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CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

**Citation: 2017 TMOB 168**

**Date of Decision: 2017-12-13**

**IN THE MATTER OF AN OPPOSITION**

**Randstad Holding N.V.**

**Opponent**

**and**

**Hays plc**

**Applicant**

**1,550,626 for POWERING THE WORLD  
OF WORK**

**Application**

FILE RECORD

[1] On November 3, 2011, Hays plc filed an application to register the trade-mark POWERING THE WORLD OF WORK, based on use in Canada since September 30, 2011, in association with the following services:

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

[2] The application claims a priority filing date of May 3, 2011, pursuant to s. 34 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, based on the applicant's prior filing of a corresponding application in OHIM(EU). A revised application was filed on January 12, 2012 adding use and

registration of the mark in OHIM(EU) as an additional basis for registration, however, the additional basis for registration was subsequently deleted in a further revised application dated October 21, 2013.

[3] The initial application was met with an objection by the Examination Section of the Canadian Intellectual Property Office (“CIPO,” under whose aegis this Board also operates). The Examination Section objected that the applied-for mark POWERING THE WORLD OF WORK was not registrable, pursuant to s.12(1)(d) of the *Trade-marks Act*, because it was confusing with the registered mark SHAPING THE WORLD OF WORK covering similar services. The applicant provided a lengthy submission to the Examination Section explaining why it did not consider the marks in issue to be confusing, which submission was successful in overcoming the objection.

[4] The subject application for POWERING THE WORLD OF WORK was then advertised for opposition purposes in the *Trade-marks Journal* issue dated April 3, 2013, and opposed shortly thereafter on June 11, 2013, by Randstad Holding N.V., the owner of the registered mark SHAPING THE WORLD OF WORK cited by the Examination Section.

[5] The Registrar forwarded a copy of the statement of opposition to the applicant on June 21, 2013, as required by s.38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[6] The opponent’s evidence consists of the affidavits of Spiro Papanicolaou and Jonathan Solomon. Both were cross-examined on their written testimony. The transcripts of their cross-examinations and answers to outstanding questions form part of the evidence of record.

[7] The applicant’s evidence consists of the affidavits of Thea Watson and Joanne Berent. Ms. Berent was cross-examined on her written testimony. The transcript of her cross-examination and answers to outstanding questions form part of the evidence of record. The applicant requested, and was granted, leave to file a second affidavit of Joanne Berent as additional evidence pursuant to Rule 44 of the *Trade-marks Regulations*. The opponent’s reply evidence consists of the affidavit of Jo-Anne McConnery.

[8] Both parties submitted a written argument and both were ably represented by counsel at an oral hearing.

#### STATEMENT OF OPPOSITION

[9] The first ground of opposition alleges that the subject application does not comply with s.30(b) of the *Trade-marks Act* because the applicant had not used the applied-for mark POWERING THE WORLD OF WORK since the date of first use claimed in the application namely, September 30, 2011.

[10] The second and fifth grounds challenge the applicant's reliance on its use and registration of the applied-for mark in the OHIM(EU) as a basis for registration in Canada. As that basis for registration was deleted by the applicant (see para. 2 above), the second and fifth grounds are moot.

[11] The remaining grounds of opposition turn on the issue of confusion between the applied-for mark POWERING THE WORLD OF WORK and the opponent's mark SHAPING THE WORLD OF WORK. The material dates to assess the issue of confusion are the date of my decision in respect of the third ground of opposition pursuant to s.12(1)(d); the date of first use claimed by the applicant (September 30, 2011) in respect of the fourth ground pursuant to s.16(1)(a); and the date of opposition (June 11, 2013) in respect of the sixth (and final) ground pursuant to s.2.

[12] I will address the grounds of opposition after summarizing the evidence of record, below.

#### OPPONENT'S EVIDENCE

##### *Spiro Papanicolaou - affidavit evidence*

[13] Mr. Papanicolaou identifies himself as an employee of Randstad Interim Inc. ("Randstad Canada") since 2006; in 2012 he was promoted to Marketing Director. His evidence may be summarized as follows.

[14] The opponent Randstad Holdings was founded in 1960 and is headquartered in the Netherlands. It is the second largest staffing organization in the world. It provides temporary and permanent staffing services for administrative and professional positions, as well as business management consulting and human resources consulting. The opponent has more than 4,000 branches and has subsidiary companies in 40 countries including Canada and the United States. Randstad Canada is a wholly owned subsidiary of the opponent Randstad and has over 85 offices across seven provinces in Canada.

[15] Randstad Canada, on behalf of the opponent, provides staffing recruitment and human resource services to Canadian companies and job seekers. The opponent has direct or indirect control over the character and quality of the services provided in association with the mark SHAPING THE WORLD OF WORK, as discussed in paras. 25-26 of Mr. Papanicolaou's affidavit:

25. On at least a yearly basis, marketing managers from Randstad Holding visits[sic] Canada to ensure that Randstad Canada's branding efforts conform to Randstad Holding's requirements. As part of their review of Randstad Canada's branding and the services performed in association there with[sic], the representatives of Randstad Holding meet with not only members of the Canadian marketing team but also with our management team and recruiters.

26. On a regular basis, members of Randstad Holding management team visit offices of Randstad Canada. One of the purposes of these visits includes ensuring that management and sales principles of Randstad Holding are being properly observed and that the services being provided by Randstad Canada meet the standards as determined by Randstad Holding. During such visits, marketing collateral is reviewed by management from Randstad Holding. They would also meet with key clients to discuss our services and would meet with various members of Randstad Canada for quality assurance purposes.

[16] The applicant is a direct competitor of Randstad Canada in Canada.

[17] The opponent's revenues generated from providing services in North America (that is, Canada, the U.S. and Mexico combined: see para. 22 below) amounted to \$2.8 billion CAD in 2010, rising to \$6 billion CAD in 2012.

[18] Randstad Canada first began using the mark SHAPING THE WORLD OF WORK in 2009. In this regard, Mr. Papanicolaou's knowledge of use of the mark is limited to Randstad Canada's recruitment division. The mark was placed on the back of business cards of the company's professional recruiters; between 150,000 to 200,000 cards were distributed to 300-400 recruiters. Clients, potential clients and job candidates are usually provided with the business card. From 2010 to 2013 recruiters were re-supplied with the same business card. Other means of promoting the opponent's services under the mark SHAPING THE WORLD OF WORK include displaying the mark on Randstad Canada's website and on sales brochures left with clients or potential clients and also displayed at trade shows. In mid-2012 Randstad Canada began to forward promotional emails displaying its mark to every contact, client, job seeker, candidate and prospective client, as shown below (reproduced from Exhibit G), wherein the mark SHAPING THE WORLD OF WORK appears diminutively following the more prominent mark RANDSTAD, with the French language equivalent appearing directly underneath.



*Spiro Papanicolaou - testimony at cross-examination*

[19] At cross-examination counsel for the applicant elicited further information on the extent of the promotional activities discussed by Mr. Papanicolaou in his affidavit. With respect to the business cards, Randstad Canada's recruiters would generally require 500 cards annually. The cards continued to be in use as of the date of Mr. Papanicolaou's cross-examination (on July 18, 2014). With respect to displaying the mark SHAPING THE WORLD OF WORK on Randstad Canada's website, such display ceased in about mid-2012 when it was replaced with the phrase "Canada's Leader for Staffing, Recruitment and HR Services."

[20] The information elicited at cross-examination concerning the above mentioned promotional brochures is fairly summarized at paras. 29-31 of the applicant's written argument:

29. . . . the Opponent's evidence makes reference to a single sales brochure dating from 2010. A single page from that brochure was appended to the Papanicolaou Affidavit where the phrase "shaping the world of work" appears merely as a sub-heading for a paragraph of text on that page, not accompanied by any indication that the phrase is being used as a trade-mark: *Papanicolaou Affidavit at para 33 and Exhibit F*.

30. A full copy of that brochure was requested on cross-examination and subsequently produced. The full brochure has 16 pages, and "shaping the world of work" appears just once as a sub-heading for text on the eleventh page: *Papanicolaou Undertakings at Q283 and Attachment C*.

31. . . . It was also clarified that any such brochures that may have been distributed would only have been distributed "at least until June 2011": *Papanicolaou Undertakings at Q288*.

[21] With respect to the promotional email featuring the mark referred to in para. 18 above, such a promotional email event occurred only once.

[22] In view of the evidence elicited at cross-examination, I agree with the applicant's submissions at paras. 28, 36 and 37 of its written argument concerning Randstad Canada's use of the mark SHAPING THE WORLD OF WORK:

28. . . . Randstad Canada's activities in association with "SHAPING THE WORLD OF WORK" have been limited in scope and duration. "SHAPING THE WORLD OF WORK" appears to have been primarily featured on the back side of business cards printed for Randstad Canada's 300-400 individuals employed as professional recruiters . . . : *Papanicolaou Affidavit at paras 15-19*.

. . . . .

36. Apart from limited specimens of purported use of "SHAPING THE WORLD OF WORK" prior to 2013, the Opponent has not in any other way evidenced the extent of purported use in terms of sales revenues and volumes or promotional expenditures associated with the mark.

37. Instead, the Opponent has merely provided information about "total revenues generated from services provided in North America" during the years 2010-2012. On cross-examination, Mr. Papanicolaou explained that references to North America in his affidavit included activities in Canada, the United States, and Mexico, and admitted that it would be impossible to determine which portion of those sales revenues related to Canada specifically: *Papanicolaou Affidavit at para 11; Papanicolaou Cross-examination at Q72-80*.

[23] Accordingly, I find that the opponent has not established that its mark SHAPING THE WORLD OF WORK has, at any material time, acquired anything more than a limited degree of distinctiveness in Canada. This finding will later be incorporated into the analysis of the issue of confusion raised in the statement of opposition: see para. 11 above.

[24] At cross-examination, counsel for the applicant requested a copy of the license agreement between Randstad Canada and the opponent. That request was taken under advisement and subsequently answered with the statement that “A copy of the license agreement is not available.” Counsel for the applicant therefore submitted that I should draw a negative inference and find that there is no written license agreement or that any license agreement that does exist does not satisfy the requirements of s.50 of the *Trade-marks Act*. Counsel submits that in either case any use of the mark SHAPING THE WORLD OF WORK by Randstad Canada does not accrue to the benefit of the opponent.

[25] In my view counsel for the applicant is overreaching. Mr. Papanicolaou never asserted, nor was it established by questioning at cross-examination, that the license agreement referred to by Mr. Papanicolaou in his affidavit was in fact contained in a written document. At cross-examination no questions were put to Mr. Papanicolaou concerning the nature of the license agreement nor the terms of the license. In these circumstances, and taking into account the close relationship between a parent and a subsidiary, I find that Mr. Papanicolaou’s evidence at paras. 25-26 of his affidavit (see para. 15 above) suffices to establish a license agreement meeting the requirements of s.50(1) of the *Trade-marks Act*. Consequently, I find that use of the mark SHAPING THE WORLD OF WORK by Randstad Canada accrues to the benefit of the opponent.

*Jonathan Solomon*

[26] Mr. Solomon identifies himself as a “contract legal counsel” employed by the agents for the opponent. He conducted various computer searches the results of which are attached as exhibits to his affidavit, described below:

- Exhibit 1 is a copy of the full particulars of the opponent's registered mark SHAPING THE WORLD OF WORK relied on by the opponent to support the ground of opposition pursuant to s.12(1)(d).
- Exhibits 2-5 relate to searches done on the Trade-marks Register data base maintained by CIPO. The searches establish that the opponent's mark and the applied-for mark POWERING THE WORLD OF WORK are the only marks on the Register that contain the phrase "the world of work." They are also the only marks containing "world" and "work" for use in association with recruitment services.
- Exhibit 6 is a screenshot of the applicant's website. I note that the phrase appearing prominently at the top left of the screenshot is POWERING THE WORLD OF WORK WITH OUR EXPERTISE.
- Exhibit 7 presents information relating to the Internet Archive website known as the Wayback Machine.
- Exhibit 8 consists of printouts of archived webpages from the Wayback Machine relating to the opponent's website.
- Exhibits 9-13 consist of printouts of archived webpages from the Wayback Machine relating to the applicant's website.

[27] Mr. Solomon's testimony at cross-examination provides a review of the methodology of his searches.



APPLICANT'S EVIDENCE

*Thea Watson – affidavit evidence*

[28] Ms. Watson identifies herself as the Marketing Director of Hays Canada, a wholly owned subsidiary of the applicant. Her evidence may be summarized as follows.

[29] The applicant is a world-wide leader in the recruitment and placement of skilled workers and the provision of related human resources services. The applicant employs over 8,200 employees in over 230 offices across 33 countries world-wide. The applicant has focused exclusively in the recruitment business since November 2004; prior to November 2004 the applicant engaged in a number of diversified businesses.

[30] Hays Canada was established in 2001. As of February 2015 Hays Canada had offices in major cities across Canada. The phrase “the world of work” has been used for many years prior to 2011 both in the recruitment industry and in common parlance. Exhibits F-G of her affidavit show examples of use of the phrase “the world of work,” in a descriptive sense, by Canadian competitors.

[31] Hays Canada’s use of the mark POWERING THE WORLD OF WORK is discussed at paras. 24-25 and 29-30 of Ms. Watson’s affidavit:

24. I confirm that since at least as early as September 30, 2011, the POWERING THE WORLD OF WORK trade-mark has been continuously and extensively used by Hays plc and/or Hays Canada in association with each of the Services.

25. I further confirm that at all times in Canada, Hays Canada’s use of all trade-marks owned by Hays plc has been under licence from Hays plc, under which licence Hays plc has always maintained direct or indirect control over the character and quality of the associated goods and services produced, sold or performed by Hays Canada. This includes our use of the POWERING THE WORLD OF WORK trade-mark for the Services that are described in the trade-mark application that is the subject of this proceeding.

.....

29. As noted above, we have been offering our Services in Canada since at least as early as September 30, 2011 in association with the POWERING THE WORLD OF WORK trade-mark. While our exact Canadian revenue figures are confidential, I confirm that our Canadian revenues have been in excess of \$20 million (CDN) in each year from 2011- 2014.

30. I also confirm that, collectively, the above-noted Canadian sales revenues are derived from the sale or performance of all of the various Services which we provide in Canada.

[32] The applicant's mark has appeared on printed materials provided to Canadian clients and featured on the applicant's website [www.hays.ca](http://www.hays.ca). Its website averaged about 80,000 visits per month between 2011 and 2012, and has averaged about 150,000 visits per month beginning in 2013. Since 2010 the applicant has spent in excess of \$1 million CDN annually on promotion and advertising featuring its mark POWERING THE WORLD OF WORK at conferences, seminars, online advertising and in various types of printed publications. Examples of advertising and promotion featuring the applicant's mark are shown in Exhibits J-S.

[33] The nature of Hays Canada's business is discussed in paras. 39-42 of Ms. Watson's affidavit:

39. Hays Canada provides its various Services both to employers (those looking to hire or recruit individuals) and employees (individuals seeking employment).

40. The target client market for Hays Canada's Services for employers are generally human resources professionals, line managers, and executives of small, medium, and large-sized companies and institutions who are seeking to recruit workers into temporary, contract or permanent positions with their organizations, . . . or who need assistance or consulting services on other issues concerning personnel and employees

41. Such persons and organizations tend to be sophisticated and approach the decision of whether or not to purchase our Services with considerable care and diligence, given the financial and institutional commitment and investment often required when recruiting new employees. Moreover, many of our institutional employer clients are either longstanding clients of Hays Canada and/or Hays or have made use of our Services in significant volume.

42. For example, some of Hays Canada's employer-side clients include KPMG (a major, global accounting firm), Vale (a major, global mining company), Morton Salt (a \$1.7 billion company and the leading North American producer of salt for consumer and industrial uses), Carleton University (a major Canadian university in Ottawa, Ontario), West Fraser (the largest lumber producer in North America), CIBC (a major Canadian bank), Scotiabank (a major Canadian bank), and FedEx (a global courier company), among many others.

[34] Ms. Watson is not aware of any instances of actual confusion between the marks in issue, as discussed at paras. 48-49 of her affidavit:

47. I am not personally aware of a single example of consumer confusion in Canada between Hays' Services offered and sold in association with the POWERING THE WORLD OF WORK trade-mark and any services that may be offered or sold by Randstad Holding N.V. in association with "SHAPING THE WORLD OF WORK".

48. Further, to satisfy myself that Hays Canada has no knowledge of any such confusion, I have co-ordinated a review of inquiries received from clients and prospective clients in a Canada, including through Hays Dashboard, which is the online customer service portal used by Hays. There are no records in the Hays Dashboard of any inquiry made to Hays Canada by a Canadian inquiring about any services provided in association with the mark "SHAPING THE WORLD OF WORK" or demonstrating confusion about services from Randstad Holding N.V.

*Thea Watson – testimony at cross-examination*

[35] Ms. Watson clarified at cross-examination that the opponent is a "generalist" recruitment firm, working in all areas of staffing from junior positions to more senior positions, while the applicant specializes in recruiting skilled and professional employees. There is overlap in the fields that both companies operate in. The opponent is a competitor of the applicant but not its biggest competitor because the applicant specializes in its areas of recruitment and the opponent does not specialize.

[36] Ms. Watson was asked to explain the meaning of the phrase "world of work." Her answer (at Q 175 of the transcript of cross-examination) is shown below:

It's a very common phrase. It can have a lot of meanings. "THE WORLD OF WORK" is a big phrase that talks about careers, advancement, HR, hiring practices, recruitment, retention. It's a very, very big term.

[37] Responses to questions concerning how the applied-for mark would be perceived are found at Q 179-184 of the transcript of cross-examination:

- 179 Q. Okay, and would people that you know also understand what “POWERING THE WORLD OF WORK” means?  
A. Yes.
- 180 Q. So what does that mean? What does “POWERING THE WORLD OF WORK” mean?  
A. In our context, “POWERING THE WORLD OF WORK” is how we fuel businesses with people, helping them achieve their work goals.
- 181 Q. So would, you know, the average person understand what that means?  
A. If they're not a target audience of ours, maybe, maybe not. Our target audiences, I would hope they would understand.
- 182 Q. So in terms of your general target market, you would think that they would understand what “POWERING THE WORLD OF WORK” means?  
A. I do believe so.
- 183 Q. Okay. So in terms of your customers, can you describe to me what type of customers you guys have in general?  
A. In general we have client customers and candidate customers.
- 184 Q. And so the clients are the potential employers?  
A. Yes.

[38] In my view, based on the entirety of the evidence presented by both parties concerning the meaning of the phrase THE WORLD OF WORK, Ms. Watson’s answers are entirely accurate. The phrase may therefore be said to be descriptive, but it is also all encompassing and amorphous. Ordinarily descriptive phrases possess low degrees of inherent distinctiveness. However, because the meaning of THE WORLD OF WORK is rather imprecise, I have concluded that it possesses a degree of inherent distinctiveness at least somewhat greater than what would ordinarily be accorded to a descriptive phrase (although still low on the spectrum).

*Joanne Berent*

[39] Ms. Berent identifies herself as a Reference Librarian employed by the agents for the applicant. She conducted computer data base searches to obtain Canadian news and media articles, from 2001 to 2015, containing the phrase “the world of work.” The results of her

searches are attached as exhibits to her affidavit. I agree with the applicant's submissions in its written argument that Ms. Berent's evidence establishes that the phrase "the world of work" is a common, descriptive phrase appearing in Canadian publications.

[40] Ms. Berent's supplementary affidavit serves to introduce into evidence, by way of an exhibit, a copy of a decision (dated April 15, 2015) of the Assistant Commissioner of Trade-marks for New Zealand (the "NZ decision"). The NZ decision concerned an opposition proceeding, between the parties herein, analogous to the instant opposition.

[41] One of the grounds of opposition was that use of the mark POWERING THE WORLD OF WORK was "likely to deceive or confuse." The New Zealand test for "likely to deceive or confuse" is essentially equivalent to the Canadian test for confusion. The NZ decision rejected all the grounds of opposition.

[42] Of course foreign decisions are not binding on this Board, but that does not mean that they cannot be persuasive: see *Neutrogena Corp. v. Guaber SRL* (1993), 49 CPR (3d) 282 (TMOB); *Origins Natural Resources v. Warnaco U.S.* (2000), 9 CPR (4th) 540 (TMOB) at 548.

[43] However, in the instant case, the NZ decision has little persuasive value on the issue of confusion. In this regard, the Assistant Commissioner concluded that there was no "awareness, cognizance or knowledge, in the relevant market, of the mark SHAPING THE WORLD OF WORK" and therefore the opponent did not meet its initial evidentiary threshold to put the allegation of "likely to deceive or confuse" into issue: see paras. 64 and 67 of the NZ decision.

[44] I note in passing the Assistant Commissioner's findings concerning the inherent distinctiveness of the parties' marks, at paras. 50-52:

50. In my view, both marks have low levels of distinctiveness. The fact that they were accepted for registration suggests that they are not wholly lacking in distinctive character, but they are both at the lower end of the spectrum.

51. "THE WORLD OF WORK" element that appears in both marks is very descriptive, and the evidence establishes that the phrase is common to the trade. Prior to the relevant date, it was used in a descriptive sense by many traders and organisations[sic]. It is also a phrase in common parlance.

52. I accept that the first elements of the marks (POWERING/SHAPING) are visually and aurally dissimilar. There is some similarity between their respective meanings, although this is limited.

#### OPPONENT'S REPLY EVIDENCE

*Jo-Anne McConnery*

[45] Ms. McConnery identifies herself as a legal assistant with the firm representing the opponent. She visited the website of a third party recruitment firm operating in Canada and obtained several examples of the third party using the phrase “powering the world of work” in a descriptive sense, between 2013 and 2016.

#### CONSIDERATION OF THE GROUNDS OF OPPOSITION

*First Ground: non-compliance with s.30(b)*

[46] The first ground of opposition alleges that the applicant has not used the applied-for mark POWERING THE WORLD OF WORK since the date of first use claimed in the application namely, September 30, 2011. Counsel for the opponent argued that the only evidence submitted by the applicant concerning use of its mark POWERING THE WORLD OF WORK by the material date September 30, 2011 was a single printout from Hays Canada's website, as retrieved from the Wayback Machine, for the date September 23, 2011, which evidence counsel characterized as having admissibility issues. In this regard I would first note that Wayback Machine evidence is admissible: see *Candrug Health Solutions Inc. v. Thorkelson* (2007) 60 CPR(4th) 35 at para. 20 (FC).

[47] I agree with counsel for the opponent that there is no single document in the applicant's exhibit materials that conclusively establishes that the date of first use of the applied-for mark is as early as September 30, 2011. I also agree with counsel that the applicant might have been expected to provide more comprehensive documentation regarding the date of first use of the applied-for mark, as well as more comprehensive documentation regarding the licence agreement between the applicant and its Canadian subsidiary. However, considering all the exhibit materials relating to the date of first use, and equally importantly, considering that the cross-examination

of Ms. Watson failed to make any inroads on her affidavit testimony, I find that the applicant has met the legal onus on it to show, on a balance of probabilities, that the date of first use of the applied-for mark was in fact as early as September 30, 2011. In so finding I have followed the guidance in *Corporativo de Marcas GJB v. Bacardi*, 2014 FC 323 at para. 37 (CanLII) that all of the pertinent evidence is to be assessed taking into consideration:

. . . its provenance (including its quality and reliability), the absence of evidence that might reasonably be expected to exist, and whether it has been tested on cross-examination and if so, how it fared. Multiple diverse considerations inform the assessment of evidence.

[48] I would also echo the sentiment expressed at the oral hearing by counsel for the applicant who noted that while the applicant's evidence in respect of the date of first use of its mark, and its evidence concerning its licensing arrangement with its Canadian subsidiary, might have been more complete, nevertheless, the applicant's evidence on these issues was at least as comprehensive and informative as the evidence put forward by the opponent concerning the opponent's use of its mark and the opponent's licensing arrangement with its Canadian subsidiary.

*Remaining Grounds: registrability pursuant to s.12(1)(d); entitlement to registration pursuant to s.16(3)(a); and distinctiveness pursuant to s.2*

[49] As discussed in paras. 10-11 above, the remaining grounds of opposition turn on the issue of confusion between the applied-for mark POWERING THE WORLD OF WORK and the opponent's mark SHAPING THE WORLD OF WORK. The issue is whether client customers or candidate customers (see para. 37 above at Q 183) of the applicant's recruitment services, provided under the mark POWERING THE WORLD OF WORK, would believe that those services were offered or authorized or licensed by the opponent, who provides similar services under the mark SHAPING THE WORLD OF WORK.

[50] The legal onus is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion between the marks in issue.

### *Test for Confusion and Factors for Assessing Confusion*

[51] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[52] Before I discuss the above factors, an overview of the considerations that come into play, at least from the applicant’s perspective, is summarized at paras. 4-8 of the applicant’s written argument:

4. . . . the mere fact that the parties’ marks share the element “the world of work” is of very limited significance. “The world of work” is a commonly used, descriptive phrase in the recruitment and human resources industry and in common parlance to describe the labour market and the notional place where people find employment.

5. Because the phrase “the world of work” is common, descriptive, and non-distinctive, consumers will look to other elements of the parties’ marks to distinguish them. In this case, the differing first elements of each party’s mark (POWERING vs. SHAPING) bear little resemblance to each other and so serve to distinguish the parties’ marks as a whole.

6. Nor has the Opponent’s mark acquired any distinctiveness in “SHAPING THE WORLD OF WORK” to enhance the limited ambit of protection to which it is entitled. There is no evidence in the record that shows that “SHAPING THE WORLD OF WORK” is known to any significant extent as a trade-mark of the Opponent . . .



7. The nature of the parties' respective services and the manner in which they are provided also militates strongly against any likelihood of confusion. The parties' services are not ordinary retail or consumer services. Rather, both parties' services are of the type that are only purchased by sophisticated clients with care and consideration, given their relative cost and importance, and typically only after meetings, consultation, and the negotiation and execution of written contracts for services. Further, in actual use, both parties have exclusively featured their respective trade-marks as "secondary" marks or slogans in association with distinctive and distinguishing "primary" brands or "house marks" (HAYS and RANDSTAD, respectively).

8. As a result, it is not surprising at all that the Opponent has been unable to put forward any evidence of actual confusion between the parties' trade-marks, despite a number of years of purported contemporaneous use in Canada . . .

*First and Second Factors: inherent and acquired distinctiveness; length of time in use*

[53] The applied-for mark POWERING THE WORLD OF WORK possesses a fairly low degree of inherent distinctiveness. In this regard, the first portion of the mark is the term "powering" which is a commonly used dictionary word and therefore has a low degree of inherent distinctiveness. The second portion of the mark is the term "the world of work" which is a commonly used descriptive term in the recruitment industry and therefore possesses a fairly low degree of inherent distinctiveness (see para. 37 above). In the instant case combining two terms of low inherent distinctiveness does not result in any type of juxtaposition which acts to increase the inherent distinctiveness of the mark as a whole. Similarly, the opponent's mark SHAPING THE WORLD OF WORK possesses a fairly low degree of inherent distinctiveness. I agree with the applicant's submission, at quoted para. 6 above (see para.52), that the opponent's mark has not acquired any significant reputation in Canada at any material time. The applied-for mark had acquired some reputation as of the later material dates (June 11, 2013 and today's date), but not as of the earliest material date (September 30, 2011): see para. 11 above. The first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, therefore favours neither party at the earliest material date but favours the opponent, to some extent, at the later material dates.

[54] The opponent began to use its mark SHAPING THE WORLD OF WORK in 2009 while the applicant began to use its mark POWERING THE WORLD OF WORK in September 2011.

The length of time that the marks have been in use therefore favours the opponent, but not to a significant extent.

*Third and Fourth Factors: the nature of the services or business; the nature of the trade*

[55] Both parties are involved in the recruitment industry, that is, finding suitable employers for job-seekers and finding suitable workers for employers. As noted earlier, the applicant specializes in certain types of occupations while the opponent does not specialize. Thus, the parties' services overlap. The third and fourth factors therefore favour the opponent.

*Fifth Factor: degree of resemblance*

[56] There is necessarily a significant degree of resemblance between the marks in issue as the latter portion of each mark consists of the phrase THE WORLD OF WORK. However, ordinarily it is first portion of a mark that is the more important for the purposes of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 46 CPR(2d) 183 at 188 (FCTD). The first portions of the parties' marks, that is, the terms SHAPING and POWERING, are different in appearance, in sounding and in ideas suggested. Considering the parties' marks in their entireties, I find that they are more different than alike owing to their different first portions. The fifth factor therefore favours the applicant.

*Other Surrounding Circumstances*

[57] I agree with the applicant that two further surrounding circumstances favour, at least to some extent, a finding of no confusion. The first is that there is no evidence of actual confusion between the parties' marks despite contemporaneous use in Canada; the second is that both parties have most often used the marks in issue as secondary marks together with their primary marks HAYS (for the applicant) and RANDSTAD (for the opponent).

*Jurisprudence concerning Weak Marks*

[58] As noted by Rand J. in *General Motors Corp. v. Bellows* (1949), 10 CPR 101 at pp. 115-6 (SCC), a weak trade-mark (i.e., a mark of low inherent distinctiveness) is not entitled to a wide ambit of protection:

. . . where a party has reached inside the common trade vocabulary for a word mark and seeks to prevent competitors from doing the same thing, the range of protection to be given him should be more limited than in the case of an invented or unique or non-descriptive word . . . In *Office Cleaning Services*, 63 RPC at p. 43, Lord Simonds used this language: “It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolize the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.” (emphasis added)

[59] Further, as noted in *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 CPR(2d) 154 at 169 (FCTD), “. . . there is ample judicial authority for the proposition that in the case of ‘weak’ marks, small differences may be accepted to distinguish one from the other and a greater degree of discrimination may be fairly expected of the public.”

DISPOSITION

[60] Having regard to the five factors discussed above, to the other surrounding circumstances, and to the jurisprudence regarding weak marks, I find that, at all material times, the parties’ marks POWERING THE WORLD OF WORK and SHAPING THE WORLD OF WORK are not confusing. The remaining grounds of opposition are rejected and therefore the opposition is rejected.

[61] This decision has been made pursuant to a delegation of authority by the Registrar of

Trade-marks under s.63(3) of the *Trade-marks Act*.

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Myer Herzig, Member,  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE: 2017-10-30**

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