

O-024-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2443798  
BY A M RECRUITMENT LTD TO REGISTER THE TRADE MARKS**



**IN CLASS 35**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
THERE TO UNDER NOS 95652 AND 95653  
BY ANGELA MORTIMER PLC AND EXCEL HOLDING SPRL**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2443798  
by A M Recruitment Ltd to register a series of two Trade Marks  
AM RECRUITMENT LTD and device in Class 35**

and

**IN THE MATTER OF Oppositions thereto under No. 95652 and 95653  
by Angela Mortimer Plc and Excel Holding SPRL respectively**

## BACKGROUND

1) On 17 January 2007, A M Recruitment Ltd, of 32 Offley Road, Sandbach, Cheshire, CW11 1GY applied under the Trade Marks Act 1994 for registration of the following series of two trade marks:



2) In respect of the following services in Class 35:

*“Personnel recruitment services; temporary staff recruitment; permanent staff recruitment; employment agency services; consultancy and advisory services in relation to all the aforesaid services.”*

3) The application was subsequently advertised in the Trade Marks Journal on 17 August 2007.

4) On 15 November 2007, Angela Mortimer Plc of 37-38 Golden Square, London, W1R 3AA and Excel Holding SPRL, Avenue Louise 326 B28, Brussels 1050, Belgium both filed separate notices of opposition to the application. The first notice of opposition was based upon the grounds that the first opponent has established a considerable goodwill and reputation in the business of recruitment and associated business trading under the initials “AM” and has been in business since 1976. It is claimed that the registration and use of the trade mark applied for will cause confusion and is likely to result in passing off of the services of the applicant for the services of the first opponent and the trade mark therefore offends under Section 5(4) (a) of the Trade Marks Act 1994 (“the Act”).

5) The second notice of opposition was based upon the grounds that the application offends against Section 5(2) (b) of the Act because the trade mark in question is similar to the Excel Holding SPRL's trade mark registration CTM3615135 for "AM Legal" filed on 5 January 2004 and covering the following services in Class 35:

*"Employment agencies and personnel management consultancy"*

6) The applicant subsequently filed counterstatements in both sets of proceedings. It denies that its trade marks offend under Sections 5(2) (b) or 5(4) (a) of the Act and puts the opponents to strict proof of use. It denies that the second opponent's trade mark is sufficiently similar to the applicant's trade marks for there to be confusion under Section 5(2) (b) of the Act. It also claims that, despite being in correspondence with Angela Mortimer Plc since 2006, no evidence of the alleged goodwill has been produced and therefore the opposition based upon Section 5(4) (a) of the Act should be dismissed.

7) The Registry was subsequently advised that Excel Holding SPRL is a wholly owned subsidiary of Angela Mortimer Plc and a request to consolidate proceedings into a single set of proceedings was accepted. The Registry was notified that future evidence and submissions from the opponents would be provided only by Angela Mortimer Plc. The applicant did not file evidence. Neither party requested to be heard but the opponent filed written submissions. Both sides seek an award of costs. After a careful study of all the papers, I give my decision.

### **Opponents' Evidence**

8) This takes the form of two witness statements. The first of these is by Daniella Bryant, Senior Consultant and Team Leader with Angela Mortimer Plc and is dated 2 June 2008. Ms Bryant states that the opponent has two separate trading divisions that deal with legal recruitment. One is "AM Legal" and the other is "Smith and Manchester". They have different web sites but use the same telephone number and share administrative staff. Ms Bryant goes on to explain that in or about late 2006, they began receiving queries from potential candidates of which they had no record. Upon further investigation it transpired that these queries were following up e-mails to the applicant, AM Recruitment. Ms Bryant is unable to provide records of the calls or names and addresses but recalls that they began in late 2006 and continued until mid-2007 at a frequency of at least one a day.

9) The second witness statement is by William Littlejohn Mortimer aka John Mortimer, Director of Angela Mortimer Plc and Excel Holding SPRL and is dated 4 June 2008. Mr Mortimer explains that he and his wife, Angela founded Angela Mortimer Plc in 1976 and originally offered recruitment services to the London office support and secretarial market helping predominantly female candidates.

The business adopted a “female career” focus earlier than its competitors and the loyalty that it inspired endures to this day.

10) In 1986, the business started to develop from offering secretarial and administrative staff to personnel head-hunting and more senior office roles. By 1995, the business had a turnover of £10 million and by today (June 2008) the opponent has offices in London, Birmingham, Manchester and Nottingham with two hundred consultants specialising in a range of employment issues. In 1994, the opponent set up a division called “AM” to provide an executive recruitment service to the banking, IT, advertising and legal sectors and in 1998 “AM Legal” and “AM Tech” began trading with “AM Finance” following in 2001. Exhibit WLM02 illustrates the trade mark “AMTech” get up as used on business cards and headers. Following further expansion by acquiring the Brussels based company Excel Careers, “AM Legal” was registered as a Community Trade Mark and has an application date of 5 January 2004. Exhibit WLM03 provides details of this registration. Mr Mortimer explains that although this Brussels based subsidiary trades in Belgium, the AM group trade in the UK. He goes on to say that offices that deal with financial, legal and technical positions are based in London, Paris, Nottingham, Brussels and Manchester. The implication in these statements is that the trade mark “AM Legal” is used in the UK, but this is not stated.

11) Exhibits WLM04/05 and 06 are summaries of the turnovers of AM Legal, AM Tech and AM Finance respectively. These figures are recorded in twelve month periods from July to June and are summarised below:

<b>Turnover (£000s)</b>	<b>AM Legal</b>	<b>AMTech</b>	<b>AM Finance</b>
1998	825	-	-
1999	442	-	-
2000	865	-	-
2001	1,102	-	-
2002	765	-	-
2003	666	381	-
2004	384	2,007	-
2005	258	3,475	223
2006	343	5,410	285
2007	521	5,381	388
2008 (to February)	325	4,091	166

12) The same exhibits also record the following PR and advertising costs:

<b>PR/Advertising spend (£000s)</b>	<b>AM Legal</b>	<b>AM Tech</b>	<b>AM Finance</b>
1998	33.1	-	-
1999	73	-	-

2000	72.1	-	-
2001	73.8	-	-
2002	119	-	-
2003	52.6	16	-
2004	41	14.6	-
2005	38.3	27.3	23
2006	43.7	37.8	29.5
2007	57.1	62.8	51
2008 (to February)	25.2	39.4	10.7

13) Advertising is placed mainly in professional magazines such as the Law Society Gazette, Legal Week and The Lawyer as well as, since at least January 2007, on specialist websites such as Job Server. Exhibit WLM09 is a copy of such an advert that, Mr Mortimer states, appeared in The Lawyer in February 2004. Exhibit WLM10 is an extract from the website gaapweb.com dated 9 May 2008 showing an advert for a “European Finance Analyst” and accredited to AM Finance. In addition, Mr Mortimer explains that the opponent also uses direct mailing to law companies and Exhibit WLM11 is an undated copy of such a flier advertising AM Legal’s professional legal recruitment services. Mr Mortimer states that this flyer has been used for several years and “certainly for a long time prior to January 2007”.

14) Mr Mortimer describes Exhibit WLM12 as being two e-mail testimonials, one from the company Sun Microsystems, the other from an individual called Ashley Fife. This description does not appear to match the contents of the exhibit which is a single e-mail dated 10 April 2008 from a contractor called Ben Pintillie, working for Sun Microsystems. He conveys his appreciation for the high standard of service received from one of the opponent’s employees. Mr Mortimer states that this illustrates how AM Legal and AM Tech have become known as a reliable source of providing quality positions and/or staff, however it is unclear as to which division Mr Pintillie is referring.

15) Mr Mortimer goes on to state that the business is well established in the UK, with its reputation built upon consultation and providing reliable staff. The vast majority of would-be professionals will know the company as AM Legal, AMTech or AM Finance.

16) The opponents became aware of the applicant in late 2006 when there were some instances of confusion where candidates were contacting the opponent to follow up the submission of CVs in the mistaken belief that they were contacting the applicant. No documentary evidence is provided to support this.

17) The opponent’s representatives wrote to the applicant in December 2006 (the exchange of letters is provided at Exhibit WLM13) informing them of instances of

confusion and stating that such confusion will damage the reputation and goodwill of the opponents.

## **DECISION**

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

18) The opposition is founded upon Section 5(2) (b) of the Act. This reads:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

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

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

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

20) Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

#### **“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

21) The trade mark relied on by the opponent is CTM 3615135 with a registration date of 6 February 2008. By virtue of a filing date of 5 January 2004, this trade mark is an earlier trade mark as defined in section 6(1) of the Act. In relation to the proof of use requirements, the applicant's trade mark was published for opposition purposes on 17 August 2007. The earlier CTM completed its registration procedure after this date and therefore the proof of use provisions do not apply.

22) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

### ***Comparison of services***

23) In assessing the similarity of services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘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 end users and their method of use and whether they are in competition with each other or are complementary.’

24) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson GmbH (monBeBé)*).

25) The applicant’s specification of services covers various recruitment services, employment agency services and consultancy and advisory services relating to the same. The services that are the subject of the opponent’s earlier trade mark are “[e]mployment agencies and personnel management consultancy” services. The services provided by employment agencies include recruitment and advice relating to the same. As such I conclude that, having considered the factors set out in *Canon*, these respective services are identical or if not identical at least at the very top end of similarity.

### ***The average consumer***

26) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the services at issue. I have already found that the respective services are identical or at least at the very top end of similarity and it follows that the average consumer for both the opponent’s and applicant’s services will be the same.

27) In this case, the average consumer can be the general public or, equally, a business enterprise, either small or large. Members of the general public may wish to use the services of either party to find new employment and business enterprises may use the services to fill a job vacancy. In identifying a number of different types of consumer of these services, a number of different purchasing acts are also apparent. The former group may encounter the service on a single occasion, or on an ongoing basis. A job seeker may use the service just once when they require assistance in finding a job placement. There may also be temporary staff or “temps” who have an ongoing relationship with the service provider and are paid by the service provider and placed with a host organisation for a short period only. Such temps will be better informed about the employment agency market than the individuals looking to the agency to find them a permanent position. The business users will also have more regular dealings with the agency and may also pay a fee for the services. The purchasing act for such businesses will often be made by a professional with specialist knowledge of the sector and will make a more considered purchasing choice.

28) In summary, I consider that the average consumer for the respective services will be the same, but that there will be differences in the purchasing act depending on the type of user of the services. In all cases however, the

purchasing act will require more than an average degree of consideration and in the case of “temps” or business users, the purchasing act will be quite highly considered.

### **Use and distinctive character of the earlier trade mark**

29) I have to consider whether the opponent’s trade mark has a particularly distinctive character either arising from the inherent characteristics of the trade mark or because of the use made of it. It contains the letters “AM” and the word “LEGAL”. The letters “AM” do not enjoy the highest degree of distinctive character by virtue of the fact that they can be merely the initials of an individual with many other individuals sharing the same initials. As such, despite having sufficient distinctive character for prima facie registration, it only enjoys an average level of distinctive character. The word “LEGAL”, in the context of the relevant services, describes the professional field which the services are targeted and as such it has a very low level of distinctive character. Taking the trade mark as a whole, I find that the level of inherent distinctive character is no more than average.

30) As the opponent has noted in its written submissions, the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such

an important consideration. But all must depend upon the circumstances of each individual case.”

31) The opponent’s evidence illustrates that use of the trade mark “AM Legal” began in 1998 and the turnover relating to services provided under this trade mark peaked at about one million pounds in 2001. Following 2001, turnover began to reduce, reaching its low point in 2005 where £258 thousand is declared. An increase to £521 thousand is recorded for the period July 2006 to June 2007. I will accept that the about half of this turnover related to the period prior to the filing of the application at issue as it was filed on 17 January 2007, about five and a half months before the end of this period. Mr Mortimer, in his witness statement, explains that “AM Legal” deals with legal positions and the business is based at offices in London, Paris, Nottingham, Brussels and Manchester. The inference is that not all the turnover relates to business in the UK, but with three offices in the UK, I am also prepared to accept that a reasonable proportion of the declared turnover relates to the UK. Having reached this finding, I must consider if this use is such as to lead to an enhanced distinctive character in the UK. No information has been provided regarding the size of the recruitment business in the UK or the sub-category of this business that operates within the legal field. I therefore find myself assessing the scale of the reputation of “AM Legal” with little context within which to assess its market share. However, accepting the fact that the opponent has traded for nine years before the filing of the application at issue, has a turnover in the hundreds of thousands on pounds a year and that Mr Mortimer is unchallenged in his statement that the opponent advertises in professional magazines such as the Law Society Gazette, Legal Week and The Lawyer, I am prepared to infer from this that there is at least a small impact upon the level of the trade mark’s inherent distinctive character as a result of its reputation.

**Comparison of marks**

32) I will now go on to consider the similarities and differences between the trade marks themselves and the impact of any differences upon the global assessment of similarity. When assessing this factor, I must do so with reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). The trade marks to be compared are:

Trade Mark of Opponent	Trade Mark of AM Recruitment Limited
AM Legal	

33) From a visual perspective, the opponent’s trade mark includes at its beginning, the letters “AM” and is followed by the word “legal”. The applicant’s

trade marks contain two device elements shaped to take the form of the stylised letters “A” and “M”. Within these devices and partially visible, as if the two letter devices are windows, is a representation of a building, possibly a church with the sky visible above the building. The presence of this “view” does not detract from the devices still having the visual impact of being the letters “A” and “M”. It also contains the word and abbreviation “Recruitment Ltd” appearing under the device elements. In both cases the letters “AM”, or in the case of the applicant’s trade marks, the devices representing the letters “AM” are visually dominant. In the former, the letters appear at the start of the trade mark and in the applicant’s trade mark “AM” consists of approximately four fifths of the overall trade mark with the word and abbreviation “Recruitment Ltd” appearing in small text under the device elements. When comparing the trade marks as a whole, I conclude that these differences and similarities combine to give a reasonably high level of visual similarity.

34) From an aural perspective, the opponent’s trade mark will be pronounced as “A-M legal” and the applicant’s as “A-M recruitment limited”. The stylisation of the letters “A” and “M” in the applicant’s trade marks will not change this. The shared use of the letters “A” and “M” creates the point of aural similarity, and the word “legal” in the opponent’s trade mark and the word and abbreviation “recruitment ltd” in the applicant’s trade mark provides a point of dissimilarity. Taking all these points into account, I consider that the respective trade marks share a reasonably high level of aural similarity.

35) Conceptually, the combination of the letters “AM” and the word “Legal” in the earlier trade mark, when viewed in relation to the services at issue, will be understood as referring to services relating to the legal profession with “AM” having no obvious meaning, it will be understood as indicating an individual or business identified by such letters. Turning to the applicant’s trade mark, the word and abbreviation “Recruitment Ltd” will be understood as referring to a limited company in the field of recruitment. As with my comments regarding the earlier trade mark, the letters “AM” will be understood as indicating the trade origin of such services. I am mindful of the guidance given by the ECJ in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* that assessment of similarity means more than taking just one component of a composite trade mark and comparing it with another mark and also in *Shaker di L. Laudato & C. Sas v OHIM* that only if other components are negligible is it permissible to make the comparison on the basis of the dominant element. In this case the elements “Legal” in the earlier trade mark and “Recruitment Ltd” in the applicant’s trade mark cannot be classified as negligible. That said, in relation to the respective services, I consider they are both descriptive. The word “legal” in the earlier trade mark will be understood as referring to a sub-set of the recruitment services inferred by the word and abbreviation “recruitment ltd” in the applicant’s trade mark. I therefore consider that the respective trademarks share some conceptual similarity, but this is on the low side.

### **Likelihood of confusion**

36) It is clear from the case law that there is interdependency between the various factors that need to be taken into account when deciding whether there exists a likelihood of confusion. I must also take into account that marks are rarely recalled perfectly with the consumer relying, instead, on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I have found that the respective trade marks share a reasonably high level of visual and aural similarity and a lowish level of conceptual similarity. The respective services are identical or very similar. I also acknowledged that the components “Legal” and “Recruitment Ltd” in the respective trade marks have descriptive significance, with the former relating to a sub-set of services provided by the latter. When taking all these factors into consideration, I find that the relevant public will confuse the trade marks and they will believe that the respective services originate from the same trade source. Accordingly, I find there is a likelihood of confusion and the opposition under Section 5(2) (b) succeeds.

37) Whilst I found an enhanced distinctive character of “AM Legal” in the UK that resulted from its reputation, the absence of such a reputation would not result in a different outcome.

### **Section 5(4) (a)**

38) In light of these findings there is no need for me to consider the opponent’s further objection under Section 5(4) (a).

### **Costs**

39) Angela Mortimer Plc and Excel Holding SPRL have been successful and are entitled to a contribution towards their costs. I take account of the fact that the decision has been reached without a hearing taking place, though with written submissions having been prepared by the opponent. I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Preparing and filing evidence	£500
Filing written submissions	£200
<b>TOTAL</b>	<b>£1400</b>

40) I order A M Recruitment Ltd to pay Angela Mortimer Plc/Excel Holdings SPRL the sum of £1400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27<sup>th</sup> day of January 2009**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**