

O/0596/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3970485

BY ELEVATE BC LTD

TO REGISTER THE TRADE MARK:

ELEVATE

IN CLASSES 9, 16, 20, 35, 36, 38, 41, 42, 43, 44 & 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 445484

BY RANDSTAD N.V.

Background and pleadings

1. On 22 October 2023, Elevate BC Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 22 October 2023. Registration is sought for the goods and services in the following classes: 9, 16, 20, 35, 36, 38, 41, 42, 43, 44 & 45.
2. The application was partially opposed by Randstad N.V. (“the opponent”) on 24 January 2024. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) against the following services in class 35:

Personnel management; Business organization and management consultancy including personnel management; Management consultancy (Personnel-); Personnel management consultancy; Personnel management consulting; Business organisation and management consultancy in the field of personnel management; Personnel management consultation; Personnel management services; Personnel management advice; Personnel resources management; Consultancy relating to personnel management; Consultancy relating to the management of personnel; Personnel management consultancy services; Personnel management and employment consultancy; Personnel management of marketing personnel; Consultancy and advisory services relating to personnel management; Consultancy and advisory services relating to personnel placement; Employment consultancy; Recruitment consultancy services; Personnel consultancy; Employment consultancy services; Personal management consultancy services; Employment counselling and consultancy services; Career planning consultancy; Staff recruitment consultancy services; Career advisory services (other than education and training advice); Career information and advisory services (other than educational and training advice); Employment recruiting consultancy; Career placement consulting services; Management advice relating to the recruitment of staff; Employment counselling; Employment counselling services; Management advice relating to the placing of staff; Advice relating to personnel management; Provision of advice relating to the recruitment of graduates; Career networking services; Recruitment consultancy for lawyers; Executive recruiting services;

Recruitment of executive staff; Recruiting of office support staff; Employment recruiting consultation.

3. The opponent relies on the following trade marks:

i) UK3571459

RELEVATE

Filing date: 23 December 2020

Registration date: 30 April 2021

Relying upon the following services:

Class 35: Human resources management and recruitment services; Data management, compilation and provision of data, online data processing services, all in the field of human resources management and recruitment services, job searching, talent acquisition and recruitment of personnel; digital human resources management and recruitment services; recruitment of personnel; search and selection of personnel; digital human resources management and recruitment services; recruitment of personnel; search and selection of personnel; employment of personnel; outplacement of personnel; personnel management consultancy; advice in the field of staff matters; administrative services, in particular salary- and personnel administration; staff utilization planning; career counselling and advising in respect of personnel and staff matters; selection of personnel, also by way of psychological testing; outplacement of personnel, career guidance, commercial interim-management services; business project management; consultancy on the subject of business management and business economy; services in relation to the process of recruitment of personnel; payroll administration and management services; employment outplacement services; human capital management outsourcing services; all aforementioned services also via telecommunication, websites, digital portals and platforms and the internet.

ii) WO1565409

RELEVATE

Date of protection of the international registration in the UK: 13 April 2021

Priority date: 11 March 2020

Relying on all class 35 services as follows:

Human resources management and recruitment services; data management, compilation and provision of data, online data processing services, all in the field of human resources management and recruitment services, job searching, talent acquisition in the framework of HR and in the field of recruitment of personnel; digital human resources management and recruitment services; recruitment of personnel; search and selection of personnel; employment of personnel; outplacement of personnel; personnel management consultancy; advice in the field of staff matters; administrative services, in particular salary- and personnel administration; staff utilization planning; career counselling and advising in respect of personnel and staff matters; selection of personnel, also by way of psychological testing; outplacement of personnel, career guidance, commercial interim-management services; business project management; consultancy on the subject of business management and business economy; services in relation to the process of recruitment of personnel; payroll administration and management services; employment outplacement services; human capital management outsourcing services; all aforementioned services also via telecommunication, websites, digital portals and platforms and the Internet.

4. The opponent claims that the marks have a high degree of visual, phonetic and conceptual similarity. The opponent also states that the applicant's goods are identical or highly similar to their own and that these similarities will give rise to a likelihood of confusion.

5. The applicant filed a counterstatement in which it denied the similarity of the marks. It admits similarity for the services but states that there is no likelihood of confusion between the marks.

6. The applicant is represented by Robertson IP Limited and the opponent is represented by Venner Shipley LLP.

7. Both parties filed evidence. Neither party requested a hearing but both filed submissions in lieu. This decision is therefore taken following careful consideration of the papers.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

9. The opponent's evidence consists of a witness statement dated 26 June 2024 by Mr J.M. Nabiço Vazquez who is the managing director of Randstad N.V. and is accompanied by one exhibit. The purpose of the evidence is to show their mark in use on their website in relation to the services they provide.

10. The applicant's evidence consists of a witness statement dated 19 August 2024 by Marian Louise Evans who is the director of Elevate BC Ltd. This is also accompanied by one exhibit. The evidence includes screenshots of the website, and the purpose is to show the mark in use.

11. The evidence provided by both parties is of limited assistance in these proceedings. As there is no proof of use requirement, I am required to undertake notional assessments of the marks and the services as they are registered.

Decision

12. Section 5(2)(b) is being relied upon and is as follows:

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

13. Section 5A of the Act is as follows:

“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.”

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

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

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;”

15. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 3, which qualify as earlier trade marks under the above provisions. As the trade marks had not completed their registration process more than 5 years before the filing date of the application in suit, they are not subject to proof of use, as per section

6A of the Act. The opponent can, as a consequence, rely upon all of the services they have identified.

Case law

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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:

(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

17. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

18. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

19. 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.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) (‘Meric’)*, Case T-133/05, the 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”.

22. For the purposes of considering the issue of similarity of 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).

23. As the services replied upon for both earlier marks are largely the same, I will conduct a single assessment, distinguishing between the earlier specifications where necessary:

Contested services	Earlier services
<p>Class 35: Personnel management; Business organization and management consultancy including personnel management; Management consultancy (Personnel-); Personnel management consultancy; Personnel management consulting; Business organisation and management consultancy in the field of personnel management; Personnel management consultation; Personnel management services; Personnel management advice; Personnel resources management; Consultancy relating to personnel management; Consultancy relating to the management of personnel; Personnel management consultancy services; Personnel management and employment consultancy; Personnel management of marketing personnel; Consultancy and advisory services relating to personnel management; Consultancy and advisory services relating to personnel placement; Employment consultancy; Recruitment consultancy services; Personnel consultancy; Employment consultancy services; Personal management consultancy services; Employment counselling and consultancy services; Career planning consultancy; Staff recruitment consultancy services; Career advisory</p>	<p><i>UK3571459</i></p> <p>Class 35: Human resources management and recruitment services; Data management, compilation and provision of data, online data processing services, all in the field of human resources management and recruitment services, job searching, talent acquisition and recruitment of personnel; digital human resources management and recruitment services; recruitment of personnel; search and selection of personnel; digital human resources management and recruitment services; recruitment of personnel; search and selection of personnel; employment of personnel; outplacement of personnel; personnel management consultancy; advice in the field of staff matters; administrative services, in particular salary- and personnel administration; staff utilization planning; career counselling and advising in respect of personnel and staff matters; selection of personnel, also by way of psychological testing; outplacement of personnel, career guidance, commercial interim-management services; business project management; consultancy on the subject of business management and business economy; services in relation to the process of recruitment of</p>

<p>services (other than education and training advice); Career information and advisory services (other than educational and training advice); Employment recruiting consultancy; Career placement consulting services; Management advice relating to the recruitment of staff; Employment counselling; Employment counselling services; Management advice relating to the placing of staff; Advice relating to personnel management; Provision of advice relating to the recruitment of graduates; Career networking services; Recruitment consultancy for lawyers; Executive recruiting services; Recruitment of executive staff; Recruiting of office support staff; Employment recruiting consultation.</p>	<p>personnel; payroll administration and management services; employment outplacement services; human capital management outsourcing services; all aforementioned services also via telecommunication, websites, digital portals and platforms and the internet.</p> <p><i>WO1565409</i></p> <p>Human resources management and recruitment services; data management, compilation and provision of data, online data processing services, all in the field of human resources management and recruitment services, job searching, talent acquisition in the framework of HR and in the field of recruitment of personnel; digital human resources management and recruitment services; recruitment of personnel; search and selection of personnel; employment of personnel; outplacement of personnel; personnel management consultancy; advice in the field of staff matters; administrative services, in particular salary- and personnel administration; staff utilization planning; career counselling and advising in respect of personnel and staff matters; selection of personnel, also by way of psychological testing; outplacement of personnel, career guidance, commercial interim-management services; business project</p>
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	<p>management; consultancy on the subject of business management and business economy; services in relation to the process of recruitment of personnel; payroll administration and management services; employment outplacement services; human capital management outsourcing services; all aforementioned services also via telecommunication, websites, digital portals and platforms and the Internet.</p>
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24. I note within the Form TM8 the applicant stated

“We do not contest the Opponent’s assertion that the services listed in the Application and identified on the Continuation sheet of the Opponent’s Notice of opposition and statement of grounds, are similar to or identical to some of those services for which the Opponent’s Marks are registered.”

25. They also made no further mention of the services comparison within their submissions. I will therefore proceed on the basis that they have accepted the services are identical or similar. As they have not specified the level of similarity for the services, I must still undertake a comparison to determine this.

26. Further, I note both earlier specifications contain the wording ‘all aforementioned services also via telecommunication, websites, digital portals and platforms and the Internet’ which I have considered has no material effect on the comparisons to be made and therefore, I do not need to refer to this in the specific comparisons.

Personnel management consultancy; Personnel management consulting; Consultancy relating to personnel management; Consultancy relating to the management of personnel; Personnel management consultancy services;

27. The above services from the applicant's specification are identical to the opponent's 'personnel management consultancy' (albeit some of them are worded slightly differently).

Personnel management; Business organization and management consultancy including personnel management; Management consultancy (Personnel-); Business organisation and management consultancy in the field of personnel management; Personnel management consultation; Personnel management services; Personnel management advice; Personnel resources management; Personnel management and employment consultancy; Personal management consultancy services; Personnel management of marketing personnel; Consultancy and advisory services relating to personnel management; Consultancy and advisory services relating to personnel placement; Personnel consultancy; Advice relating to personnel management;

28. I consider that the opponent's 'personnel management consultancy' falls within the above services from the applicant's specification and therefore, I find them to be identical under the *Meric* principles.

Employment consultancy; Employment consultancy services; Employment counselling; Employment counselling services; Employment counselling and consultancy services;

29. I consider that the above services are very wide and would encompass things like 'employment of personnel' and 'employment outplacement services' and therefore consider these to be identical under the *Meric* principles.

Recruitment consultancy services; Staff recruitment consultancy services; Employment recruiting consultancy; Management advice relating to the recruitment of staff; Management advice relating to the placing of staff; Provision of advice relating to the recruitment of graduates; Recruitment consultancy for lawyers; Executive recruiting services; Recruitment of executive staff; Recruiting of office support staff; Employment recruiting consultation.

30. I find all of the above fall within the opponent's 'Human resources management and recruitment services' and therefore consider them to be identical under the *Meric* principles.

Career planning consultancy; Career advisory services (other than education and training advice); Career information and advisory services (other than educational and training advice); Career placement consulting services

31. I believe that the above services all encompass 'career counselling and advising in respect of personnel and staff matters' from the opponent's specification and therefore, find them to be identical under the *Meric* principles.

Career networking services;

32. I consider there to be an overlap in purpose, user and trade channels between the above service and the opponent's 'career counselling and advising in respect of personnel and staff matters' but that the services differ in nature and method of use. They are not complementary nor are they in competition and therefore, I find them to be similar to a medium degree.

Average consumer and the purchasing act

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

34. 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. (as he then was) 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.”

35. The applicant provided the following submissions within the evidence rounds relating to the average consumer and purchasing act:

“We note that the relevant consumers for the Applicant’s services, including personnel services and recruitment services, are larger business owners and corporate officers, who alone require and can afford recruitment and personnel management consultation of the kind provided by the Applicant. [...]

We also note that the relevant consumers for the Opponent’s services are larger business owners and corporate officers, who alone require and can afford recruitment services on the scale provided by such a large corporation as the Opponent.

We therefore submit that the relevant consumer will have a very high degree of attentiveness indeed when carefully selecting the supplier for such important services, and will not easily be confused as a result of similarities in branding.”

36. In their submissions in lieu, the opponent stated:

“Most of the earlier and contested services relate to support and advisory services in the fields of management and hiring of people and staff as well as careers and work. These services are purchased by businesses across a broad range of sectors and ranging in size from start-ups to SMEs to large corporate organisations. However most of the Earlier and Contested Services will also be utilized by the public at large via their employers or prospective employers, with only a normal level of attention paid.

[...]

Although some of the Earlier Services “commercial interim-management services; business project management; consultancy on the subject of business management and business economy” and the Contested Services “Business organization and management consultancy including personnel management; Management consultancy (Personnel-)” may primarily be targeted at and used by businesses and therefore have a professional relevant public displaying a higher than normal level of attention [...].”

37. In my view, for recruitment/personnel/career type services, the average consumer could be commercial/business users (of any size) and the general public (for example, individuals seeking employment). The purchasing act will be primarily visual for such services, and they will likely be selected from websites. However, the aural aspect must still be considered because the services may sometimes be the subject of discussions with representatives or word of mouth recommendations. Such services may vary in price and are not considered inexpensive for business users. A number of factors will likely be taken into account by the relevant consumers when selecting a provider. In this regard, a higher than medium degree of attention will be paid when selecting these services.



Comparison of the marks

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

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

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

Contested Mark	Earlier Mark
	

40. The contested mark comprises of the word ‘ELEVATE’ in gold standard typeface. The right line of the ‘V’ is an arrow pointing upwards. I consider that the word element ‘ELEVATE’ is the dominant and distinctive element of the mark with the colour and arrow device playing a lesser role.

41. The earlier mark is a word mark comprising of one word and the overall impression lies in that word.

42. Visually, the letters of the contested mark are entirely encompassed in the earlier mark. The earlier mark contains an extra letter at the beginning that has no counterpart in the contested mark. The contested mark also contains the arrow element which is a point of visual difference. I note that the applicant has mentioned the different colours of the marks however, it should be noted that a word mark (as the earlier mark is registered) is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the

specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see *Herno S.p.A. v Miss Sparrow Ltd*, BL O/954/22 and judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited). I therefore find the marks to be visually similar to between a medium and high degree.

43. Turning next to the aural comparison, the contested mark will have its ordinary everyday pronunciation. As it is encompassed in the earlier mark, those elements will be identical. The difference lies at the beginning where the earlier mark has an 'R'. I therefore find them to be aurally similar to a high degree.

44. Both parties agree that the contested mark has the meaning "to lift up" or "raise" (which is reinforced by the arrow pointing upwards element). In relation to the earlier mark, both parties have acknowledged that it appears to be a made up term. The opponent states in its submissions that the relevant consumer will likely extract 'elevate' from their mark and therefore there is a high similarity between the marks.

45. Whilst I note it is possible for the average consumer to break down a mark into elements that represent meanings to them, I do not think this will happen here. It would be an unnatural dissection of the mark to remove or ignore the beginning letter (remembering that the beginning of marks can have the most impact)¹. Therefore, I find that the earlier mark will likely be viewed as an invented term and that the marks are therefore conceptually dissimilar.

Distinctive Character of the Earlier Mark

46. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

“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).”

47. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. Although I have been provided evidence of the mark in use on the opponent’s website, this is not enough on its own to make a finding of enhanced distinctiveness and, consequently, I have only the inherent position to consider.

48. The earlier mark is comprised of the word ‘RELEVATE’ which, as I have found above, is likely to be seen as an invented term with no link to the services. Therefore, I find the earlier mark to be inherently distinctive to a high degree.

Likelihood of confusion

49. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

50. The following factors must be considered to determine if a likelihood of confusion can be established:

- The contested mark comprises of the word 'ELEVATE' in gold standard typeface. The right line of the 'V' is an arrow pointing upwards. I consider that the word element 'ELEVATE' is the dominant and distinctive element of the mark with the colour and arrow device playing a lesser role.
- The earlier mark is a word mark comprising of one word and the overall impression lies in that word.
- I have found the marks being compared visually similar to between a medium and high degree and aurally similar to a high degree. In relation to the conceptual comparison, I have found the marks to be conceptually dissimilar.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer could be commercial/business users (of any size) and the general public (for example, individuals seeking employment). The purchasing process is likely to be predominantly visual.

- I have concluded that a higher than medium level of attention will be paid during the purchasing process.
- I have found the services to range between identical and similar to a medium degree.

51. Whilst the levels of visual and aural similarities between the marks are relatively high, I note in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

52. I consider that the difference in concepts between the marks, coupled with the different beginnings of the marks (which, as I have noted above, the beginning of the marks can have more impact) serve to counteract those higher levels of similarity. I do not believe that these are things the average consumer will overlook especially when remembering that it is unlikely the average consumer will come across the marks side by side in the market and taking into account the higher than average degree of attention paid. Even the identity between the services will not be enough to overcome the abovementioned differences. Therefore, I consider there to be no likelihood of direct confusion.

53. I will therefore turn to look at indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

“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”).

54. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”²

55. Firstly, the common element between the marks are the letters ‘ELEVATE’ which is not so highly distinctive that no other party could be using it as a trade mark at all. Secondly, the change between the marks is a different first letter (where the additional letter results in the earlier mark being considered a made up term versus the applied for mark having a clear concept) and therefore this is not likely to be a subbrand nor a logical brand extension. I can see no other reason why the average consumer would view the marks as coming from the same undertaking or indicating the same or related brands. The difference in concepts- one having a clear meaning and one being seen as a made up term would prevent the average consumer from assuming they are from the same place, it may be that there average consumer calls to mind the other mark

² Paragraph 12

upon seeing the shared letters however, this is mere association and not indirect confusion.³ Therefore, I find there to be no likelihood of indirect confusion.

Conclusion

56. The opposition fails in its entirety, subject to any successful appeal.

Costs

57. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023. As the evidence provided by both parties was short and of little value to the decision itself, I have not made any award in relation to this. I award the opponent the sum of **£600**, calculated as follows:

Considering the Notice of opposition and preparing the counterstatement	£300
Preparation of submissions in lieu	£300
Total	£600

58. I therefore order Randstad N.V. to pay Elevate BC Ltd the sum of £600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2025

L Nicholas
For the Registrar

³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17