

O/0919/25

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

Background and pleadings

1. International trade mark 1749264 (“***the IR***”) consists of the sign shown on the cover page of this decision and stands registered in the name of LegalOn Technologies, Inc. (“***the Holder***”). The IR is registered with effect from 17 February 2023 but claims priority from the 12 October 2022¹. Also with effect from 17 February 2023, the Holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The date of protection of the IR in the UK is 30 November 2023. The IR was registered for goods and services in classes 9, 35, 42 and 45 which are outlined in **Annex A** of this decision.
2. On 06 May 2024, LEGALTECH ApS (“***the Applicant***”) applied to have the IR declared invalid under section 47 of the Trade Marks Act 1994 (“***the Act***”). The application for invalidity is based upon section 5(2)(b), 3(1)(b) and 3(1)(c) of the Act. The application is directed against all the goods and services in the IR under section 5(2)(b) of the Act. The application is directed against the goods and services in classes 9, 42 and 45 of the IR under section 3(1)(b) and 3(1)(c) of the Act.
3. Under section 5(2)(b), the Applicant relies upon the following trade mark (“***the Earlier Mark***”):

LEGALTECH

UK trade mark no. UK00003721710.

Filing date: 15 November 2021.

Registration date: 15 April 2022.

Relying upon all of the services for which the mark is registered, as set out in **Annex B** of this decision.

¹ This is claimed as a priority date from the Japan national trade mark no. 2022-117203 and also valid for the UK according to section 35 of the Act.

4. In its statement of grounds, the Applicant claims, under section 5(2)(b), the goods and services and the marks are highly similar giving rise to a likelihood of confusion, including the likelihood of association.
5. Under section 3(1)(b), the Applicant claims the IR is descriptive of the goods and services in classes 9, 42 and 45, and therefore lacks distinctiveness for the goods and services in classes 9, 42 and 45.
6. Under section 3(1)(c), the Applicant claims the IR can be seen to describe a legal solution built on a tech platform and, thus, it consists exclusively of signs or indications which may serve to designate the kind, quality or intended purpose or other characteristics of the registered goods and services in classes 9, 42 and 45.
7. On 18 July 2024, the Holder filed a counterstatement denying each of the claims made by the Applicant, arguing that the invalidation action should be rejected in its entirety and putting the Applicant to strict proof of each of its allegations.
8. The Applicant is represented by Michael Johansen and the Holder is represented by Mewburn Ellis LLP. During the evidence rounds, neither party filed evidence, but, both parties filed written submissions. Neither party requested a hearing, however, both parties filed submissions in lieu. The parties' submissions will not be summarised here but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.
9. 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.

Decision

Statutory provisions

10. The relevant provisions of Section 47 of the Act read as follows:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

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

(b) [...]

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) [...]

(c) [...]

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

11. The relevant provisions of section 3 of the Act are as follows:

“(1) The following shall not be registered –

[...]

(b) trade marks which are devoid of any distinctive character

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

[...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) [...] above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

12. The relevant date for determining whether the trade mark is subject to refusal on the absolute grounds set out in section 3 of the Act is the actual filing date (or priority date) of the application in the UK, i.e. 12 October 2022.

13. The grounds are independent and have different general interests. It is possible for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): see *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-392/02 P, paragraph

25. However, where a mark is descriptive of the goods or services for which it is registered, it necessarily lacks the required distinctiveness to avoid objection under section 3(1)(b). I therefore begin by considering the claim under section 3(1)(c).

Section 3(1)(c)

14. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art. 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of

any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation

No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

15. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice of the European Union (“CJEU”) held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

16. For a sign to be caught by the prohibition set out in section 3(1)(c), there must be a sufficiently direct and specific relationship between the sign and the goods or services for which it is registered, or sought to be registered, to enable the public concerned immediately to perceive, without further thought, a description of the

goods or services in question or one of their characteristics: see *Metso Paper Automation Oy v OHIM - PAPERLAB*, Case T-19/04, paragraph 25.

17. Regarding the relevant consumer, the Holder submits that the goods and services at hand are directed mostly at a professional public since they cover a large list of goods and services that range from software and electronics goods to business advisory, advertising and legal services.² The Applicant contends that the goods and services at hand are not only used by professionals and also the public at large is likely to use the goods and access the services in question for their personal needs (e.g., someone not specialised in law using the Holder's goods and/or accessing the services to draw a family law contract).³ Overall, I find that the average consumer is a member of the general public or a specialist consumer, depending on the goods or services at issue. When I am considering the goods and services, I shall make clear which of these types of consumers is, in my view, relevant.

18. The Holder contends that whilst "legal" describes something that relates to law and "tech" is short for "technology", the combination of "legalontech" is a neologism that is not used in common English parlance and it is devoid of any clear meaning in relation to the goods and services.⁴ The Applicant argues that the relevant consumer is likely to understand the IR as "a legal solution built on a tech platform".⁵ I note the parties' submissions and I agree with the Holder that the IR's word combination "legalontech" does not have a clear meaning in relation to the goods and services at hand. I find the relevant consumer (i.e., both the public at large and the professional public) may understand the mark as indicating, for example, "legal services concerning technology" or "legal services provided via technological means" (e.g., an online platform), but it may require the consumers some additional mental elaboration to derive a clear meaning from the IR.

19. The correct approach to assessing whether a mark is descriptive in relation to a specific product or service was described by Dr Brian Whitehead, sitting as the

² Holder's written submissions dated 22 November 2024, [25].

³ Applicant's submissions in lieu dated 6 February 2025, page 2.

⁴ Holder's written submissions dated 22 November 2024, [30] – [32] and [53].

⁵ Applicant's written submissions dated 23 September 2024, page 2.

Appointed Person, in *Dr Kurt Wolff GmbH & Co KG v Coswell S.P.A.*, BL O/0301/25:

“36. The Court of Appeal in *J. W. Spear v Zynga* [2015] FSR 19 analysed the law on descriptiveness and gave approval to the analysis of the Advocate-General in his opinion in *DOUBLEMINT* [2003] ECR I-2447 at [61]-[64], in which he identified the following as the relevant question for determining whether a mark is descriptive in relation to a specific product:

‘(i) how factual and objective is the relationship between an indication and the product or one of its characteristics? (ii) how readily is the message of the indication conveyed? And (iii) how significant or central to the product is the characteristic? Asking these questions will assist a fact-finding tribunal to determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods.’

37. That approach necessitates a product by product (or service by service) analysis. Whereas it is permissible to consider goods or services in groups, care must be taken to ensure that all members of each group share the same characteristics [...]”.

Class 9

20. The goods are software (including application software) and hardware (e.g., computer hardware, electronic components, audio-video compact discs) and electronic publications either at large or applied to specific professional fields (i.e., contract drafting, document management and assistance in the field of legal affairs). Neither party put forward submissions regarding the descriptive nature of the IR specifically in relation to class 9. I am of the view that the IR, in relation to the class 9 goods, is merely suggestive and/or allusive of the fact that the goods (e.g., software, hardware or electronic publications whether at large or provided for legal and/or business purposes) concern or relate to legal matters and are provided via technological means or relate to technology. Although I appreciate that “legal” and “tech” have some semantic correlation to the goods at hand, especially regarding those goods that are offered for legal purposes (e.g., assistance in the

field of legal affairs, contract drafting and downloadable templates for contracts, regulations and legal documents) and that they are technological in nature (e.g., software), nonetheless, I find the IR to be merely suggestive and not descriptive of, for example, the kind and/or the intended purpose of the goods at hand. This is even more so in relation to goods such as “electronic calculators”, “electronic control apparatus” or “audio-video compact discs” with which the IR does not have any semantic correlation. In reaching this decision I am reminded that although the individual words forming a mark may be used in everyday speech to designate a function of the mark’s goods (or services), such mark is not considered to be descriptive where the words’ syntactically unusual juxtaposition is not a familiar expression in the English language to describe the essential characteristics of the goods (or services).⁶ I find this to be the case and the mark not to be descriptive for the goods in class 9.

Class 42

21. The class 42 services essentially consist of technological services of various nature such as for example, design and/or programming of software or hardware (and consultancy services thereof), computer platforms/websites, provision of software as a service (including hosting of websites), graphic art (for promotional purposes) or industrial design, data monitoring, storage and recovery including cloud storage services, rental or provision of computer programs, research and development of computer systems and programs, and technological consultancy services (including consulting related to survey, research and development of scientific technologies).

22. Neither party filed submissions specifically addressing the IR’s descriptiveness for the class 42 services. It is my view that the same findings and reasoning outlined in the paragraph above also apply to the services at hand. The term ‘legalontech’ may share some semantic connection with these services, as they are technological in nature and, in certain cases, relate to the legal field (e.g., contract drafting or evidence preservation). However, the IR remains merely suggestive.

⁶ Case C-383/99 P, *Procter & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), BABY-DRY*, [43].

and it does not exclusively describe the kind, intended purpose and/or any other characteristics of the services.

Class 45

23. The services are all essentially legal services. The relevant consumers for these services are the professional public, for example, businesses seeking legal assistance for contract drafting, and the general public such as, for example, individuals in need of legal assistance for personal reasons. As outlined in the paragraphs above, the same reasoning applies to the services in class 45, and I find the IR to be merely suggestive and/or allusive of the kind or intended purpose of the services at hand. The average consumer would be required a number of mental steps to make a semantic connection between the mark and the services. Absent any submissions from the parties specifically addressing the IR's descriptiveness for the class 45 services, I find that the mark is not descriptive for these services.

24. The section 3(1)(c) ground is unsuccessful.

Section 3(1)(b)

25. The principles to be applied under Article 7(1)(b) of the CTM Regulation (which is now Article 7(1)(b) of the EUTM Regulation, and is identical to Article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*, Case C-265/09 P, as follows:

“29. [...] the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

26. The Applicant, in its statement of grounds, submitted that the IR is descriptive of the goods and services at hand and, therefore, it lacks distinctiveness in relation to the classes 9, 42 and 45. In support of this argument, the Applicant contends that when it applied to register "LEGALTECH" for similar services in classes 42 and 45 to those at hand, the application failed for these classes because it was found that the mark identified 'TECH' services provided in the 'LEGAL' field. The

Applicant claims, therefore, that the same reasoning should be analogously apply to the IR “legalontech” and the services for which it is registered, leading to the conclusion that the IR lacks distinctive character. The Applicant did not provide me with the decision it refers to and it does not clarify further on the alleged IR’s lack of distinctive character. The Holder contends that whilst ‘LEGALTECH’ was correctly deemed non-distinctive since the term is used in common parlance to refer to “the use of technology and software to provide legal services and support the legal industry”, the Holder argues that this meaning does not apply to the word “legalontech”.⁷ The Applicant argues that whilst ‘LEGALTECH’ could be understood with such meaning, this would only be true for the professional public (e.g., legal, technical or business community), while the general public would not be familiar with this meaning. To this end, the Applicant submitted that both the Cambridge and Oxford English dictionaries did not give results for the word “legaltech” or “legal tech”.⁸ The Holder also submits that the IR is capable to serve as an identifier for the Holder’s goods and services in issue as originating from the Holder (i.e., origin function).⁹ I already found that the IR is not descriptive of the goods and services at hand. Whilst I appreciate that the IR is allusive of the ‘technical’ nature of the goods and services and the fact that they relate to a ‘legal field’, however that in itself does not mean that the IR is not capable of identifying the trade origin of the goods and services for which it was registered. As the Applicant did put forward no other reason why the mark is devoid of distinctive character, the section 3(1)(b) ground fails.

Section 5(2)(b)

27. Section 5(2)(b) of the Act is 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

⁷ Holder’s written submissions dated 22 November 2024, [60].

⁸ Applicant’s submissions in lieu dated 6 February, page 3.

⁹ Holder’s submissions in lieu dated 6 February 2025, [67].

public, which includes the likelihood of association with the earlier trade mark”.

28. Due to its earlier filing date, the trade mark upon which the Applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. The earlier mark has not completed its registration process more than five years before the relevant date (the filing date of the Holder’s IR). Accordingly, the use provisions at section 47(2A) of the Act do not apply. The Applicant may rely on all of the goods it has identified without demonstrating that it has used its mark.

Case law

29. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 be dominated by one or more of its components;

(f) however, it is also 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 great degree of similarity between the marks, and vice versa; Page 8 of 20

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks 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 goods and services

30. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have

pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.

31. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

32. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

33. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of

similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

34. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

35. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

36. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should

not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

37. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

38. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

“[...] definitions of services ... are inherently less precise than specifications of goods. [...]

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They

should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

39. Section 60A(1)(a) of the Act provides that goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

40. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.¹⁰

41. The goods and services for comparison are as follows:

Applicant's goods	Holder's goods
<p><u>Class 35:</u></p> <p>Advertising; Business management; Business administration; Business management assistance; Data management services; Data processing; Electronic data processing; Document preparation; Business advice relating to marketing; Business consulting; Business research for new businesses; Business consultancy and advisory services; Arranging and conducting of displays for advertising purposes; Demonstration of goods and services by electronic means, also for the benefit of the so-called teleshopping and homeshopping services; Sales demonstration [for others]; Organization</p>	<p><u>Class 9:</u></p> <p>Application software for assisting contract drafting and document management; electronic calculators; computer peripheral devices; electronic control apparatus; electronic components; hardware for electronic calculators; software for electronic calculators; application software; application software for providing assistance in the field of legal affairs; application software for providing assistance in the field of business organization; programs for electronic calculators; downloadable image files; recorded video discs and video tapes; electronic publications; data processors;</p>

¹⁰ *Separode Trade Mark* (BL O/399/10), per Mr Geoffrey Hobbs QC, sitting as the Appointed Person; and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35, at paragraphs 30 to 38).

of exhibitions for commercial or advertising purposes; Arranging of demonstrations for advertising purposes; Arranging of demonstrations for advertising purposes; Dissemination of advertising for others via an on-line communications network on the internet; Dissemination of advertisements via the Internet; Dissemination of advertising, marketing and publicity materials; Provision of space on web-sites for advertising goods and services; Administrative support and data processing services; Compiling indexes of information for commercial or advertising purposes; Compilation of information into computer databases; Updating and maintenance of data in computer databases; Data search in computer files for others; Data processing; Business administration; Administrative services relating to the management of legal dockets; Automated data processing; Business administration assistance; Computerised data verification; Data processing, systematisation and management; Business administration; Updating and maintenance of information in registries; Competitive intelligence services; Business research; Business investigations; Consumer profiling for commercial or marketing purposes;

computers; computer hardware; computer peripherals; recorded computer software; recorded computer programs; audio-video compact discs; electronic publications, downloadable; electronic publications, downloadable, namely, downloadable templates for contracts, regulations and legal documents.

Class 35:

Development of advertising concepts; layout services for advertising purposes; personnel placement and placement of staff; employment agencies; consultancy and providing information relating to personnel placement and placement of staff; advertising services; advertising consultation; providing information about newspaper articles being news clipping services; business management analysis and business consultancy; research and analysis for business risk management; market analysis and research services; business consultancy; marketing consulting; providing information in the field of marketing; input of data into computer databases for collection, analysis and management of digital data and information services relating thereto; compiling of information into computer databases and information services

<p>Market studies; Professional business consultancy; Providing business information via a web site; Updating of business information on a computer data base; Computerised business information services; Business analysis and information services, and market research; Consultancy relating to the establishment and running of businesses; Business information services provided on-line from a computer database or the internet; Commercial information services provided by access to a computer database; Market research by means of a computer data base; Provision of computerised data relating to business; Provision of business data; Providing online commercial directory information services; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Business and market research.</p> <p><u>Class 36:</u></p> <p>Finance services; Insurance underwriting; Capital investment; Fund investment services; Investment management; Administration of funds and investments; Financial consultancy relating to real estate investment; Financial underwriting and securities</p>	<p>relating thereto; data search in computer files via an online computer database for others; duplication of documents; filing of documents or magnetic tapes [office functions]; advertising; news clipping services; marketing in the framework of software publishing; business consulting services; outsourced administrative management for companies; administration of consumer loyalty programs; targeted marketing; data processing services [office functions]; updating and maintenance of data in computer databases; business information services; business management and organization consultancy; registration of written communications and data; photocopying services; data search in computer files for others; data processing in the field of legal affairs; data processing in the field of contracts; consultancy relating to efficiency improvement in clerical services in the field of legal affairs; business consulting services for assisting legal professionals in organizing and setting up their practices for legal document services to their clients; data processing services [office functions].</p> <p><u>Class 42:</u></p>
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issuance (investment banking); Financial services relating to investment; Financing of investments; Providing financing to emerging and start-up companies; Providing information relating to securities underwriting; Investment banking consulting and advisory services; Investment portfolio management services; Underwriting of shares (Services for the -); Development of investment portfolios; Financial consultancy; Financial valuation of intellectual property assets; Financial analysis; Financial research; Providing financial information via a web site; Financial analysis and consultancy; Financial information services provided by access to a computer database; Financial consultancy and information services; Financial planning services; Financial and investment consultancy services; Consultancy services relating to corporate finance; Financial appraisal services; Financial appraisals and valuations; Crowdfunding; Venture capital services; Venture capital (Services for the provision of -); Charitable fund raising; Arranging charitable collections [for others]; Organization of monetary collections; Financial sponsorship; Fundraising; Charitable fund raising; Intellectual

Design, programming and maintenance of computer programs; design, programming and maintenance of computer software; rental of computer programs; rental of computer software; rental of electronic memory space on the Internet; providing computer programs on data networks; providing computer software on data networks; computer system analysis and information services relating thereto; providing scientific and technological information; design services; graphic design of promotional materials; hosting of web sites; hosting of computerized data, files, applications and information; technological advice relating to computers, automobiles and industrial machines; design and development of computer hardware; designing of machines, apparatus, instruments [including their parts] or systems composed of such machines, apparatus and instruments; computer programmatically monitoring of electronic data in computer data storage and of input-output data; restoring and recovering digital data using computers; research and development of computer system and data processors for preservation of evidence; research and development of computer programs for analysis and disclosure of analysis

property valuation services; Valuations and financial appraisals of property.

Class 41:

Entertainment services; Sporting and cultural activities; News reporters services; Services for the publication of travel guides; Publication of manuals.

results of digital data; research and development of computer programs for classifying, mining, converting and processing of digital data; consulting related to survey, research and development of information-processing technology and communication technologies; consulting related to survey, research and development of scientific technologies; graphic art design; industrial design; consultancy in the design and development of computer hardware; computer technology consultancy; Information technology [IT] consulting services; computer software design; maintenance of computer software; development of computer platforms; creating and maintaining web sites for others; providing search engines for the Internet; research and development of new products for others; software as a service [SaaS]; software as a service [SaaS] featuring software for providing assistance in the field of legal services; software as a service [SaaS] featuring software for providing assistance in the field of business organization and management; computer rental; hosting computer websites; platform as a service [PaaS]; electronic storage services for archiving electronic data; conducting technical project studies; research in the field of

	<p>telecommunications technology; providing online non-downloadable application software for use in drafting contracts and management support thereof; research in the field of artificial intelligence technology; technological consultancy services for digital transformation; cloud storage services for electronic files for contracts, regulations and legal documents; electronic storage of files for contracts, regulations and legal documents.</p> <p><u>Class 45:</u></p> <p>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; online social networking services; legal consultancy and providing legal information related to social insurance claims; investigation or surveillance services for checking background profiles; information</p>
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	<p>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.</p>
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42. The Applicant contends that the class 9 goods are complementary to and share a similar nature with the Holder’s services in class 35, 36 and 41 because consulting firms usually provide technology services in addition to their core business services.¹¹ The Applicant, in its statement of grounds, also provides a table showing in bold the services that allegedly cover the Holder’s goods and services. The Applicant did not articulate further on the goods and/or services’ similarity. The Holder argues that the goods in class 9 differ from the Applicant’s services in that they have different natures, purposes, methods of use and are neither complementary nor in competition. The Holder also contends such dissimilarity exists on the basis that the respective goods and services require completely different expertise, they do not share the same distribution channels and providers, and it is argued that the mere finding that the respective goods and services share the same users is not enough to find similarity.¹²

43. The parties did not particularise further on the similarity of the respective goods and services. Thus, I will make my own assessment as detailed below. In reaching my findings I have born in mind the parties’ arguments outlined above and have factored them into my findings.

Class 9

- *“Application software for assisting contract drafting and document management; application software for providing assistance in the field of legal affairs”*

¹¹ Applicant’s written submissions dated 23 September 2024, page 4.

¹² Holder’s written submissions dated 22 November 2024, [22].

44. The Holder's goods above consists of software used in relation to legal affairs at large (including, for example, contract drafting and document management). The Applicant's specification in class 35 contains the terms "*Document preparation*" and "*Administrative services relating to the management of legal dockets*" in class 35. Whilst I appreciate that the goods and services have different nature (software versus services for document preparation and management) and method of use, the goods and services share the same intended purpose (i.e., document creation and/or management). The goods and services are unlikely to share the same providers or trade channels because the businesses using the software goods (e.g., law firms) are likely to purchase bespoke software from specialised software providers to offer their services (i.e., contract drafting, document management or other legal services). However, I do not exclude that some overlap in users may exist insofar there could be instances where users from the general public directly access software for their needs (e.g., to download templates to draft contracts or to manage documents) instead of turning to a law firm for these kinds of services. Therefore, to some extent, the goods and services are complementary and can be in competition. I find the goods and services to be similar at least at a low degree.

- "*recorded computer software; application software; recorded computer programs*"

45. The goods above consist of computer software (including application software) and programs. With regard to the Applicant's financial services in class 36 (e.g., "*Finance services*"; "*Financial consultancy*"; "*Financial consultancy and information service*") I am reminded of the Appointed Person's findings in case number BLO/531/22 where Thomas Mitcheson QC found that although the goods and services in object differ in their nature, trade channels and are not in competition, nonetheless as computer software and mobile applications may be used to support the provision of financial services (e.g., to give advice, present details of a client portfolio, or to enable transactions), such complementary nature warrants a low level of similarity between the goods and services. As I find the

same reasoning should apply in this case, I find the goods and services at hand to be similar to a low degree.¹³

- *“application software for providing assistance in the field of business organization”*

46. With regard to the Applicant’s *“Business management”* services in class 35, similarly to the findings at paragraph above, although the respective goods and services differ in their nature, method of use, trade channels and target users, nonetheless they share the same intended purpose (i.e., business organisation) and are complementary insofar as the Holder’s software can be used to support the provision of business organisation services. Therefore, overall, the goods and services at hand are at least similar to a low degree.

- *“software for electronic calculators; programs for electronic calculators; electronic calculators”*

47. The terms above consist of software and hardware for calculating. It may be argued that electronic calculators may be used to support the provision of some of the Applicant’s services such as, for example, *“Data processing”* services in class 35. In this regard, electronic calculators may be used to carry out data analysis. Nevertheless, the goods and services at hand have different nature (calculators versus data processing services) and method of use. The goods and services likely target different users, have different providers and do not share the same trade channels. Although there may be some degree of complementarity between these goods and services, they are not in competition with each other. Overall, I find them to be dissimilar.

- *“computer peripheral devices; electronic control apparatus; electronic components; hardware for electronic calculators; data processors; computers; computer hardware; computer peripherals; audio-video compact discs”*

48. All the above goods are hardware. In abstract they could be said to support the provision of the Applicant’s *“Data processing”* services in class 35. However, as the goods above are generic pieces of hardware, and absent further submissions

¹³ BLO/531/22, [16] – [22].

from the parties, I do not find the respective goods and services to be complementary to the extent to warrant a finding of a low level of similarity. In case I am mistaken, and the respective goods and services are complementary, in any case, I believe such level of similarity to be on an excessively general level for me to find that the goods and services are similar.¹⁴ Thus, the goods above are dissimilar from any of the Applicant's services.

- “*recorded video discs and video tapes*”

49. The Applicant's specification features “*Entertainment services*” in class 41. The Holder's broad terms above can include any type of video recorded on these storage media (e.g., DVDs and VHS), therefore also including recorded entertainment videos. I appreciate that in the current Internet era, entertainment services are provided mainly on streaming platforms and the provision of such services through recorded videos on physical storage media is quite uncommon; however, I cannot exclude such possibility a priori also considering the fact that digital videos are still being downloaded on physical media. Whilst the goods and services have different nature and method of use, they share the same intended purpose (provision of entertainment services). They differ in trade channels (streaming v physical media), but they share the same users. In instances where the entertainment services are distributed via physical media the goods/services are also complementary and can be in competition in that consumers may choose between streamed entertainment content or downloading/purchasing the entertainment services on physical media. Overall, the respective goods and services have a medium degree of similarity.

- “*electronic publications; electronic publications, downloadable; downloadable image files*”

50. The Applicant's specification in class 35 features “*Advertising*” and “*Dissemination of advertising, marketing and publicity materials*”. It may be argued that there is some similarity between the Holder's electronic publications (including downloadable publications and image files) and the Applicant's advertising and

¹⁴ *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch).

marketing services. I accept that businesses pay magazines and other providers of publications to use space for advertising and promotional purposes. I also accept that consumers may download images that constitute marketing material such as, for example images featuring leaflets or other advertising material. Consequently, there will be overlap in trade channels between these services as the sellers of magazines may also be selling advertising space. However, the nature, method of use, user and purpose of the goods and services clearly differ. They will be similar to only a low degree.

- *“electronic publications, downloadable, namely, downloadable templates for contracts, regulations and legal documents”*

51. The Holder’s goods above are electronic legal documents available for download. The Applicant provides *“Document preparation”* services in class 35 which can encompass the preparation of legal documents. The goods and services have different nature (preparation of documents versus legal documents) and method of use. The goods at hand are the end result of the Applicant’s services, therefore, they share the same intended purpose (i.e., to provide documents for the users). Consumers can choose between downloading the documents directly to draft them themselves or having them provided by a third-party provider (e.g., law firm), therefore the goods and services can be in competition, but they are unlikely to share the same trade channels and are not complementary. Overall, I find the goods and services are similar to a low degree.

Class 35

- *“Development of advertising concepts; layout services for advertising purposes; advertising services; advertising consultation; marketing consulting; providing information in the field of marketing; advertising; marketing in the framework of software publishing; administration of consumer loyalty programs; targeted marketing”*

52. The above terms all fall within the Opponent’s wider term *“Advertising”*. Therefore, the services at hand are identical in line with *Meric*.

- *“providing information about newspaper articles being news clipping services; news clipping services”*
- The Applicant’s specification in class 35 features the terms *“Business management”* and *“Business advice relating to marketing”*. News clipping provides the media’s perception of an undertaking, and it can influence business management choices. Although these services have different nature, they can overlap in method of use and intended purpose. Companies providing business and marketing advice can also provide news clipping services, therefore, the services at hand share the same consumers and trade channels. These services can be complementary, but they are unlikely in competition with each other. Overall, I find these services to have a medium degree of similarity.
- *“personnel placement and placement of staff; consultancy and providing information relating to personnel placement and placement of staff; employment agencies”*

53. Personnel/staff placement and employment services are essentially services which are provided to businesses wishing to locate people for the purposes of employment. They would include the services offered by employment agencies and “headhunters”. In comparison to the Applicant’s services of *“Business management”*, *“Business administration”*, and *“Business consulting”*, the purpose and nature of a business administration service is the provision of administrative assistance to complete certain administrative tasks. The purpose of business management is to assist in the running of the business, including matters of strategy and organisation. There is nothing implicit in this that they perform any form of recruitment function. Thus, the nature and purpose of employment or recruitment services differ from those of business administration or business management. The methods of use also differ. I also find the respective services neither compete nor are any of the services indispensable or important for the use of those of the other side, in such a way that the relevant consumers may think that responsibility for them lies with the same undertaking. Accordingly, I find no similarity.

- *“business management analysis and business consultancy; research and analysis for business risk management; market analysis and research services; business consultancy; business consulting services; business information services; business management and organization consultancy; business consulting services for assisting legal professionals in organizing and setting up their practices for legal document services to their clients; consultancy relating to efficiency improvement in clerical services in the field of legal affairs; outsourced administrative management for companies”*

54. In its counterstatement, the Holder admits that some of its broader class 35 services such as “business management” and “business consultancy” are identical or similar to the same services in the Applicant’s specification. I acknowledge the Holder’s concession and I find that, in addition, the services listed above all clearly fall within the Applicant’s wider services “*Business management*”, “*Business consultancy and advisory services*”, and “*Business administration*” in class 35. Therefore, I find all respective services at hand to be identical in line with the principle outlined in *Meric*.

- *“input of data into computer databases for collection, analysis and management of digital data and information services relating thereto; compiling of information into computer databases and information services relating thereto; data search in computer files via an online computer database for others; data processing services [office functions]; updating and maintenance of data in computer databases; registration of written communications and data; data search in computer files for others; data processing in the field of legal affairs; data processing in the field of contracts; data processing services [office functions]”*

55. The above services fall within the Applicant’s wider services “*Data processing, systematisation and management*” and “*Updating and maintenance of information in registries*” in class 35. Therefore, the respective services are *Meric* identical.

- *“filing of documents or magnetic tapes [office functions]”*

56. I find that these services have no counterpart in the Applicant’s specification and the Applicant has not provided any specific reasons why I should find these

services to be similar to any of the Holder's goods and/or services. The Applicant's services at hand all have different natures, purposes, uses, users, methods of use, they do not share trade channels and are neither complementary nor in competition. Thus, the services in question are dissimilar.

- “*duplication of documents; photocopying services*”

57. I find the closest services in the Applicant's specification to be “*Business administration*” in class 35 because the services above are all ancillary to the run of a business, however, I find it very unlikely that a company would outsource such services and rely on a third-party business for the copying of their documents. The services above are more likely offered to the general public for their private use (i.e., photocopy of personal documents). Therefore, I find the services are dissimilar in that they have different nature, method of use and intended purpose. They neither target the same users, nor share the same trade channels and they are not complementary or in competition.

58. I also considered that the services above could be similar to the Applicant's “*Document preparation*” services in class 35. However, I also find these services to be clearly dissimilar as the mere copy of a document is not, by definition, the same as “preparing” (i.e., redacting) a document and I do not see how these services would be provided together to the same consumers.

Class 42

- “*Design, programming and maintenance of computer programs; design, programming and maintenance of computer software; computer software design; maintenance of computer software; software as a service [SaaS]; software as a service [SaaS] featuring software for providing assistance in the field of legal services; software as a service [SaaS] featuring software for providing assistance in the field of business organization and management; providing online non-downloadable application software for use in drafting contracts and management support thereof; providing computer programs on data networks; providing computer software on data networks; electronic storage services for archiving electronic data; cloud storage services for electronic files for contracts, regulations*”

and legal documents; electronic storage of files for contracts, regulations and legal documents; rental of electronic memory space on the Internet

59. The Holder's services above differ from any of the Applicant's services in class 35, 36 and 41. In reaching my conclusion I considered the Applicant's "Data processing" services as the closest services to those of the Holder listed above. However, I find that the respective services do not have the same nature (i.e., software design/provision versus data processing), method of use or intended purpose. The services do not target the same users and are unlikely to share the same trade channel. They are neither complementary nor in competition.

- *"development of computer platforms; creating and maintaining web sites for others; hosting computer websites; platform as a service [PaaS]; hosting of web sites; hosting of computerized data, files, applications and information; providing search engines for the Internet"*

60. The Holder's services above all consist of development and/or provision of web platforms and internet search engines. The Applicant's class 35 contains, among others, data processing and data management services. Whilst the respective services have different nature, intended purpose and method of use they could overlap in providers, users and trade channels in circumstances where, for example, a platform provider also offers data analysis of the website's traffic for the website they provide or other data relating to the website's functioning. However, the services are not complementary and are unlikely to be in competition with each other. Overall, I find the services are lowly similar.

- *"design services; design and development of computer hardware; designing of machines, apparatus, instruments [including their parts] or systems composed of such machines, apparatus and instruments; consultancy in the design and development of computer hardware; industrial design"*

61. The services above essentially are design services (e.g., product design) for the manufacture of hardware (e.g., machines, apparatuses, instruments and computers). Absent further clarification from the parties, I find these services to be dissimilar to any of the Applicant's terms in classes 35, 36 or 41.

- “computer programmatically monitoring of electronic data in computer data storage and of input-output data”

62. The services above consist of the process of tracking and managing the performance and overall health of storage systems. The Applicant’s specification features the more general term “*Data processing*” which refers to any process performed to transform raw data into meaningful and usable information. I find the services to be highly similar insofar as they share the same nature (i.e., analysis of data to derive information), method of use and intended purpose (i.e., to derive information from data such as, for example, to assess storage systems). Data processing is likely an intrinsic (and essential) activity for those businesses that offer storage monitoring services, therefore the services at hand likely overlap in trade channels and target the same users, although they may not be in competition with each other. The services can also be complementary as data processing can be an integral process of data monitoring to assess storage systems.

- “restoring and recovering digital data using computers”

63. The Applicant’s specification contains the term “*Data processing, systematisation and management*” in class 35. Whilst both services deal with data, their nature and intended purpose are different. The services overlap in trade channels as they could be provided together by the same service provider and can target the same users requiring a range of services relating to data (e.g., data recovering and data processing). Given the services’ different nature and purpose, they are neither complementary nor in competition with each other. Overall, I find the services to have a low degree of similarity.

- “graphic design of promotional materials; graphic art design”

64. The Applicant’s class 35 specification features the term “*Dissemination of advertising, marketing and publicity materials*”. Marketing companies can provide graphic design services as part of their offerings to enhance branding and support digital marketing strategies. The services have different nature (i.e., creation versus dissemination of marketing material), method of use, and intended

purpose. They share the same providers, target users and trade channels. These services also are likely to be in competition and they are complementary with each other in that the dissemination of marketing material requires the prior creation (i.e., design) of such promotional material. Overall, the services have a medium degree of similarity.

- *“rental of computer programs; rental of computer software; computer rental”*

65. The Holder’s services above differ from any of the Applicant’s services in class 35, 36 and 41. Absent further articulation from the parties, I find the terms above to be dissimilar.

- *“research and development of computer system and data processors for preservation of evidence; research and development of computer programs for analysis and disclosure of analysis results of digital data; research and development of computer programs for classifying, mining, converting and processing of digital data; research and development of new products for others; conducting technical project studies; research in the field of telecommunications technology; research in the field of artificial intelligence technology”*

66. The above terms consist of research and development services of various technological nature (e.g., computer programs, telecommunications technologies and AI). I appreciate that the Applicant’s specification features “*Data processing*” services and the services above are aimed at developing technology for processing data. However, I find that the Holder’s services differ from those of the Applicant’s in that the Holder’s services consist of research and development of the technology later used for the provision of data processing services by different users. Therefore, the services differ in their natures, methods of use and intended purposes. They are not in competition nor complementary and they do not share the same trade channels or target the same users. Therefore, they are different.

- *“consulting related to survey, research and development of information-processing technology and communication technologies; consulting related to survey, research and development of scientific technologies; computer technology consultancy; Information technology [IT] consulting services; technological*

consultancy services for digital transformation; computer system analysis and information services relating thereto; providing scientific and technological information; technological advice relating to computers, automobiles and industrial machines”

67. All the above are consulting and information services of scientific and/or technological nature. Absent further submissions from the parties, I find such services to differ from those of the Applicant in classes 35, 36 and 41.

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.¹⁵ 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”*.¹⁶

¹⁵ Applicant’s statement of grounds dated 6 May 2024, page 4.

¹⁶ 17/10/2016, R 1185/2015-5, CVC CAPITAL PARTNERS/CVC CAPITAL PARTNERS, [33].

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.¹⁷

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 not similar.

- "*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.

Conclusion on the goods and services similarity

¹⁷ Holder's submissions in lieu dated 6 February 2025, [30].

71. Under section 5(2)(b), a degree of similarity between the goods and/or services is essential for there to be a finding of a likelihood of confusion. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49 [...] I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

72. The invalidity action against the terms that I have found to have no similarity to the Applicant’s goods and services therefore fails at this point. For ease of reference, those terms are:

Class 9 Computer peripheral devices; electronic control apparatus; electronic components; hardware for electronic calculators; data processors; computers; computer hardware; computer peripherals; audio-video compact discs; software for electronic calculators; programs for electronic calculators; electronic calculators.

Class 35 Personnel placement and placement of staff; consultancy and providing information relating to personnel placement and placement of staff; employment agencies; filing of documents or magnetic tapes [office functions]; duplication of documents; photocopying services.

Class 42 Design, programming and maintenance of computer programs; design, programming and maintenance of computer software; computer software design; maintenance of computer software; software as a service [SaaS]; software as a service [SaaS] featuring software for providing assistance in the field of legal services; software as a service [SaaS] featuring software for providing assistance in the field of business organization and management; providing online non-downloadable

application software for use in drafting contracts and management support thereof; providing computer programs on data networks; providing computer software on data networks; electronic storage services for archiving electronic data; cloud storage services for electronic files for contracts, regulations and legal documents; electronic storage of files for contracts, regulations and legal documents; rental of electronic memory space on the Internet; design services; design and development of computer hardware; designing of machines, apparatus, instruments [including their parts] or systems composed of such machines, apparatus and instruments; consultancy in the design and development of computer hardware; industrial design; rental of computer programs; rental of computer software; computer rental; research and development of computer system and data processors for preservation of evidence; research and development of computer programs for analysis and disclosure of analysis results of digital data; research and development of computer programs for classifying, mining, converting and processing of digital data; research and development of new products for others; conducting technical project studies; research in the field of telecommunications technology; research in the field of artificial intelligence technology; consulting related to survey, research and development of information-processing technology and communication technologies; consulting related to survey, research and development of scientific technologies; computer technology consultancy; Information technology [IT] consulting services; technological consultancy services for digital transformation; computer system analysis and information services relating thereto; providing scientific and technological information; technological advice relating to computers, automobiles and industrial machines.

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; online social networking services.

73. I will now continue with the assessment of the invalidity action based on section 5(2)(b) of the Act in respect of the similar goods and services outlined below.

Class 9 Application software for assisting contract drafting and document management; application software for providing assistance in the field of legal affairs; recorded computer software; application software; recorded computer programs; application software for providing assistance in the field of business organization; recorded video discs and video tapes; electronic publications; electronic publications, downloadable; downloadable image files; electronic publications, downloadable, namely, downloadable templates for contracts, regulations and legal documents.

Class 35 Development of advertising concepts; layout services for advertising purposes; advertising services; advertising consultation; marketing consulting; providing information in the field of marketing; providing information about newspaper articles being news clipping services; advertising; news clipping services; marketing in the framework of software publishing; administration of consumer loyalty programs; targeted marketing; business management analysis and business consultancy; research and analysis for business risk management; market analysis and research services; business consultancy; business consulting services; business information services; business management and organization consultancy; business consulting

services for assisting legal professionals in organizing and setting up their practices for legal document services to their clients; consultancy relating to efficiency improvement in clerical services in the field of legal affairs; outsourced administrative management for companies; input of data into computer databases for collection, analysis and management of digital data and information services relating thereto; compiling of information into computer databases and information services relating thereto; data search in computer files via an online computer database for others; data processing services [office functions]; updating and maintenance of data in computer databases; registration of written communications and data; data search in computer files for others; data processing in the field of legal affairs; data processing in the field of contracts; data processing services [office functions]”

Class 42 Development of computer platforms; creating and maintaining web sites for others; hosting computer websites; platform as a service [PaaS]; hosting of web sites; hosting of computerized data, files, applications and information; providing search engines for the Internet; computer programmatically monitoring of electronic data in computer data storage and of input-output data; restoring and recovering digital data using computers; graphic design of promotional materials; graphic art design.

Average consumer and the purchasing act

74. It is necessary for me to determine who the average consumer is for the goods and services in question; I must then determine the manner in which the goods and services are likely to be selected by the average consumer in the course of trade.

75. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *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), Birss J. described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

76. The Holder contends that the goods and services at hand range from software and electronics to business advisory services and advertising to legal services and that such goods and services are mostly directed at a professional public, who will likely show an above-average degree of attention when considering the marks.¹⁸ The Applicant submits that its products are not only used by professional users.¹⁹

77. I acknowledge the parties’ submissions. I find that the relevant consumer for the goods in class 9 (e.g., computer software/programs, application software, recorded video discs/video tapes and electronic publications) and for the services in class 45 (online social networking services) will be the general public. For those more specialised goods in class 9 such as, for example, application software for contract drafting, document management, assistance in the field of legal affairs or in the field of business organization, the relevant consumers will be professionals in the legal or business fields (e.g., law firms or business advisors). For goods such as downloadable templates for contracts, regulations and legal documents in class 9 the relevant consumer will be both the general and professional public (e.g. law firms). Regarding this latter consideration, I remind myself that the likelihood of confusion must be assessed from the perspective of the general public (rather than the professional one) since they are the group who will pay the lower degree of attention.²⁰

¹⁸ Holder’s written submissions dated 22 November 2024, [25].

¹⁹ Applicant’s submissions in lieu dated 6 February 2025, page 2.

²⁰ Case T-356/14, [25] – [26].

78. The average consumer for the services in class 35 (i.e., advertising services, business management consultancy, consultancy in the field of legal affairs, processing, updating and maintenance of data) and in class 42 (i.e., development and provision of platforms as a service including maintaining and hosting of web sites or providing search engines; graphic design of promotional materials) will be professionals such as law firms or businesses.
79. The costs of the goods and services will likely vary according to the level of specialisation of the goods or services being purchased; on balance the price can range from relatively low (e.g., for online networking services) to high (but not the highest) for business management or legal consultancy. When purchasing the goods in class 9 and the services in class 45, the general public will take various factors into consideration such as cost, functionalities, compatibility for software/programs, the platform's network, the content for electronic publications and the general suitability to their needs. Consequently, I consider that the degree of attention paid by the average consumer when selecting the more general (and less specialised) goods in class 9 and the services in class 45 will be medium.
80. When purchasing the more specialised goods in class 9 and the services in classes 35 and 42, the average consumer will be professionals who would want to ensure that the goods and services they purchase will be provided professionally and will meet their particular business needs. Accordingly, the relevant consumers will take various factors into consideration such as the nature of the goods and services, cost, the reputational standing of the provider and the suitability of the goods and/or services for their specific needs. As the average consumer is a professional, they are likely to pay a higher degree of attention due to the potential impact of the goods and/or services on their company's reputation or professional activity. It is my view that the level of attention paid during the purchasing process for the goods and services at hand will be relatively high (but not the highest).
81. The goods and services are likely to be obtained by self-selection from websites, app stores, or specialised (online) retail outlets. The goods may also be purchased following advertisements on social media or other specialised online platforms. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the

purchase of the goods and services through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

Comparison of marks

82. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same 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. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

83. It would be wrong, therefore, to dissect the trade marks artificially, although 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 therefore contribute to the overall impressions created by the marks.

84. The respective trade marks are shown below:

Applicant's trade mark	Holder's IR
LEGALTECH	legalontech

Overall impression

85. The Applicant's mark consists of the word combination “LEGALTECH” in standard characters. The mark's overall impression lies on the word combination itself that forms the mark.

86. The IR is comprised of the conjoined word combination “legalontech” in standard character. The Applicant contends that the dominant parts of the IR are “legal” and “tech”²¹ and that the preposition “on” is so short that it does not materially move the focus away from the dominant elements of the Applicant’s trademark being “legal” and “tech”.²² The Holder submits that the relevant public will not read “legal” and then “tech”, but rather “legalontech” and they will not simply ignore the middle portion of the mark²³ and contends that neither of the respective marks has a dominant element.²⁴ I agree with the Holder and find that none of the words “legal”, “on” and “tech” is predominant over the others and each individual word retains its own meaning within the mark. Therefore, the distinctive character resides in the mark as a whole without one word dominating.

Visual similarity

87. The Earlier Mark is the all-capitalised word combination “LEGALTECH” in standard character and the IR consists of the conjoined word combination “legalontech” in plain typeface and all in lower case. The Holder submits that “*visually, the respective marks are, at best, only similar to a low degree. They overlap in the letters “L-E-G-A-L” and “T-E-C-H”. However, the Registered Proprietor’s mark contains the additional letters “O-N”, which give it a different overall visual impression*”.²⁵ The Applicant contends that the competing marks overlap in their beginnings and ends being, respectively, “legal” and “tech” and they merely differ in the IR’s additional preposition “on” placed in the middle of the IR.²⁶ The Applicant also argues that the Holder may use the IR by reducing the size and/or changing the font and colour (e.g., yellow) of the preposition “on” to change its visual significance.²⁷ With this submission the Applicant seems to argue the Holder could change the IR’s stylistic representation to make the preposition “on” less visible and visually closer to the Earlier Mark. Regard this argument, I must remind myself that it is wrong to approach the marks’ comparison by hypothesising a way of

²¹ Applicant’s statement of grounds dated 6 May 2024, page 3.

²² Applicant’s submissions in lieu dated 6 February 2025, page 2.

²³ Holder’s counterstatement dated 18 July 2024, [8] section 2.

²⁴ Holder’s written submissions dated 22 November 2024, [35].

²⁵ Holder’s written submissions dated 22 November 2024, [36].

²⁶ Applicant’s statement of ground dated 6 May 2024, page 2.

²⁷ Applicant’s written submissions dated 23 September 2024, page 3.

styling one of the parties' word mark (whether by choice of font or the use of other forms of presentation) in a way which is similar to the other party's mark.²⁸

88. Following from the above, the parties agree that the competing marks coincide in the words "legal" and "tech" placed at the beginnings and ends of both marks while they differ in the word "on" placed in the middle of the IR. It must be born in mind that UK consumers read from left to right. Overall, I find the marks to be visually similar to a high degree.

Aural similarity

89. The Earlier Mark is comprised of the two-syllable word "LEGALTECH" for a total of nine letters. The IR is a three-syllable word combination consisting of the words "legalontech" amounting to eleven letters. The respective marks coincide in the two words "legal" and "tech", in this order and only differ in the two-letter word "on" in the IR and absent from the Earlier Mark. The Applicant contends that *"the first syllables of words tend to be more prominent than later syllables. In this case the first two syllables "le" and "gal" are identical. 3 of 4 syllables in the holder's trademark are identical – the first two and the last"*.²⁹ The Holder argues that *"phonetically, the signs are different. While both signs begin with the word "Legal", the similarities end there. The Invalidation Applicant's mark contains only three syllables (LEGAL-TECH), while the Registered Proprietor's mark contains four syllables (LE-GAL-ONTECH)"*.³⁰ The Holder seems to argue that the relevant consumers will read "on" and "tech" as one word (i.e., 'ontech'), however, I do not see how this would be the case. Albeit I appreciate that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details,³¹ they will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for them, suggest a concrete meaning or which resemble words known to them.³² Therefore, I find that the relevant consumers will read the Earlier Mark as the combination of the words "legal " and "tech" and they will read the IR

²⁸ BL O/954/22, [42].

²⁹ Applicant's written submissions dated 23 September 2024, page 2.

³⁰ Holder's written submissions dated 22 November 2024, [37].

³¹ *Lloyd Schuhfabrik Meyer*, paragraph 25.

³² Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II 3445, paragraph 51; Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II 0000, paragraph 57.

as the string of words “legal”, “on” and “tech”. The words forming both marks are common English terms, and the consumers will recognise these words within the competing marks and voice them in line with their common English pronunciation. Therefore, the consumers will voice identically the first and last word in both marks (“legal” and “tech”) with the only aural difference of “on” in the IR. Overall, I find the marks to be aurally similar to a high degree.

Conceptual similarity

90. The Applicant submits that the word “tech” is short for “technology” according to the Collins dictionary and will understand “on” in the IR as describing “a legal solution on a tech platform”.³³ The Applicant also contends that “*the most common usage of “on” is as a preposition. It is typically used to refer to something that is touching something else, either physically or metaphorically*”³⁴ and that “*conceptually there is also a very high degree of similarity between the two marks, as “on” in this trademark context only acts as a descriptive phrase, without any differentiator effect*”.³⁵ The Holder submits that “legal” in both marks describes things that relate to the law and “tech” refers to “technology” whereas “on” does not have a specific meaning.³⁶ The applicant also contends that “*conceptually, the same meaning could be applied to the “legal” and “tech” elements of the respective marks. However, when taken as a whole, the average consumer will view the mark “legalontech” as conceptually incomplete, with no clear meaning*”.³⁷ The Holder also submits that “*the term “legal tech” is used in common parlance and refers to “the use of technology and software to provide legal services and support the legal industry” [...]. As noted above, the Invalidation Applicant’s mark is descriptive. Therefore, the distinctiveness of the Invalidation Applicant’s mark must be seen as low*”.³⁸ The Holder did not provide evidence showing that “legal tech” conveys the meaning reported above. The Applicant argues that while “legaltech” could be recognised as a term used in common parlance by professional consumers (i.e., the legal, technical, and business community), this is not true for the general public.

³³ Applicant’s statement of grounds dated 6 May 2024, page 2.

³⁴ Applicant’s written submissions date 23 September 2024, page 2.

³⁵ Applicant’s statement of grounds dated 6 May 2024, page 3.

³⁶ Holder’s written submissions dated 22 November 2024, [30] and [31].

³⁷ Ibid, [38].

³⁸ Ibid, [32] and [43].

To this end, the Applicant submits that “legaltech” or “legal tech” are not dictionary words or expressions.³⁹ Although the Applicant recognises that “legal tech” could be used as a term by professionals, it did not provide me with the meaning that such expression could mean when used by professionals.

91. From the parties’ submissions it seems that whilst the parties do not agree on a common meaning for both marks, they seem to agree on the fact that both marks allude to the concepts of “legal” and “tech” (i.e., technology). Therefore, although the competing marks are neologisms that do not convey a clear meaning, they both evoke the meanings of “legal” and “technology”. For this reason, I find the marks to have a medium degree of conceptual similarity.

Distinctive character of the earlier trade mark

92. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

“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).

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

³⁹ Applicant’s written submissions in lieu dated 6 February 2025, page 3.

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).”

93. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.
94. The Applicant has not filed any evidence to support that its mark’s distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.
95. As reported above, both parties seem to agree that, at least for the professional public, the Earlier Mark conveys the meaning of ‘the use of technology to provide legal services’. Therefore, the Earlier Mark is clearly suggestive when used in relation to goods and services that have a technological nature and are aimed at or relate to the provision of legal services. Its inherent distinctiveness would, for such goods and services, be fairly low (i.e. between low and medium). For those goods and services that are not related to legal services (whether they are technological or not) the Earlier Mark does not have any particular connotations which would put its distinctive character at below a normal level. Therefore, it is inherently distinctive to a medium degree.

Likelihood of Confusion

96. 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 goods down to the responsible undertakings being the same or related. 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. The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may

be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 he has retained in his mind.

97. For the respective goods and services where I found similarity, this ranges from low to identical. The level of attention is medium for the general public and relatively high (but not the highest) for the professional public. The distinctiveness of the Earlier Mark will vary from fairly low in respect of goods and services that are technological and refer to the legal sector to medium for the other goods and services that are not legal in nature (irrespective of whether they are technological or not). I found the marks to be visually and aurally similar to a high degree and conceptually similar to a medium degree. The purchase of the contested goods and services is considered to be mainly visual but the potential for aural use is borne in mind.

98. As far as direct confusion is concerned, the marks share significant similarities. They overlap at the beginning and end with the words “legal” and “tech,” differing only by the IR’s addition of “on” in the middle. When faced with these marks, the relevant consumers (both the general and professional public) are likely to clearly recognise the words “legal” and “tech” in both. Taking into account the effects of imperfect recollection, these consumers are likely to directly confuse the marks, even for goods and services where the Earlier Mark enjoys a medium degree of distinctiveness. I accept that the combination and conjoining of the words “legalontech” is somewhat unusual but it is not, in my view, sufficient to mitigate the likelihood of the consumer misremembering the marks and being confused. I reach this conclusion with regard to both the general and the professional public and notwithstanding the fact that the professional public pays a higher level of attention. Thus, there is a likelihood of direct confusion.

99. In the event that I am wrong to have found that the marks are likely to be mistaken for one another, I will turn to consider the likelihood of indirect confusion between them.

100. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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)”.

101. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.⁴⁰ I recognise that a finding of indirect confusion 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: this is mere association not indirect confusion.⁴¹ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.⁴²

102. Bearing all of the above in mind, I am of the view that if the consumers (both the general and the professional public) do recall the differences between the trade marks, or do not construe “LEGALTECH” as weakly distinctive, there is, in my view, a likelihood of indirect confusion. For example, when consumers encounter “legalontech” they are likely to interpret it as a creative extension of or a slogan deriving from the original house mark “LEGALTECH”, especially since it retains the same core words in the same order. Furthermore, in a commercial context, consumers are accustomed to seeing brand extensions that play on the original name. The addition of “on” in “legalontech” can be interpreted as a thematic variation that still clearly relates to the original mark, suggesting a focus or specialisation within the broader “LEGALTECH” brand.

103. Consequently, I consider that there is a likelihood of indirect confusion between the marks at issue.

Conclusion

104. The application for a declaration of invalidity under section 47(2) of the Act, based on section 5(2)(b) grounds, has been successful in respect of some of the goods and services against which it is directed. Subject to any successful appeal, under section 47(6) of the Act, the IR No. WO0000001749264 is deemed never to have been made in respect of the following goods and services in classes 9, 35 and 42:

⁴⁰ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

⁴¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

⁴² *Liverpool Gin Distillery*.

Class 9 Application software for assisting contract drafting and document management; application software for providing assistance in the field of legal affairs; recorded computer software; application software; recorded computer programs; application software for providing assistance in the field of business organization; recorded video discs and video tapes; electronic publications; electronic publications, downloadable; downloadable image files; electronic publications, downloadable, namely, downloadable templates for contracts, regulations and legal documents.

Class 35 Development of advertising concepts; layout services for advertising purposes; advertising services; advertising consultation; marketing consulting; providing information in the field of marketing; providing information about newspaper articles being news clipping services; advertising; news clipping services; marketing in the framework of software publishing; administration of consumer loyalty programs; targeted marketing; business management analysis and business consultancy; research and analysis for business risk management; market analysis and research services; business consultancy; business consulting services; business information services; business management and organization consultancy; business consulting services for assisting legal professionals in organizing and setting up their practices for legal document services to their clients; consultancy relating to efficiency improvement in clerical services in the field of legal affairs; outsourced administrative management for companies; input of data into computer databases for collection, analysis and management of digital data and information services relating thereto; compiling of information into computer databases and information services relating thereto; data search in computer files via an online computer database for others; data processing services [office functions]; updating and maintenance of data in computer databases; registration of written communications and data; data search in computer files for others; data processing in the field of legal affairs; data processing in the field of contracts; data processing services [office functions]”

Class 42 Development of computer platforms; creating and maintaining web sites for others; hosting computer websites; platform as a service [PaaS]; hosting of web sites; hosting of computerized data, files, applications and information; providing search engines for the Internet; computer programmatically monitoring of electronic data in computer data storage and of input-output data; restoring and recovering digital data using computers; graphic design of promotional materials; graphic art design.

105. The IR will remain registered for the following goods and services in classes 9, 35, 42 and 45 for which the invalidity action has failed:

Class 9 Computer peripheral devices; electronic control apparatus; electronic components; hardware for electronic calculators; data processors; computers; computer hardware; computer peripherals; audio-video compact discs; software for electronic calculators; programs for electronic calculators; electronic calculators.

Class 35 Personnel placement and placement of staff; consultancy and providing information relating to personnel placement and placement of staff; employment agencies; filing of documents or magnetic tapes [office functions]; duplication of documents; photocopying services.

Class 42 Design, programming and maintenance of computer programs; design, programming and maintenance of computer software; computer software design; maintenance of computer software; software as a service [SaaS]; software as a service [SaaS] featuring software for providing assistance in the field of legal services; software as a service [SaaS] featuring software for providing assistance in the field of business organization and management; providing online non-downloadable application software for use in drafting contracts and management support thereof; providing computer programs on data networks; providing computer software on data networks; electronic storage services for archiving electronic data; cloud storage services for electronic files for contracts, regulations and legal documents; electronic storage of files for contracts, regulations and legal documents; rental of

electronic memory space on the Internet; design services; design and development of computer hardware; designing of machines, apparatus, instruments [including their parts] or systems composed of such machines, apparatus and instruments; consultancy in the design and development of computer hardware; industrial design; rental of computer programs; rental of computer software; computer rental; research and development of computer system and data processors for preservation of evidence; research and development of computer programs for analysis and disclosure of analysis results of digital data; research and development of computer programs for classifying, mining, converting and processing of digital data; research and development of new products for others; conducting technical project studies; research in the field of telecommunications technology; research in the field of artificial intelligence technology; consulting related to survey, research and development of information-processing technology and communication technologies; consulting related to survey, research and development of scientific technologies; computer technology consultancy; Information technology [IT] consulting services; technological consultancy services for digital transformation; computer system analysis and information services relating thereto; providing scientific and technological information; technological advice relating to computers, automobiles and industrial machines.

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; Online social networking services.

Costs

106. As both parties have had a reasonable degree of success, I decline to favour either with an award of costs.

Dated this 30th day of September 2025

Andrea Rossi

For the Registrar

Annex A

Goods and services of IR no. WO0000001749264

Class 9:

Application software for assisting contract drafting and document management; electronic calculators; computer peripheral devices; electronic control apparatus; electronic components; hardware for electronic calculators; software for electronic calculators; application software; application software for providing assistance in the field of legal affairs; application software for providing assistance in the field of business organization; programs for electronic calculators; downloadable image files; recorded video discs and video tapes; electronic publications; data processors; computers; computer hardware; computer peripherals; recorded computer software; recorded computer programs; audio-video compact discs; electronic publications, downloadable; electronic publications, downloadable, namely, downloadable templates for contracts, regulations and legal documents.

Class 35:

Development of advertising concepts; layout services for advertising purposes; personnel placement and placement of staff; employment agencies; consultancy and providing information relating to personnel placement and placement of staff; advertising services; advertising consultation; providing information about newspaper articles being news clipping services; business management analysis and business consultancy; research and analysis for business risk management; market analysis and research services; business consultancy; marketing consulting; providing information in the field of marketing; input of data into computer databases for collection, analysis and management of digital data and information services relating thereto; compiling of information into computer databases and information services relating thereto; data search in computer files via an online computer database for others; duplication of documents; filing of documents or magnetic tapes [office functions]; advertising; news clipping services; marketing in the framework of software publishing; business consulting services; outsourced administrative management for companies; administration of consumer loyalty programs; targeted marketing; data

processing services [office functions]; updating and maintenance of data in computer databases; business information services; business management and organization consultancy; registration of written communications and data; photocopying services; data search in computer files for others; data processing in the field of legal affairs; data processing in the field of contracts; consultancy relating to efficiency improvement in clerical services in the field of legal affairs; business consulting services for assisting legal professionals in organizing and setting up their practices for legal document services to their clients; data processing services [office functions].

Class 42:

Design, programming and maintenance of computer programs; design, programming and maintenance of computer software; rental of computer programs; rental of computer software; rental of electronic memory space on the Internet; providing computer programs on data networks; providing computer software on data networks; computer system analysis and information services relating thereto; providing scientific and technological information; design services; graphic design of promotional materials; hosting of web sites; hosting of computerized data, files, applications and information; technological advice relating to computers, automobiles and industrial machines; design and development of computer hardware; designing of machines, apparatus, instruments [including their parts] or systems composed of such machines, apparatus and instruments; computer programmatically monitoring of electronic data in computer data storage and of input-output data; restoring and recovering digital data using computers; research and development of computer system and data processors for preservation of evidence; research and development of computer programs for analysis and disclosure of analysis results of digital data; research and development of computer programs for classifying, mining, converting and processing of digital data; consulting related to survey, research and development of information-processing technology and communication technologies; consulting related to survey, research and development of scientific technologies; graphic art design; industrial design; consultancy in the design and development of computer hardware; computer technology consultancy; Information technology [IT] consulting services; computer software design; maintenance of computer software; development of computer platforms; creating and maintaining web sites for others; providing search

engines for the Internet; research and development of new products for others; software as a service [SaaS]; software as a service [SaaS] featuring software for providing assistance in the field of legal services; software as a service [SaaS] featuring software for providing assistance in the field of business organization and management; computer rental; hosting computer websites; platform as a service [PaaS]; electronic storage services for archiving electronic data; conducting technical project studies; research in the field of telecommunications technology; providing online non-downloadable application software for use in drafting contracts and management support thereof; research in the field of artificial intelligence technology; technological consultancy services for digital transformation; cloud storage services for electronic files for contracts, regulations and legal documents; electronic storage of files for contracts, regulations and legal documents.

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; online social networking services; 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.

Annex B

Services of UK trade mark no. UK00003721710

Class 35:

Advertising; Business management; Business administration; Business management assistance; Data management services; Data processing; Electronic data processing; Document preparation; Business advice relating to marketing; Business consulting; Business research for new businesses; Business consultancy and advisory services; Arranging and conducting of displays for advertising purposes; Demonstration of goods and services by electronic means, also for the benefit of the so-called teleshopping and homeshopping services; Sales demonstration [for others]; Organization of exhibitions for commercial or advertising purposes; Arranging of demonstrations for advertising purposes; Arranging of demonstrations for advertising purposes; Dissemination of advertising for others via an on-line communications network on the internet; Dissemination of advertisements via the Internet; Dissemination of advertising, marketing and publicity materials; Provision of space on web-sites for advertising goods and services; Administrative support and data processing services; Compiling indexes of information for commercial or advertising purposes; Compilation of information into computer databases; Updating and maintenance of data in computer databases; Data search in computer files for others; Data processing; Business administration; Administrative services relating to the management of legal dockets; Automated data processing; Business administration assistance; Computerised data verification; Data processing, systematisation and management; Business administration; Updating and maintenance of information in registries; Competitive intelligence services; Business research; Business investigations; Consumer profiling for commercial or marketing purposes; Market studies; Professional business consultancy; Providing business information via a web site; Updating of business information on a computer data base; Computerised business information services; Business analysis and information services, and market research; Consultancy relating to the establishment and running of businesses; Business information services provided on-line from a computer database or the internet; Commercial information services provided by access to a computer database; Market research by means of a computer data base; Provision of computerised data

relating to business; Provision of business data; Providing online commercial directory information services; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Business and market research.

Class 36:

Finance services; Insurance underwriting; Capital investment; Fund investment services; Investment management; Administration of funds and investments; Financial consultancy relating to real estate investment; Financial underwriting and securities issuance (investment banking); Financial services relating to investment; Financing of investments; Providing financing to emerging and start-up companies; Providing information relating to securities underwriting; Investment banking consulting and advisory services; Investment portfolio management services; Underwriting of shares (Services for the -); Development of investment portfolios; Financial consultancy; Financial valuation of intellectual property assets; Financial analysis; Financial research; Providing financial information via a web site; Financial analysis and consultancy; Financial information services provided by access to a computer database; Financial consultancy and information services; Financial planning services; Financial and investment consultancy services; Consultancy services relating to corporate finance; Financial appraisal services; Financial appraisals and valuations; Crowdfunding; Venture capital services; Venture capital (Services for the provision of -); Charitable fund raising; Arranging charitable collections [for others]; Organization of monetary collections; Financial sponsorship; Fundraising; Charitable fund raising; Intellectual property valuation services; Valuations and financial appraisals of property.

Class 41:

Entertainment services; Sporting and cultural activities; News reporters services; Services for the publication of travel guides; Publication of manuals.