesses are shown when searching for ‘acuity’ in relation to the services at hand. However, the Opponent failed to provide further evidence that actual confusion has derived, among the relevant consumers, as direct consequence of such internet results or other uses of ‘acuity’ by the Holder. Thus, I find the Opponent’s evidence not to be sufficiently persuasive to find actual likelihood of confusion in the relevant market solely on the basis of this evidence.

Different commercial sector

17. The Holder argued, in its submissions in lieu, that *“whilst there is some limited overlap of services in classes 35 and 41, it is clear from the submissions below on*

¹ Opponent’s submissions in lieu, dated 21 October 2024, paragraphs 25 – 26.

² *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.

³ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

likelihood of confusion that there is no actual or likely confusion or association between the Applicant's mark and the Opponent's mark given the very different fields in which they have operated and continue to operate in the UK".⁴

18. I acknowledge the Holder's submissions, however, the fact that the parties may operate in different commercial sectors is irrelevant to the assessment of similarity of the services. Accordingly, the similarity or otherwise of services is to be assessed solely on the basis of those registered, and it is impermissible to take into account the services actually provided.⁵

Third-party uses of 'ACUITY' marks

19. In its submissions in lieu, the Holder also argued that *"other third parties are also using ACUITY alone or with other words in the UK, including for personnel assessments (for example "The Acuity Measure"). This makes it even less likely that there would be confusion or association between the Applicant's mark and the Opponent's mark".⁶* I appreciate the Holder's argument that consumers may be accustomed to see such marks without confusing them. However, the Holder did not specify what these 'ACUITY' marks are and no further evidence was provided to show that such third-party marks have genuinely been used in relation to the relevant services. Whilst I acknowledge the Holder's comments, I find that the alleged existence of some third-party marks containing the word "ACUITY" does not provide much assistance in relation to the assessment of similarity between the marks at hand. In the eventuality the Holder refers to 'ACUITY' registered trade marks, the General Court ("GC") in *Zero Industry Srl v OHIM*,⁷ found that the presence on the UK register of marks containing the same or shared elements is not evidence of how many of such trade marks are in fact used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks. The decision I am required to make is based on a notional assessment of the likelihood of confusion. For the sake of completeness, I am unable to rely on this submission even to assess the Earlier Mark's inherent distinctive character (or lack thereof) because it is unclear whether these third-

⁴ Holder's submissions in lieu, dated 21 October 2024, paragraph 13.

⁵ See decision number BL O/0065/24 by the Appointed Person (AP) at paragraph 19.

⁶ Holder's submissions in lieu, dated 21 October 2024, paragraph 20.

⁷ Case T-400/06.

party marks have been actually registered for the services at hand and it is unclear the number of such marks, their nature (e.g., whether they contain additional matter or have different stylisations) and whether they have been used in the market for the relevant services. Hence, this submission has no apparent relevance for the proceedings at hand.

Decision

Section 5(2)(b)

20. Sections 5(2)(b) and 5A of the Act state:

“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,

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

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant Law

21. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

23. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity 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.

24. In *Gérard Meric v OHIM*, 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.”

25. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]- [49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

26. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term

‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded.”

27. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

“[...] definitions of services [...] are inherently less precise than specifications of goods. [...] 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.”

28. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

29. The services to be compared are shown in the table below:

The Opponent's services	The Holder's services
<u>Class 35</u>	<u>Class 35</u>
Interviewing/assessment for the selection of personnel; Business/occupational psychology assessments and consultancy;	Business and employment recruiting services, namely providing customized candidate recruitment consulting for

psychometric testing and assessments for the selection of personnel.	businesses, government agencies and health care agencies.
<u>Class 41</u>	<u>Class 41</u>
Psychometric testing, interviewing and assessment for the development of personnel; Coaching and training services for personnel.	Conducting of seminars, congresses and educational conferences in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies; providing training through courses, seminars, conferences and providing training via a website portal in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies; educational and institute admission consulting services, namely providing educational consulting for admission to educational institutions; providing educational and training information in the field of applicant and candidate

	screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies via a website featuring blogs and non-downloadable publications in the nature of articles, brochures and e-books; providing educational information in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies.
	<u>Class 42</u>
	Scientific research in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants, admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies; providing on-line

	non-downloadable software for use in the field of applicant an candidate screening and testing for personal and professional characteristics, competency, skills, knowledge, interests and values; providing on-line non-downloadable software for administering tests, determining test score results and generating reports for use by educational institutions, businesses, government agencies and health care agencies to assess competency, skills, traits of character, knowledge, interests and values of applicants and candidates, which is used for curriculum development, hiring processes program evaluation, accreditation, preparation for licensing and professional certification, management, applicant assessment, and student learning outcomes assessment; providing on-line non-downloadable software for assessing competency, skills, traits of character, knowledge, values and interests of applicants featuring interview scripts and recording and transcribing of interviews; providing on-line non-downloadable software for analyzing and compiling data and providing reports related to test score results for educational institutions, businesses, government agencies and health care
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	agencies to assess competency, skills, traits of character, knowledge, interests and values of applicants and candidates, which is used for curriculum development, hiring processes program evaluation, accreditation, preparation for licensing and professional certification, management, applicant assessment, and student learning outcomes assessment; providing on-line non-downloadable software for screening and ranking applicants and candidates, namely administering tests and determining test score results by comparing the values of the applicant and candidate with the values of the programs from educational institutions, businesses, government agencies and health care agencies; software as a service (saas) services, namely, hosting computer software for use by educational institutions in applicant performance tracking, in student evaluation tracking, in student response tracking, in student reporting, in student performance flagging, in student procedure logging, in scheduling student schedules, in scheduling student clinical rotations, in scheduling academic half days, and in scheduling student hospital rounds; software as a service (saas) services,
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	namely, hosting computer software for use by businesses, government agencies and health care agencies in candidate performance tracking.
<u>Class 44</u>	
Psychometric assessment services.	

30. In their respective submissions in lieu, the Opponent contended that the competing services in classes 35 and 41 are identical or highly similar. The Holder submitted that:

“13. Whilst there is some limited overlap of services in classes 35 and 41, it is clear from the submissions below on likelihood of confusion that there is no actual or likely confusion or association between the Applicant’s mark and the Opponent’s mark given the very different fields in which they have operated and continue to operate in the UK.

[...]

15. Having regard to these factors [*Treat*], it is submitted that the respective services (other than those referenced in paragraph 13 above) are not similar.”

31. From the above, the Holder seems to admit some overlap between the competing services in classes 35 and 41 whilst arguing dissimilarity for the services in class 42. However, as the degree of similarity, if any, at least for classes 35 and 41, is not specified, I will proceed to assess it as indicated below.

Class 35

- “*Business and employment recruiting services, namely providing customized candidate recruitment consulting for businesses, government agencies and health care agencies*”

32. The Holder’s services consist of candidate recruitment (and consulting services in this field) on behalf of businesses, government agencies and health care agencies.

This activity of sourcing candidates likely encompasses interviewing, assessing (e.g., conducting psychometric testing) and screening of potential personnel. I find that all the Opponent's services in class 35 (i.e., *"Interviewing/assessment for the selection of personnel; Business/occupational psychology assessments and consultancy; psychometric testing and assessments for the selection of personnel"*) all consist of activities carried out for candidate recruitment and would fall within the wider definition of the Holder's services and vice versa. Therefore, I find the respective services to be identical in line with the principle outlined in *Meric*.

Class 41

- *"Conducting of seminars, congresses and educational conferences in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies;*
- *providing training through courses, seminars, conferences and providing training via a website portal in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies;*
- *providing educational and training information in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies via a website featuring blogs and non-downloadable publications in the nature of articles, brochures and e-books;*
- *providing educational information in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants and admissions*

for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies”

33. The Holder’s services all essentially consist of educational/training services for personnel recruitment and professional development. The Holder’s services can address 1) businesses seeking to have a (or improve their already existing) recruitment system, 2) applicants/candidates wanting to improve their chances to be hired or 3) employees who desire to progress in their career. With regard to the Opponent’s “*Coaching and training services for personnel*”, I find these services can be intended as being training services for businesses’ personnel (e.g., HR departments) for candidate assessment as well as aimed at business’ employees to develop in their career. Businesses are likely to purchase the Opponent’s services to train their employees also on how to carry out candidate recruitment. Therefore, I find the Holder’s services fall within the Opponent’s wider category of training services for personnel and are identical in line with *Meric*. However, in case I am mistaken, I find the respective services to overlap in their nature (educational services in personnel recruitment), intended purpose (candidate assessment and recruitment), method of use (i.e., the training is likely delivered in the same form notwithstanding the different types of potential users) and end users. These services also are likely to share the same trade channels and be in competition with each other. Thus, these services are, overall, highly similar.

34. I also note that the services above include education/training aimed at admissions for educational institutions. In line with the considerations in the paragraph above, these services are likely provided to educational institutions’ personnel to assess candidates as well as to students who seek to prepare themselves to pass the required tests and be admitted into educational institutions. With regard to the Opponent’s “*Coaching and training services for personnel*”, these services can be intended as training provided to educational institutions’ personnel to assess candidates and, thus, the same considerations outlined above apply. Therefore, these services are considered either *Meric* identical or highly similar.

- “*educational and institute admission consulting services, namely providing educational consulting for admission to educational institutions*”

35. The services above consist of consulting services to help future students to identify education institutions (e.g., colleges and universities) that can be the right fit for them, support them to understand the application and admission process (e.g., admission essays, interviews, or standardised tests) or help them identify scholarship opportunities. These consulting services likely also include the provision of psychometric testing that is sometimes used to assess students. With regard to the Opponent's "*Psychometric testing, interviewing and assessment for the development of personnel*" the competing services share the same nature (psychometric testing) although they may differ in the type of testing as they tackle different testing needs (educational against professional). The services have the same intended purpose (testing) and method of use. The services likely address different users (students versus job candidates) and are not in competition with each other; nonetheless, they can overlap in trade channels (i.e., the same provider can offer different types of psychometric tests). Overall, I find these services to have a medium degree of similarity.⁸

Class 42

- "*Scientific research in the field of applicant and candidate screening, assessments and testing for personal and professional characteristics, professional development, recruitment and selection of applicants, admissions for educational institutions, and for selection of candidates for hiring for businesses, government agencies and health care agencies;*
- *providing on-line non-downloadable software for use in the field of applicant and candidate screening and testing for personal and professional characteristics, competency, skills, knowledge, interests and values;*
- *providing on-line non-downloadable software for administering tests, determining test score results and generating reports for use by educational institutions, businesses, government agencies and health care agencies to assess competency, skills, traits of character, knowledge, interests and values of*

⁸ I note the Opponent's specification also features "*Psychometric assessment services*" in class 44. According to WIPO's explanatory notes, class 44 services mainly refer to 'medical care' services. Thus, psychometric testing in class 44 would be exclusive for medical purposes and greatly differ from the Holder's psychometric services in class 41.

applicants and candidates, which is used for curriculum development, hiring processes program evaluation, accreditation, preparation for licensing and professional certification, management, applicant assessment, and student learning outcomes assessment;

- *providing on-line non-downloadable software for assessing competency, skills, traits of character, knowledge, values and interests of applicants featuring interview scripts and recording and transcribing of interviews;*
- *providing on-line non-downloadable software for analyzing and compiling data and providing reports related to test score results for educational institutions, businesses, government agencies and health care agencies to assess competency, skills, traits of character, knowledge, interests and values of applicants and candidates, which is used for curriculum development, hiring processes program evaluation, accreditation, preparation for licensing and professional certification, management, applicant assessment, and student learning outcomes assessment;*
- *providing on-line non-downloadable software for screening and ranking applicants and candidates, namely administering tests and determining test score results by comparing the values of the applicant and candidate with the values of the programs from educational institutions, businesses, government agencies and health care agencies;*
- *software as a service (saas) services, namely, hosting computer software for use by businesses, government agencies and health care agencies in candidate performance tracking.”*

36. In its submissions in lieu the Opponent argued that:

“The class 42 services of the Applicant cover a range of scientific research and online non-downloadable software, all for the specific purpose in assisting in the screening, assessment and testing of personnel, whether it is for employment or education. The services relied upon by the Opponent are all services utilised for the screening, assessment and testing of personnel. Consequently, the services perform the same function, are put to the same use and used by the same users. The Opponent utilises software in the delivery of

their services, see Paragraph 20 of the Witness Statement of James Bloomfield and Exhibit JB15 which demonstrate the development of the online element of the ACUITY service.

The class 42 services of the Applicant are in direct competition with the services of the Opponent. Consumers can either select software to run personnel assessment and testing in-house, or they can engage a service provider, such as the Opponent to provide the very service. Clearly the use and users of the services will be the same and the services will move through the same trade channels and appeal to the same consumer.

The Class 42 services of the Applicant are, therefore, highly similar to the services of the Opponent.”

37. The Holder did not provide submissions with regard to the degree of similarity (or lack thereof) for the services in class 42.

38. I agree with the Opponent the Holder’s services in class 42 share a level of similarity with the Opponent’s services “*Interviewing/assessment for the selection of personnel*” in class 35 and “*Psychometric testing, interviewing and assessment for the development of personnel*” in class 41. I share the Opponent’s view that the Opponent’s services above can be provided through online software (or other online platforms) for the selection of personnel and that the respective services share the same purpose (selection and development of personnel), end users (job seekers or personnel), trade channels and are likely to be in competition with each other since consumers can either purchase the software directly or refer to a third-party provider that would offer the software for personnel assessment/development. Thus, albeit the services have different nature, overall, they have a high degree of similarity.

39. I note that the Holder’s terms in class 42 also target students and offer their services to educational institutions. Whilst my findings in the paragraph above remain relevant also in relation to this category of end users, I must take into consideration that, in this instance, the respective services would differ in their end users. Thus, in line with my findings at paragraph 38 above, I find the respective services to be similar to a medium degree.

- “software as a service (saas) services, namely, hosting computer software for use by educational institutions in applicant performance tracking, in student evaluation tracking, in student response tracking, in student reporting, in student performance flagging, in student procedure logging, in scheduling student schedules, in scheduling student clinical rotations, in scheduling academic half days, and in scheduling student hospital rounds”

40. The Opponent in classes 35 and 41 offers assessment services for personnel selection and testing for the development of personnel. With regard to the Holder’s services above, the respective services differ in their nature (provision of software versus personnel assessment and selection), and end users (educational institutions/students versus businesses/individual job seekers). They can partially overlap in their intended purpose (candidate assessment) although the type of assessment is likely to differ according to the various end users. These services could share the same trade channels and be in competition with each other as the same company could develop and offer software for different types of testing services (addressing different types of needs and users). Overall, I find the respective services to share a low degree of similarity.

The average consumer and the purchasing act

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

42. In its submissions in lieu the Opponent argued that:

“In the present case, the services in question are predominantly directed at business consumers, primarily within human resource departments, with an average degree of attention. This indicates that consumers’ recollection of marks will be imperfect, that similarities between the marks will be heightened and that as a result, consumers will be less capable of distinguishing the marks.”

43. The Holder contended that:

“The average consumer for the Applicant’s services is, as shown by the Applicant’s evidence, a university course provider, particularly but not exclusively for medical schools, seeking to use a holistic admissions assessment for potential students. As a result, the average consumer is likely to pay a high degree of attention to the services provided under the ACUITY INSIGHTS mark.”⁹

44. I note that the Opponent’s Earlier Mark is not subject to the use conditions as stated above in this decision, therefore, it can rely upon all the services identified without any restriction to their actual use. It follows that the Opponent’s services do not exclusively consist of a university course provider using a specific admissions assessment practice and the average consumer must be identified on the basis of all the competing services for which I found some degree of similarity.

45. The services in question are in respect of candidate assessment for professional (i.e., recruitment) and educational (i.e., student applications) purposes. These services are aimed at both the business sector wishing to subcontract such a function and also jobseekers/students within the public at large. For a business (i.e., company or educational institution), the employ of such a function is likely to be a considered decision, possibly involving a tender process. Even if not, the stakes are high in ensuring the correct supplier is chosen in order to obtain the correct personnel or students. Further, such a service is likely to be relatively expensive. For a business therefore, it is considered that a higher than medium

⁹ Holder’s submissions in lieu, dated 21 October 2024, paragraph 16.

(average) degree of attention is likely to be displayed during the purchasing process. Likewise, a jobseeker or student will wish to ensure they use the most reliable professional/educational assessment tool so that they can obtain the most suitable employment opportunities or school applications are successful. Such a consumer is also likely to display a higher than medium (average) degree of attention.

Comparison of trade marks

46. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, that:

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

47. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

48. The marks to be compared are as follows:

The Opponent's Earlier Mark	The Holder's Contested Mark
ACUITY	ACUITY INSIGHTS

Overall impression

49. The overall impression of the Earlier Mark resides in the single word “ACUITY” of which it is composed.

50. Turning to the Contested Mark, the Opponent submitted that *“the mark of the Applicant consists of the word ‘ACUITY’ and a descriptive term ‘INSIGHTS.’ The relevant public will recognise the word ‘ACUITY’ as the dominant and distinctive element of the mark. The term ‘Insights’ refers to the capacity to gain an accurate and deep understanding of someone or something, which is entirely relevant for the services in question”*.¹⁰ I appreciate that ‘INSIGHTS’ is a dictionary word with the meaning indicated by the Opponent. However, I do not find that the relevant consumer would perceive “INSIGHTS” as being descriptive of the services at hand; at best it may be perceived as allusive of the services’ characteristics (i.e., provide insights on, for example, a business’ recruitment process). Accordingly, I find that the words “ACUITY INSIGHTS” in the Contested Mark are not correlated to create a unitary meaning, both being nouns, and the overall impression rests solely and equally on those two words.

Visual similarity

51. The Earlier Mark consists of the single six-letter word “ACUITY” represented in standard typeface and all capitalised letters. The Contested Mark features the all-capitalised words “ACUITY” and “INSIGHTS” for a total of 14 letters.

52. The Opponent submitted that *“the dominant element of the mark of the Applicant consists of the word ‘ACUITY’ which is identical to the mark of the Opponent. The only visual difference in the marks is the addition of the descriptive term ‘INSIGHTS’ in the mark of the Applicant. The relevant consumer will instantly recognise the descriptive nature of this term and will therefore, put far more weight on the first word, ACUITY”*. The Holder contended that *“visually, ACUITY comprises one word whilst ACUITY INSIGHTS consists of two words, with the second word being visually longer in length and very different to the overlapping first word”*.

¹⁰ Opponent’s submissions in lieu dated 21 October 2024, paragraph 10.

53. I note the Earlier Mark is wholly contained within the Contested Mark and that the competing marks overlap in their first word ('ACUITY') to which consumers pay more attention when reading the marks. In this respect it is recalled that words are normally read from left to right¹¹ and that the initial part of a mark normally has a greater impact, both visually and aurally, than the following or final parts.¹² The Contested Mark is a longer mark comprising two words. Having considered the parties' arguments and keeping in mind the marks' overall impression, I find, overall, the respective marks have a medium degree of visual similarity.

Aural similarity

54. The Earlier Mark is comprised of the two-syllable word "ACUITY". The Contested Mark features two words, with the former ("ACUITY") being identical to the Earlier Mark (also in its enunciation) and the latter ("INSIGHTS") being an additional two-syllable word that introduces a point of aural difference. All words in both the Earlier Mark and Contested Mark are English dictionary words and the relevant consumer will voice them accordingly.

55. In light of the above considerations, I find, overall, the respective marks to be aurally similar to a medium degree.

Conceptual similarity

56. In its submissions in lieu the Opponent contended that *"the term ACUITY refers to a keenness or sharpness of thought, vision, or hearing. The addition of the term 'Insights' in the mark of the Applicant does little if anything to alter the conceptual impression created on the consumer. The overriding conceptual impression of both marks is one of a clarity or sharpness of thought. Consequently, the marks are conceptually similar to a very high degree"*.¹³

57. The Holder submitted that *"the first word in the Applicant's mark ACUITY INSIGHTS may be conceptually identical to the Opponent's mark, although since the word "acuity" has at least two dictionary meanings ("sharpness of vision or*

¹¹ *New Look Ltd v European Union Intellectual Property Office*, Joined Cases T-117/03 to T-119/03 and T-171/03, [28].

¹² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, [81].

¹³ Opponent's submissions in lieu dated 21 October 2024, paragraph 13.

hearing, or quickness of thought” per the Collins English Dictionary), it is not apparent which of these two meanings attach or are intended to attach to the Opponent’s mark and to the first word of the Applicant’s mark. In addition, the Applicant’s mark includes a second word, INSIGHTS, which is missing from the Opponent’s mark. The word “insights” has a dictionary meaning of “the ability to perceive clearly or deeply” and “a penetrating and often sudden understanding, as of a complex situation or problem” (per the Collins English Dictionary). Properly comparing the Applicant’s mark as a whole with the Opponent’s mark therefore, there is low conceptual similarity”.¹⁴

58. From the submissions above it seems that the parties agree on at least one meaning for ‘ACUITY’ (i.e., sharpness/quickness of thought). I acknowledge the Holder’s submissions contending that the word ‘ACUITY’ has different dictionary meanings and that the relevant consumers can understand this word with such different meanings. However, notwithstanding the different meanings for ‘ACUITY’, I note that both meanings relate to enhanced cognition, and I agree with the Holder that the first word in both competing marks (‘ACUITY’) is conceptually identical. This because the relevant consumers are likely to understand “ACUITY”, in either of its meanings, identically in both marks.

59. Along with “ACUITY” the Contested Mark features the additional word “INSIGHTS”. According to the submissions outlined above, the Holder submitted that “INSIGHTS” means *“the ability to perceive clearly or deeply” and “a penetrating and often sudden understanding, as of a complex situation or problem” (per the Collins English Dictionary)*.¹⁵ The Opponent did not provide a meaning for this word, but contended that *“does little if anything to alter the conceptual impression created on the consumer”*. Referring to the dictionary meanings for “INSIGHTS” provided by the Holder, I find that that the two words composing the Contested Mark are not placed in a syntactically correct structure and do not create a unitary meaning. Therefore, the insertion of “INSIGHTS” in the Contested Mark creates a point of difference in the marks’ conceptual similarity, taking it away from the identity of their respective first verbal element. Therefore, overall, I find the marks share a high degree of conceptual similarity.

¹⁴ Holder’s submissions in lieu, date 21 October 2024, paragraph 11.

¹⁵ Holder’s submissions in lieu, date 21 October 2024, paragraph 11.

Distinctive character of the earlier mark

60. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

61. Registered trade marks possess varying degrees of inherent distinctive character.

These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words.

62. Dealing first with the inherent distinctiveness, the Holder submitted that “*ACUITY, on its own, has low distinctiveness for psychometric testing given that one of the dictionary meanings is “quickness of thought” as set out above*”.¹⁶ I note the Opponent’s services at hand mainly relate to testing and assessment for the selection of personnel. With regard to the Holder’s submissions, I find that the

¹⁶ Holder’s submissions in lieu, date 21 October 2024, paragraph 17.

relevant consumers, when confronted with the Earlier Mark, will perceive “ACUITY” as alluding to a characteristic of the services (e.g., the testing/assessment services allow the users to select candidates who are sharp, or the services will make the candidates quicker of thought). Therefore, the Opponent’s mark consists of a dictionary word that will be understood as alluding to a characteristic of the services. Thus, the Earlier Mark is found to be inherently distinctive to a medium degree.

63. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, the Opponent provided evidence that the Earlier Mark has been used on the Opponent’s website between 2018 and 2021, a few invoices dated 2019, 2020 and 2022, marketing expenditure for the promotion of the ‘ACUITY’ service (including brand identity, website design and video advertisements), social media advertising, and the investment made for the technical development and testing of the Opponent’s services. Whilst I acknowledge the Opponent’s evidence, I do not believe that the evidence provided sufficiently shows that the Earlier Mark has acquired enhanced distinctiveness through use.

Likelihood of confusion

64. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 has retained in his mind (*Lloyd Schuhfabrik* at [26]).

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

66. I have found the degree of similarity of the respective services to range from low to identical. The level of attention is medium for a business and for the general

public. The distinctiveness of the Earlier Mark is medium. The visual and aural similarity is medium. The marks are conceptually highly similar. The purchase of the contested services is considered to be mainly visual but the potential for aural use is borne in mind. The Contested Mark fully contains the Earlier Mark, however it also contains an additional (relatively long) dictionary word that the relevant consumers are likely to perceive independently from “ACUITY”. Therefore, I find that the marks are unlikely to be mistakenly recalled or misremembered as each other and I do not consider there to be a likelihood of direct confusion.

67. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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)".

68. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.¹⁷ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹⁸ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.¹⁹

69. I found above that the competing marks share the same first word "ACUITY" and that the relevant consumers will understand this term identically in both marks and are likely to pay more attention to this word being placed at the beginning of both marks. The Contested Mark contains an additional dictionary word that does not form a syntactically correct unit with "ACUITY" and so the word "ACUITY" performs an independent distinctive role within that mark. Furthermore, the addition of "INSIGHTS" does not amount to such an unusual arbitrary choice when used in relation to the services at hand. Accordingly, the relevant consumers could understand the Holder's services as being aimed at providing 'insights' on the process of candidate assessment or provide 'insights' on the candidates' professional characteristics. Therefore, the word "INSIGHTS" in the Contested Mark is likely to be perceived as referring to an attribute of the Holder's services. It follows that, also taking into consideration the distinctive character of the Earlier Mark, a significant proportion of the relevant consumers will likely see the Contested Mark as a sub-brand or brand extension deriving from the Earlier Mark and will likely believe that both marks originate from the same or economically

¹⁷ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

¹⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

¹⁹ *Liverpool Gin Distillery*.

linked undertakings. As a result, I find that there is a likelihood of indirect confusion.

Conclusion

70. The opposition under section 5(2)(b) succeeds in its entirety and, subject to any appeal, the IR may not become protected in the UK.

Costs

71. The Opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the Opponent as follows:

Official fee	£100
Preparing the notice of opposition and considering the counterstatement	£250
Preparing evidence and considering and commenting on the other side's evidence	£600
Submissions in lieu of a hearing	£350
Total:	£1,300

72. I order Altus Assessments Inc. to pay BlooJam Consulting Limited the sum of **£1,300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2025

For the Registrar

Andrea Rossi