BL O/0300/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION

NO. WO0000001749264

IN THE NAME OF LEGALON TECHNOLOGIES, INC.

legalontech

IN CLASSES 9,35,42 AND 45

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF UNDER NO. CA000507319

BY

LEGALTECH APS

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY LEGALTECH APS

AGAINST A DECISION OF ANDREA ROSSI (O/0919/25)

DATED 30 SEPTEMBER 2025

DECISION

Introduction

1. This is an appeal from a decision of Andrea Rossi acting for the Registrar dated 30 September 2025 (**"the Decision"**) in relation to invalidity proceedings brought by LEGALTECH ApS (**"the Appellant"**) regarding International trade mark 1749264 (**"the Respondent's Mark"**).

2. The application to have the Respondent's Mark declared invalid was brought under s.47 of the Trade Marks Act 1994 ("**the Act**"), based on ss.5(2)(b), 3(1)(b) and 3(1)(c) of the Act. For the ground under s.5(2)(b) the Appellant relied upon the following earlier mark (**"the Earlier Mark"**):

   LEGALTECH

   UK trade mark no. UK00003721710

   relying on all of the services for which the mark was registered under classes 35, 36 and 41.

3. The Hearing Officer found that the application for a declaration of invalidity under s.3(1)(b) and s.3(1)(c) was unsuccessful, and the Appellant does not appeal those parts of the Decision.

4. With respect to the ground under s.5(2)(b), the Hearing Officer found the application for a declaration of invalidity failed in respect of certain goods and services under classes 9, 35, 42 and 45 on the basis that they were dissimilar to the Appellant's services under the Earlier Mark. The Hearing Officer found the similarity of the remaining goods and services of the Respondent's Mark to range from low to identical to the services covered by the Earlier Mark. In respect of those goods and services, the Hearing Officer concluded that there was a likelihood of direct and indirect confusion, so that the application for a declaration of invalidity under s.5(2)(b) succeeded in respect of those goods and services of the Respondent's Mark.

The Appeal

5. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. Neither party requested a hearing, so I have reached my decision from careful consideration of the papers.

Standard of Review

6. It is well established that, in order to interfere with the decision of the Hearing Officer, I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be *"wrong"* if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was *"outside the bounds within which reasonable disagreement is possible"* (*Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

7. In the judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, Arnold LJ said at [110]:

> *"It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2](v) (Lewison LJ)."

8. The Supreme Court recently restated the approach to appeals of this kind in its judgment in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25 at [94] to [95] as follows:

> *"94. It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially*

trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions. While of course the decision of an appellate court trumps that of the court below, the law has imposed structured constraints designed to prevent a free for all in a higher court whenever a party (with the necessary resources) wishes to challenge the first instance decision of the trial judge. The reasons for these constraints are set out in a string of well-known authorities including, in the intellectual property context, Fage UK Ltd v Chobani UK Ltd [2014] EWCA Civ 5; [2014] FSR 29, per Lewison LJ at para 114. The reasons there set out relevantly include the following:

> *(i) The trial is not a dress rehearsal. It is the first and last night of the show.*
>
> *(ii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court.*
>
> *(iii) In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.*

95. In Lifestyle Equities CV v Amazon UK Services Ltd [2024] UKSC 8; [2024] Bus LR 532 this court reviewed those constraints in a trade mark context. After citing from the Fage case this court in a joint judgment said, at paras 49- 50:

> *"49. That does not, however, mean the appeal court is powerless to intervene where the judge has fallen into error in arriving at an evaluative decision such as whether an activity was or was not targeted at a particular territory. It may be possible to establish that the judge was plainly wrong or that there has been a significant error of principle; but the circumstances in which an effective challenge may be mounted to an evaluative decision are not limited to such cases. Many of the important authorities in this area were reviewed by the Court of Appeal in In re Sprintroom Ltd [2019] 2 BCLC 617, paras 72–76. There, in a judgment to which all members of the court (McCombe, Leggatt and Rose LJJ) contributed, the court concluded, at para 76, in terms with which we agree, that on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.*
>
> *50. On the other hand, it is equally clear that, for the decision to be 'wrong' under CPR r 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."*

9. I have borne those principles firmly in mind.

Grounds of Appeal

10. The Appellant stated in their Grounds of Appeal that they were only appealing the Hearing Officer's finding that the Class 45 services of the Respondent's Mark were not similar to the Class 35 services of the Earlier Mark, as set out in paragraphs 68-70 of the Decision. The relevant paragraphs from the Decision are set out below:

> *"**Class 45***
>
> *• "Legal consultancy and providing legal information about drafting contracts and other documents relating to rights and obligations and proof of facts; providing information about legal services; legal advice; legal consultation services; arbitration and mediation for resolution services of Internet disputes; Internet legal assistance in alternative dispute resolution; research and analysis of prior literature regarding intellectual property rights; research and analysis relating to lawsuits and other legal issues using database information; legal consultancy and providing legal information related to social insurance claims; investigation or surveillance services for checking background profiles; information services relating to legal services in relation to the negotiation of contracts for others; providing information about legal services relating to licenses; personal background investigations; legal research; legal watching services; providing information relating to legal document preparation services"*
>
> *68. The above services are all essentially legal services. The Applicant contends that the Holder's services in class 45 and the Applicant's "business management" and "business administration" in class 35 have the same nature, providers, relevant public and may be complementary. To this end, the Applicant refers me to a decision from the EUIPO where it was found that "[...] business management or business administration is frequently supplemented by legal service provision. An example given is where a lawyer is trustee for a client business or where a lawyer works as an insolvency practitioner and therefore as a business administrator". The Holder argues that even assuming that the services in class 45 and the Applicant's advertising and business services in class 35 target the same end users, this fact alone is insufficient for a finding of any degree of similarity.*
>
> *69. I acknowledge both parties' submissions. With regard to the Applicant's argument, although I am not bound by previous decisions of the UK IPO or the EUIPO, I took into consideration the Applicant's submission in my assessment and I agree that legal and business management services can be provided together as part of legal advice/services, nonetheless this does not make them similar because whilst the users would be the same, the services themselves and the trade channels are different and they would not be in competition. Nor, to my mind, are the services complementary as one is not indispensable or important for the use of the other, nor would consumers think that the responsibility for these services would lie with the same undertaking. The result is that the services at hand are <u>not similar</u>."*
>
> *• "online social networking services"*
>
> *70. The Holder's social networking services above are aimed at providing an online platform where individuals can build social networks, engage with others*

and share their interests (e.g., Facebook or LinkedIn). With regard to the Applicant's "Entertainment services" in class 41, I find there may be some overlap in nature since social networking platforms may also provide entertainment content and the services at hand may also target the same users. However, the services have different methods of use since entertainment in class 41 is more of a passive activity (e.g., watch a movie, a play or a match) while online social networking requires a more active participation. The services are also neither in competition with each other nor complementary and they do not share the same trade channels. Bearing in mind that specifications for services should not be given a wide construction covering a vast range of activities, and absent any submissions from the parties on this point, overall, I find the services at hand to be dissimilar."

11. However, in fact the Grounds of Appeal were limited to identifying purported errors in paragraphs 68-69 of the Decision, so the Appellant is not entitled to seek to overturn the Hearing Officer's decision under paragraph 70 of the Decision as that was not subject to one of the Grounds of Appeal.

12. The Appellant relied on five grounds of appeal, which I will consider in turn.

Ground 1: Insufficiently granular comparison; failure to assess against the closest class 35 services

13. The Appellant criticised the Hearing Officer for treating all of the class 45 entries (not including *"online social networking services"* which were considered separately in paragraph 70) as *"homogenous "legal services""* and comparing them only to "*business management/administration"*. By doing so, the Appellant argued that the Hearing Officer overlooked the similarity between the closest pairs of services, giving as an example a comparison between *"providing information relating to legal document preparation services"* in class 45 of the Respondent's Mark with "*Document preparation"* in Class 35 of the Earlier Mark. As the Appellant relied on the same example under Ground 2, I discuss it further below.

14. **Ground 2: Misapplication relating to specific services**

Using the same comparison between *'providing information relating to legal document preparation services'* in class 45 of the Respondent's Mark and *'Document preparation'* in Class 35 of the Earlier Mark, the Appellant submitted that the Hearing Officer overlooked the intended purpose and actual market reality. The Appellant submitted that both of those services share a common purpose, namely the production of enforceable business documents, are often supplied by the same professional providers and are at least alternatives, and therefore in competition, or functionally complementary.

15. The Hearing Officer set out in paragraphs 30 to 40 of the Decision the applicable law relating to the relevant factors to be taken into account when comparing goods and services, and the Appellant made no criticism of these paragraphs.

16. The Hearing Officer agreed that legal and business management services can be provided together as part of legal advice or legal services, and that the users would be the same. However, he concluded that that did not mean that they were similar services because (1) the services themselves were different, (2) the trade channels were different, (3) they would not be in competition and (4) nor were they complementary, as one was not indispensable or important for the use of the other, and consumers would not think that the responsibility for these services would lie with the same undertaking.

17. I am conscious that Hearing Officers are entitled to express their reasoning in *"highly compressed form"*, as Arnold LJ explained in his judgment in *Extreme Networks Ltd v Extreme E Ltd* [2024] EWCA Civ 1386 at [31]:

> *"31. It is common for hearing officers when assessing the similarity of goods or services to express their reasoning in highly compressed form. There are a number of reasons for this: first, their extensive experience in the field; secondly, comparison of goods or services is a routine exercise for them to have to undertake when writing decisions; thirdly, it is frequently necessary for them to have to undertake multiple comparisons in each decision; and fourthly, it is often the case that no evidence has been adduced by either party (leaving the hearing officer to rely upon their own knowledge and experience as a consumer) and that the parties have addressed the issue quite briefly in their submissions. In such circumstances the principles summarised by Lord Hamblen in HA (Iraq) v Secretary of State for the Home Department [2022] UKSC 22, [2022] 1 WLR 3784 at [72] apply mutatis mutandis to the hearing officer's evaluation:*
>
> > *"It is well established that judicial caution and restraint is required when considering whether to set aside a decision of a specialist fact finding tribunal. In particular:*
> >
> > *(i) They alone are the judges of the facts. Their decisions should be respected unless it is quite clear that they have misdirected themselves in law. It is probable that in understanding and applying the law in their specialised field the tribunal will have got it right. Appellate courts should not rush to find misdirections simply because they might have reached a different conclusion on the facts or expressed themselves differently: see AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49; [2008] AC 678 per Baroness Hale of Richmond at para 30.*
> >
> > *(ii) Where a relevant point is not expressly mentioned by the tribunal, the court should be slow to infer that it has not*

been taken into account: see MA (Somalia) v Secretary of State for the Home Department [2010] UKSC 49; [2011] 2 All ER 65 at para 45 per Sir John Dyson.

(iii) When it comes to the reasons given by the tribunal, the court should exercise judicial restraint and should not assume that the tribunal misdirected itself just because not every step in its reasoning is fully set out: see R (Jones) v First-tier Tribunal (Social Entitlement Chamber) [2013] UKSC 19; [2013] 2 AC 48 at para 25 per Lord Hope of Craighead."

18. However, I consider that the conclusions expressed by the Hearing Officer in paragraph 68 of the Decision lacked sufficient reasoning and did not logically follow on from his findings that legal and business services could be provided together, and that the users would be the same.

19. With respect to the similarity of services, he simply stated that they were different, whereas it is difficult to see why, for example, "*providing information relating to legal document preparation services"* and *"Document preparation"* services are not at least similar to some degree given that they both relate to document preparation services. In this respect I agree with the Appellant's criticism of the Hearing Officer under Ground 1 that by only comparing *"legal services"* with *"business management/administration"* he failed to consider some of the more specific services included in the respective specifications that were similar to each other.

20. With regard to trade channels, the Appellant had referred the Hearing Officer to an EUIPO decision which had found that business management or business administration services were frequently supplemented by the provision of legal services, giving the example of where a lawyer is a trustee for a client business or where a lawyer *"works as an insolvency practitioner and therefore as a business administrator"*. While acknowledging that he was not bound by EUIPO decisions, the Hearing Officer said that he *"took into consideration [the Appellant's] submission in my assessment and I agree that legal and business management services can be provided together as part of legal advice/services"*. If those services are being provided together by the same business, or in the two examples given by the EUIPO, by the same individuals, then they are likely to be provided through the same trade channels (e.g. through details provided on webpages on the same website).

21. Similarly, if a firm of lawyers is providing business management or administration services, then they will be in competition with other providers of those services, which

could be other law firms or businesses which specialise in business management or administration services. The Hearing Officer was therefore wrong to say that they would not be in competition with each other.

22. While some legal services will not be complementary to some business management or administration services, I consider that the Hearing Officer was also wrong not to find that some legal services will be indispensable or important for the use of some business management or administration services. In the two examples given by the EUIPO, the work of the insolvency practitioner acting as a business administrator would be important to the related legal insolvency services, and the fact that the Hearing Officer accepted that those services could be provided by the same firms shows that the average consumer is likely to assume that they were provided by the same undertaking.

23. I therefore find that the Hearing Officer erred in not finding the respective services to be similar to each other to some extent. I will return later to the extent of such similarity once I have considered the Appellant's other arguments.

Ground 3: Inconsistency with the decision's own similarity analysis

24. In paragraph 44 of the Decision, the Hearing Officer found that "*application software for assisting contract drafting and document management"* in class 9 to be similar to a low degree to *"document preparation"* and "*administrative services relating to the management of legal dockets"* services in class 35. This was on the basis that they shared the same intended purpose (i.e. document creation or management), some overlap in users and they were to some extent complementary and in competition. The Appellant submitted that if that were the case, then *"legal document preparation"* services and "*information services"* (which related to legal services or to legal document preparation services) in class 45 were at least as close as *"document preparation/administration services"* in class 35, and to find otherwise was inconsistent with the Hearing Officer's own logic and represented a misapplication of the factors laid down in *Canon* (Case C-39/97). I agree.

Ground 4: Insufficient consideration of overlap in nature, purpose, and providers.

25. The Appellant submitted that the Hearing Officer erred in finding that *"the services themselves and the trade channels are different".* I have already covered most of the factors relied upon by the Appellant under Ground 2 above relating to the nature and purpose of the services, and the fact that the provider of the services and the trade

channels may be the same. I agree with the Appellant that the Hearing Officer's findings do not reflect the commercial reality that there is a significant overlap in the professional services market between legal and business advisory services, with many firms providing both.

Ground 5: Materiality

26. The Appellant submitted that if the Hearing Officer had found at least some degree of similarity between the respective services, then it is likely that he would have found a likelihood of indirect confusion in relation to those services under s.5(2)(b). I agree, because the Hearing Officer found a likelihood of indirect confusion in relation to all the services in respect of which he had found at least some degree of similarity, including a wide range of services where he had found only a low degree of similarity. There is nothing in the Decision to suggest that he would have reached a different conclusion when considering the services in issue on this appeal to the other goods and services where he had found at least a low degree of similarity.

Relief sought

27. The Appellant asked me to declare the Respondent's Trade Mark invalid in respect of at least the services shown in bold in the class 45 specification from the Respondent's Mark set out below:

> *"**Legal consultancy and providing legal information about drafting contracts and other documents relating to rights and obligations and proof of facts;** providing information about legal services; legal advice; legal consultation services; arbitration and mediation for resolution services of Internet disputes; Internet legal assistance in alternative dispute resolution; research and analysis of prior literature regarding intellectual property rights; research and analysis relating to lawsuits and other legal issues using database information; legal consultancy and providing legal information related to social insurance claims; investigation or surveillance services for checking background profiles; **information services relating to legal services in relation to the negotiation of contracts for others;** providing information about legal services relating to licenses; personal background investigations; **legal research; legal watching services; providing information relating to legal document preparation services;** Online social networking services."*

28. This was on the basis that they should have been found to have been similar to at least a low degree to, in particular, the following class 35 services of the Earlier Mark:

> *"Document preparation;" "Administration services relating to the management of legal dockets", "Updating and maintenance of information in registries"* and *"Data processing, systematisation and management"*.

29. With the exception of *"legal research"*, I agree that, for the reasons set out above, the Hearing Officer erred by not finding some degree of similarity between the services highlighted in bold and the class 35 services relied on by the Appellant. Had he done so, he would have found at least a likelihood of indirect confusion pursuant to s.5(2)(b) of the Act. I do not accept the Appellant's bare assertion without further reasoning that *"legal research"* is complementary to business administration services.

30. As I explained above, paragraph 70 of the Decision, which considered *"online social networking services"* under class 45 of the Respondent's Mark, was not subject to one of the Grounds of Appeal, and therefore I reject the Appellant's invitation for me to order that the Respondent's Mark is invalid *"in respect of all the Class 45 services"* as it requested in paragraph 22 of its Form TM55P. I am not prepared to overturn the Hearing Officer's decision in respect of the other services in class 45 of the Respondent's Mark which are not highlighted in bold above as the Appellant did not make any specific submissions on the appeal in relation to the similarity of those particular services. I do not consider all of those services to be sufficiently comparable to each other to be considered collectively in accordance with Geoffrey Hobbs QC's guidance in *Separode Trade Mark* (BL O/399/10). In addition, to consider all of those services together would be contrary to the Appellant's submissions under Ground 1 that the Hearing Officer erred by treating all of those services as *"homogenous legal services"*.

Conclusion

31. The appeal succeeds for the reasons set out above, and the Respondent's Mark shall be declared invalid in relation to the following additional services in class 45 not previously declared invalid by the Hearing Officer:

> *"Legal consultancy and providing legal information about drafting contracts and other documents relating to rights and obligations and proof of facts; information services relating to legal services in relation to the negotiation of contracts for*

others; legal watching services; providing information relating to legal document preparation services".

Costs

32. Since the Appellant has been partially successful on the appeal, I order the Respondent to pay to the Appellant the sum of £1,000 in respect of its costs of the Appeal. The Hearing Officer declined to make an award of costs in favour of either party since he found that both parties had a reasonable degree of success. In light of the narrow scope of this appeal, and the fact that the Appellant was only partially successful, I do not intend to vary the position regarding those costs. Accordingly, I order that the Respondent shall pay the sum of £1,000 to the Appellant within 21 days of the date of this decision.

Simon Clark
The Appointed Person
2 April 2026