

O/0737/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3696054
IN THE NAME OF HARPER MACLEOD LLP
TO REGISTER THE FOLLOWING TRADE MARK:**

HARPERS

IN CLASSES 35, 36, 41 & 45

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 430965
BY ROSS HARPER LIMITED**

Background and pleadings

1. On 16 September 2021, Harper Macleod LLP (“the applicant”) applied to register the trade mark **HARPERS** in the UK, under number 3696054 (“the applicant’s mark”). It was published for opposition purposes on 10 December 2021. Registration is sought for services in classes 35, 36, 41 and 45. These are set out in the annex to this decision.

2. Ross Harper Limited (“the opponent”) opposes the application in full under sections 5(2)(b), 5(3), 5(4)(a), 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(b) and 3(6) of the Trade Marks Act 1994 (“the Act”).¹

3. For the purposes of its claims under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon its UK trade mark number 2629379, **ROSS HARPER** (“the opponent’s mark”). The opponent’s mark was filed on 24 July 2012 and became registered on 26 October 2012 for services in classes 36, 41 and 45. These are also outlined in the annex to this decision.

4. In its notice of opposition, the opponent contends that, due to the similarity between the parties’ trade marks and services, there is a likelihood of confusion on the part of the public. On this basis, the opponent argues that the applicant’s mark ought to be refused in accordance with section 5(2)(b).

5. As for section 5(3), the opponent claims that its mark has a reputation in respect of all its services. The opponent submits that this reputation is such that use of the applicant’s mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and repute of its mark.

6. Under section 5(4)(a), the opponent claims that it has a protectable goodwill in relation to which it has used the sign **Ross Harper** (“the opponent’s sign”) throughout

¹ The section 3(1) and 3(3) grounds were added by way of Form TM7G filed alongside the opponent’s evidence in chief.

the UK and online since at least 2 April 1999.² The opponent's sign is said to have been used in relation to *legal services, real estate services, financial services, educational and training services related to law.*

7. Turning to sections 3(1)(b) and 3(1)(c), the opponent argues that consumers would not attribute any trade mark significance to the applicant's mark as it merely indicates that the services offered under the mark relate to the law/legal remedy which was the product of the campaign associated with the killing of PC Andrew Harper, i.e. Harper's Law. The opponent submits that the applicant's mark is, therefore, descriptive and devoid of any distinctive character.

8. Under section 3(1)(d), the opponent submits that the applicant's mark had, at the relevant date, become customary in the current language and/or *bona fide* established practice of the trade for the law/legal remedy which was the product of the campaign associated with the killing of PC Andrew Harper, i.e. Harper's Law.

9. In respect of section 3(3)(b), the opponent claims that, if the applicant's mark is used for services which do not relate to the law/remedy which was the product of the campaign associated with the killing of PC Andrew Harper, i.e. Harper's Law, it will deceive the public.

10. Under section 3(6), the opponent's pleaded case is that there is no genuine intention to use the applicant's mark for the applied-for services. According to the opponent, the applicant was aware that the opponent/its licensee had incorporated and registered its 'HARPERS LAW' legal practice; therefore, it is alleged that the application was made to block the opponent/its licensee from registering the mark or to unfairly drive away a competitor. On this basis, the opponent submits that the application was made in bad faith.

² Originally, there was an additional sign relied upon under this ground of opposition. However, reliance on the same was withdrawn within the opponent's skeleton argument dated 11 December 2023.

11. The applicant filed a counterstatement, denying the grounds of opposition.³ Insofar as its pleadings are relevant, it submits that the parties' marks are not confusingly similar. Moreover, it argues that use of its mark significantly predates the opponent's use of its mark/sign, such that it has a concurrent right to use its mark and there can be no passing off. It also contends that its mark is, in essence, a personal name which is not descriptive or deceptive of the applied-for services. Finally, it denies that the application to register its mark was made in bad faith.

12. Both parties filed evidence in these proceedings. A hearing was requested and held before me, by video conference, on 13 December 2023. The opponent was represented by Philip Hannay of Cloch Solicitors. Jamie Watt appeared on behalf of the applicant.

Relevance of EU law

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

Evidence and submissions

14. The opponent's evidence is given in the witness statement of Nigel Scullion, together with 14 exhibits (OPP01-OPP06 and OPPR01-OPPR08), the witness statement of Philip Hannay, together with three exhibits (OPP-PAH1-OPP-PAH3), and the witness statement of Val McEwan.

15. Mr Scullion is a director of the opponent. Generally, his evidence goes to the opponent's use of its mark and prior dealings between the parties. Mr Hannay is the

³ The applicant also filed an amended counterstatement following the addition of the section 3(1) and 3(3) grounds.

opponent's professional representative. He gives evidence in response to that filed by the applicant. His statement contains criticisms of the applicant's evidence and gives his view as to whether the applicant is referred to as 'HARPERS'. Ms McEwan is Communications Manager at the Law Society of Scotland. She provides information from the records of the same.

16. The opponent also filed written submissions dated 31 October 2022.

17. The applicant's evidence is given in the witness statement of Lorne Crerar, together with 22 exhibits (HM1-HM11 and HM13-HM23), two witness statements from Jamie Watt, each with one exhibit (JW1 and JW2), the witness statement of Richard Harvey, together with three exhibits (RH1-RH3), and witness statements from 15 other witnesses including Ms McEwan.

18. Mr Crerar was one of the founding members of the applicant. He gives evidence as to the background of the applicant and its use of its mark. Mr Harvey is IT Director of the applicant. He produces emails which contain the word 'Harpers'. Mr Watt is a member of the applicant. He provides printouts from the internet to support Mr Harvey's evidence. He also produces an email containing the word 'Harpers'. Ms McEwan clarifies some terminology she uses in her witness statement for the opponent. The other witnesses comprise, *inter alia*, accountants, solicitors and members of the banking industry. Broadly, they give evidence of the ways in which the applicant is referred to.

19. The applicant filed written submissions dated 29 June 2023.⁴

20. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

⁴ I note that the official letter of 1 June 2023 provided the parties with the choice to either request a hearing or file written submissions in lieu. As outlined above, the applicant filed written submissions dated 29 June 2023. However, Mr Watt then attended the hearing and gave oral submissions on behalf of the applicant. In the circumstances, I will treat Mr Watt's oral submissions as the applicant's final say, though I note for completeness that much of what was said at the hearing reflected the applicant's written submissions. Therefore, I do not consider that anything turns on this point.

Proof of use

21. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

22. The opponent’s mark qualifies as an earlier trade mark in accordance with these provisions. As it had completed its registration process more than five years before the filing date of the applicant’s mark, it is subject to the use requirements specified within section 6A of the Act.

23. Within its statement of grounds, the opponent stated that it has used its mark in relation to all its services. Within its counterstatement, the applicant indicated that it would require the opponent to provide proof of use of the same.

24. Section 6A of the Act states as follows:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

25. Pursuant to the above provisions, the relevant period of assessing whether there has been genuine use of the opponent's mark is the five-year period ending with the filing date of the applicant's mark, i.e. 17 September 2016 to 16 September 2021.

26. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76];

Centrotherm at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

27. Section 100 of the Act is also relevant. It states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

28. I am also guided by *Awareness Limited v Plymouth City Council*, BL O/236/13, in which Mr Daniel Alexander QC as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance)

comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

[...]

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

29. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs QC as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is

required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

30. Mr Scullion says that the law firm ‘ROSS HARPER & MURPHY’ was formed in 1961, named after its founder Professor Ross Harper. The firm traded under this name until 2001, when it was simplified to ‘ROSS HARPER’. It traded under this name until it ceased trading in 2012. Ms McEwan confirms this to be the case from the records of the Law Society of Scotland. In covering the closing down of the firm in an article dated 1 May 2012, *The Scotsman* referred to it as a “top law firm” and “one of Scotland’s best-known law firms”.⁵ The then chief executive of the Law Society of Scotland is quoted in the article, also speaking to the renown of the firm in Scotland. A second article from *The Scotsman*, of the same date, describes it as “one of Scotland’s biggest legal firms”.⁶ Both articles speak to Professor Harper’s individual

⁵ Exhibit OPP-01

⁶ Exhibit OPP-01

prominence. I note that he published a memoir. This was published on 7 September 2016,⁷ and, as of 31 May 2022, it was available to purchase from amazon.co.uk.⁸ According to Mr Scullion, the 'ROSS HARPER' offices were strategically positioned on Clyde Street, Glasgow. A photograph from Google Street View, from August 2015, shows the (closed) offices at that address.⁹ Glasgow's central rail station and sheriff court were nearby.

31. Scullion Law Limited ("SLL") was incorporated on 30 August 2011.¹⁰ Mr Scullion says it is a law firm owned and managed by members of his family. On or around 10 May 2012, SLL is said to have acquired business and assets from 'ROSS HARPER'. These are said to have included, *inter alia*, its criminal law, family law and conveyancing practices, all goodwill, all client files, its criminal law 'hotline' telephone number, and the 'Ross Harper Criminal' and 'Ross Harper Property' intellectual property rights. These were immediately integrated into SLL's business. On 24 July 2012, SLL sought to "shore up" the goodwill in the 'ROSS HARPER' mark by filing the opponent's mark. Mr Scullion says that the mark has been used continuously since. SLL is also said to have acquired the domain names rossharper.com and rossharper.co.uk in September and October 2012. Mr Scullion says they have been in use since at least 2001.

32. Mr Scullion says that, in 2016, the management of SLL developed different views as to the future direction of the firm. Internal discussions began which included the potential separation and demerger of the 'ROSS HARPER' and 'ROAD TRAFFIC DEFENCE' businesses he had been responsible for. The opponent was incorporated on 26 September 2016 for that purpose. The opponent is said to have used the mark 'ROSS HARPER' under licence. The plan was for the opponent to eventually hold the intellectual property rights, including the opponent's mark; it would then licence new trading companies to commercialise the brands. AMNS (Scotland) Limited ("AMNS") was formed on 30 September 2016.¹¹ Mr Scullion says that his plan was to operate the road traffic and legal aid part of the licence through AMNS. However, the demerger

⁷ Exhibit HM3

⁸ Exhibit OPP-02

⁹ Exhibit OPP-03

¹⁰ Exhibit OPP-04

¹¹ Exhibit OPP-04

was delayed. He was appointed director of SLL in the meantime, between 12 October 2017 and 1 January 2020. During that period, he says that the ‘hotline’ continued to receive calls and the websites continued to receive inbound enquiries. I note that printouts from the Wayback Machine and what could be this website have been provided.¹² The interim trading arrangement was prolonged by the Covid-19 pandemic but in May 2021 the demerger was “revitalised”. AMNS was renamed Harpers Law Ltd (“HLL”) on 26 May 2021.¹³ Mr Scullion says that HLL was registered with the Scottish Legal Aid Board by around 10 August 2021. HLL was granted professional indemnity insurance on 13 August 2021.¹⁴ By this date, Mr Scullion says that HLL was registered with the Law Society of Scotland.

33. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹⁵

34. The evidence shows that Professor Harper started a law firm in 1961, which traded under the opponent’s mark since 2001. It had an office in Glasgow and two websites. The law firm was referred to in third-party publications in 2012 as having been a top law firm in Scotland. However, all of this occurred prior to 2016 and, therefore, cannot be relied upon as showing the position during the relevant period. Indeed, the evidence establishes that the firm ceased trading in 2012, some four years before the beginning of the relevant period. SLL is said to have acquired rights in the opponent’s mark thereafter. The opponent is then said to have used the mark under licence after its incorporation at the beginning of the relevant period. However, there is no evidence of use by the opponent at all. Moreover, although Mr Scullion says that SLL received inbound enquiries during the relevant period through the ‘hotline’ and websites, the evidence from the Wayback Machine only shows that the website *rossharper.com* was ‘saved’ 154 times between 9 March 2001 and 23 December 2021. It does not show what the website looked like on any given date, or whether the opponent’s mark was displayed on it during the relevant period. In addition, although printouts of what could

¹² Exhibits OPP-05 and OPP-06

¹³ Exhibit OPP-04

¹⁴ Exhibit OPP-06

¹⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

be this website have been provided, in which the words 'Ross Harper' can clearly be seen in relation to legal services, they are not dated and do not establish that any business was generated through the website.

35. There are a number of other deficiencies in the opponent's evidence. Firstly, no turnover figures relating to services provided under the opponent's mark have been provided. There is no evidence of any business having been done in the relevant period, such as, for example, invoices, client engagement documents or contracts. Moreover, there is no information about the size of the relevant markets in the UK, or the opponent's share(s) of the same. I also note that no evidence has been provided of any advertising or promotional activities conducted in connection with the opponent's mark during the relevant period.

36. Based upon the evidence that has been filed, I am unable to assess the scale and extent of use of the opponent's mark during the relevant period (if there was any), or how geographically widespread any such use has been. Likewise, there is nothing before me from which I can ascertain whether such use is warranted in the economic sectors concerned to create or maintain a share in the market for the services protected by the opponent's mark. It is my view that the evidence provided is insufficiently solid or specific to meet the requisite standard of proof. Following a careful consideration of the evidence in its entirety, I am not satisfied that the opponent has demonstrated genuine use of its mark in the UK for any of services for which it is registered.

37. The consequence of this is that the opponent's mark may not be relied upon to support its claims under sections 5(2)(b) and 5(3) of the Act. Therefore, insofar as it is based upon those grounds, the opposition is dismissed.

Section 5(4)(a)

38. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

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

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

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

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

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

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

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

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

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

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

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

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

Relevant date

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

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

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

43. The applicant has filed evidence of its activities. Mr Crerar describes the applicant as one of Scotland’s largest law firms. Companies House records show that, at the

date of Mr Crerar's statement, the applicant had 76 members.¹⁶ I note that The Legal 500 referred to the applicant as a market leader.¹⁷ The applicant won various awards for its employment practices and was consistently rated amongst the top performers of Scottish law firms in terms of mergers and acquisitions by *Scottish Business Insider* prior to the relevant date.¹⁸ Company accounts show that the applicant generated a significant amount of gross turnover per annum between 2012 and 2022, the lowest figure being over £19million (2012).¹⁹ However, none of this evidence relates to the mark 'HARPERS'. There is nothing to tether the applicant's awards or turnover, for example, with this mark. Rather, this evidence all relates to either 'Harper Macleod LLP' or 'Harper Macleod'. The only reference to use of the word 'HARPERS' is in an advertising brochure.²⁰ Mr Crerar says that the brochure was distributed to clients and potential clients throughout Scotland and the UK. Although the brochure is not dated, Mr Crerar gives narrative evidence that it is from 1988. Even though I consider this to be unchallenged,²¹ I am unable to ascertain a particular date in that year when the brochure was distributed in the UK. In any event, the brochure is not, by itself, direct evidence of any services being provided under the word 'HARPERS', and there is no evidence of how many of the brochures were produced and distributed. Moreover, the use of the word 'HARPERS' on the brochure is historical; it is from nearly 40 years ago. Without any evidence that use under 'HARPERS' continued, it is, in my view, far too long ago to justify considering the position from a relevant date in 1988. The potential effect of this would be to exclude a claim from a party who could, in theory, have been trading continuously under the name 'HARPERS' for more than 30 years prior to the filing date of the applicant's mark.

44. Mr Crerar also says that clients, potential clients, and the public generally refer to the applicant as 'Harpers'. In support of this, he provides the following evidence:

¹⁶ Exhibit HM8

¹⁷ Exhibit HM9

¹⁸ Exhibits HM5 and HM6

¹⁹ Exhibit HM7

²⁰ Exhibit HM1

²¹ I note that, in his first witness statement, Mr Hannay says that "I do not recall having ever received or seen or known anyone to have received or seen exhibit HM1, nor do I have a copy in my collection of legal paraphernalia". However, I do not consider that to be a direct challenge to what Mr Crerar says. It is merely a reflection of Mr Hannay's own experience. Mr Hannay may not be familiar with the document himself, but that does not mean it was not produced or distributed.

i) An article from insider.co.uk dated 25 September 2019.²² It is about individuals from the applicant taking part in the Great Scottish Run. There are no standalone uses of the word 'Harper's', i.e. it only refers to the applicant as 'Harper Macleod'.

ii) An article from rollonfriday.com dated 10 July 2020.²³ A comment from an anonymous user is highlighted which refers to 'Harpers'. I note that this user was responding to a comment from another anonymous user who used the full name 'Harper Macleod'.

iii) Articles from *The Herald*, *The Press and Journal* and Law Society of Scotland dated 31 October 2018, 17 March 2014 and 8 June 2019, respectively.²⁴ They discuss how Mr Crerar and a fellow Ross Harper Murphy partner launched 'Harpers', which later became 'Harper Macleod'. Except for when giving a history of the beginning of the firm, the full name is used in the articles.

iv) An article from the Royal Philosophical Society.²⁵ The article is undated, but it discusses a lecture which was due to take place on 23 March 2022. It says that Mr Crerar became a partner in 'Harpers' which later became 'Harper Macleod'.

v) Listings from the business directories of *The Independent*, *Edinburgh Evening News* and *The Evening Standard*,²⁶ as well as a listing in The Legal 500.²⁷ They are undated, but the copyright notices are given as 2022. The listings are for 'Harper Macleod LLP'. These directories all say that the firm started out as 'Harpers'.

²² Exhibit HM10

²³ Exhibit HM11

²⁴ Exhibits HM13, HM18 and HM21

²⁵ Exhibit HM14

²⁶ Exhibits HM15, HM16 and HM22

²⁷ Exhibit HM17

vi) A printout of the Wikipedia page for 'Harper Macleod', which was last edited on 17 November 2019,²⁸ as well as Google search results for "harpers law scotland" dated 9 September 2021.²⁹ However, these documents are of little probative value. As far as I understand it, Wikipedia is a community-based encyclopaedia that any user can contribute to or edit. This means that the content may be unverified. Moreover, it is my understanding that internet searches use algorithms which become tailored to a user based upon their search history. Search results will also vary over time and are dependent upon who is doing the search.

vii) Printouts from reviewsolicitors.co.uk.³⁰ It contains a collection of reviews about 'Harper Macleod LLP' from 2018 and 2019. It contains the same history of the firm, i.e. that it started out as 'Harpers'. One reviewer refers to the firm as 'Harpers', whilst others use the full name.

45. Mr Harvey provides copies of emails the applicant received from external entities between 1 January 2010 and 13 December 2022.³¹ These were obtained from Mimecast, a cloud email filter platform used by the applicant, which allows for the searching of all emails sent and received by key words.³² They show third parties, such as other solicitors, referring to the applicant as 'Harpers'. I note that Mr Watt provides (undated) printouts from Wikipedia, The Legal 500, and various websites, which contain details of these third parties.³³

46. The applicant has also filed witness statements from the following individuals: Charles Barnett (Chartered Accountant), Craig Gebbie (Relationship Director for Scotland, Cynergy Bank), David McKie (Partner at Levy & McRae Solicitors LLP), Frasia Wright (Managing Director of Scottish legal recruitment consultancy), Jonathan Kelly (Scotland & Northern Ireland "Large Corporate" Relationship Management Banking team lead at Santander UK plc), Manus Fullerton (retired banker), Martin Gill

²⁸ Exhibit HM19

²⁹ Exhibit HM20

³⁰ Exhibit HM23

³¹ Exhibit RH3

³² Exhibit RH1

³³ Exhibit JW1

(Chartered Accountant), Murdoch MacLennan (Partner of accounting and business advisory firm), Nabil Mohamed (Senior Legal Counsel at National Car Parks), Philip Rodney (retired solicitor), Rebecca Dymond (Procurement Manager at Admiral Group plc), Richard McDonald (Account Executive and Board Director at Bruce Stevenson Insurance Brokers), Ronald Murison (Sheriff Officer and Messenger-at-Arms, Stirling Park LLP) and Scott Manson (advocate and part-time Sheriff). Broadly, these witnesses claim to have a very good knowledge of the Scottish legal market due to their own careers and experiences. They attest to knowing the applicant and say that they and others they know refer to it as 'Harpers'. Some believe that the applicant is widely known as such in the Scottish legal market. Some go as far as to say that it is the only legal or professional services firm referred to in this way.

47. To my mind, none of this evidence is sufficient for establishing the relevant date for the assessment of the opponent's claim under section 5(4)(a) is earlier than the filing date of the applicant's mark. This is because it all relates to use by third parties, i.e. it is not use by the applicant. I should add that, although I note the opinions of the witnesses listed at paragraph 46, they are not impartial experts. They all say that they have (or have had) business relationships with the applicant or personal relationships with its employees. I also note that no request was made to file expert evidence about the Scottish legal market, or any other subject for that matter.

48. Finally, Mr Watt provides a copy of an email which was "received by persons engaged by the applicant" on 27 September 2012.³⁴ Mr Hannay was copied into the email. From what I can gather, Mr Watt produced this evidence in an attempt to undermine a comment made by Mr Hannay in his statement, i.e. that he does not recall having seen material in which the applicant is referred to as 'Harpers'. Whilst Mr Hannay was clearly copied into the email, Mr Hannay said that he did not recall something. This is a different proposition to denying that something happened entirely. The email is from 2012, around 11 years before the date of Mr Hannay's statement. If Mr Hannay had sight of it at that time, forgetting a single reference over a period of 11 years does not strike me as a reasonable basis to disbelieve his evidence. This is particularly the case when considering that Mr Hannay goes on to qualify his

³⁴ Exhibit JW2

recollections with “apart from one or two occasions many years ago”. Nonetheless, although I do not consider Mr Hannay’s evidence to have been undermined, his own opinion can neither be taken as expert evidence nor representative of whether the applicant has used the ‘HARPERS’ mark.

49. Overall, I do not consider that the evidence establishes an earlier relevant date. Therefore, the relevant date for assessing this ground of opposition is the filing date of the applicant’s mark, namely 16 September 2021.

Goodwill

50. The first hurdle for the opponent to show that it had the necessary goodwill resulting from the trading activity relied on under the sign ‘Ross Harper’ at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) in the following terms:

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

51. I have already assessed the opponent’s evidence of use and found that it was insufficient for the purposes of establishing genuine use of a mark identical to the opponent’s sign. However, an assessment of goodwill is not limited to a five-year period; any use preceding the relevant date can be considered. The evidence from when ‘Ross Harper & Murphy’ was formed in 1961 until the cessation of trading activities under ‘Ross Harper’ in 2012 is extremely limited. There is no evidence from this time of any turnover being generated through the provision of any services under the sign, no direct evidence of any trading activities, and no evidence of any promotional activities having been conducted in relation to the sign. However, around the time of the closure of the firm, it was described in third-party publications as one of Scotland’s biggest and best-known law firms. On this basis, I am prepared to accept that the firm accrued goodwill in relation to legal services offered under the name ‘Ross

Harper' in Scotland by that time. Nevertheless, whilst the reported strength and size of the firm in the press coverage is noted, this is not demonstrated through any supporting evidence. Whilst, on balance, I consider the press coverage to be sufficient to point to the existence of goodwill, the level of that goodwill is unclear.

52. As noted above, the relevant date for assessing the opponent's claim under section 5(4)(a) is 16 September 2021. Therefore, it falls to me to determine whether the opponent still had goodwill at the relevant date and whether the sign 'Ross Harper' remained distinctive of that goodwill at the relevant date.

53. In *Ad Lib Club Limited v Granville* [1971] FSR 1 (HC), Vice Chancellor Pennycuik stated that:

"It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law."

54. In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J (as he then was) stated that:

"14. More recently, in *Sutherland v V2 Music Ltd* [2002] EMLR 28, Laddie J had to consider whether the goodwill generated by a funk music band called Liberty 1, which had been formed in the late 1980s, still subsisted in March 2001. Laddie J considered the relevant principles and reviewed the authorities. At paragraph 22 he said this:

"There is one other general matter to deal with before turning to the facts, namely the size of the claimant's reputation. At some point a reputation may be respected by such a small group of people that it will not support a passing-off action. Neither Mr. Purle nor Mr. Speck were able to formulate a test for this bottom level. Mr. Purle said it was a matter of fact and degree. I agree with that. The law of passing off protects the goodwill of a small business as much as the large, but it will not intervene to protect the goodwill which any reasonable person would consider trivial".

15. It is difficult to define any minimum threshold. It will all depend on the facts. How big was the reputation when use stopped? How lasting in the public eye are the goods or services to which the mark is applied? How, if at all, has the person asserting the existence of the goodwill acted in order to keep the reputation in the public eye? The greater each of these elements is, the longer, it seems to me, it will take for any goodwill to dissipate."

55. Assessing the criteria set out above against the evidence provided, I have found that the reputation when use stopped was unclear. In the absence of any evidence on the point, it is my impression that law firms may not last a long time in the public eye. This is because there are many firms in a very competitive market. In addition, as far as I understand it, it is not uncommon for the names of law firms to vary over time, as their named partners change, for instance. As for whether the opponent has acted to keep the 'Ross Harper' reputation in the public eye, the evidence encounters the same problems as discussed whilst assessing genuine use. SLL is said to have acquired rights in the sign after the firm's closure (including "all goodwill") and applied for a trade mark identical to the opponent's sign. It is also said to have acquired the domain names and Mr Scullion says that websites at those domains have been in use since. The opponent is said to have used a mark identical to the opponent's sign since 2016 under licence, through enquires received via the 'hotline' and websites. However, as I have explained previously, there is no evidence of use by the opponent. The printout from the website is undated and, therefore, cannot be relied upon as showing the position at the relevant date. There is no evidence of any direct business or marketing activities having been carried out. Professor Harper's memoir, whilst being published

before the relevant date, is, unsurprisingly, about him as an individual, and I do not consider this to be evidence of keeping the reputation of the firm in the public eye. In any event, there is no evidence as to how many copies were sold/distributed. On the balance of the evidence, I conclude that there was only a minimal effort (if any) to keep the reputation in the public eye. Taking all of the above into account, I find that any goodwill which existed at the closure of 'Ross Harper' in 2012, such as it was, would have dissipated by the relevant date. As the opponent has not demonstrated that it had the necessary goodwill resulting from the trading activity relied on under the sign at the relevant date, its claim under this ground cannot proceed.

56. I should add that I also have my doubts as to whether the opponent would have been the owner of any residual goodwill at the relevant date. As a result of the Trade Marks (Relative Grounds) Order 2007, only the proprietor of an earlier right may bring an opposition based upon section 5(4)(a) of the Act. Whilst the evidence of SLL's acquisition of the original firm's goodwill is limited, I would have been prepared to accept that aspect of the chain of title based upon Mr Scullion's narrative evidence. The opponent is said to have used the 'Ross Harper' mark under licence. Whilst the plan was for the opponent to eventually hold the intellectual property rights that SLL had acquired, there is nothing in the evidence which suggests that this was ever done in respect of any goodwill. Mr Scullion says that SLL agreed to formally transfer the same with effect from 15 February 2022 (after the relevant date) to the "Transferee". However, this term is not defined in his statement and no evidence of such an agreement has been filed. There being no evidence that any goodwill was assigned to the opponent, I would not have been convinced that the opponent could demonstrate that is the owner of any relevant goodwill.

Conclusion

57. The opponent's claim under section 5(4)(a) is dismissed.

Sections 3(1)(b) and 3(1)(c)

58. The relevant parts of section 3 of the Act read as follows:

“(1) The following shall not be registered—

(a) [...]

(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) or (d) 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.”

59. The relevant date for determining whether the applicant’s mark is objectionable under the above provisions is its filing date, namely, 16 September 2021.

60. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.³⁵ The relevant public will vary depending on the particular services concerned. Given their nature, it is my view that the applied-for services are likely to be purchased by business users. However, some of the services, such as *estate agency*, *advisory services relating to insurance*, *legal advice*, for example, are also likely to be purchased by the general public. At least a medium level of attention will be paid by both types of average consumer, since the applied-for services are all broadly related

³⁵ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

to company, financial or legal matters. Such services are not typically purchased casually due to the potentially serious implications for the business or individual.

61. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b).³⁶ However, where a mark is descriptive of services, it necessarily lacks the required distinctiveness to avoid objection under section 3(1)(b). As the opponent's pleaded case under 3(1)(b) is inextricably linked to its claim under section 3(1)(c), i.e. that the applicant's mark describes a characteristic of the services, I will assess both grounds of opposition together. As there is no other basis for the opponent's claim that the applicant's mark is non-distinctive, if its claim under section 3(1)(c) fails, so too will its claim under section 3(1)(b).

62. 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*

³⁶ *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, paragraph 25

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].”

63. The opponent’s pleaded case is as follows:

“It is considered that, when greeted with the sign “Harpers”, the average consumer would not attribute any trade mark significance to these words. The mark simply serves to indicate to the consumer that the goods and services on

offer are, for example, products or services which relate to the law or legal remedy which was the product of the campaign associated with the killing of Andrew Harper PC (i.e. Harper's law)."³⁷

And

"It is considered that, when greeted with the sign HARPERS, the average consumer would not attribute any trade mark significance to these words. The mark simply serves to indicate to the consumer that the legal goods and services on offer relate to the law or legal remedy which was the product of the campaign associated with the killing of Andrew Harper PC (i.e. Harper's law)."³⁸

64. Within its counterstatement, the applicant states as follows:

"38. [...] The Application Mark does not describe the services for which registration is sought. The Application Mark is in essence a personal name.

39. To the extent that the Application Mark has been used to refer to a particular happening, specifically a law proposed in relation to the death of a policeman [...]

41. [...] such third party use relates to the proposal of a law. The average consumer will understand that any such use is not in a trade mark sense and does not refer to a particular business. The average consumer will understand that such use refers to a specific individual and a law proposed as a result of their death. This type of use of a name is generally known by the average consumer to happen, and does not affect the ability of entirely separate use of that name as a trade mark in relation to a designation of source of services. Examples include "Claire's Law" (in relation to domestic violence), "Sarah's Law" and "Megan's Law" (in relation to sex offences). To find otherwise would mean in effect that whenever such circumstances arose, registered trade marks

³⁷ Under section 3(1)(b) of the Act.

³⁸ Under section 3(1)(c) of the Act.

using the relevant name would become capable of invalidation. In any case such use was only in a short period between 2020 and 2021, with the resulting enacted law being The Police, Crime, Sentencing and Courts Act.”

65. Mr Scullion says that he understands the word ‘HARPERS’ to have taken on a new meaning by the trade and the public at large before the relevant date. He provides a printout from Wikipedia, which discusses the killing of PC Andrew Harper on 15 August 2019.³⁹ He also printouts from Google dated 4 August 2022, which show the search results for “harpers law” and “#harperslaw”.⁴⁰ The website links contained in the results appear to refer to the same events. This evidence is of limited probative value for reasons I have already explained. Nevertheless, Mr Scullion also provides a copy of a press release from the Ministry of Justice, dated 24 November 2021, entitled “Government to introduce ‘Harper’s Law’”.⁴¹ On that date, the government confirmed that, following the killing of PC Harper in 2019 and a campaign by his family, ‘Harper’s Law’ would be added to the statute book. This sought to introduce mandatory life sentences for anyone convicted of killing an emergency worker whilst committing a crime. Quotes from cabinet ministers referring to it as ‘Harper’s Law’ are included in the press release. On this basis, I accept that there was a successful campaign before the relevant date to enact a legislative change that was dubbed ‘Harper’s Law’. However, it does not automatically follow that the word ‘HARPERS’ would be perceived as a descriptive reference to a characteristic of the applicant’s services.

66. Many of the terms in the applicant’s specification do not constitute legal services at all, such as, *inter alia*, *analysis, evaluation, creation and brand establishment of trademarks, trade names and domain names* in class 35 or *estate agency* in class 36. In addition, some of the legal services themselves have no direct relevance to the nature of the legislative change introduced through the campaign. For example, I do not consider there to be any material connection between the same and, *inter alia*, *conveyancing services, enforcement of trade mark rights* or *consultancy services relating to the legal aspects of franchising*. It is difficult to envisage the circumstances

³⁹ Exhibit OPP-R07

⁴⁰ Exhibit OPP-R08

⁴¹ Exhibit OPP-R07

in which the relevant public would perceive the applicant's mark as descriptive in the manner pleaded by the opponent for any of these services.

67. It seems to me that the opponent's best case is in relation to the broader legal services in class 45, which could, in theory, be provided in relation to the substance of the legislative change. Even in relation to these services, whilst the evidence shows a government announcement, through an official communication channel, that a legislative change would be enacted because of a campaign, there is a distinct lack of evidence which demonstrates that consumers of the relevant services became aware of it before the relevant date. There is nothing which indicates how widely the term was known. No information has been provided as to what proportion of the relevant public would have seen the announcement and there is no evidence of any wider publicity or use of the term, not least in relation to the provision of legal services.

68. I note that the applicant's mark is not 'Harper's Law'; rather, it is 'HARPERS' solus. Notwithstanding that the word 'Law' is entirely descriptive of legal services, there is no evidence that the word 'HARPERS' on its own would be immediately seen as synonymous with the full term 'Harper's Law'. For instance, there is no evidence of the word and the full term being used interchangeably, or the word being used on its own in relation to the events described in the government press release. Even if it was, I note that the term 'Harper's Law' is not the official name of a statutory provision; it is an informal one, named after PC Harper and used by the campaign. It is my view that an informal reference to one specific legislative change is insufficiently direct when considering the applied-for services. In the absence of any evidence to the contrary, it is my understanding that legal services are not typically described or categorised by reference to such narrow fields of application. Rather, they are generally described or categorised by defined areas of law, such as, for example, immigration law, criminal law, intellectual property or conveyancing. It is not a matter of serious debate that the latter would be perceived as descriptions of the type of legal services on offer, but an informal term for a specific legislative change is unlikely to be immediately perceived in the same vein.

69. I also note that ‘Harper’ is a name, as highlighted by Mr Scullion.⁴² Moreover, as far as I understand it, it is not uncommon for legal services to be provided under marks which include surnames. In my view, the relevant public would be accustomed to law firms using one or more surnames to designate the origin of their services. In this connection, it is considered far more likely that the relevant public would, upon immediate perception of the mark, assume that it is a reference to a person involved in providing the services, possibly a partner, founder or head of the firm.

70. I recognise that it is not necessary that the sign in question is actually used in a way that is descriptive for it to fall foul of section 3(1)(c); it is sufficient, by virtue of the wording of the provision, if the sign could be used for such purposes. However, all the above leads me to conclude that the average consumer would not immediately perceive the applicant’s mark in the manner pleaded by the opponent without further mental processing or analysis, and I do not consider that there is a reasonably foreseeable risk thereof in the future. For these reasons, I am not satisfied that the applicant’s mark is exclusively descriptive of any of the applied-for services or a characteristic thereof.

71. For the avoidance of doubt, in reaching this finding I have not placed any reliance on the applicant’s submission that its mark was “considered at examination to have sufficient distinctive character”. Regardless of whether a mark is considered registrable at examination stage, the Registrar must act as an independent tribunal in *inter partes* proceedings and judge the matter purely on the basis of the arguments and evidence raised in such proceedings.

72. The opponent’s claims under sections 3(1)(b) and 3(1)(c) are dismissed.

⁴² In his witness statement, Mr Scullion states that ‘HARPER’ is a common first name. He also provides a printout from *Time Magazine*, dated 6 May 2016, which describes it as “the hot new baby name” for that year, albeit that the article does not appear to have specifically targeted UK readers.

Section 3(1)(d)

73. Section 3(1)(d) of the Act reads as follows:

“3(1) The following shall not be registered—

[...]

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) 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.”

74. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of section 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

75. The question to be determined is whether, at the relevant date of 16 September 2021, the word 'HARPERS' had become customary in the current language or in the *bona fide* and established practices of the trade to designate the applied-for services in classes 35, 36, 41 and 45. This must be based upon the perception of the average consumer of the services in the UK. My findings at paragraph 60 are equally applicable here.

76. The opponent's pleaded case under this ground is as follows:

"The trade mark HARPER consists exclusively of the word "Harper's" which, for law and legal goods and services, as at the relevant date, had become customary in the current language and/or bona fide established practice of the trade for the law or legal remedy which was the product of the campaign associated with the killing of Andrew Harper PC (i.e. Harper's Law)."

77. I have already found that I do not consider that the average consumer would perceive the applicant's mark as a reference to 'Harper's Law'. Even if they did, there is no evidence that 'HARPERS' had, at the relevant date, become customary in the current language or established practices in the trade of any of the services at issue. The only evidence going to this point date consists of the Wikipedia entry, the Google search results and the government press release. I have already explained why the first two pieces of evidence are of little probative value. Even taking them at face value, they do not establish that 'HARPERS' had been used in relation to the services at issue. The Wikipedia page outlines the incident involving Andrew Harper and the ensuing legal processes, whereas the search results appear to show links to websites about the campaign and coverage of the resulting legislative change. This is not use in trade. The government press release, whilst carrying more evidential weight, also does not reflect the position in trade; it was an announcement that a legislative change would be made. Mr Hannay provides some evidence of trade relating to the word 'HARPERS', albeit not specifically directed at this ground. He provides Google search results which show other law firms which trade under the word (in combination with other matter), as well as printouts from the websites of Harper James and Harper Law.⁴³ Even if this evidence was from before the relevant date (which it is not), it shows trade mark use of the word, not generic use.

78. As a consequence of the above, the opponent's claim under section 3(1)(d) is dismissed.

Section 3(3)(b)

79. Section 3(3)(b) of the Act is as follows:

"3(3) A trade mark shall not be registered if it is—

[...]

⁴³ Exhibits OPP-PAH1 and OPP-PAH2

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

80. In *TWG Tea Company Pte Ltd v Mariage Frères SA*, BL O/358/17, Mr Phillip Johnson, sitting as the Appointed Person, conveniently summarised the case law (at paragraph 84 of his decision) as follows:

“(a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: *C-87/97 Consorzio per la tutela del formaggio Gorgonzola*, ECLI:EU:C:1999:115, paragraph 41; *C259/04 Emanuel*, ECLI:EU:C:2006:2015, paragraph 47; *C-689/15 W.F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;

(b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer); *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei*, paragraph 56;

(c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder’s Club* [2010] ETMR 12, paragraph 25 and 26;

(d) the decision must have some material effect on consumer behaviour: *CFA Institute’s Application* [2007] ETMR, paragraph 40;

(e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: *T-248/05, HUP Usługi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) where a mark does not convey a sufficient specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services: *HUP*, paragraph 67 and 68; T-327/16; *Aldi v EUIPO* ECLI:EU:T:2017:439, paragraph 51;

(h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T29/16 *Caffé Nero Group v EUIPO*, ECLI:EU:T:2016:635, paragraph 48;

(i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T-41/05 *SIMS – École de ski internationale v OHIM*, EU:T:991:200, paragraph 50, *Caffé Nero*, paragraph 47.”

81. I can deal with this ground relatively briefly. The opponent’s pleaded case is as follows:

“The trade mark HARPERS is of such a nature as to deceive the public if used for legal goods and services which do not relate to the law or legal remedy which was the product of the campaign associated with the killing of Andrew Harper PC (i.e. Harper’s law).”

82. Clearly, this claim is predicated on the opponent’s argument that the word ‘HARPERS’ will be perceived as a reference to ‘Harper’s Law’. For a claim under section 3(3)(b) to succeed, the mark must create actual deceit or a sufficiently serious risk that the average consumer will be deceived, resulting in the economic behaviour of the average consumer being materially affected. I have already found that the average consumer is unlikely to perceive the applicant’s mark as a reference to ‘Harper’s Law’. Accordingly, it follows that there is no risk that the average consumer will be deceived in the manner asserted.

83. The opponent's claim under section 3(3)(b) is dismissed.

Section 3(6)

84. Section 3(6) of the Act states as follows:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

85. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law

namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54].”

86. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed?

(c) Was it established that the contested application was filed in pursuit of that objective?

87. It is necessary to ascertain what the applicant knew at the relevant date.⁴⁴ In these proceedings, that is the filing date of its mark, i.e. 16 September 2021. Evidence about

⁴⁴ *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

subsequent events may be relevant if it casts light backwards on the position at the relevant date.⁴⁵

88. As per the case law cited above, it is for the party alleging bad faith to prove it. The initial evidential burden falls upon the opponent: it must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If it does that, then the burden shifts to the applicant to rebut the allegation.

89. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith.⁴⁶

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

90. The opponent's pleaded case under this ground is as follows:

“(i) The application was filed for, at best, protection of a purported ‘ghost’ or ‘halo’ or other similarly filed bad faith mark. There is no genuine intention to use the mark in trade for the goods and services applied for.

(ii) Having ascertained that the Opponent/its licensee had incorporated & registered its ‘HARPERS LAW’ legal practice with the Law Society of Scotland and the profession’s professional indemnity insurers, the Applicant then either filed the application to ‘block’ the Opponent/its licensee from registering the mark or filed to unfairly ‘drive away’ a competitor. Either way, there was no genuine intention to use the mark in trade.

(iii) The filing of the Application falls short of the standards of reasonable practitioners in the field in question.”

⁴⁵ *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

⁴⁶ *Red Bull*

91. I take the above to be a claim that the applicant has no intention to use its mark but, rather, applied for the mark in order to block the opponent or its licensee from registering it or to unfairly block its business activities as a competitor.

Was that an objective for the purposes of which the contested application could not be properly filed?

92. If proven, this is an objective for the purpose of which the applicant's mark could not be properly filed.⁴⁷

Was it established that the contested application was filed in pursuit of that objective?

93. The evidence shows that AMNS was formed on 30 September 2016.⁴⁸ The name was later changed to HLL on 26 May 2021.⁴⁹ Mr Scullion says that, by or around 10 August 2021, HLL (the licensee) was registered with the Scottish Legal Aid Board. HLL was granted professional indemnity insurance on 13 August 2021.⁵⁰ By this date, Mr Scullion says that HLL was registered with the Law Society of Scotland.

94. On 16 September 2021, the applicant wrote to HLL.⁵¹ It references HLL's incorporation in 2016 and its name being changed to include the word 'Harpers' as its dominant and only distinctive element. It also acknowledges that HLL is registered with the Scottish Legal Aid Board and the Law Society of Scotland. Within the letter, the applicant asserts alleged unregistered rights in 'Harper Macleod' and 'Harpers' and seeks a number of undertakings from HLL. If the requests were not complied with, the applicant said it would take further action. Mr Scullion argues that the letter being sent on the same day that the application was filed discloses the applicant's intent. He also says that the applicant refused to provide any evidence to substantiate its claims. In addition, Mr Scullion states that HLL made efforts to resolve the dispute in good faith,

⁴⁷ See, for example, *Copernicus-Trademarks v EUIPO (LUCO)*, Case T-82/14, in which the General Court found that the filing of EU trade marks for the purposes of blocking applications by third parties, and without an intention to use the mark, was an act of bad faith.

⁴⁸ Exhibit OPP-04

⁴⁹ Exhibit OPP-04

⁵⁰ Exhibit OPP-06

⁵¹ Exhibit OPP-R03

including making four or more offers to mediate. However, no resolution was achieved, resulting in the filing of the present opposition.

95. Mr Scullion gives narrative evidence that, on or around 15 February 2022, the applicant contacted SLL. He alleges that this was done to put pressure on SLL; according to his narrative, the applicant claimed that the present opposition was an impediment to it engaging further with SLL and providing it with certain services (such as 'HM Connect').

96. Mr Scullion says that he has dealt with the applicant and its lawyers numerous times throughout his career, but he is not aware of the applicant having ever used the mark 'HARPERS'. In this connection, Mr Scullion has provided the applicant's accounts for the years ending 31 March 2005 and 31 March 2021,⁵² which he highlights contain no record of any trading under 'HARPERS' or acquisition of a 'HARPERS' business.

97. The evidence establishes that the applicant was aware of HLL, its incorporation and registration with the Scottish Legal Aid Board and Law Society of Scotland. Based upon the applicant's letter to HLL, that was clearly the case on the relevant date. The chronology of events presented by the opponent does, to my mind, raise the question of why the applicant decided to make an application to register the 'HARPERS' mark when it did, having – in its own words – “recently” become aware of the complained about activities. This is particularly the case, considering evidence has been presented of business being conducted as 'Harper Macleod' for many years before that time (see, for example, the accounts from 2005). In this connection, the timing of the application is relevant. On the balance of probabilities, it seems unlikely that the filing of the applicant's mark coinciding with its letter to HLL was coincidental. I also note the opponent's allegation of the applicant's outright refusals to provide any evidence to substantiate its bare assertions of unregistered rights. In my view, these matters do call into question the applicant's intentions on the relevant date. I acknowledge that mere knowledge of another party does not constitute bad faith and neither is a lack of intention to use a mark, at least without objective, relevant and consistent indications

⁵² Exhibits OPP-R01 and OPP-R02

showing that the applicant had the intention of a) undermining, in a manner inconsistent with honest practices, the interests of third parties, or b) obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark. The opponent's pleaded case goes further than mere knowledge and/or mere lack of intention to use; it alleges that the applicant became aware of the opponent's preparations with respect to a 'HARPERS LAW' legal practice, then proceeded to apply for its mark to act as a blocker to the opponent's activities with no intention to use the mark itself. Whilst the evidence presented in support of its case is somewhat limited, I find that the opponent has raised a rebuttable presumption of a lack of good faith.

98. The evidential burden now shifts to the applicant to explain its intentions at the time of making the application. In its counterstatement, the applicant's pleaded case in respect of section 3(6) was as follows:

"43. In relation to any allegation of bad faith, the Application Mark has been used by and with respect to the Applicant. The Applicant is therefore entitled to register the Application Mark as a trade mark, and it is not in bad faith to so do."

99. As can be seen from this, the applicant's defence is entirely predicated on its argument that it has an entitlement to register the mark because a) it has used the mark and b) others have used the mark with respect to it. The applicant asserts that this defeats any allegation of bad faith. Submissions going to the same point were made by Mr Watt at the hearing.

100. I have already discussed the applicant's evidence under the section 5(4)(a) ground. In short, the only reference to use of the word 'HARPERS' by the applicant is in an advertising brochure from 1988. No evidence has been given as to how many of the brochures were produced and distributed. In and of itself, I do not consider the brochure to be evidence of use of the mark in trade. Moreover, given that it was produced nearly 40 years before the relevant date, it cannot, in my view, establish what the applicant's intentions were when it made the application at issue. The applicant is best placed to explain its intentions. However, it has not filed any direct evidence of its intentions in applying for its mark. Furthermore, none of the witness

evidence produced by the applicant disputes the events as described by Mr Scullion or puts forward any alternative narrative. I find that the applicant has not demonstrated that it has used the mark 'HARPERS', or had any intention to do so, such that the *prima facie* case is rebutted.

101. I have also considered the applicant's evidence in respect of third parties referring to it as 'Harpers' under the section 5(4)(a) ground. Aside from the numerous witness statements on the topic (the shortcomings of which I have already outlined), this evidence broadly shows several sources using the word 'Harpers' to refer to the beginnings of the applicant's firm as well as some individuals using the word to refer to the firm within email correspondence. As previously explained, third-party references to 'Harpers' in a historical context do not constitute use and the use of 'Harpers' in correspondence appears to have been as a shorthand, informal way of referring to the applicant's firm, i.e. 'Harper Macleod'. I do not consider this to establish that the applicant had any intention to use the mark to distinguish its services. In the absence of such an intention, I disagree with the applicant that third-party references to it as 'HARPERS' entitles it to register the word alone as a trade mark. A third party may abbreviate a business' name for ease or brevity, but that does not imbue that business with an automatic right to register that abbreviated name, particularly where it has not actually traded under it as such for many years, has provided no evidence that it intends to do so in future, and had knowledge that a third party was preparing to trade under that name. It makes no difference that the applicant believed it had the legal right to prevent such use based on its rights under 'Harper Macleod' and/or a residual goodwill under 'HARPERS'. In those circumstances, the applicant should have based its case on those claimed rights, not registered the mark the opponent proposed to use as a blocking tactic. For these reasons, I do not consider that use of 'HARPERS' by third parties with respect to the applicant is sufficient to rebut the *prima facie* case of bad faith.

102. I recognise that 'HARPERS' is (aside from being in the plural or possessive form) part of 'Harper Macleod'. I do not consider this to be a sufficient answer, by itself, so as to rebut the presumption of a lack of good faith. In *Lidl Great Britain Limited & Anor v Tesco Stores Limited & Anor* [2023] EWHC 873 (Ch), Smith J held that Tesco had raised a rebuttable presumption of lack of good faith against Lidl in its application to

register its logo without the word 'LIDL' (as used). The judge held that it was then for Lidl to provide a plausible explanation of its objectives and commercial logic. Lidl had filed no evidence as to its intentions at the time of the application at issue and the judge was unable to accept any of its points for persuading the court of its good faith as evidencing the necessary subjective intentions. In the circumstances, the judge found that Lidl had been unable to displace the *prima facie* inference raised by Tesco that, at the time of the application, the mark was registered in order to use it as a weapon to secure a wider legal monopoly than it was entitled to, with no genuine intention to use it. As a result, the judge held that this was sufficient to amount to bad faith. This finding was later upheld by the Court of Appeal in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262. The mere fact that 'HARPERS' is (almost) part of 'Harper Macleod' is likewise insufficient to rebut the presumption of a lack of good faith.

103. In my view, the opponent has raised a *prima facie* case which has not been answered by the applicant. On this basis, I find that the applicant's mark was filed in bad faith and the opponent's claim under section 3(6) of the Act is successful.

104. I should add that, at the hearing, Mr Hannay referred to a previous decision of this Tribunal, namely BL O/468/01. In that case, the footballer Andrew Cole brought an opposition against the footballer Joe Cole and sought to rely upon unregistered rights consisting of nicknames/appellations given to him by the national press and recognised by football fans: 'King Cole' and 'Net King Cole'. Although it was established that Mr A Cole had traded as a professional footballer, and had been given these nicknames/appellations, the Hearing Officer determined that this did not give rise to any goodwill (in the absence of any trading activity). Of course, I am not bound by this decision, and, for the avoidance of doubt, I have placed no weight on it in assessing the opponent's claim. However, my own view that the applicant has no entitlement to the 'HARPERS' registration as a result of third-party references is not inconsistent with the findings of the Hearing Officer in that case.

Overall outcome

105. Whilst the opposition under sections 5(2)(b), 5(3), 5(4)(a), 3(1)(b), 3(1)(c), 3(1)(d) and 3(3)(b) has failed, the opposition under section 3(6) of the Act has been successful. Subject to any appeal, the applicant's mark will be refused registration in the UK.

Costs

106. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.⁵³

107. At the hearing, Mr Hannay submitted that the opponent sought costs at the upper end of the published scale because of the volume of repetitive witness statements and the vast volume of material lodged on behalf of the applicant. In response, Mr Watt submitted that the amount of evidence filed by the applicant was within the page limit set by the Tribunal and was not excessive in that respect.

108. Whilst I do not consider the overall volume of the applicant's evidence to have been excessive, I do agree with Mr Hannay to the extent that many of the witness statements filed by the applicant were repetitive. Ultimately, they had no impact on the outcome of the proceedings. Nonetheless, the opponent would have spent time reviewing and responding to the same. As such, I consider it appropriate to make a slightly uplifted award of costs in respect of considering and commenting on this evidence.

109. In the circumstances, I award the opponent the sum of **£2,400**, which is calculated as follows:

⁵³ The proceedings having commenced after 1 July 2016 but before 1 February 2023.

Preparing a statement and considering the applicant's counterstatement ⁵⁴	£400
Preparing evidence and considering and commenting on the applicant's evidence	£1,000
Preparing for and attending a hearing	£800
Official fees	£200
Total	£2,400

110. I order Harper Macleod LLP to pay Ross Harper Limited the sum of **£2,400**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 6th day of August 2024

James Hopkins
For the Registrar

⁵⁴ Although the opposition was brought under eight grounds in total only one was successful. Furthermore, the statement of grounds was not particularly lengthy. In the circumstances, I consider a contribution of £400 to be proportionate.

Annex

Services of the applicant's mark (UK application no. 3696054)

Class 35: Provision of initial company secretarial services on company formation; company office secretarial services; analysis, evaluation, creation and brand establishment of trademarks, trade names and domain names; registered office services; the provision of information and advisory services all relating to the aforesaid services.

Class 36: Estate agency; estate agency services for sale and rental of buildings and/or land; agency services for sale and rental of businesses; real estate (leasing of -); real estate acquisition (for others); real estate administration; real estate services; real estate consultancy; real estate investment services; fiduciary services; trustee services; nominee services; advisory services relating to insurance; investment services; the provision of information and advisory services all relating to the aforesaid services.

Class 41: Provision and organisation of events, workshops, seminars and conferences in the field of entity governance, compliance and management, intellectual property, trade marks and brands, estate agency services, real estate leasing, real estate acquisition, real estate administration, real estate affairs, real estate investment, real estate management, legal matters, legal services, financial matters, financial services, and regulatory compliance; provision of education and training in relation to entity governance, compliance and management, intellectual property, trade marks and brands, estate agency services, real estate leasing, real estate acquisition, real estate administration, real estate affairs, real estate investment, real estate management, legal matters, legal services, financial matters, financial services, and regulatory compliance; the provision of information and advisory services all relating to the aforesaid services.

Class 45: Legal advice; legal services; court and tribunal representation services; legal consultancy services; legal enquiry services; conveyancing services (legal services); consultancy services relating to the legal aspects of franchising; consultancy services

relating to the legal aspects of real estate matters, estate agency, and real estate administration; compilation of legal information; certification of legal and other documents; advisory services relating to consumers rights (legal advice); legal information services; legal research; legal services relating to entity governance, compliance and management, intellectual property, trade marks and brands, estate agency matters, real estate (leasing of -), real estate acquisition (for others), real estate administration, real estate affairs, real estate investment, and real estate management; litigation services; alternative dispute resolution services (legal services); mediation (legal services); registration services (legal); trademark watch services; enforcement of trade mark rights; litigation consultancy; litigation advice; registration of domain names; domain name advisory services; mediation services for marital disputes; notary public services; legalisation services; services for the arrangement of Apostilles; the provision of information and advisory services all relating to the aforesaid services.

Services of the opponent's mark (UK registration no. 2629379)

Class 36: Property and real estate agency services; property and real estate management, selling, leasing, valuation, selection and acquisition, appraisals and consultancy services; rating and rent review services; property and investment consultancy services; financial services relating to real estate and property; insurance, financial and monetary services, all relating to investment services; financial management; financial analysis; financial appraisals; trusteeship services; research consultancy and advisory services relating to the aforesaid services; factoring.

Class 41: Educational and training services all relating to law, business, finance, property management; arranging and conducting of conferences and seminars; preparations of reports relating to the aforesaid services; education and training services; translation services; provision of information and advisory services relating to all the aforesaid services.

Class 45: Legal services; solicitor's services; legal research services; criminal investigations; forensic advice for criminal investigations; conveyancing services; title searching; professional consultancy services relating to property management;

preparation of reports relating to all the aforesaid services; provision of consultancy, information and advisory services relating to the aforesaid, including such services provided online from a computer network and/or via the internet and/or extranets; providing an on-line database (information) of data, text, information, documents, bibles (being bundles of information), precedents (being prior examples of documents); preparation of reports, provision of information and advisory services, all relating to the aforesaid services.