

O/0546/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. 3915285
IN THE NAME OF KINGS CHAMBERS LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:

KINGS CHAMBERS

IN CLASSES 9, 16, 41 & 45

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 443068
BY ESTHER ANATO-DUMELO

AND

IN THE MATTER OF APPLICATION NO. 3908621
IN THE NAME OF ESTHER ANATO-DUMELO
TO REGISTER THE FOLLOWING TRADE MARK:

King's Court Chambers

IN CLASSES 41 & 45

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 443286
BY KINGS CHAMBERS LIMITED

Background and pleadings

1. On 24 May 2023, Kings Chambers Limited (“KCL”) applied to register the trade mark **KINGS CHAMBERS** in the UK, under no. 3915285 (“KCL’s word mark”). Registration is sought for the following goods and services:

Class 9: Electronic publications; podcasts; electronic downloads; electronic recordings; audio-visual recordings; recorded audio and visual content; recorded presentations and events.

Class 16: Printer matter; printed publications.

Class 41: Education and training services; arranging and conducting seminars, training events, and conferences; all of the aforementioned including services provided online; arranging and conducting webinars; entertainment and education services in the form of the provision of podcasts.

Class 45: Legal services; legal consultation, advice and information; provision of legal advice, arbitration, mediation and advocacy services; legal research; litigation services; barrister services; information and advisory services relating to all the aforementioned services.

2. The application was published for opposition purposes on 16 June 2023. On 15 September 2023, Esther Anato-Dumelo opposed the registration of KCL’s word mark in classes 41 and 45 under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(b), Ms Anato-Dumelo relies upon her UK trade mark no. 3908621, **King’s Court Chambers** (“EAD’s mark”). The application for EAD’s mark was filed on 6 May 2023 and published on 28 July 2023. Registration is sought for the following services:

Class 41: Tuition in law; courses (training -) relating to law; publication of documents in the field of training, science, public law and social affairs; adult education services relating to law; training relating to the provision of legal services; legal education services.

Class 45: Advisory services relating to the law; providing information in the field of law; provision of legal research; legal consultation in the field of taxation; legal conveyancing; enforcement of testaments; reviewing standards and practices to assure compliance with laws and regulations; legal services in the field of immigration; legal compliance auditing; provision of legal information; enforcement of intellectual property rights; provision of expert legal opinions; mediation in legal procedures; legal and judicial research services in the field of intellectual property; provision of judicial information; legal research in the field of environmental protection; legal services relating to copyright licensing; patent licensing [legal services]; enforcement of trade mark rights; legal consultancy relating to intellectual property rights; legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; legal advice relating to franchising; legal services relating to wills; monitoring intellectual property rights for legal advisory purposes; legal research; legal consultancy relating to patent mapping; legal services for procedures relating to industrial property rights; licensing of intellectual property in the field of copyrights [legal services]; monitoring industrial property rights for legal advisory purposes; legal services relating to the exploitation of copyright and industrial property rights; legal advice; legal mediation services; mediation [legal services]; legal services relating to the exploitation of copyright for printed matter; legal services provided in relation to lawsuits; legal services relating to the management and exploitation of copyright and ancillary copyright; legal services relating to business; licensing of intellectual property [legal services]; consultancy relating to copyright protection;

patent attorney services; legal services relating to intellectual property rights; professional legal consultations relating to franchising; personal legal affairs consultancy; legal advice and representation; legal services relating to the exploitation of film copyright; legal research relating to real estate transactions ; legal advocacy services; legal services relating to the management, control and granting of licence rights; legal services in relation to the negotiation of contracts for others; preparation of legal reports in the field of human rights; legal services; attorney services [legal services]; registration services (legal); legal services relating to social insurance claims; certification of legal documents; licensing of patent applications [legal services]; advisory services relating to consumers rights [legal advice]; copyright protection; legal services relating to the exploitation of patents; legal services relating to the exploitation of intellectual property rights; licensing of intellectual property in the field of trademarks [legal services]; provision of information relating to legal services; consultancy relating to patent protection; forensic advice for criminal investigations; licensing [legal services] in the framework of software publishing; legal investigation services; legal services relating to company formation and registration; arranging for the provision of legal services; expert consultancy relating to legal issues; consultation in relation to data protection compliance; consultancy services relating to the legal aspects of franchising; litigation advice; licensing of industrial property rights and copyright; exploitation of industrial property rights and copyright by licensing; granting of software licenses [legal services]; legal research services; legal services relating to the exploitation of broadcasting rights; litigation services [services of a lawyer]; legal assistance in the drawing up of contracts.

4. In principle, EAD's mark qualifies as an 'earlier mark' in accordance with section 6 of the Act. It is not yet registered and, therefore, it is not subject to the use requirements in section 6A of the Act.

5. In her statement of grounds, Ms Anato-Dumelo contends that the competing marks are similar and that the parties' services are identical or similar, resulting in a likelihood of confusion.

6. Under section 5(4)(a), Ms Anato-Dumelo claims that she has goodwill in her business in relation to which she has used the sign **King's Court Chambers** throughout the UK since 2017. The sign is said to have been used in respect of *arranging and conducting seminars, arranging and conducting webinars, provision of legal consultation, advice, information and advocacy services, legal research, barrister services*. Ms Anato-Dumelo argues that use of KCL's word mark in relation to *barrister services* would constitute passing off.

7. KCL filed a counterstatement, denying the grounds of opposition. Whilst KCL does not dispute, for example, that the competing marks are similar or that the parties' services are identical or similar, it contends that Ms Anato-Dumelo cannot succeed under section 5(2)(b) because the validity of the mark on which she relies is the subject of pending opposition proceedings. As for section 5(4)(a), KCL puts Ms Anato-Dumelo to proof of goodwill.

8. The opposition against EAD's mark was brought by KCL on 27 September 2023. It is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act and is directed at all the services thereof.

9. Under section 5(2) and 5(3), KCL relies upon its UK registration no. 2301756, which is displayed below.



KINGS
CHAMBERS

("KCL's figurative mark")

10. KCL's figurative mark was filed on 30 May 2002 and became registered on 2 May 2003. It stands registered for goods and services in classes 16 and 42. For the purposes of the opposition, KCL only relies upon *barrister services* in class 42.¹

11. KCL's figurative mark qualifies as an 'earlier mark' in accordance with section 6 of the Act. As it had been registered for more than five years at the filing date of EAD's mark, it is subject to the use provisions in section 6A of the Act.

12. In its statement of grounds, KCL argues that the competing marks are similar and that the parties' services are identical or highly similar. On this basis, KCL submits that there is a likelihood of confusion, including the likelihood of association.

13. Under section 5(3), KCL claims that its mark has a substantial reputation in the UK in respect of *barrister services*. It argues that use of EAD's mark would, without due cause, take unfair advantage of, and be detrimental to, the repute and distinctive character of its mark. KCL also claims that the relevant public will mistakenly believe that there is an economic connection between the users of the competing marks.

14. As for section 5(4)(a), KCL claims that it has goodwill in its business in relation to which it has used the sign **KINGS CHAMBERS** throughout the UK since 1946. The sign is said to have been used in respect of *barrister services*. KCL argues that use of EAD's mark would constitute passing off.

15. Ms Anato-Dumelo filed a counterstatement, denying the grounds of opposition. She also puts KCL to proof of use, reputation and goodwill in respect of its mark and sign.

16. On 17 January 2024, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008 ("the Rules").

¹ Although these services now appear in class 45 of the Nice Classification system, they were proper to class 42 at the time the application was filed.

17. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 18 June 2025. KCL was represented by Beth Collett of counsel, instructed by Marks & Clerk LLP. Ms Anato-Dumelo represented herself.

Relevance of EU law

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

Evidence

19. KCL's evidence is given in the witness statement of Andrew Timothy Grantham KC and three exhibits (ATG1-ATG3). Mr Grantham is a barrister and member of Kings Chambers, a position he has held since 2001. He provides evidence of use of KCL's figurative mark and its sign.

20. Ms Anato-Dumelo filed evidence in the form of two witness statements and 17 exhibits (EAD1-EAD17). Ms Anato-Dumelo is a barrister and founder of King's Court Chambers. She provides a history of her career and use of her mark, as well as the dispute between the parties.

21. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Preliminary remarks

22. Within her evidence in reply, Ms Anato-Dumelo raised the issue of bad faith. The very last paragraph of her statement is as follows:

“12. It appears that given proper consideration of the above, [KCL’s] application to register their trade mark and their opposition to the registration of the earlier application to register a trade mark for King’s Court Chambers has been made in bad faith, and certainly not within the spirit of respect and co-existence that is encouraged within the Bar Profession within which it operates.”

23. A similar argument was raised in her skeleton argument. The very last paragraph before her concluding remarks was as follows:

“41. Bad Faith Allegation: [KCL] only filed for registration after [Ms Anato-Dumelo’s] earlier application, suggesting reactive and possibly strategic opposition without genuine conflict, *Sky Ltd v SkyKick UK Ltd* [2021] EWCA Civ 1121.”

24. This line of argument was not developed at all during Ms Anato-Dumelo’s oral submissions. Reference was simply made to it having been raised in her witness statement.

25. Bad faith is a serious allegation which must be adequately pleaded and distinctly proved. As I clarified at the hearing, bad faith is not a pleaded ground of opposition in these proceedings. Moreover, Ms Anato-Dumelo has made no application to amend her pleadings to include it at any stage. Accordingly, Ms Anato-Dumelo’s comments regarding bad faith will have no bearing on the outcome of this decision. I shall say no more about this issue, save to say that it is far from satisfactory to include unsupported remarks of this nature in passing, particularly in circumstances where bad faith is not in issue.

My approach

26. If KCL’s opposition to EAD’s mark is successful, Ms Anato-Dumelo will have no valid earlier mark to rely upon in her opposition. Accordingly, although her opposition is not wholly dependent on its outcome, it is convenient to first deal with KCL’s opposition. I will then consider Ms Anato-Dumelo’s opposition to the extent that it is necessary to do so.

KCL's opposition

Proof of use

27. At the hearing, Ms Anato-Dumelo conceded that there has been genuine use of KCL's figurative mark in respect of the services relied upon, namely *barrister services*.

Section 5(2)(b)

Legislation and case law

28. Sections 5(2)(b) and 5A of the Act state as follows:

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

[...]

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

29. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, 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; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

30. At the hearing, Ms Anato-Dumelo conceded that the parties' services are identical or highly similar.

Average consumer

31. As the authorities indicate, I must determine who the average consumer is for the parties' services and how they are likely to be selected. The average consumer is deemed to be reasonably well informed, observant and circumspect.²

32. In *Iconix*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

² *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

33. The services at issue in these proceedings broadly consist of a range of legal services, together with education, training and publication services relating thereto. The average consumer of such services may comprise members of the general public, businesses or professionals within the legal sector.

34. The services may be purchased with varying degrees of frequency. For instance, they may be purchased quite regularly for ongoing professional development or legal advice, or more occasionally where prompted by a specific legal need. The cost will likewise vary. For example, one-off training sessions may be relatively inexpensive, whereas instructing a legal professional, such as a barrister, is likely to incur

significantly higher expense. The level of attention will also vary depending on the nature of the service. The selection of legal services is, in general, likely to be relatively important; the average consumer will be mindful of the consequences of failing to instruct a competent and appropriate provider. In relation to the class 41 services, the importance of the selection is likely to vary. Whilst more casual consideration may be given to occasional learning opportunities, the selection of a provider of legal education or professional qualifications is likely to involve a higher degree of care. Taking all of this into account, I find that the average consumer will demonstrate at least a medium level of attention overall.

35. The services are likely to be purchased directly from the provider, after viewing information in brochures, advertisements or on websites. Consequently, I find that the purchasing process will be predominantly visual in nature. Nevertheless, aural considerations in the form of word-of-mouth recommendations or discussions with potential service providers, for instance, cannot be entirely excluded.

Distinctive character of the earlier mark

36. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, the Court of Justice of the European Union (“CJEU”) stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

37. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

38. KCL's figurative mark consists of the words 'KINGS CHAMBERS' in a slightly stylised blue font, above which appears a blue, yellow and white monogram featuring the letter 'K'.

39. At the hearing, Ms Anato-Dumelo contended that the word 'CHAMBERS' is a generic term, whereas the word 'KINGS' is commonly used in the legal profession. These arguments were foreshadowed by her evidence, in which she set out that the word 'CHAMBERS' is used to describe barristers' organisations or companies and claimed that several chambers use the words 'King's' or 'Kings' in their names. Although not expressed in these exact terms, I consider that the submissions and evidence advanced by Ms Anato-Dumelo are naturally to be understood as an argument that the verbal elements of KCL's figurative mark lack, or possess only a low level of, distinctiveness.

40. I accept that submission in respect of the word 'CHAMBERS'; this is likely to be readily understood by the average consumer as referring to an organisation of barristers or the physical premises in which they conduct their work.

41. As for the word 'KINGS', it would not be appropriate to take it on judicial notice that this is a commonly used name in the relevant sector. In addition, Ms Anato-Dumelo has filed evidence in support of her argument, but it is extremely limited. It comprises printouts from the Bar Council which show search results for the words "king" and

“king’s”.³ The results are several chambers with addresses on King’s Bench Walk, a chambers called “King’s Bench Chambers”, two entries for “King’s Bench Godolphin (KBG) Chambers”, and one for “Activision Blizzard King”. The word ‘KINGS’ is not an independent element of any of these; it forms part of longer addresses or names. At best, this evidence shows that there are several chambers located on King’s Bench Walk, a particular street in London. I consider that it falls a long way short of establishing that the word ‘KINGS’ is of no or low distinctiveness.

42. In my view, the word ‘KINGS’ will be understood by the average consumer as referring to male rulers of a country or countries. It has a normal (medium) level of inherent distinctive character. The distinctive character of the mark predominantly lies in this word. The ‘K’ monogram is likely to be perceived as a representation of the first letter of the same. In addition, it is a single letter with fairly basic stylisation. As such, whilst it provides a contribution, it is less distinctive than the word ‘KINGS’. The word ‘CHAMBERS’, as discussed above, is likely to be understood by the average consumer as referring to an organisation of barristers or the physical premises in which they conduct their work. Therefore, it has a very low level of distinctive character. The use of colour is likely to be seen as decorative. This provides a nominal contribution of distinctive character. Overall, I find that KCL’s figurative mark possesses a medium level of inherent distinctive character.

43. Evidence has been filed and I am now required to consider whether the distinctive character of KCL’s figurative mark had been enhanced through use at the filing date of EAD’s mark, that being 6 May 2023.

44. Mr Grantham gives evidence that Kings Chambers was established in Manchester in 1946 and has had additional premises in Leeds and Birmingham since 1996 and 2012, respectively. He explains that the set comprises around 120 barristers, including 24 King’s Counsel, and offers advice, litigation and advocacy services to a wide range of clients. Members of the chambers are said to regularly appear in courts and tribunals throughout England and Wales.

³ Exhibit EAD4

45. According to Mr Grantham, KCL's figurative mark was originally adopted in 2002 and has since been used in relation to the provision of barrister services. He provides printouts from KCL's website (kingschambers.com), dated 20 March 2003 and between 16 July 2018 and 3 April 2023,⁴ from which it is clear that such services were offered at these times. KCL's figurative mark was presented on the website as follows:



46. Mr Grantham provides the following figures for approximate amounts generated in 'billings':

Year ⁵	Billing amount (£)
2018/2019	36,236,978.16
2019/2020	37,644,451.76
2020/2021	39,406,248.30
2021/2022	45,724,026.18
2022/2023	47,463,607.90
Total	206,475,312.30

⁴ Exhibit ATG1

⁵ Each given period runs from 6 May to 5 May the following year.

47. It is my understanding that 'billings' refers to the amounts that barristers bill to their clients in a given period, and Mr Grantham confirms that these figures are associated with the provision of barrister services.

48. In support, Mr Grantham provides a selection of invoices, dated between 4 September 2018 and 16 February 2023.⁶ Most of the invoices do not relate to barrister services. Rather, they relate to other services provided at the chambers, such as room hire and providing refreshments. However, those dated 22 November 2018, 17 January 2020 and 21 March 2022 are for providing mediation briefs to customers in London and Leeds. The words 'Kings Chambers' are clearly displayed at the top of the invoices, as is KCL's figurative mark in the following form:



49. In addition, Mr Grantham provides a range of news articles.⁷ These include articles from *Manchester Evening News* (2 August 2018) and *Place North West* (10 February 2021) regarding a leading employment barrister and a renowned planning barrister joining Kings Chambers. Moreover, there are articles from *The Business Desk* (17 January 2020 and 14 September 2020) about two of Kings Chambers' barristers becoming Queen's Counsel and one being appointed Justice of the High Court. Furthermore, I note that *The Business Desk* (20 July 2018) and *Manchester Evening News* (23 July 2018) published articles about Kings Chambers' record growth, billing £17million for the first half of that year. The latter described KCL having a national client base.

⁶ Exhibit ATG2

⁷ Exhibit ATG3

50. Finally, Mr Grantham provides news announcements from KCL's website.⁸ These detail the various awards and nominations therefor which the chambers received, such as winning Regional Chambers of the Year at the Chambers Bar Awards (2018), being voted the best chambers by students and graduates in *The Guardian* UK 300 (2018), being shortlisted for Barristers Chambers of the Year at the Manchester Legal Awards (2020), and being shortlisted for Best Chambers for Quality of Work at the Legal Cheek Awards (2021). In addition, the announcements contain details of rankings, including being the highest-ranked chambers in England and Wales by Chambers UK (2021), being ranked as a top tier set in numerous practice areas in Chambers UK Bar Guides (2018, 2019, 2022 and 2023), and being described as "by far the standout set in the North" in the Legal 500 (2021). There are also details of personal accolades for members of Kings Chambers. These include a member winning Personal Injury Silk of the Year at Chambers & Partners Bar Awards (2019), a member receiving an award for Outstanding Achievement in Clinical Negligence at the AvMA Conference in Leeds (2019), and members being named Women of Influence by *The Planner* (2020 and 2022). Finally, I note that members of Kings Chambers were appointed, amongst other things, Vice Chair of the Planning and Environmental Bar Association (2019), Secretary of the Society of Construction Law (2022) and UK chair of the British Irish Commercial Bar Association (2022).

51. On the basis of all the above, and, in particular, the consistent use of the mark on KCL's website,⁹ over £200million being billed by KCL's members in the five years before the relevant date, the invoice evidence demonstrating barrister services actually being provided prior to the relevant date, the various third-party press references to KCL and its members, and the numerous awards and nominations therefor for KCL and its members, I am satisfied that the distinctive character of KCL's mark had been enhanced to a high level at the relevant date.

⁸ Exhibit ATG3

⁹ Although this was not raised by Ms Anato-Dumelo, I record here for completeness that I consider the use shown on the website to constitute acceptable use of KCL's mark as registered, notwithstanding any slight stylistic differences.

Comparison of trade marks

52. It is clear from *Sabel BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. This case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. In *Bimbo SA v OHIM*, Case C-591/12P, the CJEU stated (at paragraph 24 of its judgement) that:

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

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

54. The marks to be compared are as follows:

KCL's figurative mark	EAD's mark
	King's Court Chambers

55. KCL's figurative mark comprises the words 'KINGS CHAMBERS' in a slightly stylised blue font, above which appears a blue, yellow and white monogram featuring the letter 'K'. It is my view that the word 'KINGS' dominates the overall impression of the mark. It is the most distinctive element, occupies a prominent position, and is the principal verbal element. Due to its size and position, the 'K' monogram also makes a relatively important contribution to the overall impression. However, it plays a lesser role than the word 'KINGS', given that it represents the first letter of that word and consists of a single letter with fairly basic stylisation. The word 'CHAMBERS', as discussed, is likely to be understood by the average consumer as referring to an organisation of barristers or the physical premises in which they conduct their work. Therefore, it plays a much lesser role in the overall impression. The use of colour is likely to be seen as decorative and, as such, also plays a much lesser role.

56. EAD's mark is in word-only format and consists of the words 'King's Court Chambers'. The individual words 'Court' and 'Chambers' are clearly meaningful in the legal sector and, if considered in isolation, would not be significant from a trade mark perspective. However, separating the words in the mark from one another and apportioning 'Court' and 'Chambers' no weight at all in the comparison would, to my mind, represent an artificial dissection of EAD's mark. Due to its composition, the words 'King's Court' combine to form a phrase. They dominate the overall impression of the mark. Again, the word 'Chambers' will be understood by the average consumer as referring to an organisation of barristers or the physical premises in which they conduct their work. Therefore, it plays a much lesser role in the overall impression.

57. Visually, the competing marks are similar in that they share the highly similar words 'KINGS' and 'King's', as well as the identical word 'CHAMBERS'/'Chambers'. Any differences created by varying capitalisation and the font used in KCL's figurative mark are not significant. This is because the registration of word-only marks protects the words themselves, regardless of how they are presented.¹⁰ The competing marks are visually different insofar as KCL's figurative mark contains the 'K' monogram. This element plays a relatively important role in that mark but has no counterpart in EAD's mark. Further, EAD's mark contains the additional word 'Court', which plays a

¹⁰ *LA Superquímica, SA v EUIPO*, Case T-24/17

meaningful role in its overall impression. Balancing all the above, I find that there is a medium degree of visual similarity between the competing marks.

58. In my view, the 'K' monogram in KCL's figurative mark is unlikely to be articulated by the average consumer. This is because it is likely to be seen as a representation of the first letter of the word 'KINGS'. All the words in the competing marks will be pronounced in the ordinary way. The words 'KINGS' and 'King's' are identical in pronunciation. The competing marks are similar in that both words in KCL's figurative mark appear in EAD's mark. They differ to the extent that the additional word 'Court' appears between those words in EAD's mark. Overall, I find that there is between a medium and high degree of aural similarity between the competing marks.

59. Conceptually, KCL's figurative mark conveys the meanings of kings (i.e. male rulers) and an organisation of barristers or their physical premises. The 'K' monogram does not introduce any additional concept. On its own, it conveys no meaning other than its existence as a letter in the alphabet. In the context of the mark, it will be seen as a representation of the first letter of the word 'KINGS'. EAD's mark, considered as a whole, conveys the concept of a chambers located at, or operating from, a place called King's Court. The coincidence of the highly similar words 'KINGS' and 'King's', as well as the identical word 'CHAMBERS'/'Chambers', creates some conceptual overlap. However, taking into account the overall meanings conveyed by the competing marks, I find that the degree of conceptual similarity between them is low.

Likelihood of confusion

60. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of KCL's figurative mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to

make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related.

62. Earlier in this decision, I concluded as follows:

- The parties' services are identical or highly similar;
- The average consumer may be a member of the general public, a business or a professional in the legal sector;
- Overall, at least a medium level of attention will be exhibited during the purchasing process;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been excluded;
- KCL's figurative mark has a medium level of inherent distinctive character, which had been enhanced to a high level at the relevant date;
- The overall impression of KCL's figurative mark is dominated by the word 'KINGS', whilst the 'K' monogram, the word 'CHAMBERS' and the stylisation play lesser roles (to varying degrees);
- The overall impression of EAD's mark is dominated by the words 'King's Court', whilst the word 'Chambers' plays a much lesser role;

- The competing marks are visually similar to a medium degree, aurally similar to between a medium and high degree, and conceptually similar to a low degree.

63. At the hearing, Ms Anato-Dumelo argued that, due to an apparent geographical separation between the parties, there would be no likelihood of confusion. However, even if proven, that would not be sufficient to avoid a likelihood of confusion between the competing marks. This is because KCL's mark is a national mark which is protected across the UK. The same would be true of EAD's mark, if registered.

64. Moreover, Ms Anato-Dumelo highlighted that there is no evidence of actual confusion. However, this will have no bearing on my assessment which follows. As Kitchen LJ stated in *Roger Maier and Another v ASOS* [2015] EWCA Civ 220:

"80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

65. As I will discuss in more detail later in this decision, the only evidence of use of EAD's mark in the UK from before the relevant date consists of two invoices for *pro bono* barrister's services, the earliest of these being dated 1 August 2020. I do not consider this to be sufficient for the purpose of demonstrating that the competing marks have been used side by side, or that there has been any real possibility for

confusion between them to occur. As such, I place no weight on there being no evidence of actual confusion.

66. Turning to the global assessment, I acknowledge that there are differences between the marks, namely the 'K' monogram and colours used in KCL's figurative mark and the word 'Court' and the use of the possessive form of the word 'King's' in EAD's mark. Nevertheless, in light of all the above factors, it is my view that these differences may not be sufficient for the average consumer, even paying a higher level of attention, to distinguish between them and avoid mistaking them for one another. The competing marks share the highly similar words 'KINGS' and 'King's', as well as the identical word 'CHAMBERS'/'Chambers'. KCL's figurative mark is highly distinctive and the parties' services are identical or highly similar. Although the 'K' monogram plays a relatively important role in the overall impression of KCL's figurative mark, this is due to its size and positioning; it is likely to be seen as a mere representation of the first letter of the word 'KINGS' (which has a highly similar counterpart in the word 'King's'). The colours used in KCL's figurative mark play a much lesser role in its overall impression and are likely to be perceived as purely decorative. In this connection, I am of the view that the average consumer may misremember whether the verbal elements were accompanied by a monogram and the colours used. Moreover, whilst EAD's mark is formulated in such a way that the words 'King's Court' may combine to form a phrase, resulting in the competing marks only having a low degree of conceptual similarity, conceptual differences do not always overcome visual or aural similarities.¹¹ In the present case, I do not consider the difference between the overall meanings conveyed by the marks to be sufficient for this purpose. Taking all the above into account, as well as the principles of imperfect recollection and interdependency, the average consumer may not recall the respective marks with sufficient accuracy to differentiate between them. Consequently, I find that there is a likelihood of direct confusion.

67. I now go on to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

¹¹ *Nokia Oyj v OHIM*, Case T 460/07

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

68. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹² However, indirect confusion has its limits; such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.¹³ It has also been emphasised that there must be a proper basis for finding indirect confusion.¹⁴

69. Imperfect recollection is not only applicable to direct confusion; it is also relevant when considering indirect confusion.¹⁵ In this connection, it is my view that, even if the average consumer is able to discern some difference between the competing marks, it remains likely that the verbal elements ‘KINGS CHAMBERS’ and ‘King’s Court Chambers’ will be misremembered or inaccurately recalled as one another. The words ‘KINGS’ and ‘King’s Court’ dominate the overall impressions of the competing marks, both marks contain the identical word ‘CHAMBERS’/‘Chambers’ (albeit playing a much lesser role), and the ‘K’ monogram and use of colour play lesser roles in the overall impression of KCL’s figurative mark. In circumstances where the average consumer imperfectly recalls the verbal elements as one and the same, the other differences between the competing marks readily lend themselves to a sub-brand or brand extension used by the same (or an economically connected) undertaking; the competing marks are likely to be seen as alternate brands, one in plain wording and the other with additional decorative embellishments. Even if the word ‘Court’ is accurately recalled and the conceptual difference between the competing marks is sufficient for the average consumer to avoid mistaking the verbal elements as one another, there is still potential for the average consumer to perceive the competing marks as alternate brands; EAD’s mark may be seen as the full name of the chambers in plain wording, whereas KCL’s figurative mark may be seen as a shortening of that name with additional decorative embellishments. In light of all this, I am satisfied that the average consumer, even paying a higher level of attention, may assume a commercial association between the parties due to the highly similar words

¹² As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹⁴ See the Court of Appeal’s comments in *Liverpool Gin Distillery*, paragraph 13.

¹⁵ As was confirmed by Simon Clark, sitting as the Appointed Person, in *Rituals International Trademarks B.V. v Natals, Inc.*, BL O/0116/26.

‘KINGS’/‘King’s’ and the identical word ‘CHAMBERS’/‘Chambers’. This is particularly the case, given the distinctiveness of KCL’s figurative mark and the parties’ services being identical or highly similar. Accordingly, I find that there is a likelihood of indirect confusion.

Conclusion

70. KCL’s claim under section 5(2)(b) is successful.

Section 5(3)

Legislation and case law

71. Section 5(3) of the Act states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

72. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

73. The relevant case law can be found in the following judgments of the CJEU: *General Motors*, Case C-375/97, *Intel*, Case 252/07, *Adidas-Salomon*, Case C-408/01, *L’Oréal v Bellure*, Case C-487/07, *Marks and Spencer v Interflora*, Case C-323/09, and *Environmental Manufacturing LLP v OHIM*, Case C-383/12P. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas-Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

74. The conditions of section 5(3) are cumulative. Firstly, KCL must show that its mark is similar to EAD's mark.¹⁶ Secondly, KCL must show that its mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, KCL must establish that the public will make a link between the marks, in the sense of its mark being brought to mind by EAD's mark. Finally, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by KCL will occur. It is not necessary for the purposes of section 5(3) that the services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

75. The relevant date for the assessment under this ground is the filing date of EAD's mark, namely 6 May 2023.

¹⁶ On the basis of my findings at paragraphs 55 to 59, this condition is clearly satisfied.

Reputation

76. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

77. At the hearing, Ms Anato-Dumelo conceded that KCL’s mark has a reputation. In addition, I have already found that KCL’s evidence was sufficient for the purposes of establishing that the distinctive character of its figurative mark had been enhanced at the relevant date. Whilst I acknowledge that reputation and enhanced distinctive character are different, the nature, factors, and evidence used to prove them are the same.¹⁷ For the same reasons as given previously, I am satisfied that KCL’s figurative mark had a relatively strong reputation in the UK at the relevant date in respect of *barrister services*.

¹⁷ *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

Link

78. As noted above, my assessment of whether the public will make the requisite mental 'link' between the competing marks must take into account all relevant factors. As identified at paragraph 42 of *Intel*, these are:

The degree of similarity between the competing marks

The competing marks are visually similar to a medium degree, aurally similar to between a medium and high degree, and conceptually similar to a low degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

It is common ground that the services at issue in these proceedings are identical or highly similar. I have already assessed who the average consumer is for those services and how they are likely to purchase them. My findings at paragraphs 33 to 35 are equally applicable here.

The strength of the earlier mark's reputation

KCL's figurative mark has a relatively strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

KCL's figurative mark possesses a medium level of inherent distinctive character, which has been enhanced to a high level in respect of the reputed services.

Whether there is a likelihood of confusion

I have found that there is a likelihood of direct and indirect confusion.

79. Having already found that the average consumer is likely to mistake the competing marks for one another or assume that there is an economic connection between the users thereof, it is highly likely that the relevant public will make the requisite link between them. Even if I had found that there was no likelihood of confusion, taking all the other factors into account, it is my view that KCL's figurative mark would still be brought to mind by a significant part of the relevant public upon encountering EAD's mark.

Damage

80. One of the types of damage pleaded by KCL is unfair advantage. The taking of unfair advantage of the reputation or distinctive character of an earlier trade mark means that consumers are more likely to buy the goods or services of the later trade mark than they would otherwise have been if they had not been reminded of the earlier trade mark. As a result, the marketing of the later mark will not require as much effort or investment due to the familiarity that the relevant public would already feel with it or the message they are sent about what to expect. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J (as he then was) concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate

case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

81. I have already found that there is a likelihood of direct and indirect confusion. Therefore, even if there is no intention on Ms Anato-Dumelo’s part, it is clearly foreseeable that she would secure an unfair commercial advantage, benefitting from KCL’s reputation without paying financial compensation and diverting custom to her. Even if there was no confusion, it is my view that, upon encountering EAD’s mark, the relevant public will be reminded of KCL’s figurative mark; EAD’s mark will appear instantly more familiar, making it easier for Ms Anato-Dumelo to establish her mark and provide her services without incurring the marketing costs that would ordinarily be required. EAD’s mark will be able to attract more customers than would be the case if KCL’s figurative mark was not brought to mind. This will essentially allow Ms Anato-Dumelo to ‘free ride’ on the reputation of KCL’s figurative mark and gain an unfair commercial advantage.

82. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider any of the other types of damage pleaded by KCL.

Conclusion

83. KCL’s claim under section 5(3) is successful.

Section 5(4)(a)

Legislation and case law

84. Section 5(4)(a) of the Act states as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

85. Subsection (4A) of section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

86. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

87. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander QC, sitting as the Appointed Person, endorsed the Registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDSERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

88. The *prima facie* relevant date is the filing date of EAD's mark, that being 6 May 2023.

89. Ms Anato-Dumelo's case is that she has operated under the name 'King's Court Chambers' since 2017. Most of Ms Anato-Dumelo's evidence consists of printouts from the register, correspondence between the parties, correspondence from the IPO, and opposition forms.¹⁸ None of this is evidence of use of EAD's mark. Moreover, I note that Ms Anato-Dumelo has provided printouts from the Bar Council and King's Court Chambers websites; the former suggests that 'King's Court Chambers' is a registered practice, whereas the latter shows use of 'KING'S COURT CHAMBERS' in connection with the offering of legal services.¹⁹ However, the printouts are not dated. I infer that they reflect the position at the date of Ms Anato-Dumelo's statement, which

¹⁸ Exhibits EAD1-EAD3 and EAD5-EA14

¹⁹ Exhibits EAD4 and EAD15

is after the prima facie relevant date.²⁰ Furthermore, Ms Anato-Dumelo has exhibited printouts from social media regarding a webinar she spoke at (January 2021); materials relating to a Women's Conference in Sheffield she spoke at (August 2022); and an excerpt from the Emerging Business Intelligence and Innovation Group Summit magazine 2023, which Ms Anato-Dumelo featured in due to an interview she had previously given (July 2022).²¹ I accept that these activities took place before the prima facie relevant date. Nevertheless, Ms Anato-Dumelo's involvement appears to have been on a personal basis; there is no use of, or reference to, 'King's Court Chambers'. There are two invoices for *pro bono* barrister's services in evidence which feature the words 'King's Court Chambers' and are addressed to undertakings based in the UK (another one referring to Norway, which is not relevant).²² The earliest is dated 1 August 2020. As such, I will consider the position at that date ("the earlier relevant date") as well as the prima facie relevant date.²³

Goodwill

90. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (at 223-224):

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

91. I have already found that KCL's evidence demonstrates that its figurative mark had a reputation and enhanced distinctive character at the prima facie relevant date. For

²⁰ Whilst the exhibits are labelled "As per Statutory Declaration Date: 24.03.2023", this predates both the filing date of EAD's mark and the commencement of these proceedings. The date of the witness statement, as originally filed, was 24 March 2023. This was queried by the Tribunal and subsequently amended to 24 March 2024. The labels on the exhibits were not amended. Nevertheless, in the circumstances, I take it that they should read as being "as per" the amended date.

²¹ Exhibit EAD17

²² Exhibit EAD16

²³ Although the invoice is said to relate to services provided in July 2020, no further details or specific date(s) have been given. As such, I will focus on the date of the invoice itself.

the same reasons, I am satisfied that KCL has established that its business in *barrister services* enjoyed a strong level of goodwill at the prima facie relevant date.

92. The position was somewhat weaker at the earlier relevant date. However, on the basis of all KCL's evidence, I am satisfied that its business in *barrister services* had accrued at least a moderate level of goodwill by 1 August 2020. In particular, the evidence shows that, by this time, three premises were in operation, barrister services had been offered on the website for a number of years, over £73million had been billed by KCL's members, invoices had been issued to clients, and Kings Chambers and its members had received third-party press coverage, awards and nominations therefor.

93. I am also satisfied that the sign 'KINGS CHAMBERS' was distinctive of KCL's goodwill at both relevant dates.²⁴

Misrepresentation and damage

94. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ stated that:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

"is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

²⁴ Although my prior findings on reputation and enhanced distinctive character were made in respect of KCL's figurative mark and the sign relied upon under this ground is a word-only sign, use of the former constitutes use of the latter.

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

95. Later in the same judgment, it was stated that:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

96. *Halsbury's Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

97. In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal’s later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors

being equal) produce different outcomes.²⁵ This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

98. I have already found that there is a likelihood of confusion between KCL's figurative mark and EAD's mark. The sign relied upon under this ground is even more visually similar to EAD's mark, since it does not feature the 'K' monogram or any colours. All other factors being equal, I find that a substantial number of members of the public will be deceived into believing that the services provided under EAD's mark and KCL's sign are offered by the same or economically linked undertakings. In such circumstances, I consider that damage through diversion of sales is entirely foreseeable.

99. The above findings are applicable at both the earlier relevant date and the prima facie relevant date; there being misrepresentation at the former, the position would have been no different by the latter.

Conclusion

100. KCL's claim under section 5(4)(a) is successful.

Outcome

101. KCL's opposition to EAD's mark under sections 5(2)(b), 5(3) and 5(4)(a) has succeeded in its entirety. As a consequence, Ms Anato-Dumelo has no valid earlier mark to rely upon in her opposition to KCL's word mark. Her claim under section 5(2)(b) of the Act must fail. I will proceed to determine Ms Anato-Dumelo's opposition, but this will be limited to an assessment of her claim under section 5(4)(a).

²⁵ Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

Ms Anato-Dumelo's opposition

Section 5(4)(a)

102. I can deal with this ground relatively swiftly. The statutory provisions and case law principles outlined earlier in this decision are equally applicable here. For Ms Anato-Dumelo's claim under this ground to succeed, she is required to demonstrate that she was the owner of goodwill prior to the filing date of KCL's word mark, that being 24 May 2023. I have already discussed both parties' evidence in this decision.

103. My primary position is that Ms Anato-Dumelo has not demonstrated that she owned protectable goodwill in the UK through services distinguished by the sign 'King's Court Chambers' at any point before the filing of KCL's word mark. In this connection, I reiterate that the printouts from the Bar Council and the King's Court Chambers websites are not dated (and are likely to represent the position at 24 May 2024). The evidence relating to Ms Anato-Dumelo's participation in the webinar, conference and summit does not show use of the sign relied upon. Whilst I acknowledge the two invoices headed with 'King's Court Chambers', it is my view that, without more, this evidence falls short of establishing that a protectable level of goodwill had been generated.

104. Even if Ms Anato-Dumelo's evidence was sufficient to establish goodwill, the earliest identifiable use of the sign is the invoice dated 1 August 2020, relating to *pro bono* legal services provided in July 2020. To my mind, it is clear from the evidence that KCL's use of its word mark predated Ms Anato-Dumelo's earliest use of her sign 'King's Court Chambers'. In such circumstances, Ms Anato-Dumelo cannot establish an earlier right capable of preventing KCL's use by virtue of the law of passing off. Accordingly, Ms Anato-Dumelo's claim under section 5(4)(a) must fail.

Outcome

105. Ms Anato-Dumelo's opposition to KCL's word mark under sections 5(2)(b) and 5(4)(a) of the Act has failed in its entirety.

Overall outcomes

106. KCL's opposition has been successful. Subject to any appeal against this decision, registration of EAD's mark (application no. 3908621) will be refused.

107. Ms Anato-Dumelo's partial opposition has been unsuccessful. Subject to any appeal against this decision, KCL's word mark (application no. 3915285) will proceed to registration for all the applied-for goods and services.

Costs

108. KCL has been successful and is entitled to a contribution towards its costs. In her skeleton argument, Ms Collett made a request for me to depart from the usual scale. It was argued that 'off-scale' costs are appropriate on the basis that the filing of Ms Anato-Dumelo's opposition was vexatious. In this connection, Ms Collett pointed to the timing of it and her failure to provide corroborating evidence supporting her claim under section 5(4)(a) of the Act.

109. This request was maintained at the hearing, at which Ms Collett added that Ms Anato-Dumelo had indicated that her opposition was essentially retaliatory. Ms Collett also submitted that her attempts to give evidence at the hearing and her lateness with filing a skeleton argument should be taken into account.

110. Ms Anato-Dumelo resisted KCL's request for off-scale costs, disputing that her conduct in these proceedings amounts to unreasonable behaviour. She also submitted that reasons had been provided to the Tribunal prior to the hearing regarding the lateness of her skeleton argument.

111. Rule 67 of the Rules provides:

"The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid."

112. Tribunal Practice Notice (“TPN”) 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it.²⁶ The TPN stipulates that costs off the scale are *available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”*. KCL has not argued that Ms Anato-Dumelo has breached any rules or utilised delaying tactics. The matter at issue is whether her conduct in should be considered unreasonable behaviour, including whether the filing of her opposition was vexatious.

113. Firstly, I do not consider the filing of Ms Anato-Dumelo’s opposition to have been vexatious or indicative of unreasonable behaviour. There is no evidence of repeated proceedings being brought by Ms Anato-Dumelo against KCL. Ms Anato-Dumelo raised arguable grounds of opposition to KCL’s word mark on the basis of her earlier filed application. Both TPNs cited above make it clear that *“just because a party has lost, this in itself is not indicative of unreasonable behaviour”*. Although Ms Anato-Dumelo’s claims were ultimately unsuccessful, I do not consider them to have been entirely without merit. It is true that Ms Anato-Dumelo’s evidence was not sufficient, in my view, for the purposes of establishing that she had generated actionable goodwill under her sign, but I do not consider that to be sufficient for finding that the opposition was vexatious or that she has behaved unreasonably.

114. It is not entirely clear to me what Ms Anato-Dumelo meant by submitting at the hearing that she filed her opposition because she *“wanted the Registrar...to consider the totality of the arguments being presented”* and what she *“was hoping for was for both cases to be consolidated and considered”*. However, I do not consider that those comments amount to an admission that her opposition was retaliatory. In any event, Ms Anato-Dumelo’s opposition was filed on 15 September 2023. KCL’s opposition to her mark was actually filed later, on 27 September 2023. The factual circumstances of the proceedings do not support the notion that it was retaliatory. Moreover, there is no evidence that it was.

²⁶ The more recent TPN on costs (1/2023) reiterates the Tribunal’s discretion in this regard.

115. I acknowledge that Ms Anato-Dumelo's skeleton argument was filed late. In the official letter dated 11 February 2025, in which the hearing date was communicated to the parties, the Tribunal confirmed that skeleton arguments should be received by 14:00 on 16 June 2025. Ms Anato-Dumelo's skeleton argument was not filed until 00:53 on 17 June 2025. I cannot find any recorded details of a telephone conversation between her and the Tribunal in which she explained why her skeleton argument had been submitted late and was advised that it was "*completely fine*". However, parties who do not have a legally qualified representative are not required to provide skeleton arguments. Whilst Ms Anato-Dumelo is a barrister, she has represented herself throughout these proceedings and does not appear to be practicing in the field of intellectual property. Moreover, although the timing of the filing would have impacted upon the time in which KCL was on notice of Ms Anato-Dumelo's intended arguments, it would not have created any additional work for KCL. All in all, I do not consider the late filing of the skeleton argument to be indicative of unreasonable behaviour.

116. As for the complaint about Ms Anato-Dumelo giving evidence at the hearing, I agree that it did seem that she sought to expand a little on the matters actually in the evidence during oral submissions. However, none of that has been taken into account, and, aside from inviting me to ignore any matters that were not in evidence and raising it as a matter for costs, this did not create any additional work for KCL. Whilst the substantive hearing is not the time or place for giving evidence, of which I reminded the parties at the outset of the hearing, I do not consider Ms Anato-Dumelo briefly straying into evidential matters to be indicative of unreasonable behaviour.

117. Having considered the conduct of the proceedings, it is my view that off-scale costs are not appropriate in this instance.

118. The relevant scale is that published in TPN 1/2023.²⁷ In the circumstances, I award KCL the sum of **£2,450**, which is calculated as follows:

²⁷ Both oppositions having commenced after 1 February 2023.

Considering Ms Anato-Dumelo's statement and preparing a counterstatement ²⁸	£350
Preparing a statement and considering Ms Anato-Dumelo's counterstatement ²⁹	£400
Preparing evidence and considering Ms Anato-Dumelo's evidence	£800
Preparing for and attending a hearing	£700
Official fees	£200

119. I order Esther Anato-Dumelo to pay Kings Chambers Limited the sum of **£2,450**. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 30th day of June 2026

James Hopkins
For the Registrar

²⁸ In respect of Ms Anato-Dumelo's opposition to KCL's word mark.

²⁹ In respect of KCL's opposition to EAD's mark.