

**TRADE MARKS ORDINANCE (Cap. 559)**

**APPLICATION NO. : 302074239**

**MARK :** POWERING THE WORLD OF WORK

**APPLICANT : Hays plc**

**CLASS : 35**

---

**STATEMENT OF REASONS FOR DECISION**

***Background***

1. On 2 November 2011, Hays plc (“the applicant”) filed an application for registration (“the subject application”) of the mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap.559) (“the Ordinance”).

POWERING THE WORLD OF WORK

2. Registration of the subject mark was sought in respect of the following services in Class 35:

Permanent temporary and contract recruitment services; recruitment and employment agency services; specialist recruitment services; personnel and human resources management services relating to recruitment; recruitment process management and human resources (HR) outsourcing services relating to recruitment; assessment and development of candidates, such services being in the field of recruitment; employee talent management relating to recruitment; salary surveys for recruitment purposes (“the applied-for services”).

3. At the examination stage, an objection was raised against the subject application under section 12(3) of the Ordinance on the basis of the following registered mark (“the cited mark”):

Trade mark : SHAPING THE WORLD OF WORK

Registration no. : 301024596

Date of registration : 2 January 2008

Specification : Class 35  
Recruitment 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; career counseling and advising in respect of personnel and staff matters; advisory services with respect to the choice of profession; 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; advisory services regarding the choice of profession; all aforementioned services also provided via telecommunication, including the Internet.

4. The applicant has not filed any evidence of honest concurrent use of the subject mark and the cited mark under section 13 of the Ordinance.
5. Despite submissions made on behalf of the applicant, the objection was maintained by the Registrar. The applicant requested a hearing on the registrability of the subject mark and this was held before me on 24 September 2014. Ms. Karen Sit of Messrs. Rouse Legal represented the applicant at the hearing, and filed written submissions and a list of authorities in support (“Applicant’s Submissions”). I reserved my decision at the conclusion of the hearing.

## *Decision*

### **The Ordinance**

6. The objection is raised under section 12(3) of the Ordinance, which provides that:

“A trade mark shall not be registered if –

- (a) the trade mark is similar to an earlier trade mark;
- (b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and
- (c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.”

7. An “earlier trade mark”, as referred to in section 12(3), is defined in section 5 of the Ordinance, and the relevant part of the section reads as follows:

“(1) In this Ordinance, “earlier trade mark”, in relation to another trade mark, means –

- (a) a registered trade mark which has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities claimed in respect of each trade mark, if any...”

The date of application for registration of the cited mark is earlier than that of the subject mark. The cited mark therefore constitutes an “earlier trade mark” in relation to the subject mark for the purpose of section 12(3) of the Ordinance.

8. Another section to consider is section 7(1) of the Ordinance which throws light on how subsection (c) of section 12(3) is to be interpreted. Section 7(1) provides that:

“For greater certainty, in determining for the purposes of this Ordinance whether the use of a trade mark is likely to cause confusion on the part of the public, the Registrar or the court may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.”

9. The basic principles regarding the assessment of similarity between marks and

the likelihood of confusion between them are set out in the cases of *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (the “*Canon*” case) [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] F.S.R. 77, *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] F.S.R. 19 and adopted by the Court of Appeal in *Tsit Wing (Hong Kong) Company Limited and Others v TWG Tea Company Pte Ltd* (CACV 191/2013) at paragraph 35. These principles are:

- (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 observant and circumspect, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question.
- (c) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.
- (d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements.
- (e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.
- (f) And beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark.

- (g) A lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.
- (h) There is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it.
- (i) Mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient.
- (j) The reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense.
- (k) If the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

10. In accordance with the above principles, I need to examine whether there are similarities between firstly, the subject mark and the cited mark and secondly, the services covered by the marks and then consider whether such similarities (if any) would be likely to lead to confusion by the public.

#### *Comparison of marks*

- 11. A comparison of the marks has to be based on an overall appreciation of the visual, aural and conceptual similarities of them, taking into account the overall impressions given by them, and bearing in mind, in particular, their distinctive and dominant components.
- 12. The subject mark consists of the phrase “POWERING THE WORLD OF WORK”. All the words are capitalised and are in pure plain font. For the cited mark, it consists of the phrase “SHAPING THE WORLD OF WORK”. Likewise, all the words are capitalised and are in pure plain font. There is no dispute that both phrases are promotional statements.

13. In comparing the marks, I shall consider the perception of the marks in the mind of the average consumer of the applied-for services. The applied-for services relate to various recruitment services, including but not limited to employment agency services, outsourcing services, personnel and human resources management services, and recruitment of specialist and for permanent, temporary and contract placements. The average consumer therefore consists of members of the general public who are looking for jobs and employers who are seeking to recruit employees, and they are reasonably well-informed, observant and circumspect. However, it is trite law that the level of attention of the relevant public may be relatively low when it comes to promotional indications, whether it involves average end consumers or a more attentive public made up of specialists or circumspect consumers (Case T-291/12, *Deutsche Bank AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*, para. 32).
14. Ms. Sit submitted that the phrase “THE WORLD OF WORK” was commonly and descriptively used by various recruitment agencies to market their services. Further, as she averred that the frontal part of a mark has a greater impact, the distinctive and dominant elements of the subject mark and the cited mark were therefore the words “POWERING” and “SHAPING” respectively. On that basis, she considered that such difference was sufficient to distinguish the marks from each other (Case T-112/03 *FLEX* at para. 64/65, Case T-183-4/02 *MUNDICOR* at para. 81, Registrar’s Decision on Hong Kong Application No. 301655550 for **Botáni** (“the *Botani* case”) at para. 16). In her submissions, visually, the word “POWERING” is made up of eight letters whilst the word “SHAPING” consist of seven letters, and they only overlap in relation to the ending. Similarly, their pronunciation was also different, again only overlapping in relation to the ending. Conceptually, Ms. Sit considered that there were no similarities due to the different meanings of the words.
15. I do not concur. Although I acknowledge that the beginning of a sign generally has more importance than the ending in the overall impression produced by a sign, this consideration cannot undermine the principle that an examination of the similarity of the signs must take account of the overall

impressions produced by those signs, and the overall impression conveyed to the public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components (paras. 9(d) and (e), above). In this case, both the subject mark and the cited mark consist of two elements, namely a transitive verb, i.e. respectively “POWERING” and “SHAPING”, and a common noun phrase “THE WORLD OF WORK”. Given the common noun phrase “THE WORLD OF WORK” takes up four of the five words in each of the marks, and that the verbs “POWERING” and “SHAPING” are used to describe the noun phrase “THE WORLD OF WORK”, the noun phrase “THE WORLD OF WORK” stands out to be the dominant element of each of the marks.

16. Furthermore, to distinguish the subject application from the three cited cases referred to by Ms. Sit, I should point out at the outset that those cases dealt with word marks and not promotional statements. The *Botani* case concerned the application for registration of a single word mark **Botáni** where an earlier word mark “BotaniZen” was cited. In that case, despite the applicant’s argument that the first character of the applied-for mark is a Greek letter “β” and an accent above the letter “a”, the Registrar considered that these subtle differences would unlikely be noticed by the relevant consumers who normally perceive a mark as a whole. Hence, the overall impression cast by the applied-for mark remained to be the word “Botani”, which was identical to the frontal part of the cited mark “BotaniZen”. Likewise, the marks in the other two cited cases were word marks (i.e. between “MUNDICOR” and “MUNDICOLOR” and between “FLEXI AIR” and “FLEX”) and not promotional statements. As decisions by the Registrar should be considered on a case by case basis, the cited cases are unable to advance the applicant’s case.
17. In the Applicant’s Submissions, it was mentioned that a finding of a likelihood of confusion cannot be based on elements (i.e. “THE WORLD OF WORK”) which were descriptive or devoid of distinctive character (para. 16). However, although it is settled case-law that, as a general rule, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by the mark, the weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in

particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them (*Inex SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Wiseman – Representation of a cowhide)* (Case T-153/03), para. 32). As explained above, given the common noun phrase “THE WORLD OF WORK” takes up four of the five words in each of the marks, and that the verbs “POWERING” and “SHAPING” are used to describe the noun phrase “THE WORLD OF WORK”, such noun phrase stands out to be the dominant element of each of the marks and would make an impression on the consumers and be remembered by them.

18. Visually, the overlap in the dominant and distinctive element “THE WORLD OF WORK” has a significant impact on the visual perception of the marks. The additional verbs in each of the marks (i.e. “POWERING” and “SHAPING”), while not being negligible, cannot counteract the overall visual similarity resulting from the overlap in the noun phrase “THE WORLD OF WORK”. As such, the marks coincide with regard to the common noun phrase “THE WORLD OF WORK” and are visually similar.
19. Phonetically, as the subject mark and the cited mark share the same noun phrase “THE WORLD OF WORK”, and to that extent, the marks are aurally identical. Although there are also the words “POWERING” and “SHAPING”, while not being totally discarded, the common noun phrase “THE WORLD OF WORK” occupies four of the five words in each of the marks and the subject mark is therefore considered to be aurally similar to the cited mark.
20. Conceptually, both marks end with the common noun phrase “THE WORLD OF WORK” and differ in their transitive verb element (i.e. “POWERING” and “SHAPING”). Although different verbs are used in the subject mark and the cited mark, both marks convey the idea of some changes to be brought to the world of work and I do not consider such differences in meaning significant. Further, applying the principles as discussed, the overall impressions of the subject mark and the cited mark in the mind of the average consumer will be dominated by the noun phrase “THE WORLD OF WORK”; the subject mark and the cited mark therefore share a certain degree of similarity in concept.
21. I have compared the subject mark and the cited mark visually, aurally and

conceptually. Taking into account the overall impressions created by the subject mark and the cited mark and bearing in mind the perception of the average consumer of the applied-for services and the imperfect recollection he/she has of the marks, I consider the similarities outweigh the dissimilarities. I therefore find the subject mark and the cited mark to be similar.

*Comparison of services*

22. In *British Sugar v James Robertson and Sons Ltd* [1996] RPC 281 (at pages 296-7), Mr. Justice Jacob (as he then was) found that the following factors were relevant in considering whether or not there is similarity in the goods and services at issue:

- (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 services;
- (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; and
- (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.

It was also held in the *Canon* case, *supra* (at paragraph 23) that in assessing the similarity of the services in question, all the relevant factors relating to those services themselves should be taken into account. Those factors include, *inter alia*, their nature, end users, method of use as well as whether they are in competition with or are complementary to each other.

23. Also, it is stated in *Merix v OHIM* (T-133/05) that goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark, or vice versa (at

paragraph 29).

24. The services covered by the cited mark (“the cited services”) include various recruitment services including but not limited to recruitment, employment, selection, outplacement of and consultancy, career counselling and advisory services relating to personnel, and various advisory and administrative services relating to staff matters, choice of profession and business services which are also provided via telecommunication in Class 35. It is considered that the above services are broad enough to cover the applied-for services. Both services are offered in the form of a recruitment business; they target the same users and are competitive services. In fact, the applicant conceded at both the examination stage and during the hearing that the applied-for services overlap, or are identical/similar to the cited services. I therefore conclude that the applied-for services are identical to the services as protected by the cited mark.

*Likelihood of confusion*

25. Under section 12(3) of the Ordinance, likelihood of confusion refers to confusion on the part of the public as to the trade origin of the services in question. This is a matter of global appreciation taking into account all relevant factors and judging through the eyes of the average consumer of the services at issue.
26. At the hearing, Ms. Sit submitted that the relevant consumers would spend considerable time when searching for the right job or candidate and hence the level of attention of such consumers is likely to be high. As such, she contended that the relevant consumers would be able to differentiate the subject mark and the cited mark as having two distinct trade origins. By applying the global appreciation test, it was Ms. Sit’s submission that there is no likelihood of confusion.
27. I disagree. As mentioned in paragraph 13 above, the average consumer consists of members of the general public who are looking for jobs and employers who are looking for employees. Whilst their level of attention should be high with regard to job searches, it may be relatively low when it comes to promotional indications, whether it involves average end consumers or a more attentive public made up of specialists or circumspect consumers. Even if I were to

accept that a higher level of care and attention can be expected of the average consumer, in view of the similarity between the subject mark and the cited mark, and the identity of the applied-for services and the cited services, the average consumer is likely to believe that the services provided by the two conflicting marks come from the same or economically-linked undertakings.

28. Therefore, having regard to the visual, aural and conceptual similarities between the subject mark and the cited mark, and the identity of the applied-for services and the cited services, and bearing in mind the principles set out in paragraph 9 above and taking into account all relevant factors, I consider that when the subject mark is used in relation to the applied-for services, the average consumer would be confused into believing that the applied-for services and the cited services come from the same or economically-linked undertakings. In the premises, the registration of the subject mark is objectionable under section 12(3) of the Ordinance.

#### ***Overseas registrations***

29. Ms. Sit pointed out at the hearing the co-existence of the subject mark with the cited mark and/or the stylised version of it in the UK and Singapore. She also urged the Registrar not to turn a blind eye to the trade mark laws of other Commonwealth countries. It should be noted that national trade mark rights are territorially limited and granted independently of each other. The mere fact that a sign is registrable in other countries is not sufficient to establish that it is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). As valid reasons for refusal have been found, I am not persuaded that the subject mark should be accepted merely by following the decisions of other registries, in particular, when I am not aware of the reasons behind the acceptances.

#### ***Other marks on the register***

30. At the hearing, Ms. Sit drew my attention to other registered marks on the register and urged the Registrar to adopt a consistent approach in examination and accept the subject mark for registration. As each case must be considered on its own merits, I do not think that it is appropriate to make direct comparison

between different marks on the register. This issue has been discussed in *British Sugar plc* (supra):

“It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, e.g. MADAME Trade mark ([1996] R.P.C. 541) and the same must be true under the 1994 Act.”

31. As there are valid grounds for refusal in the subject application, I am not convinced that the registration of other marks in Hong Kong is of any assistance to the applicant in overcoming the objection.

### ***Conclusion***

32. I have considered all the oral and written submissions made by the applicant in respect of the subject application. For the reasons stated above, the subject mark is therefore precluded from registration under section 12(3) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.

Karine Lai  
for Registrar of Trade Marks  
11 March 2015