

O/0844/25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3793453

IN THE NAME OF LEGALTECH APS

AND



OPPOSITION THERETO UNDER NO. 437431

BY THELAWYER.COM LIMITED

BACKGROUND AND PLEADINGS

1. On 29 May 2022, Legaltech ApS (“the applicant”) applied to register the word trade mark “The Lawyer Hub” (“the contested mark”). The contested mark has a priority date of 2 December 2021 from a Danish trade mark. Registration is sought for a wide range of services in classes 35, 36, 41 and 42, listed at annexe 1 to this decision.

2. The application is opposed in full by Thelawyer.com Limited (“the opponent”) based on ss. 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following two registered trade marks for the opposition based on ss. 5(2)(b) and 5(3):

Trade Mark	Dates	Specification relied upon
UK 918001810 (“UK810”) 	Filed: 19.12.2018 Registered: 27.06.2019	Goods in classes 9 and 16, services in classes 35, 38 and 41 (see annexe 2).
UK 2179699 (series of two) (“UK699”) THE LAWYER 	Filed: 15.10.1998 Registered: 18.05.2001	Goods in classes 9 and 16, services in class 41 (see annexe 2).

3. The opponent says that the competing marks are similar and that the goods and services are identical or similar. Consequently, it submits that there is a likelihood of confusion and that the contested mark should be refused registration under s. 5(2)(b).

4. The opponent also asserts that its trade marks have a reputation for all of the goods and services in their specifications. It says that the average consumer will make a link between the competing marks and that the average consumer will think that there is an economic connection between the users of the marks. It further submits that the contested mark will gain an unfair advantage from the earlier marks’ reputation and

that the earlier marks will suffer damage through tarnishing or degradation and/or dilution of their distinctive character. It therefore requests that the application be refused under s. 5(3).

5. In addition, the opponent claims that it has a protectable goodwill of which the sign “THE LAWYER” is distinctive as a result of its business in the UK since 1987 in relation to a wide range of goods and services. The asserted scope of the business is set out in full at annexe 2 to this decision. The opponent says that the use of the contested mark would mislead the relevant public and that that misrepresentation would damage the opponent’s goodwill. It requests that the application be refused under s. 5(4)(a).

6. The final ground of opposition is bad faith. The opponent’s case is that, in open correspondence, the applicant’s attorneys disclosed the fact that the application has been made not with the intention of using the mark but as a defensive measure. The opponent says that the mark was filed as a blocking mechanism to stop others protecting the mark and that the applicant’s averred intention, to use the mark for a basic homepage which redirects consumers to “The Attorney Hub” website, is not genuine use of a trade mark and is bad faith. Alternatively, it says that the applicant’s filing strategy is intended to disadvantage the opponent, causing it to incur unreasonable and unnecessary legal costs in defending its rights against the application. The opponent requests that the application be refused under s. 3(6) of the Act.

7. The holder filed a counterstatement in which it denies all of the grounds and puts the opponent to proof. I will return to the detail of the counterstatement as appropriate later in this decision but I note at this juncture that the applicant places particular reliance on what it says is the non-distinctiveness of the words “The Lawyer”.

8. Both sides filed evidence as well as submissions during the evidence rounds. The applicant also filed written submissions in lieu of a hearing. Neither party requested to be heard orally. The opponent is represented by Bird & Bird LLP. The applicant is represented by its Director, Michael Johansen.

Case management

9. A joint hearing was held before another hearing officer on 14 June 2023 to consider the applicant's objection to certain parts of the statement of case, which were said to contain without prejudice material. The objection related to correspondence between the parties, which was filed in advance of the joint hearing and which was considered by the hearing officer. The hearing officer decided that the material was not without prejudice, for the reasons given in her decision dated 15 June 2023. The applicant attempted to appeal the decision but, as the decision did not terminate the proceedings or award costs, there was no automatic right to appeal the procedural decision at that point. The tribunal refused the request for permission to appeal in its letter of 26 July 2023. The correspondence in question was subsequently filed in proper evidential form and admitted into these proceedings (see [188] below).

10. A case management conference was held, before me, on 20 September 2023, to discuss a request for confidentiality of some of the opponent's evidence. I allowed that request in part, for the reasons I gave in my letter of 21 September 2023 and which I adopt here.

11. The above case management decisions are appealable as part of this decision.

12. I note that the order for confidentiality is put in broader terms than the directions in my decision of 21 September 2023. Any discrepancy between my decision and the confidentiality order is a procedural irregularity: my decision is the authoritative version.

Witnesses

13. Both parties' evidence was filed in the form of witness statements, in some cases supported with exhibits. None of the witnesses was cross-examined.

14. The opponent's evidence is given by:

- Jane Wilkinson, Managing Director of the opponent. Ms Wilkinson's evidence goes to the use which has been made of the marks and sign relied upon.

- Liisa Laitinen, Marketing & Communications Director for Borenius Attorneys Ltd, which has offices in the UK and Finland, among other places. Ms Laitinen gives evidence about subscriptions and reports purchased by her firm from the opponent, as well as some information about events involving the opponent.
- Isabel Casas Domínguez, Head of Knowledge Management at J&A Garrigues SLP, which has offices in the UK as well as other countries, including in the EU. Ms Casas Domínguez describes subscriptions and reports purchased by her firm from the opponent and provides some details of events.
- Rafael García Llaneza, Deputy Managing Partner at Uría Menéndez Abogados, SLP, a firm with offices in the UK, EU and USA. Like Ms Laitinen and Ms Casas Domínguez, Mr García Llaneza's evidence is about subscriptions taken out by his firm from the opponent, reports his firm has purchased and events hosted or sponsored by the opponent.
- Emma Green, a partner at Bird & Bird LLP. Ms Green provides two witness statements. These concern an article about the opponent and copies of correspondence between the parties regarding the application.

15. The applicant's evidence is provided by Michael Johansen, its Director. Mr Johansen's evidence is brief and includes correspondence between the parties, as well as some website evidence.

16. I have read all of the evidence. I will refer to it, as I consider necessary, in the course of this decision.

PROOF OF USE

17. The use provisions are at s. 6A of the Act which, so far as relevant, reads 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.

(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.”

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:¹

“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].

¹ 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. This is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

(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].”

19. As the contested mark’s priority date is 2 December 2021, the relevant period for the purposes of s. 6A(1A) is 3 December 2016 to 2 December 2021. UK810 had not completed its registration period by the start of that period and is therefore not subject to the use provisions at s. 6A. It may be relied upon whether or not it has been put to use. UK699, in contrast, is subject to the use provisions and the applicant requested evidence proving genuine use.

Proof of use: the evidence

20. The opponent was incorporated in July 2018.² Its parent company has been in existence since 1981. The parent company, another company in the group called Centaur Communications Limited and the opponent have all used the earlier marks. Since 2018, that use has been with the consent of the opponent. The applicant has not taken issue with any of this and I proceed on the basis that it is not disputed that the opponent may rely on the use shown.

² Wilkinson, [3]-[4], exhibit JW-1 and JW-2.

21. The evidence is that the opponent published a magazine in print from 1987 to July 2021, initially weekly, then, from 2017, monthly.³ The masthead from 2016 to 2021 corresponds to UK810; an example is shown below:



22. From 2013, the front covers include the website address, www.thelawyer.com. The final print issue of *THE LAWYER* magazine was published in July/August 2021.⁴ Prints from the opponent's website show archive copies of the magazine from 2017 to 2021 available as PDF documents.⁵

23. Circulation figures for the weekly printed magazine (48 issues per year) were approximately 11,520 copies per week in 2014 and 9,240 in 2016. From 2017 to July 2021, there were 10 issues per year. Approximately 5,000 copies were published per issue in 2019 and 2020; in 2021 the figure fell to around 3,800.⁶ Ms Wilkinson says that her understanding is that law firms would circulate their copy of the magazine internally among their employees, so it would be seen by many more people than the number of copies published suggests.

24. The evidence includes archive prints of the opponent's website, www.thelawyer.com, dated between 2001 and September 2021.⁷ Prints from May 2016 to 2020 show the slightly stylised words "THE LAWYER" in white on red, as in UK810 and the masthead image reproduced above, though there are also some examples of red on white in this period and it is this red-on-white version which is shown in a print dated 2021.⁸ There is word-only use of "The Lawyer" (e.g., "SUBSCRIBE TO THE LAWYER PREMIUM", "Search The Lawyer and press 'return'") throughout.

³ Wilkinson, [5]; EG-1.

⁴ JW-5, pp. 39-40.

⁵ JW-6, pp.10-13.

⁶ Wilkinson, [8].

⁷ JW-6.

⁸ For example, at JW-15.

25. Since 2018, thelawyer.com has operated a subscription business in which a single subscription is purchased by law firms allowing multiple user access.⁹ The evidence is that the Lawyer’s UK customer base from 2016 to 2021 has been comprised of approximately 370 UK law firms, including all of the Magic Circle firms.¹⁰

26. Website user data is provided from 2017 to 2020.¹¹ The precise figures are subject to a confidentiality order but the number of unique users annually from the UK is significant. Figures in open evidence say that, as of 2020, the website had 264,400 unique registered users with 5,000+ partner and general-counsel-level subscribers visiting monthly.¹² This is much lower than the data in the witness evidence, though it is possible that it reflects a difference between registered unique users and total unique users who visited the site. I note, however, that the same article says that around 95% of the website’s content is behind a paywall, which makes casual users less likely to make up a very significant portion of unique users. It is reported that the Lawyer’s print magazine has a circulation of 6,000 copies read by 18,000+ senior lawyers each month.

27. The articles in both the print magazine and the website concern topics of interest to the legal profession, such as lawyers’ moves between firms, “in-house interviews”, mergers of law firms and skills for legal practitioners. Sections on the website in 2019 included “latest”, “commentary”, “market reports” and “litigation tracker”, whilst the homepage shows news items for law firms and business leadership, among other things. There is reference to “THE LAWYER DATABASE”, which appears to cover 71,808 companies, 9,154 legal advisers, 101,430 “matters” and 14 sectors.¹³ There is a further reference in documents from 2018 to “The Lawyer’s Litigation Tracker database, which contains details of over 9,000 judgments dating back to 2015”.¹⁴

28. Editorial newsletters bearing UK810 and concerning law firms and their business were issued in the relevant period.¹⁵ In addition, it is reported in an article from

⁹ EG-1.

¹⁰ Wilkinson, [39]. A similar figure for 2020 is given in EG-1.

¹¹ Wilkinson, [10].

¹² EG-1.

¹³ JW-6, p. 7.

¹⁴ JW-5, p. 19. It is unclear whether a reference to the Litigation Tracker in EG-1 is also about the database: “litigation tracker” also appears to be the name of a report and the dates of first use do not coincide.

¹⁵ JW-7.

InPublishing that the opponent has issued a daily newsletter under the name “Horizon by The Lawyer” since January 2020.¹⁶ An example of the newsletter heading from 2021 is shown below:¹⁷



29. There are several references to reports in the relevant period, such as “*The Lawyer’s* US Top 50 report”, “*The Lawyer’s* European 100 report” and “*The Lawyer* Technology Report 2019”.¹⁸ Some are visible available for purchase via the website. Extracts are provided from the “European 100” 2019 and 2020, which show UK810 in a composite mark also including the words “Market Reports”, as well as “THE LAWYER” in both red on white and in word-only form.¹⁹ An example is reproduced below (it is taken from a 2016 document because the image is better but the same form is shown in the relevant period):



30. Ms Wilkinson’s evidence is that the opponent has published the “European 100” report since 2010 (this appears on the website print as “The Lawyer Euro 100”).²⁰

31. There is an extract from 2017 about “The Lawyer UK 200: The Independents” report from 2016.²¹ This contains detailed analysis of law firms’ metrics such as turnover, and ranks the firms. Front covers for the same report for 2018 to 2021 (November) are also in evidence, along with front covers for other supplements with names including “THE LAWYER” or bearing UK810 in the composite form with “Market Reports”.²² The evidence is that these supplements are market reports focusing on the UK legal market and finances and strategies of law firms in the UK and overseas.²³

¹⁶ EG-1.

¹⁷ JW-7, p. 7. It is also mentioned at JW-6, p. 8.

¹⁸ JW-5, JW-6.

¹⁹ JW-11.

²⁰ Wilkinson, [14]-[15].

²¹ JW-5.

²² JW-9, JW-10.

²³ Wilkinson, [13].

A print of the website dated September 2021 refers to “THE LAWYER Signal”, said to offer “in-depth strategic insight and benchmarking of your markets, clients and more”. It lists three reports, including “The Global Litigation 50”, for which front covers from 2017 to 2020 are provided.

32. There is also some evidence that there was a careers section on THE LAWYER website throughout the relevant period.²⁴ Users of the website are able to browse by category (e.g., practice area, vacancy type, region) or search the database. It appears to list thousands of jobs, very many of which are in the UK. However, whilst headings such as “job alerts”, “careers news” and “Lawyer 2B” are visible, the content is not in evidence.

33. Approximate UK revenue for *The Lawyer* in print and online, including subscriptions and market reports, is as follows:²⁵

Financial year	Print & online revenue
2018	£2,077,000
2019	£2,427,000
2020	£2,727,000
2021	£2,879,000

34. Website prints dated June 2020 and September 2021 include headings for “events” on mental health matters and about the role of general counsel.²⁶ Marketing email information and associated marketing images showing UK810 include information about an “e-learning launch” in 2017 with a course on contract drafting.²⁷ This is how the mark is presented:



²⁴ JW-8.

²⁵ Wilkinson, [40].

²⁶ JW-6.

²⁷ JW-7.

35. In 2020 and 2021 (during the relevant period), the opponent hosted online webinars on subjects such as contracts, disclosure and practical business topics.²⁸ UK810 is visible in still video images. There is also promotion from 2017 to 2020 of conferences and “summits”.²⁹ A handful were in London but even cross-referencing the exhibits there are a number which may or may not have taken place in the UK (some were clearly on the continent, so it cannot be inferred that all of the events were directed at UK customers). “The Lawyer” word only, as well as in red on white and UK810 are visible.

36. “THE LAWYER Awards” were established in 1993 and continued annually throughout the relevant period.³⁰ There is evidence that they were promoted in marketing emails.³¹ In 2017 over 1,300 legal professionals attended the awards ceremony.³² The awards were billed on the opponent’s website as “unquestionably the biggest night of the year for the legal profession” and reports about winners were published on the website following the events. Marketing material from 2017 to 2019 shows the same font and typeface as UK810 but in black on white, as shown below.³³ There is also evidence that third parties in the UK have purchased the right to use logos featuring “THE LAWYER” in connection with nominations/awards they have won.³⁴ The images appear to have been compressed and, of those about *The Lawyer* awards (UK) which are clearly in the relevant period, most are illegible even with magnification. Those which can be read at all show use of “THE LAWYER” corresponding to the example below from 2018:



²⁸ JW-19.

²⁹ JW-7, JW-15, JW-18.

³⁰ Wilkinson, [20]; JW-14, JW-15, JW-16.

³¹ JW-7.

³² JW-15, p. 13.

³³ JW-7, JW-16.

³⁴ Confidential exhibit JW-13, JW-17.

37. Confidential figures are provided for the revenue generated in relation to the sale of rights to use the logos for The Lawyer European Awards in the relevant period.³⁵ However, these awards have limited categories for UK firms, so it is doubtful that much of it relates to the UK and the use of UK699; there is no way for me to determine how much might. Approximate revenue generated in the UK from events including sponsorship, attendees and logos purchased in connection with The Lawyer Awards and The Lawyer European Awards for use on promotional materials is given as follows:³⁶

Financial year	UK revenue from events & training
2018	£1,476,000
2019	£1,695,000
2020	£731,000
2021	£885,000

38. I also take into account that The Lawyer won the PPA (Professional Publishers' Association) Awards for Business Media Brand of the Year in 2017, Editor of the Year (Business Media) in 2018 and Business Information Product of the Year in 2020.³⁷ Further, third parties in the legal field have commented on the standing of the opponent's publication. Examples from the relevant period include "Today, with its focus on forward-looking data-rich content targeting the leadership teams of top legal service providers in the world's leading international law markets operating out of London, The Lawyer is a leading provider of digital intelligence on the business of law" (2020, in the *InPublishing* article) and "The Lawyer' is the UK's leading magazine and website for commercial law firms" (2017, in relation to The Lawyer European awards).³⁸

³⁵ Wilkinson, [34].

³⁶ Wilkinson, [41].

³⁷ Wilkinson, [38], JW-30. See also EG-1.

³⁸ EG-1; JW-24.

Assessment

Form of the mark

39. The applicant's main objection to the evidence of use concerns the form in which the mark has been used. It criticises the opponent for referring to UK699 as a word, rather than figurative, mark and says that "the distinctive, dominant and protected part of the Opponent's figurative trademark is therefore clearly not the words "*the lawyer*" (they are generic) but instead [...] the shadow effect on the registered mark" (original emphasis).

40. I accept that the prints of search results from the register provided by Mr Johansen indicate "mark type: figurative" for both earlier trade marks.³⁹ However, that is not the end of the story. The mark at issue is a series mark, with two marks in the series. This means that there are two trade marks registered under the same number. It is clear from the register that the second mark is in a stylised typeface. The first, though, is the words "THE LAWYER" presented in an utterly unremarkable typeface and font. It appears to me to be the words "THE LAWYER" presented in the typeface and font which was used for registration of word trade marks at the time. This is also what the opponent says but I have no positive evidence to that effect. Although the series of two may properly be classed as "figurative", I am doubtful that that means the plain words should be treated as figurative. Even if it is not, strictly speaking, a word-only trade mark, I do not consider that the typeface or font are distinctive in their own right: the overall impression of the first mark is of the words "THE LAWYER" and any contribution made by the typeface and font is negligible. For convenience, I will refer to the first mark in the series of UK699 as "the Word Mark".

41. The above point feeds into the applicant's submissions regarding the distinctiveness of the words "THE LAWYER". I would not be able to find that the earlier marks are descriptive or non-distinctive, because they are registered trade marks and must be taken to have at least the minimum degree of distinctiveness required for registration.⁴⁰ As there is nothing else in the Word Mark which might make it distinctive, the words must perform that function. Nevertheless, while I accept that the words "THE

³⁹ MJ-1.

⁴⁰ *Formula One Licensing BV v OHIM*, C-196/11P, EU:C:2012:314.

LAWYER” are potentially lacking in distinctiveness for goods and services in the legal field, including magazines intended for consumption by lawyers, it is well established that magazine titles are frequently highly allusive and that the average consumer is accustomed to distinguishing between the names of publications, so that lower levels of distinctiveness are tolerated for such goods and services than they may be in relation to other goods and services.⁴¹ Consequently, for the goods in classes 9 and 16, and the publication services in class 41, the average consumer is likely to recognise the words “THE LAWYER” as distinctive for these goods and services, even though they remain inherently weak. The same would appear to apply to conferences, awards and fairs, all of which may have highly allusive names which are still capable of functioning as indicators of origin. As I have already said, though, I am doubtful that the Word Mark is indeed “figurative”, in which case the words must be treated as distinctive.

42. As the Word Mark has no, or negligible, stylisation, it is closer to the contested mark than the second mark in the series. The Word Mark will therefore in theory offer the opponent the better case. Further, there is no use at all of the second mark in the series as registered. I will therefore focus on the Word Mark, as the opposition will not succeed based on the second mark in the series if it fails based on the Word Mark.

43. I turn to the question of whether the marks have been used as registered or in a form which does not alter the distinctive character of the mark under s. 6A(4)(a). In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

⁴¹ See, for example, *The ADULT CHANNEL*, case R-772/2000-4 (EUIPO Fourth Board of Appeal), 3 December 2001.

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

44. The evidence contains multiple examples of word-only use of “The Lawyer”. As the Word Mark has no distinctive features other than the words, I consider this use of

the mark as registered. Even if that is wrong, any use in upper case is acceptable variant use of the Word Mark, namely the unadorned words “THE LAWYER”, since any difference in the particular typeface used is incapable of changing the distinctive character of the mark. Use in title case, or indeed lower case, is also use which does not alter the distinctive character of the trade mark. A change in case, even combined with very slight differences in the typeface between the registered mark and the mark as used, does not change the distinctiveness of the mark from one which consists of the words “THE LAWYER” with no other discernible distinctive features.

45. Most of the use of “THE LAWYER” is of those words presented in a slightly stylised serif typeface in contrasting colours, whether white on red (including in the same form as UK810), red on white or white on black. I also consider these to be acceptable variants of the Word Mark. If I am correct that the Word Mark is not figurative, the use in different colours and typefaces/fonts is fair and notional use of the registered mark. If I am not right about that, the typeface is entirely ordinary and unlikely to make any impression on the average consumer. Although the colours are contrasting, such colour combinations are commonplace and not themselves distinctive. Use of the words “THE LAWYER” in those colours and/or slightly stylised typefaces does not change the distinctiveness of the registered mark. I note that the applicant relies, indirectly, upon the decision of this tribunal in BL O/025/15, which concerned acceptable variants of the word “SIMPLY”. However, the present case is not on all fours with that one. The use of colour in that case was a more complex arrangement, combined with the use of a particular typeface which was enough to change the distinctive character of the very weak word. Even if that decision were particularly persuasive, I do not consider the alterations in the present case are comparable.

46. Finally in relation to this trade mark, I would add that a number of the examples of “THE LAWYER” appear with other matter. The masthead includes additional information. Other examples are reproduced at paragraphs 28, 29, 34 and 36, above. It is settled law that there may be genuine use of a trade mark if it is used as part of a composite mark or in conjunction with another trade mark, provided that the trade mark continues to be perceived as indicating the origin of the product: *Colloseum Holdings AG v Levi Strauss & Co.*, C-12/12, EU:C:2013:253. In the vast majority of the instances where “THE LAWYER” is used with additional matter, that material is descriptive or

non-distinctive (e.g., “awards”, “market reports”, “conferences”, the addition of “.com” on the website). I recognise that use in plain text in combination with descriptive matter may change the distinctive character of the mark, particularly as the registered mark is only weakly distinctive. However, in most cases the words “THE LAWYER” are highlighted or isolated, for example by being presented in capital letters and/or in a bolder font than the other descriptive matter, such as in the images shown above. In these presentations, the trade mark is separated from the descriptive matter (or, in the case of “Horizon by The Lawyer”, the other sign) and will, in my judgement, continue to be perceived as indicative of the origin of the products, in line with the guidance in *Colloseum*. These are also acceptable variants. In many cases, the plain text use is on the website with the words “THE LAWYER” displayed prominently at the top of the page.⁴² This constitutes use of the mark in relation to the goods or services shown on the website. Additionally, with this context, the consumer is likely to recognise that “The Lawyer” serves as a trade mark, rather than having a purely descriptive purpose, even in phrases such as “The Lawyer Awards”.

Sufficiency of use and fair specification

47. The next issue is whether the mark has been used for all the goods and services asserted and whether such use is sufficient to qualify as genuine use. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

⁴² See, for example, JW-15.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

48. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

49. The evidence establishes that the opponent regularly published a print magazine under the mark concerning matters relevant to the legal profession for most of the relevant period. The revenue figures are not broken down between the print magazine and the website but, given that the magazine is targeted at a specific professional

public, the circulation figures for the print edition are likely to be significant in that niche market. There is also evidence, albeit quite limited, from third parties that “THE LAWYER” was considered a leading magazine in its field in the relevant period. I am satisfied that there has been use of the mark on or in relation to “magazines; all relating to legal matters and/or the legal profession” in class 16. There is, however, no evidence that the opponent has produced journals, leaflets, catalogues or newspapers at all in the relevant period.

50. As for newsletters, the Horizon newsletter appears to be an online, rather than print, publication: the third party comment about the newsletter in context is “[the opponent] launched Horizon by The Lawyer – a daily newsletter that goes out at 7am with all of its information contained in it, so users don’t need to click through to thelawyer.com website”.⁴³ The editorial newsletters were issued by email. I cannot see any evidence that newsletters were published, in print, under the mark. However, electronic newsletters fall under the mark’s class 9 term “Publications in electronic forms supplied on-line from databases or from facilities provided on the internet (including web sites) relating to legal matters and/or the legal profession”. Although there are no revenue figures specific to newsletters, I am satisfied that their issue over a number of years, and daily for almost two years at the end of the relevant period, constitutes genuine use in relation to electronic newsletters in the legal field provided via email in class 9. There is no evidence that the newsletters were made available via databases, nor by any other means of internet transfer.

51. As regards other “publications” made available from databases or the internet, thelawyer.com website appears to be a vehicle for the publication of market reports, which are available for purchase through the website. There is evidence that market reports covering various matters in the legal sector have been issued in the relevant period. All of these have been offered for sale under the “THE LAWYER” mark or acceptable variants thereof. Again, there is no breakdown of revenue for market reports specifically and only limited invoice evidence of actual purchase. There are no circulation figures for the reports. Marketing from April 2016 suggests that a subscription includes access to the market reports but it is unclear whether this remained the position in the relevant period. In particular, evidence from the relevant

⁴³ See also the final line in the table at JW-7, p.1, concerning a Horizon newsletter.

period advertises the market reports on the website at additional cost, while an email from 2018 distinguishes between a complimentary subscription to premium content and free access to three specific market reports, suggesting that by 2018 at least the two did not go hand in hand.⁴⁴ In terms of the format, Ms Wilkinson refers to them as supplements, suggesting a print publication attached to the print magazine. There is a reference in 2020 which says that “the title has sold its benchmarking market reports for quite some time” and that it “took its benchmarking product online” in 2019.⁴⁵ The reference to sales suggests that the reports were a product sold separately from the magazine and this evidence indicates that market reports were published in print until 2019 and through the website thereafter.

52. In terms of whether the digital market reports are supplied via the internet or a database, I accept that the market reports were made available from the opponent’s website, although the evidence is quite limited: there are some headings on the website for “market reports” and a small number of reports are listed on some of the home page prints. The only other evidence shows contact details for the relevant person at the opponent for more information. The reports may, in fact, be contained on a database on a server somewhere. However, it is not clear to me that the average consumer would perceive the goods as being supplied on-line from a database. That term, to my mind, suggests that the consumer interacts with the database in some way, such as a library catalogue which contains newspapers and magazines in digital form which may be searched by the user. There is nothing in the evidence to suggest that the average consumer would do anything more than select one of the opponent’s market reports from a list on the relevant web page, make payment and then be able to download it.

53. In terms of digital magazines, whether downloadable or not, there is some evidence that archive copies of the print magazine are available on thelawyer.com. Ms Wilkinson’s evidence regarding the exhibit is that the prints are archive prints taken from the Wayback Machine. Some of the images in the exhibit clearly are from this archive source but not those showing the magazines, which are not dated and bear no indication that they are from the internet archive. The back issues may well have

⁴⁴ JW-7, p. 8.

⁴⁵ EG-1.

been available on the website throughout the relevant period and, if they were, they may have been available on a database searchable by the consumer. However, there are obvious reasons why the opponent needs positively to demonstrate that this was the case, not least of which is that the PDF documents may well have been uploaded in July 2021 simply as an archive at the end of the print run, rather than being uploaded as they were published. It would have been easy for Ms Wilkinson to give this information. I have been unable to find any indication from the prints dated in the relevant period that the magazine in electronic form was available on the website. Even if the issues were present somewhere, the fact that they are not apparent from the evidence points towards them being archival documents maintained as a record rather than being intended to carve out a trade for electronic magazines, whether available via a database or other internet-based means. I should add that “magazine” normally means a print publication, issued weekly or monthly, containing a range of articles accompanied by photographs or other images. I accept that magazines may be digital but, in my view, the average consumer would expect a digital magazine to have a similar issue frequency and format to a print magazine and be either accessed as a single document or downloadable. I do not think that the average consumer would understand “magazine” to mean a website, even though many of the items and articles may coincide.

54. There is evidence that the opponent operated a database containing judgments and commercial information in the relevant period. As with much of the evidence, there is very limited information going beyond the website prints or comments in the magazine. The print magazine suggests that the database can be purchased; the options in relation to the database extract shown on the website are unclear but it is reasonable to infer access is available and Ms Wilkinson says that the revenue figures include subscriptions to the magazine/website “and the associated litigation tracker and market reports [...]”. It is not clear whether subscription automatically results in access to the database and there are no specific figures relating to the database. It does not seem to me that the sale of access to a database would amount to the sale of a “publication in electronic form supplied on-line from databases”. A “publication” usually means a product such as a magazine, newspaper or newsletter. Here, the database is the product sold and I do not think that the average consumer would consider a database to be a “publication”. As with the market reports discussed above,

I cannot rule out that the “litigation tracker” report product is supplied via a database but the evidence does not establish that it is.

55. There is clear evidence that the opponent offered a database of legal jobs in the relevant period. It was searchable or could be browsed by category. However, for the reasons given above, this searchable database would also not, in my view, be considered a “publication” by the average consumer.

56. In terms of a fair specification for the goods in class 9, the goods which have actually been provided are electronic newsletters and market reports, via email and a website, respectively. I consider that newsletters and reports are distinct products. Given the breadth of “publications” at large, despite the existing limitation, it is appropriate to limit the specification to these products, which appear to me to be discrete subcategories of publication. There is no evidence that either of these products were supplied online from databases. That said, while the specification suggests that “online from databases” is a separate type of delivery from “facilities provided on the internet”, rather than a subcategory of the latter, I have some difficulty envisaging how this would be the case. This takes me to the question of whether the average consumer would fairly describe the opponent’s goods as being provided by email and via websites (i.e., their actual use) and consider that these are distinct means of communication which it is appropriate to reflect in the fair specification, or whether they would simply be regarded as provided via the internet. An emailed newsletter differs in nature from news provided on a website in the sense that it is delivered directly to the recipient’s email inbox and may have a rather different format from a website. Yet very often an email newsletter will look like a web page and will contain links directly to a website; sometimes, the newsletter itself provides only a summary and the user must click through links to a website for the articles proper, or the reader will be given an option to open the newsletter in a browser. I think that the average consumer would consider it pedantic to limit the specification for the products in question to the precise means of delivery which has been used and would simply describe them as provided over the internet, without distinction between email and the world wide web/web browsers. However, as the opponent appears to consider provision from databases to be a distinct category and the opponent knows its business best, I will exclude this term.

57. Turning to the “provision of information relating to legal matters and/or the legal profession; provision of information on-line from a computer database or the internet; all relating to legal matters and/or the legal profession” in class 41, the thelawyer.com website has been operational throughout the relevant period with the mark prominently displayed. Although there is a discrepancy regarding the user figures, even the lower figure shows a substantial number of subscribers, bearing in mind the specialist nature of the offering. Ms Wilkinson’s evidence is that the average number of law firm subscribers was 370 from 2016 to 2021. It is unclear whether this means subscriptions to the magazine or website, or both. However, from July 2021, it must relate only to the website. The website provides sector-specific news to the legal profession and appears to have done so throughout the relevant period. I accept that this properly constitutes a service under the registered specification’s “provision of information relating to legal matters and/or the legal profession; provision of information on-line from [...] the internet; all relating to legal matters and/or the legal profession”. In addition, the email newsletters are also part of a service offering information via the internet, though in this case it is by email rather than a website. Taking all of this evidence into account, and despite the absence of service-specific revenue, I am satisfied that there has been consistent use throughout the relevant period such that it amounts to genuine use. Given that the matters discussed on the website are not confined to, for example, the reporting of important cases but relate to a range of issues connected to the legal profession and the “business of law”, and that the registered terms are already limited to the legal field, I consider that the specification as it stands is a fair way of describing the services provided. I would add that I do not think that the careers pages described above take the matter further. Without any evidence of the content of the career news/insights pages or what the student/Lawyer2B provision is, I cannot tell whether it is career information proper to class 41, or career information other than educational and training advice, which is proper to class 35. Nor is there anything to indicate the size of this part of the business.

58. Regarding the same information services provided from a database, although the opponent has provided databases, there is no evidence of how many consumers have used these services or how much revenue they have generated. The best evidence relates to the jobs database. However, the provision of an employment database is not a service proper to class 41. There are also “The Lawyer Database” and the

“Litigation Tracker” database. These include judgments and information, the detail of which is not specified, about companies, legal advisers, “matters” and sectors. The class heading for class 41 is “education; providing of training; entertainment; sporting and cultural activities”. Legal services were, at the time of the application for the mark, proper to class 42.⁴⁶ The provision of a database for the purposes of legal research would, in my judgment, have been proper to class 42 (now 45), rather than 41. Similarly, databases containing commercial information are not proper to class 41. The opponent relies on the list of webinars in relation to these services. “Webinar libraries/Virtual events” is visible at the top of the page. Provision of a database of training information, including webinars, would constitute a service under the term at issue. However, I doubt that that the average consumer viewing the list of webinars in evidence would consider it a database. It appears to be a simple list, capable of only the most basic filtering. While some of the webinars have reasonable numbers of participants registered, there are only 47 webinars listed, which appear to be all of the events in the two-year time period. Of these, some were cancelled and others are “test” entries. This list of webinars does not establish genuine use for the provision of information from a database.

59. For reasons similar to those given above, while I am doubtful that the omission of “on-line from a computer database” materially limits the provision, the average consumer is unlikely to consider it necessary to narrow “from the internet” to the specific means of delivery. However, to the extent that “from a computer database” is a separate means of electronic provision of such documents, that should be excluded.

60. The remaining services are those relating to conferences, award ceremonies and fairs in class 41. It is clear that *The Lawyer Awards* have been an annual event over the relevant period, promoted in emails and on the website under the mark or an acceptable variant. I am satisfied on the evidence that UK699 has been used in relation to award ceremonies in the UK during the relevant period. As for conferences, there is limited evidence but there were a few conferences (or “summits”, which I take to be another term for the same thing) in the UK each year between 2017 and 2020. Again, no attempt has been made to specify the revenue attributable to these events or the number of attendees each year. However, given that there were several

⁴⁶ Nice Classification, 7th Edition, Version 1997.

conferences over a number of years and that the registration is limited to a specialist field, I am prepared to accept that there has been genuine use of the mark in relation to the organisation etc. of conferences. I am not prepared to extend this finding to “fairs”. In my view, “fairs” would be construed as events at which exhibitors display their wares (in this case likely to be legal services, or business services relevant to law firms). I consider this to be a separate subcategory of event, for which there is no evidence of use at all.

61. The opponent may rely on the following goods and services:

Class 9: Newsletters and reports in electronic form supplied on-line or from facilities provided on the internet (including web sites) relating to legal matters and/or the legal profession

Class 16: Magazines; all relating to legal matters and/or the legal profession.

Class 41: Provision of information relating to legal matters and/or the legal profession; provision of information on-line from the internet; all relating to legal matters and/or the legal profession; organisation, arrangement and conduct of conferences and award ceremonies; all relating to legal matters and/or the legal profession.

SECTION 5(2)(B)

62. The relevant parts of s. 5 of the Act read as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

63. The EU courts have identified a number of principles relevant to the global assessment of the likelihood of confusion in the following cases: *Sabel BV v Puma AG*, C-251/95, EU:C:1997:528; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, EU:C:1998:442; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B. V.*, C-342/97, EU:C:1999:323; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, C-425/98, EU:C:2000:339; *Matratzen Concord GmbH v OHIM*, C-3/03, EU:C:2004:233; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, C-120/04, EU:C:2005:594; *Shaker di L. Laudato & C. Sas v OHIM*, C-334/05P, EU:C:2007:333; and *Bimbo SA v OHIM*, C-591/12P, EU:C:2016:591. The principles are:

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Approach

64. Of the three earlier marks, the Word Mark is most similar to the contested mark but UK810 has the wider specification and offers a better case on the goods and services. I will focus on these two marks. If the opposition based on these marks fails, it will also fail based on the less similar second mark in UK699.

Average consumer and the purchasing act

65. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J. Fox Limited*, [2014] EWHC 439 (Ch) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention

is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik*.

66. The average consumer of the goods and services at issue will be either the public at large or a professional user. Some of the goods and services will be used by both of these groups (e.g., electronic publications (unlimited) in class 9; temporary personnel services in class 35). Others are more likely to be used by one group or the other. In particular, many of the services in issue, such as strategic business analysis (cl. 35), financial underwriting (cl. 36) and industrial analysis services (cl. 42), are business-to-business services only likely to be purchased by professional users.

67. Across the full competing specifications, there will be a wide range of levels of attention. However, all of the contested services, as well as the goods and services relied upon as identical or similar in the opponent's written submissions,⁴⁷ will be subject to at least a medium degree of attention. For some of the goods and services which will be selected by both the general public and professionals, such as publication services and software, the general public will pay a medium degree of attention, whilst the level of attention for people acting in their professional capacity will be fairly high. Some of the services, such as financial services, will be selected with a fairly high level of attention irrespective of consumer group because of the importance of financial transactions and the risks associated with making the wrong choice. The goods and services will be selected through primarily visual means, though there is some variation in the precise methods of selection. They may include shelves in retail premises, websites and catalogues or price lists. Aural considerations may play a part in the selection of any of the goods and services but for some of the competing services, such as advertising services, word-of-mouth recommendations are more likely, though they will still not dominate.

Distinctive character of the earlier trade marks

68. In *Lloyd Schuhfabrik*, the Court of Justice said, at [22], that the court must make an overall assessment of a mark's capacity to distinguish the goods or services of one undertaking from those of others. It continued:

⁴⁷ Annex 3 to the submissions dated 21 August 2023, refiled 3 October 2023.

“23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

69. The opponent says that the earlier marks are not used in relation to the provision of legal services and that there is no clear link between the marks and the goods and services. It submits that the earlier marks are inherently highly distinctive. For its part, the applicant appears to consider the words “THE LAWYER” descriptive.

70. I have already explained why I would not be able to find that the words “THE LAWYER” are inherently descriptive so far as concerns the Word Mark. Equally, however, I do not accept the opponent’s submissions. In my view, “THE LAWYER” is or may be highly allusive of the subject matter and/or intended users of the goods and services in classes 9, 16 and 41 of the earlier specifications. It is potentially less so for the services in classes 35 and 38 but it seems unlikely that normal and fair use of the marks would extend beyond the legal field without becoming deceptive. I do not think that the presentation of the words in a serif typeface in red on white in UK810 significantly increases that mark’s distinctiveness: the typeface is unremarkable and the colour combination is not unusual. “THE LAWYER” is an ordinary combination of ordinary English words. Neither earlier mark has more than a fairly low degree of inherent distinctive character for the goods and services for which they are registered.

71. Enhanced distinctive character was not explicitly pleaded but the opponent relies upon both earlier marks for its reputation claim, which requires consideration of the same factors. An assessment of the earlier marks’ distinctive character is a fundamental part of the global assessment and, as evidence has been filed and a reputation claimed, it would be artificial not to consider the evidence. More importantly, not to do so would result in a distorted picture of how the average consumer actually

perceives the marks. For enhanced distinctive character, only use in the UK is relevant because it is the perception of the UK consumer which matters for the purposes of the likelihood of confusion.

72. I have already considered much of the evidence. There is additional evidence showing use of the words “THE LAWYER” in white on red on the masthead for the opponent’s print magazine since 2001.⁴⁸ The typeface has varied slightly but nothing turns on this in relation to the Word Mark, for the same reasons as above. UK810 has been used extensively as registered. I do not think that variations in colour (e.g., red on white or white on black) alter the distinctive character: the contrast is respected and the colour of the registered mark is not so significant that its alteration changes the overall distinctive character. Nor are the small changes in typeface significant, in my view. All of this use qualifies.

73. The evidence is clear that the publication has been concerned throughout with matters of interest to legal professionals. The opponent’s website has operated over many years, providing news and information to the legal profession. The magazine and website appear to have enjoyed significant circulation figures/visitors, given their niche field. There is also some evidence of third parties in the UK describing the magazine in complimentary terms, though mostly some years before the relevant date (e.g., “The Lawyer is one of the most highly-regarded legal trade magazines in the country”).⁴⁹ Notwithstanding the absence of specific revenue for the print magazine and website, and the fact that the revenue figures provided are not especially large, I find that the earlier marks had enhanced distinctive character in relation to magazines (subject to the Word Mark’s limitation). I also consider that the Word Mark had enhanced distinctive character for the “provision of information on-line from the internet; all relating to legal matters and/or the legal profession”, whilst UK810 had a reputation for “online publication of news and information; news reporting; all in the legal field”. The use has resulted in an above average degree of factual distinctiveness for these goods and services among legal professionals but not more widely.

74. I am also satisfied that the earlier marks have enhanced distinctiveness for “arranging, conducting and organising award ceremonies” (UK810) and “organisation,

⁴⁸ JW-3, JW-4, JW-5.

⁴⁹ JW-17, p. 1.

arrangement and conduct of award ceremonies; all relating to legal matters and/or the legal profession” (the Word Mark). Despite the absence of clear revenue, there has plainly been longstanding use and the evidence shows that “The Lawyer” awards have been promoted consistently and attended by reasonable numbers of legal professionals/firms. There is also some evidence that recognition in the awards, and association with those awards, is something firms have been willing to pay for by purchasing rights to use the logos in the years leading up to the relevant date. This all points to the awards having a certain reputation. Two other awards are mentioned but they are from 2016 or earlier and the evidence is limited; I do not think they improve the position.⁵⁰ The evidence could be better but is sufficient overall to establish a modest uplift in distinctiveness. As with the other goods and services, any enhanced distinctiveness is limited to professionals in the legal field. The marks are factually distinctive to a medium degree for these services.

75. As regards market reports and the related research and analysis services in class 35 of UK810’s specification, it is clear that the opponent has published reports on topics relevant to the legal market over the years. Beyond this, the evidence is limited. There is no clear indication of how many reports have been published each year, what they were or how much revenue was generated by them. The only concrete evidence of purchases is by overseas firms.⁵¹ These firms are said to have offices in the UK but there is no evidence that the reports were intended for the UK offices and the only report specified is the European 100, which appears to focus on continental Europe and makes that unlikely. There are a few complimentary comments but they are quite limited and not necessarily reflective of the UK consumer’s perception. Nor is there evidence of extensive promotion of the reports. It appears that firms have paid to display logos associated with the opponent’s reports but there are only a few legible examples.⁵² There are no clear revenue figures for any research services specifically; this is how the figures are presented:

⁵⁰ JW-15; JW-17.

⁵¹ Confidential exhibit JW-12, Wilkinson, [17]. See also the witness statements of Ms Laitinen, Ms Casas Domínguez and Mr García Llana.

⁵² For example, JW-17, pp. 3, 8.

Financial year	UK revenue from advertising & bespoke research
2018	£2,338,000
2019	£2,397,000
2020	£1,710,000
2021	£1,898,000

The evidence is insufficiently solid to support enhanced distinctiveness for these goods and services.

76. The magazines from 2013 to 2020 all say that they include job advertisements or have recruitment sections. Two job adverts are shown in the evidence (JW-5). From 2018 to January/February 2021 each issue includes a “career clinic”, though the articles are not in evidence. There is some advertising shown in the extracts, including full-page advertisements by insurers and law firms, as well as recruitment information. The invoices for these advertisements are in evidence.⁵³ Ms Wilkinson gives the number of orders for advertising space in print and online, including in supplements, from 2016 to 2020.⁵⁴ Ms Wilkinson’s evidence is that they are mostly from UK based law firms and businesses such as Transport for London. They show a decline from 687 orders in 2016 to 184 in 2020.

77. I accept that the opponent has sold advertising space and published job advertisements on its careers pages. As the numbers of orders total only a fraction of the number of job vacancies advertised, the order numbers must relate to advertising space sold in print or online rather than job postings.⁵⁵ The revenue figures are for advertising combined with “bespoke research” so I have no way of knowing how much is attributable to either service. While the number of orders for advertising space in the print publication and online between 2016 and 2020 show consistent, if declining, sales of advertising space over five years, they are small numbers in absolute terms. In the context of the advertising market as a whole—and I note Ms Wilkinson’s evidence that businesses such as Transport for London have advertised with the opponent—they are minuscule. Regarding the job vacancy pages, I acknowledge that

⁵³ Confidential exhibit JW-13.

⁵⁴ Wilkinson, [19].

⁵⁵ Wilkinson, [19].

there are fairly high numbers of vacancies and there have been over several years. However, there is no information at all about how the job vacancies reach the site, how they are paid for or how the facility is advertised. It is impossible to know how much revenue the job advertisements have generated and there is no information, other than the bare numbers of job postings, which enables me to gauge the relevance of the opponent's business in these services to the market as a whole. The evidence does not establish enhanced distinctiveness.

78. I do not consider that enhanced distinctiveness has been established in the UK for any of the other goods and services covered by the earlier marks' specifications. For some goods and services (e.g., image banks; pens and pencils; arranging subscriptions of the online publications of others) there is no evidence that the opponent has provided them at all. For others, there is some evidence of use but essentially the same point applies to all of them: there is no breakdown of revenue as between the goods and/or services and very little in the way of supporting evidence such as promotional material and third party comment. There is no evidence at all about market share. I should mention in particular that the evidence showing some use in relation to conferences is unsupported by precise figures or promotion and it is too slight to establish enhanced distinctiveness. Similarly, whilst the opponent has offered courses and webinars, there is no way for me to determine the revenue generated by these activities. There were fewer than fifty webinars held and although the number of registrations are visible, they are mostly in the low to mid hundreds. In addition, although the business appears to operate a subscription model, I do not consider that merely selling one's own publication by means of a subscription amounts to the provision of subscription services.


Comparison of marks

79. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice stated at paragraph 34 of its judgment in *Bimbo* that:

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

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

81. The marks to be compared are:

The earlier marks	The contested mark
<p data-bbox="331 1104 635 1149">THE LAWYER</p> <p data-bbox="371 1234 616 1267">(The Word Mark)</p>  <p data-bbox="432 1462 555 1496">(UK810)</p>	<p data-bbox="979 1084 1214 1117">The Lawyer Hub</p>

82. The contested mark consists of the words “The Lawyer Hub”. The overall impression is contained in these words alone. It will be read as a complete phrase, meaning a centre (“hub”) for lawyers.

83. The overall impression of the Word Mark is dominated by the words “THE LAWYER”. Even treating the mark as a figurative mark, any role played by the particular typeface is likely to be considered negligible by the average consumer. In terms of the similarity between the Word Mark and the contested mark, the competing marks both begin with the same words, “The Lawyer”. There is a difference because

of the word “Hub” in the contested mark. The marks are visually similar to a medium degree. Aurally, the marks coincide in three syllables but differ because the contested mark has an additional word, and one more syllable, at the end. They are aurally similar to a medium degree. Conceptually, the Word Mark evokes the idea of a person who is a lawyer, i.e., a member of the legal profession. The contested mark refers to lawyers in the context of a centre for lawyers. There is a degree of overlap and a degree of difference. The marks are conceptually similar to a medium degree.

84. Turning to UK810, this mark consists of the words “THE LAWYER” presented in an unexceptional typeface in white on a rectangular red background. The words play the greatest part in the overall impression, with the presentation having a lesser role. These marks coincide in the words “The Lawyer” at the beginning but differ because of the word “Hub” in the contested mark. There is an additional difference in presentation. There is a lower than average degree of visual similarity. The same considerations apply for the aural and conceptual comparison as they did for the Word Mark: UK810 has a medium level of both aural and conceptual similarity to the contested mark.

Comparison of goods and services

85. The Court of Justice in *Canon* stated at [23] of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

86. It is well established that goods are considered identical when a wider term covers a narrower subset of goods included in the general class: *Gérard Meric v Office for Harmonisation in the Internal Market*, T-133/05, EU:T:2006:247.

87. Complementarity may be the sole basis for the existence of similarity between goods: *Kurt Hesse v OHIM*, C-50/15 P, EU:C:2016:34. In *Boston Scientific Ltd v Office*

for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), T-325/06, EU:T:2008:338, the General Court said that “complementary” means:

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

88. Words in specifications must be given their ordinary and natural meaning: *YouView Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12]. Where services are concerned, Jacob J (as he then was) warned in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 against construing specifications for services too widely, saying:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

89. The opponent has helpfully provided submissions regarding each of the contested goods and services and why it says they are identical or similar to the earlier specifications. The majority of its submissions concern the specification for UK810. I infer that, for most of the contested services, it considers these are its best case and I proceed on that basis.

Class 35

Advertising; Demonstration of goods; Arranging and conducting of displays for advertising purposes; Arranging and conducting of demonstrations for advertising purposes; Demonstration of photographic equipment [for advertising purposes]; Demonstration of goods for promotional purposes; Demonstration of goods and services by electronic means, also for the benefit of the so-called teleshopping and home shopping services; Sales demonstration [for others]; Organization of exhibitions for advertising purposes; Arranging of demonstrations for advertising purposes; Arranging of demonstrations for advertising purposes; Organisation of events for advertising purposes; Customer loyalty services for promotional and/or advertising

purposes; Organisation of customer loyalty programs for promotional or advertising purposes; Dissemination of advertising matter; Promoting the sale of goods and services of others through the distribution of printed material and promotional contests; Dissemination of advertising for others via an on-line communications network on the internet; Dissemination of advertisements via the Internet; Dissemination of advertising, marketing and publicity materials; Dissemination of advertising via online communications networks; Consultancy regarding advertising communication strategies; Marketing assistance; Business advice relating to marketing; Business advice relating to strategic marketing; Advisory services relating to corporate identity; Business consultancy services relating to the promotion of fund raising campaigns; Market segmentation consultation; Consultancy relating to demographics for marketing purposes; Consultancy relating to advertising and promotion services; Consulting services in the field of Internet marketing; Consultancy services in the field of affiliate marketing; Business marketing consultancy; Marketing advice; Rental of advertising space; Rental of advertising time on communication media; Provision of space on web-sites for advertising goods and services; Provision and rental of advertising space, time and media; Provision of advertising space on a global computer network; Rental of advertising space on the Internet for employment advertising; Rental of advertising space on the internet; Rental of advertising space on the internet; Compiling indexes of information for advertising purposes; Personnel recruitment advertising; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Advertising, including on-line advertising on a computer network

90. The specification for UK810 includes “marketing services” and “consultancy and advice relating to [marketing services]”. It also includes “advertising services”. “Marketing” is a wide term which includes both advertising and promotional services. The contested services listed above are literally identical to the same terms in the earlier specification and/or they are identical to the earlier mark’s marketing and/or advertising services based on the principle outlined in *Meric*.

Customer relationship management

91. This service is self-evidently identical to UK810’s “customer relationship management [CRM] services”.

Market studies; Market analysis and research; Market research; Market analysis and research; Market research by means of a computer data base; Market research services regarding customer loyalty

92. These terms are identical to UK810's marketing services and/or "strategic business analysis" under the principle outlined in *Meric*.

Organization of exhibitions for commercial purposes; Organisation of exhibitions and trade fairs for business and promotional purposes; Arranging and conducting business fairs; Organisation of events for commercial purposes; Arranging of presentations for business purposes

93. "Events" includes exhibitions. Consequently, "organisation of exhibitions for commercial purposes", "organisation of exhibitions for business and promotional purposes; organisation of events for commercial purposes" are identical to UK810's "exhibition services" under the principle established in *Meric*.

94. UK810 also includes "arranging, conducting and organising [...] demonstrations and trade shows for commercial business or trade purposes" and "business and commercial trade shows and business events". "Trade fairs" and "trade shows" are different names for the same events. A "demonstration" is a synonym of "presentation". The contested "organisation of trade fairs for business purposes", "arranging and conducting business fairs" and "arranging of presentations for business purposes" are identical to these earlier services. The contested "organisation of trade fairs for promotional purposes", if not covered by the above terms, is encompassed by UK810's "advertising services".

95. In view of my conclusions on enhanced distinctive character, I should also compare the above "events", exhibition and trade fair services, along with the "organization of exhibitions for advertising purposes; organisation of events for advertising purposes" I considered earlier (and the broad term "advertising" which includes them), to the earlier marks' class 41 services of "arranging, conducting and organising award ceremonies"/"organisation, arrangement and conduct of award ceremonies; all relating to legal matters and/or the legal profession". There is a degree of similarity between the competing services, in that they both involve the organisation

and running of large events and will require, for example, the booking of venues and organisation of promotion and tickets. However, as the contested services are for advertising or commercial (i.e., trade) purposes and award ceremonies are to reward excellence, the nature of the content is different and the overarching purpose differs. There is also some difference in the nature of an award ceremony on the one hand and trade fairs and exhibitions on the other. Whilst some of the skills required will coincide, in the absence of any evidence it seems likely that the particular skillsets and knowledge, including contacts, for the competing services will mean that the businesses offering these services will tend to remain within their field of expertise. Therefore, in terms of the contested specification as it is written, “advertising; organization of exhibitions for commercial or advertising purposes; organisation of exhibitions and trade fairs for business and promotional purposes; arranging and conducting business fairs; organisation of events for commercial and advertising purposes” have a lower than average degree of similarity to the services with enhanced distinctiveness. I cannot see that there is any meaningful overlap with the contested presentation services (or the demonstration services considered earlier).

Providing an on-line commercial information directory on the internet; Providing business information via a web site; Updating of business information on a computer data base; Computerised business information services; Business information services; Business information services provided on-line from a computer database or the internet; Commercial information services provided by access to a computer database; Providing business information, also via internet, the cable network or other forms of data transfer; Provision of business data; Providing online commercial directory information services; Providing information about commercial business and commercial information via the global computer network; Providing business information directory services, via a global computer network; Provision of computerised data relating to business; Provision of business information via global computer networks; Providing commercial information relating to companies

96. These services are identical under *Meric* to UK810’s “business information services” and/or “online commercial information and directory services”.

Administrative support and data processing services; Compiling indexes of information for commercial or advertising purposes; Compilation of information into computer

databases; Compilation of statistics; Updating and maintenance of data in computer databases; Data search in computer files for others; Systemization of information into computer databases; Data processing; Management and compilation of computerised databases; Administrative services relating to the management of legal dockets; Automated data processing; Data processing, systemisation and management; Collection and systemisation of information into computer databases; Updating and maintenance of information in registries

97. These services are or include services for the compilation, processing and management of data. They are identical under *Meric* to UK810's "information compilation services" and/or its "data management" services.

Cost price analysis; Strategic business analysis; Evaluation of business opportunities; Business analysis services

98. UK810 includes "strategic business analysis" which is self-evidently identical to the same term above. The remainder are identical based on *Meric* to "strategic business analysis" and/or "analysis of business trends" in UK810.

Business administration; Business administration assistance; Document preparation

99. The opponent submits that business administration overlaps with and is identical to UK810's "sales [...] administration" services. I accept that submission: business administration services at large include business administration services relating to sales (e.g., preparation of invoices). "Document preparation" may also include the preparation of invoices. The respective services are identical.

Consumer profiling for commercial or marketing purposes

100. These services are included within UK810's "conducting of business research" and "conducting of market research". The services are identical.

Competitive intelligence services; Business research; Business investigations

101. "Business research" is self-evidently identical to UK810's "conducting of business research". "Business investigations" and "competitive intelligence services" at least

include business research as well as other types of investigations and services. These terms are identical.

Media relations services; Consultancy regarding public relations communication strategies; Corporate communications services

102. These services are identical under *Meric* to UK810's "publicity services" and/or "advertising services".

Administration of consumer loyalty programs; Administration of customer loyalty and incentive schemes; Customer loyalty services for commercial purposes; Organisation of customer loyalty programs for commercial purposes

103. The opponent submits that these services are identical to UK810's "customer relationship management [CRM] services; sales promotion, administration and management services; information, consultancy and advice relating to these services". I consider the closest of these terms is "sales promotion, administration and management services", because loyalty programmes may be a means of promoting sales. This earlier term includes the contested terms identified above and they are identical.

Auctioneering provided on the internet; Auctioning via telecommunication networks; On-line trading services in which seller posts products to be auctioned and bidding is done via the Internet

104. The opponent submits that the above services are all types of sales promotion. However, any sales promotion undertaken by an auction house is typically limited to the bare listing of the lots for sale and their details. The purpose of auctioneering services is to sell goods on behalf of third parties; the purpose of advertising is to promote third parties' products. I accept that there may be some overlap in users because property sold at auction, whether personal property or real property, may be sold by businesses who use advertising services. However, this is a very high-level overlap and I do not consider it sufficient to establish similarity between these services. The channels of trade will be entirely distinct and there is neither competition nor complementarity. If these services have any similarity at all, it is a low level.

Accountancy, book keeping and auditing; Business auditing; Financial auditing; Book-keeping; Tax filing services; Tax preparation; Administration, billing and reconciliation of accounts on behalf of others; Book-keeping; Book-keeping and accounting services; Computerised accounting; Preparation of documents relating to taxation; Financial statement preparation and analysis for businesses; Tax preparation and consulting services; Preparation and completion of income tax returns; Business advice relating to accounting; Consultancy and information services relating to accounting; Advice on tax preparation; Consulting and information concerning accounting; Taxation [accountancy] consultation; Business accounting advisory services; Consultancy relating to auditing; Tax return advisory [accountancy] services

105. The opponent submits that the above services are similar to UK810's "electronic collection and processing services for data [...]; data management" or various of its business services (e.g., strategic business analysis) because they share users and channels of trade. The contested services relate to the accurate recording of financial transactions and records, and/or analysis and advice about such matters. Broadly, all of the contested services are concerned with the proper functioning of a business. To that extent, they coincide in purpose with the earlier "strategic business analysis". The services are often provided through the same channels, by the same companies, to the same users. They are similar to a medium degree.

Computerised data verification

106. In my view, UK810's "electronic collection and processing services for data" encompass computerised data verification. These services are identical.

Provision of initial company secretarial services on company formation; Consultancy relating to the establishment and running of businesses

107. The responsibilities of a company secretary are not clearly defined but they will include providing advice to the directors on matters such as company governance, ensuring compliance with the law, keeping certain registers up to date and filing required documents at Companies House. Although the specific purpose of these services is not shared by any of either earlier mark's services, I agree with the opponent that, like UK810's "strategic business analysis", these services are directed at furthering or improving a business and that, to that extent, they overlap in purpose.

It seems likely that these services will share channels of trade and providers, as well as users. They are similar to a medium degree.

Mail sorting, handling and receiving

108. The opponent relies on UK810's "electronic collection and processing services for data, images and electronic messages" and "data collection" services, which it says are similar because they have the same purpose, relevant public and trade channels. I accept that submission. These services are similar to a medium degree.

Business management

109. These services are similar to a medium degree to "strategic business analysis" because both have the broad aim of improving a company's performance and success, they have the same providers, channels of trade and users.

Personnel recruitment; Human resources recruitment services; Recruitment consultancy for lawyers; Temporary personnel services; Employment agency services; Employment agency services for people skilled in the use of computers; Job matching services; Career advisory services (other than education and training advice)

110. All of the above services are broad recruitment or employment services which cover "providing on-line employment information" and/or "information services relating to jobs and career opportunities" in UK810's specification. These services are identical.

Personnel selection using psychological testing; Personnel management assistance; Human resources management; Advisory services relating to personnel placement; Consultancy relating to the selection of personnel; Consultancy relating to management selection; Provision of advice relating to the recruitment of graduates; Testing to determine employment skills; Work analysis to determine worker skill sets and other worker requirements; Personnel management assistance

111. These services will be provided by the same undertakings and through the same channels of trade as "providing on-line employment information" and/or "information services relating to jobs and career opportunities". They have a broadly similar

purpose (recruitment/employment) and users of the respective services are the same. These services are similar to a medium degree.

Professional business consultancy; Business management and organization consultancy; Assistance, advisory services and consultancy with regard to business management; Consultancy and advisory services in the field of business strategy; Business appraisal consultancy; Business organization and management consultancy including personnel management; Business management and organization consultancy; Business management consultancy via the Internet; Consultancy regarding business organisation and business economics; Advisory services relating to the corporate structure of businesses; Advisory services relating to business organisation and management

112. UK810 includes “strategic business analysis”, as well as consultancy relating to strategic business analysis. It seems to me that strategic business analysis would include analysis of all aspects of a business from organisational structure to performance, and that consultancy relating to strategic business analysis would include advice, assistance and recommendations based on the results of the research. These earlier services therefore appear to cover the same ground as the contested services above. If they are not identical, they are similar to a high degree, the respective services being consultancy services aimed at improving a business and therefore having a good degree of overlap in both nature and purpose, having identical users and being provided through the same trade channels and via the same providers.

Rental of office machines; Rental of office equipment in co-working facilities

113. The opponent says that these services are similar to “strategic business analysis; analysis of business trends; customer relationship management services; sales promotion, administration and management services; information, consultancy and advice relating to these services” on the grounds that the rental of office machines and equipment are indispensable to the administration and management of a business. I do not accept that the fact that a business may need machines and equipment to function amounts to rental services relating to those goods being similar to the services the opponent has identified. Other than at a very superficial level of generally being

related to business, the purpose of the respective services is different: the contested services have the sole aim of renting specific goods to a business. The earlier services, in contrast, are concerned with ensuring the proper and effective administration of aspects of a business. The services have no similarity in nature. The contested services are generally provided by specialist undertakings, who do not provide the services relied upon by the opponent. There is therefore no overlap in provider, without the expectation of which there can be no complementarity, nor is there overlap in channels of trade or any competition between the services. The overlap in user is at a level of generality too high to be determinative of similarity. These services are not similar.

Commercial lobbying services

114. The opponent says that these services have a related purpose, are complementary to and share trade channels and relevant public with UK810's "conducting public opinion polls". The purpose of lobbying services is to influence government or to advise others about how to influence government. In contrast, the purpose of an opinion poll is to find out what people think about a particular matter, which may or may not have any connection to government policy. The purpose of the services is therefore different. I do not accept that because they are both connected to opinions (changing them versus canvassing them) there is any overlap in uses. The nature of the services is different. I accept that users of both will coincide. My understanding of opinion polls is that they require specialist skills, distinct from the skills required for lobbying, and that they are normally provided by firms dedicated to opinion polling. The opponent asserts that the services are provided through the same trade channels but I am not prepared to accept that this is so without evidence. As complementarity requires that the consumer may think that the services are provided by the same undertaking and I do not consider that this would be the case, they are not complementary services (even though opinion polls may be an important part of the information on which lobbyists base their advice). There is no competition. These services are not similar.

Class 36

Finance services; Financial advisory services relating to insolvency; Capital investment; Fund investment services; Investment management; Administration of funds and investments; Financial services relating to investment; Financing of investments; Investment portfolio management services; Development of investment portfolios; Financial consultancy; Financial analysis; Financial research; Financial analysis and consultancy; Financial consultancy and information services; Financial planning services; Financial and investment consultancy services; Providing financial information via a web site; Financial information services provided by access to a computer database; Financial information provided by means of a computer database; Information services relating to finance, provided on-line from a computer database or the Internet; Financial appraisal services; Financial appraisals and valuations; Arranging of insurance; Brokerage; Consultancy services relating to insurance; Arranging of insurance; Insurance consultancy

115. UK810's "strategic business analysis" may include certain financial aspects, such as an assessment of a business's financial position or tax liabilities, and is often a service provided by accountancy firms. The above services appear to be or to include financial planning services which would commonly be provided to businesses by the same accountancy firms, albeit perhaps not the smallest of such firms. For example, accountancy firms may advise businesses on where to invest employee pension funds or cash reserves. Users, providers and channels of trade therefore overlap but the services have different purposes, business analysis being essentially concerned with running a company and setting out its direction and strategy, whereas the above services are about money and how it should be used. The services are different in nature, are not in competition and if there is any complementarity it is limited. There is a low degree of similarity.

116. I cannot see any term in the earlier specifications which would improve on this. However, I should address a specific submission from the opponent that some of these services (e.g., "providing financial information via a web site") are highly similar or identical to "provision of commercial information from online databases; business information services; business and commercial information provided by access to a computer database". The opponent says that the services are all intended to share

information in relation to issues facing businesses and that they coincide in trade channels and users. There may be some overlap in trade channels and users but the nature of the information is quite different: one has a commercial focus (e.g., increasing market share, business structure), the other is about financial matters (e.g., investments, pensions, insurance). This has an impact on the purpose of the services. I recognise that the competing services cover the provision of information on a website. However, given that websites are ubiquitous, it would not, in my view, be proper to find that the mere fact that information is provided via a website amounts to the services being highly similar or identical overall. This submission does not improve the opponent's position.

117. Similarly, I do not think that the fact that the contested "financial research" and UK810's "business research" are research services means that they must be considered similar. The competing services have a different purpose and the consumer's view of them will, in my view, be heavily conditioned by this. Any similarity between these services is confined to users, providers and channels of trade and does not result in any more than a low level of similarity, putting the opponent in no better a position.

118. The opponent also submits that certain of these services are complementary to certain services in classes 38 and 41 of UK810's specification because "they relate to the access and presentation of information which is closely connected to the provision of information". In relation to the services in class 38, these are telecommunications services concerned with the provision of means of access and transmission of information. They have nothing in common with financial services of any description. As for the services in class 41, financial services, even those provided online, have a different purpose from publication services. The services differ in nature, are provided through discrete channels of trade, by different businesses and there is no competition or complementarity. Users only coincide superficially. These services are different.

Insurance underwriting; Providing on-line stock exchange information from a computer database or the Internet; Debt collection; Bailiff services (debt collection); Debt counseling services; Debt recovery; Consultancy for clients with regard to the organisation of debt recovery; Financial underwriting and securities issuance (investment banking); Providing financing to emerging and start-up companies;

Providing information relating to securities underwriting; Investment banking consulting and advisory services; Underwriting of shares (Services for the -); Financial valuation of intellectual property assets; Consultancy services relating to corporate finance; Consultancy services relating to credit; Provision of credit information; Evaluation of the credit worthiness of companies and private individuals; Crowdfunding; Venture capital services; Venture capital (Services for the provision of -); Charitable fund raising; Arranging charitable collections [for others]; Organization of monetary collections; Financial sponsorship; Fundraising; Charitable fund raising; Intellectual property valuation services; Valuations and financial appraisals of property; Warranty services; Providing information relating to non-life insurance underwriting; Underwriting of insurance (Services for the -); Warranty programme services

119. I cannot see any similarity between these services and any of those of the earlier marks' specifications. They differ in nature and purpose and, unlike the financial services I considered above, are not likely to be provided by the same businesses or through the same channels of trade as strategic business analysis. Apart from a superficial overlap in user, there is no point of similarity. These services are dissimilar.

Real estate brokerage; Rental of offices for co-working; Rental of offices [real estate]; Assisting in the acquisition of real estate; Assisting in the acquisition of and financial interests in real estate; Real estate acquisition services; Computerised information services relating to real estate; Provision of information relating to the property market [real estate]; Provision of information relating to property [real estate]; Apartment locating services for others [permanent accommodation]; Arranging of shared ownership of real estate; Real estate consultancy; Advisory services relating to real estate valuations; Research services relating to real estate acquisition; Rental of real estate and property; Financial consultancy relating to real estate investment; Commercial property investment services; Real estate investment planning; Real estate investment advice; Real estate appraisal; Real estate appraisal

120. The opponent's primary submission appears to be that "market analysis reports" and "market reports" may concern the real estate market and that they therefore target the same public and have the same intended purpose as the contested services. Market reports in class 35 are constrained by the classification system. Such reports

may analyse the size of the market, the biggest players and the proportion of market share attributable to certain companies, or indeed consider the commercial strategy and/or structure of a given real estate company, but they do not provide information about the buying and selling of property or give property investment advice. The purpose of market reports is entirely distinct from the purpose of the above services and I cannot see any other meaningful point of overlap. Nor is there any obvious point of similarity with the other services the opponent has identified. In particular, “strategic business analysis” is concerned with the direction and strategy of a business. It has a purpose which is different from that of the above services, which are broadly concerned with the buying and selling of real property. Other than a superficial overlap in users, these services have no intersection. I cannot see any basis for a finding of similarity with the other services in class 35 identified by the opponent: the services are entirely distinct.

121. For essentially the same reasons as above, there is no overlap between the contested real estate services and UK810’s telecommunications services in class 38. The same point arises regarding the services relied upon in class 41: it is not sufficient that users coincide and the services are different in every other respect.

Class 41

Entertainment services

122. These services are identical to UK810’s “entertainment services”, either literally or based on the principle in *Meric*.

123. I do not think that these services are similar to the publishing services for which the earlier marks have enhanced distinctive character. Their purpose differs and, given the very different subject matter, they are unlikely to intersect in users to any significant extent, or to be provided through the same channels/by the same undertakings. “Entertainment services” covers services such as party planning, for private and corporate clients. These services may be provided by the same companies as the earlier marks’ award ceremony services, there is some similarity of purpose and users coincide. These services have a medium degree of similarity.

Provision of video recording studio services; Rental of audio equipment; Videotaping; Audio, video and multimedia production, and photography; Audio-visual display presentation services for entertainment purposes; Online interactive entertainment; Audio and video recording services; Audio and video editing services; Sound recording and video entertainment services; Production of sound recordings; Production of audio-visual recordings; Production of audio/visual presentations; Live entertainment production services; Production of video and/or sound recordings; Production of audio tapes for entertainment purposes; Provision of entertainment via podcast; Telephone conversation services for entertainment purposes; Provision of video recording studio facilities; Studio services for the recording of videos; Audio, film, video and television recording services; Provision of recording studio facilities; Providing multi-media entertainment via a website; Providing video entertainment via a website; Rental of audio/visual and photographic equipment and facilities; Rental of sound and video recording apparatus; Rental services relating to equipment and facilities for entertainment; Video production services; Video editing; Video entertainment services

124. UK810's "entertainment services" is a very wide term covering all manner of services related to entertainment. All of the above fall under its wide banner. These services are identical based on the principle in *Meric*.

Publishing, reporting, and writing of texts; Publishing of reviews; Publication of work manuals for business management; Services for the publication of travel guides; Publication of manuals; Digital video, audio and multimedia entertainment publishing services; News reporters services

125. "News reporters services" are literally identical to the same services in UK810's specification and are the same services under a different name as the "news reporting services" for which it has enhanced distinctive character. The remainder are types of publishing service which fall under UK810's "publishing" services and are identical under *Meric*.

126. The "reporting and writing of texts" in the contested mark is identical to UK810's news reporting services. These contested services overlap in purpose with the Word Mark's "provision of information on-line from the internet; all relating to legal matters and/or the legal profession" and have the same users, channels of trade and providers.

They have a strong complementary relationship and are highly similar. The contested “publishing [...] of texts” is also wide enough to contain “provision of information on-line from the internet; all relating to legal matters and/or the legal profession” / “online publication of news and information; all in the legal field” for which the earlier marks have enhanced distinctive character. These services are identical.

127. Although the other services above are also publishing services and have some similarity of purpose, the object of those services is different from that of the opponent’s services with a reputation. There may be an overlap in users but channels of trade and provider are not likely to intersect. There is a fairly low degree of similarity.

Coaching [training]; Conducting instructional courses; Conducting of courses relating to business management; **Arranging of demonstrations for training purposes;** **Arranging of demonstrations for educational purposes;** **Arranging of courses of instruction;** **Arranging of presentations for educational purposes;** Coaching in economic and management matters; Demonstration of photographic equipment [for training purposes]; **Preparation of educational courses and examinations;** Provision of instruction relating to communications techniques; Provision of instruction courses in finance; Provision of courses of instruction in the management of information technology; Education and training consultancy; Consultancy services relating to academic subjects; Consultancy relating to vocational skills training; **Provision of training courses;** **Provision of facilities for tuition;** Production of educational sound and video recordings; Professional consultancy relating to education; **Provision of training facilities;** **Production of course material distributed at professional courses;** Providing training courses on business management; Provision of instruction relating to computer programming; Management education services; Advisory services relating to education; Education services relating to the use of computers in business; **Educational services for providing courses of instruction;** Educational services relating to information technology; Education services relating to the application of computer systems; Rental services relating to equipment and facilities for education, **Developing educational manuals;** **Development of educational materials;** Staff training services relating to modern office technology; Staff training in the use of electrical equipment; Training in the use of photographic equipment; Training services relating to the use of information

technology; Training in the operation of software systems; Training in the operation of computer programs; Provision of instruction relating to computer programming; Training relating to computer hardware; Training in computer programming; Training in business management; Industrial relations training; Training services relating to management consultancy; Provision of training courses in personal development; Training services in the field of computer software development; Teaching services relating to business assistance; Training services concerned with the use of computer software; Adult education services relating to finance; Adult education services relating to management; Computer training; **Providing of training, teaching and tuition; Training relating to the provision of legal services**

128. All of the above are educational services. They are included in “education”, again a very wide term including all manner of services connected to education, and/or “consultancy [...] relating to [education]” in UK810’s specification. They are identical based on *Meric*.

129. In terms of the publishing services with enhanced distinctiveness, the contested services might or do relate to the legal field but the purpose of the earlier publishing services is entirely different. The earlier marks’ publishing services do not extend to publications which might be used for education (e.g. books) and where there might therefore be some complementarity, among other things. These services are not similar. Insofar as award ceremonies are concerned, the specific purpose (training versus organisation of an event) differs. However, there may be some overlap in provider, channels of trade and user given that awards are often given for academic achievement and, consequently, a lower than average degree of similarity. As the Word Mark’s specification has a limitation to the legal field, this applies to the services in bold, above; where the fields diverge, as they do for the services not in bold, I do not think that there is any similarity. If there is, it only a low degree.

Conducting of business conferences; Arranging of conferences relating to business; Organisation of conferences, exhibitions and competitions; Organising of education exhibitions

130. These services are included in UK810’s “arranging, conducting and organising conferences, consumer shows, exhibitions, events, placements, courses, training,

seminars, tutorials, workshops and award ceremonies”. They are identical under *Meric*.

131. UK699 is specifically relied upon for these services. Its “organisation, arrangement and conduct of conferences and award ceremonies; all relating to legal matters and/or the legal profession” are identical under *Meric* to the conducting, arranging and organisation of conferences/business conferences, listed above.

132. Award ceremonies are the result of a sort of competition. They have an overlap in purpose, providers and channels of trade. The services are also complementary. They are similar to an above average degree.

133. Exhibitions are not the same as conferences, because an exhibition is focused on the display of something (wares, services, art), whilst conferences tend to be events focused on discussion, albeit potentially with some advertising stands. The purpose of the services is similar, however, and there will be an overlap in channels of trade and users. They are similar to a medium degree.

134. As regards “arranging, conducting and organising award ceremonies” and “organisation, arrangement and conduct of award ceremonies; all relating to legal matters and/or the legal profession” for which UK810 and the Word Mark respectively have enhanced distinctiveness, these services are similar to an above average degree to “organisation of competitions” for the reasons given above. “Conducting of business conferences; arranging of conferences relating to business; organisation of conferences, exhibitions” are not limited and would cover conferences and exhibitions in the legal field or on topics relevant to lawyers. There is a degree of shared purpose and users may intersect. The services are not in competition or complementary but they may, as the opponent’s evidence shows, be provided by the same undertakings and share channels of trade. These services have a medium degree of similarity.

135. “Organising of education exhibitions” strikes me as less similar to the reputed services, given the differences between exhibitions and award ceremonies and the contested services’ educational purpose. Nevertheless, education exhibitions could relate to legal training and award ceremonies could be for educational achievement. I accept that there is potential for some similarity in purpose, users, channels of trade and providers, resulting in no more than a medium degree of similarity.

Sporting and cultural activities

136. It is, to my mind, at least arguable that “sporting and cultural activities” are forms of “entertainment” at large and therefore that these terms cover the same services as UK810’s “entertainment”. If that is not right, sporting and cultural activities are intended to entertain, widely construed, and there is therefore an overlap in purpose. The activities covered by the terms may differ but are likely to be organised through the same trade channels and providers, for the same users. There is a medium degree of similarity.

Rental services relating to equipment and facilities for sports and culture

137. UK810’s “entertainment” services cover rental of entertainment equipment and facilities. The competing services overlap as they both provide rental services, though their ultimate purpose differs and there may be both similarities and differences in the equipment and facilities for rent. Channels of trade, providers and users may overlap. The services are similar to a medium degree.

Class 42

IT security, protection and restoration; Internet security consultancy; Design of information systems relating to management; Design of information systems relating to finance; Design of software for processing and distribution of multimedia contents; Computerised business information storage; Providing temporary use of non-downloadable software for analyzing financial data and generating reports; Hosting multimedia educational content; Hosting multimedia entertainment content; Hosting of transaction platforms on the internet; Provision of technical information in relation to computers; Compilation of information relating to information systems; Information services relating to information technology; Consultancy services for analysing information systems; Consultancy relating to the creation of homepages and Internet pages; Consultancy in the field of security software; Consultancy relating to the design of homepages and Internet pages; Information technology [IT] consultancy; Computer and information technology consultancy services; Technical consultancy relating to the installation and maintenance of computer software; Provision of expert appraisals relating to computing; Provision of information relating to information technology;

Website usability testing services; Design services relating to the reproduction of documents; Web site design consultancy; Development, design and updating of home pages; Hosting services, software as a service, and rental of software; Platform as a service [PaaS]; Software as a service [SaaS].

138. All of the above are IT services. The opponent relies on certain services in classes 35, 38 and 41. However, in my view these services are not similar to the contested services. In particular, the fact that telecommunications services are required for website content does not make the services complementary unless the average consumer will consider that the same undertaking provides the services. I do not think that this would be the case. In class 41, the opponent relies upon entertainment and education services. Whilst businesses providing entertainment or education services may use the above services, they have a different purpose and nature from the IT services above. There is no obvious reason why they would be offered through the same channels of trade or by the same providers and there is no other relevant point of similarity. These services are not similar.

139. In my view, the better case is that based on UK810's "software applications" in class 9. These goods cover software of all descriptions. All of the above services are likely to be offered by the same companies as the earlier "software applications" and they are likely to be sold through the same channels. Users will be the same. For the contested software design and consultancy services, there is an additional point of similarity because the goods and services are complementary. These services have at least a low degree of similarity, rising in some case to medium.

Testing of computer programs; Website load testing services; New products (Testing of -); Analysis of product design; Analysis and evaluation of product design; Analysis and evaluation of product development; Computer aided diagnostic testing services; Design and testing of new products; Evaluation of performance of computer systems against bench-mark references; Evaluation of product design; Product quality evaluation; Evaluation of product development; Quality audits; Quality checking; Quality control; Quality control relating to computer systems; Quality control relating to computer software; Product testing; Product quality testing; Testing of computer programs; Testing of computing equipment; Testing, authentication and quality control

140. Again the opponent relies on services in class 35, such as market reports and strategic business analysis, because, it is said, market studies include analysing, evaluating and testing products. The opponent says that the services have the same trade channels, end users and that they are complementary because the contested services are essential for analysing the overall performance of a business. It seems to me that while some of the class 35 services relied upon may assess the overall performance of a business, none of those identified in the opponent's submissions could fairly be described as testing products. I accept that marketing services may include assessing how products may be placed in a given market or that they may even extend to marketing consultancy about product development. However, unlike the contested services above, marketing services do not "test" products in the sense of quality checking their manufacture, that they meet minimum production standards or comply with any legal requirements. Research and development of new products is not a service covered by the opponent's services in class 35. Though a business may employ both a marketing consultant and a company to conduct research and development of a new product, I do not think that this is sufficient for similarity overall, given the differences in purpose and that these services are unlikely to be provided through the same channels and/or by the same undertakings and the opponent has provided no evidence to show that they are. They are not similar.

141. I accept that all of the above services concern, or could concern, computer software. They are likely to share users, distribution channels and providers with UK810's "software applications". They are similar to a low degree.

Industrial analysis services; Analysis and testing services relating to electrical engineering apparatus; Material testing; Material testing

142. The opponent says that these services are highly similar to UK810's "market analysis reports; provision of marketing reports; market reports and studies; strategic business analysis; analysis of business trends". I do not accept its submissions. Even where there is an overlap of sorts because "analysis" is involved, the nature of that analysis is very different: the earlier services are concerned with marketing and business functions/performance, the contested services relate to, for example, oilfield exploration and chemical analysis. There is no other point of overlap.

143. I would add that, although the contested services may be provided with the assistance of software applications, I do not consider that there are sufficient points of similarity for the goods and services to be considered similar. They are different in nature and purpose, will not reach the market through the same channels and there is only a superficial overlap in user. The goods and services are neither essential nor important for one another and are not provided by the same undertakings. Consequently, they are not complementary. There is no competition. These goods and services are dissimilar.

144. I have not considered each of the contested services against the services for which the earlier marks have enhanced distinctive character. For the avoidance of doubt, unless otherwise identified, there is no obvious similarity, in my view: despite a potential overlap in users, the competing services differ in every material respect. I have no submissions from the opponent to inform me otherwise.

Likelihood of confusion

145. Confusion may be direct or indirect. Direct confusion is where the average consumer simply mistakes one mark for another. Indirect confusion is where the average consumer notices that the two marks are not the same but where the common elements lead them to conclude that the later mark is another brand of the owner of the earlier mark: see the comments of Iain Purvis QC, as the Appointed Person, in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10 at [17]. Mr Purvis QC also gave some non-exhaustive examples of how indirect confusion may occur:

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

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

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

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

146. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ pointed out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

147. Where goods and services are dissimilar, there can be no likelihood of confusion under s. 5(2)(b). The opposition based on this ground is dismissed insofar as it relates to the services I have found not similar.

148. As for the remaining services, the similarity with the earlier specifications ranges from low to identical. The marks themselves have a lower than average or medium degree of visual similarity and are aurally and conceptually similar to a medium degree. The average consumer's level of attention for the identical goods and services will be medium or, for professional users, fairly high. Nonetheless, there is no risk of direct confusion in this case even for those paying only a medium degree of attention to the selection of identical services. The differences between the marks are such that the average consumer will notice the differences and will not mistake the marks for one another.

149. Turning then to indirect confusion, I do not consider that there is a likelihood of confusion where the services are identical or similar but the earlier marks enjoy no more than a fairly low degree of distinctive character. In the contested mark, I accept that "hub" is at best weakly distinctive but so are the words "the lawyer". Taking all of the relevant factors into account, my view is that the conceptual differences are sufficient for the average consumer not to be confused. The average consumer will see the contested mark as meaning a hub for lawyers and will attribute the shared use of "the lawyer" to coincidence rather than an indication that the contested mark is another mark used by the opponent or an economically connected entity, or vice versa.

I consider that this will be the case even where “hub” may be used to indicate an online area, such as for educational materials. The inherent distinctiveness of the earlier marks is too low for the average consumer to believe that “The Lawyer Hub” is a brand extension rather than a mark with a distinct, if overlapping, concept, used by an unconnected entity.

150. However, where the earlier marks have enhanced distinctive character, confusion is more likely, because the average consumer is more predisposed to see “The Lawyer” as indicating trade origin and “Hub” as a non-distinctive addition to the mark. I note in this regard that there is some evidence that the opponent has used “THE LAWYER FINANCIAL SERVICES HUB” and “THE LAWYER In-house Community Hub”.⁵⁶ Although these uses include further descriptive matter, it shows that the use of “hub” in addition to “THE LAWYER” is plausible rather than fanciful. That said, the public for whom the earlier marks have enhanced distinctive character are professionals whose degree of attention is fairly high. Having considered the matter carefully, I have come to the view that there is a likelihood of indirect confusion for the following identical or highly similar services in class 41: “news reporters services; publishing, reporting, and writing of texts”. This is because “hub” is commonly used to describe an online environment and, for these services, notwithstanding the fairly high degree of attention, the average consumer is likely to perceive “The Lawyer Hub” as another mark being used by the opponent in relation to its online publication and news reporting services. I do not, however, think that there is a likelihood of confusion for the remaining similar publication services, which are too far removed from the area in which the opponent has enhanced distinctiveness to give rise to a realistic prospect of confusion.

151. As for the services in classes 35 and 41 which are similar to the award ceremony services for which the opponent has some enhanced distinctive character, I do not consider that there is a likelihood of confusion. This is despite the levels of similarity between the services, in some cases above average, and the degree of similarity between the respective marks. There are two particular reasons for this. First, although there is some enhancement of distinctiveness, it is more limited than for the services considered above: the earlier marks are distinctive to a medium, rather than above

⁵⁶ JW-6.

average, degree. Secondly, I do not think that “The Lawyer Hub” is an obvious or realistic brand extension of “THE LAWYER” for these services. “Hub” would not be used as a descriptive or non-distinctive addition to “THE LAWYER” for the similar services such that it will be perceived as an extension of “THE LAWYER” brand (or vice versa). The closest of these services to the earlier marks’ services are the organisation of competitions in class 41. However, there is no good reason why “hub” would be used to signal an online space for these services. It is also, in my view, too much of a stretch for the average consumer to think that “The Lawyer Hub” is a mark of the opponent or a connected undertaking for the contested conference/exhibition and education services, particularly as these services are only similar to a medium degree at most. The above factors, to which may be added the elevated level of attention paid by the relevant consumer, point away from confusion. There is no proper basis for a finding of indirect confusion.

152. The second mark in UK699’s series is less similar to the contested mark and its specification is no wider than the Word Mark. The opposition based on that mark cannot succeed where the Word Mark has failed. The opposition based on s. 5(2)(b) is dismissed, save in relation to the services listed below, for which registration is refused:

Class 41: News reporters services; publishing, reporting, and writing of texts.

SECTION 5(3)

153. The relevant section of the Act reads:

“5.—(3) A trade mark which-

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

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

154. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited*, 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.*, C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L’Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. The law appears to be as follows:

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

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

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

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark: *L'Oréal v Bellure NV*, paragraph 44.

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oréal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

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

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

Reputation

155. In *General Motors*, the CJEU gave the following guidance for the assessment of a trade mark's reputation:

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

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

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

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

156. UK810 is a comparable mark and paragraph 10 of Part 1, Schedule 2A of the Act is relevant to the assessment of reputation for this mark. Paragraph 10(2) reads:

“(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

- (a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.”

157. For the reasons given at paragraphs 72 to 78, above, I consider that the opponent had established among legal professionals a reasonable reputation for “magazines” in class 16 and, in class 41, “provision of information on-line from the internet; all relating to legal matters and/or the legal profession” (the Word Mark) and “online publication of news and information; news reporting; all in the legal field” (UK810). The marks also had among legal professionals a reasonable reputation for “arranging, conducting and organising award ceremonies” at the relevant date (subject to the existing limitation for the Word Mark).

158. UK810 is a comparable mark and therefore the evidence relating to the EU is relevant for this mark. I have already mentioned the opponent’s “The Lawyer European Awards” when considering the evidence above. The awards were established in 2009 and there is evidence that they continued until 2021.⁵⁷ The evidence includes prints from law firms’ websites in connection with the European Awards in 2009 and 2010 and between 2017 and 2021, and an example invoice showing the purchase in 2018 of a “Lawyer European Awards” winner’s logo for use by a law firm. There are a few comments such as “The Lawyer European Awards – among the most important awards within the European legal community [...]” (2015) and “These European awards are the most-sought [sic] among the legal profession” (2019). There are also confidential figures for the revenue generated by the licence of logos associated with The Lawyer European Awards, which has been fairly consistent between 2016 and 2021.⁵⁸ Though not trivial, the figures are rather small. There is also the evidence of Ms Laitinen, Ms Casas Domínguez and Mr García Llaneza, which recounts subscriptions by their firms to the opponent’s “The European 100” report and unspecified other reports, purchase of advertising space, awards at The Lawyer European Awards and confirmation that the firms have been invited to and attended events hosted by or sponsored by the opponent. However, although I note the (confidential) figures relating to expenditure on various services and publications, they are but three examples and, other than the logo purchase figures, there is no indication of how much revenue might have been generated in continental Europe for goods and

⁵⁷ Wilkinson, [27]-[33]; JW-20 to JW-26.

⁵⁸ Wilkinson, [34].

services provided under UK810. Bearing all of the above in mind, I do not think that the evidence relating to The Lawyer European Awards materially increases the reputation of UK810.

Link

159. Whether the relevant public will make the required mental 'link' between the marks must take account of all relevant factors. The factors are identified in *Intel* and set out below.

The degree of similarity between the conflicting marks

160. I have already compared the trade marks and adopt those reasons and findings here. The Word Mark has a medium degree of visual, aural and conceptual similarity to the contested mark. UK810 has a lower than average degree of visual similarity and a medium level of aural and conceptual similarity with the contested mark.

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

Average consumer and purchasing process

161. The earlier marks have a reputation among legal professionals, who are the relevant public for this ground, and who will select the services mainly visually with a fairly high degree of attention.

Similarity between the services

162. I have considered the similarity between the services at paragraphs 90 to 144, above, and I adopt those findings here, the relevant assessment being that for the services with enhanced distinctiveness.

The strength of the earlier mark's reputation

163. The earlier marks had among legal professionals a fairly strong reputation for magazines and publication and news reporting services in the legal field, and a

reasonable reputation for arranging, conducting and organising award ceremonies (subject to the Word Mark's limitation).

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

164. I adopt my findings at paragraphs 72 to 78, above. The earlier marks were factually distinctive to legal professionals to an above average degree for magazines and publication/news reporting services and to a medium degree for arranging, conducting and organising award ceremonies (subject to the Word Mark's limitation).

Whether there is a likelihood of confusion

165. For the reasons given above, there is a likelihood of confusion for the identical or highly similar news reporting and publishing services in class 41 listed at paragraph 152, above. I do not consider that there would be a likelihood of confusion in respect of any of the other services. Although the strength of the earlier marks' reputation and their factual distinctiveness are in the opponent's favour, these are not sufficient, in light of the differences between the services and the marks, particularly the conceptual differences, to cause confusion.

Conclusion on link

166. Taking all of the above into account, I consider that there would be a link for the services listed at paragraph 152 (i.e., those for which there is a likelihood of confusion). I do not consider that there would be a link for any of the remaining services. Although the earlier marks benefit from enhanced distinctiveness and a reputation, the differences between the marks, the likely perception of "The Lawyer Hub" simply as a combination of weakly distinctive elements and the distance between the services will not cause the average consumer to think of the earlier marks. Accordingly, the opposition based on s. 5(3) fails for all but the services listed at paragraph 152.

Unfair advantage

167. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

168. I have found that, for the goods for which there is a link, there is a likelihood of confusion. That constitutes an unfair advantage: the consumer is confused into believing that the goods are sold by the owner of the earlier marks or a connected undertaking and the contested mark benefits from sales it would not otherwise have made. I also find that the confusion as to origin would confer an unfair advantage because the contested mark would benefit from the marketing efforts and financial investment of the opponent in establishing and maintaining its reputation. This ground is made out in relation to the services below but not otherwise:

Class 41: News reporters services; publishing, reporting, and writing of texts.

169. In view of my findings above, there is no need for me to consider the alternative assertions of damage under the s. 5(3) ground.

PASSING OFF: SECTION 5(4)(A)

170. The relevant legislation is as follows:

“5.—(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,

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.

(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.”

171. The relevant date for assessing the passing off claim is the priority date but if the applicant has used the mark before that date such use must be taken into account.⁵⁹ There is no evidence that the applicant has used the mark and the relevant date is therefore 2 December 2021.

Goodwill

172. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341 HL, Lord Oliver of Aylmerton described at [406] the “classical trinity” that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous

⁵⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11 at [43].

belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

173. I am satisfied that the opponent had a protectable goodwill resulting from its business providing magazines and a website covering topics in the legal field, as well as awards in that field, and that the sign "THE LAWYER" was distinctive of that goodwill. The business extended to the provision of market reports and analysis, digital newsletters, databases of legal and commercial information, the sale of advertising space in the magazine and on the website, including employment advertising, conferences and some training services. The trade in the latter goods and services was, on the evidence before me, more limited in scope and on a smaller scale, particularly for services such as conference organisation and training services.

Misrepresentation

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

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

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

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

175. The requirement for a "substantial number" of members of the public to be deceived means a substantial number of the claimant's actual or potential customers

would be likely to be deceived: *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

176. Although a common field of activity is not essential, it is a relevant consideration. As Millet LJ said in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA),

“Where the plaintiff’s business name is a household name the degree of overlap between the fields of activity of the parties’ respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties’ respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’”

177. In class 35 of the contested specification, some of the services are in the same field as the opponent’s activities. This applies to the various advertising and marketing services, including exhibitions and trade fairs, market/business analysis and research services. Business management consultancy services have a more tenuous connection but are likely to involve a degree of business analysis so are not entirely distinct. It seems to me that the remaining services, covering business administration, auctioneering, accountancy, auditing, tax, bookkeeping, equipment rental and lobbying are in different fields from the opponent’s business. The contested services

in class 36 are also in a distinct field of business from the opponent's goodwill, as are all of the services in class 42.

178. "THE LAWYER" is far from a household name. In my view, the opponent's goodwill is not strong enough, nor the sign distinctive enough, for there to be a misrepresentation among the relevant public where the fields of activity are entirely different. Where some of the areas of trade coincide, the opponent's trade and the sign's distinctiveness in relation to these services are more limited. Coupled with the distance between the areas of business and the differences between the mark and sign, misrepresentation is not likely: the relevant public is not likely to assume that the common use of "The Lawyer" means that the services offered under "The Lawyer Hub" are provided by or connected with the opponent. I dismiss the passing off ground for all of the contested services in classes 35, 36 and 42.

179. In class 41, there would be a misrepresentation in relation to publishing services in the same field as the opponent, because that is where "THE LAWYER" is most strongly distinctive of the opponent's goodwill and where the addition of "Hub" in the contested mark is likely to be seen as indicating the opponent's services provided via an online "hub". I do not think that the extent of the goodwill or distinctiveness of the sign in relation to the other services in class 41 is sufficient for there to be a misrepresentation. Misrepresentation is made out for the following services:

Class 41: News reporters services; publishing, reporting, and writing of texts.

Damage

180. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases as follows:

"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the

plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

181. The opponent has not identified a specific type of damage. Damage through loss of sales, where the relevant public is misled as to the origin of the services, and loss of control of the sign's reputation are both reasonably foreseeable. Damage is made out for the services identified at paragraph 179, above.

BAD FAITH: SECTION 3(6)

182. An objection to a trade mark on the grounds of bad faith is provided for at s. 3(6) of the Act, which reads:

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

183. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed and said:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and

services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...]."

184. Lord Kitchin then summarised the general principles applicable to bad faith (at [240]). The principles relevant to the present case are as follows:

"(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*"), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have

regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition 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 consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”)], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).”

185. The first strand of the opponent's claim is a simple one. It says that in correspondence the applicant admitted that the trade mark was filed as a defensive measure and a blocking mechanism rather than in order to put the mark to use. This, it says, amounts to bad faith.

186. The opponent also asserts that the applicant's filing strategy is designed to force the opponent "to incur unreasonable and unnecessary legal costs in defending their rights against this needless application". It says the applicant's behaviour falls below the standards of acceptable commercial behaviour and is bad faith.

187. The presumption is that the applicant has acted in good faith. Bad faith must be distinctly proved and the burden is on the opponent to show that the facts surrounding the application establish a prima facie case of bad faith. It is, however, also clear following the Supreme Court's judgment in *Skykick* that, if a prima facie case of bad faith is established, the burden shifts to the applicant to provide a plausible explanation of the rationale underlying the application.

188. The principal evidence for the first limb of the claim is a letter from the applicant's representative. This was written in response to a letter before action, enclosing draft undertakings, from the opponent's representatives on 24 August 2022.⁶⁰ The most relevant parts of this are the applicant's explanation of its motivation for making the application (reproduced as written):

"Your client might find some comfort in the information that LEGALTECH ApS registered "*The Attorney Hub*" as a word trademark well before the application date for "*The Lawyer Hub*".

The reason for this is that we primarily intend to use '*The Attorney Hub*' for our homepage and services. For us '*Attorney*' is the more relevant and used professional title for a qualified legal practitioner in Europe.

However, while also registering the word trademark '*Full Stack Attorney*', we experienced that a Finnish law firm subsequently tried to register '*Full Stack Lawyer*' as a trade mark, for the same services.

⁶⁰ EG-2.

So primarily as a defensive measure, we decided to register the trademarks with both ‘*Attorney*’ and ‘*Lawyer*’. We would most likely (and did in the case of ‘*Full Stack Attorney/Lawyer*’, be able to prove ‘*risk of confusion*’ and therefore have the other application denied for our registered classes – but it takes time and costs money.

So, we simply found it easier and legally cost effective to register both word trademarks.

But for ‘*The Lawyer Hub*’ trademark to be valid long term, we will naturally need to make relevant use of the trademark and have a very basic homepage, which refers potential new customers to ‘*The Attorney Hub*’.”

189. As Lord Kitchin makes clear at [204(iv)]-[204(v)] of his judgment in *Skykick*, bad faith must be understood in the context of trade mark law and, in particular, the essential function of a trade mark. The above statement indicates that the contested mark was applied for in order to be used as a legal weapon to prevent other businesses from registering a mark which the applicant considered to be too close to its “The Attorney Hub” brand. The applicant’s indication that the trade mark will have to be used by means of a “very basic homepage” could be construed as showing an intention to use the mark and, therefore, that the application was not made for the sole purpose of blocking other parties’ applications. However, it is clear that any such homepage would simply refer users to the applicant’s “The Attorney Hub”. The applicant may have considered that this amounts to an intention to use the mark and saves it from bad faith. Whilst the applicant’s subjective intention is relevant, the question of whether the conduct fell short of ethical behaviour or honest commercial practices involves an objective standard. The use of a trade mark as a net to catch and redirect potential customers to the applicant’s official website, which uses a different brand name, is a purpose which does not fall within the functions of a trade mark. This conclusion is consistent with that of the General Court in *Target Ventures Group Ltd v EUIPO*, T-273/19, EU:T:2020:510, a case with similar facts, though of course that decision is not binding on me. It is, in my view, apparent from the applicant’s comments, above, that the application was filed not to put it to a use falling within the functions of a trade mark but to obtain an exclusive right in order to expand

any protection it legitimately had, or expected to have, in the name “The Attorney Hub”. Prima facie, that is bad faith.

190. The applicant has, in response, filed an email dated 15 November 2022 in which it attempts to justify the application. This was after the present opposition was filed. It is unclear whether the applicant had seen the notice of opposition by this point but it was plainly aware that its earlier comments were relied on by the opponent (“[...] you try to use our initial (nonbinding) comments [...] against us”). The applicant, so far as relevant, says that:

“We will be fighting for the right of lawyers to use the term ‘lawyer’, when describing their offerings to the public – so that it is not only an online publisher who may use the term ‘lawyer’ in a trademark.

The Lawyer Hub will be a service by lawyers for lawyers – and now an online publisher wants to prohibit that – because the lawyers use the term “lawyer” in the trademark?!”

191. I do not find this terribly convincing. It seems to me far more likely that the unguarded comments in the applicant’s first letter, where it was trying to reassure the opponent about its intentions, represent the truth and that the comments of 15 November 2022 are an attempt to justify the application after the fact, in light of the opponent’s reliance on those comments as grounds for the present opposition.

192. I note that the applicant proffers other details in its submissions of 3 December 2023. None of this is in evidential form. The tribunal objected to the exhibits which had been attached to the submissions as not being in evidential form but did not point out that the various statements of fact in the submissions would also have no weight unless filed under cover of a statement of truth. Mr Johansen, however, makes clear in those submissions that he is not only legally trained but a practising lawyer. It is not the tribunal’s responsibility to second-guess what the parties file and it is not unreasonable of the tribunal to expect a practising lawyer to know the importance of giving evidence in the proper format, or of informing themselves via publicly available guidance of the requirements for filing of evidence in this tribunal.

193. The submissions point out that the applicant filed six trade marks containing the word “Hub”, including “The Lawyer Hub” and “The Attorney Hub”, between August 2021 and August 2023. It also has a number of other trade mark registrations and says it will use the contested mark with one of these in the combination “THE LAWYER HUB By Full Stack Lawyer”. Further, it has bought domain names including thelawyerhub.uk/ thelawyerhub.eu/ thelawyerhub.dk.

194. Even if this were in evidential form, I do not consider that it would assist the applicant. The applicant asserts that it intends to operate through the six online hubs but has provided no documentary evidence showing its plans, either before or after the relevant date. There is nothing other than its bare assertion and the trade mark filings to support its claim. The existence of other trade marks featuring “hub” does not show that there was an intention to use the contested mark. The contested mark was initially admitted to have been filed to protect at least one of those marks more easily. Without more, I cannot say that the remaining four marks were not filed for the same purpose. The fact that the domain name has been purchased offers no rebuttal to the prima facie case of bad faith at all: the domain name corresponding to the contested mark would be required for the redirection of customers to “The Attorney Hub” website.

195. On this first limb, I find that the applicant has not rebutted the prima facie inference of bad faith. It applied for the trade mark not with the intention of using it in accordance with the functions of a trade mark but in order to enlarge the protection of rights in the name “the Attorney Hub” and to make protection of that sign easier. The s. 3(6) ground is made out.

196. I will briefly address the second limb of the opponent’s claim. This is a claim that the applicant intended to cause harm to the opponent specifically, by way of costs the opponent would incur defending its rights. The basis of the claim appears to be that the opponent has prior rights. However, first, the opponent has not established that the applicant was aware of the opponent prior to the application: the opponent’s business is in a niche field and is not significant enough for it to be inferred that the applicant was aware of it. Secondly, even if the applicant was aware of the opponent, that fact alone is not sufficient to establish bad faith: see the comments of Daniel Alexander KC, as the Appointed Person, in *Rui Qu (Shanghai) Enterprise Management Consulting Company Limited v Accessible Labs Ltd*, BL O/0534/25 at

[49]. Thirdly, there is no evidence that by filing the application in the classes sought (particularly those which are in entirely different areas of business) the applicant was knowingly seeking to inflict damage of the type asserted, or indeed at all, on the opponent. Given the weak distinctiveness of the words “the lawyer”, it cannot be inferred from the mere use of those words that there was any deliberate attempt to undermine the opponent. I do not think that, even if it had been aware of the opponent, the applicant can be criticised for adopting a position that, on its face, any similarity between the marks was in weakly distinctive elements and that there would be no conflict. As the decision above confirms, this was not an unreasonable position. This is not a case where the applicant has clearly made the application simply for the purpose of vexing the opponent and that should have been apparent to the opponent. Claims of bad faith are allegations of dishonesty and should not be lightly made. There is no evidence whatsoever that the opponent was specifically targeted and this part of the claim ought not to have been brought.

197. There was another claim made in written submissions, namely that the application constitutes a disruptive filing practice against the opponent, designed to be a blocking strategy or which may be used to obtain financial benefit from the opponent. This is a distinct claim which was not pleaded and I do not need to consider it. I would, however, simply reiterate that there is no evidence at all that the applicant had any motivation directed at the opponent specifically and I would have had no hesitation in dismissing what is a hopeless claim on the evidence and which should also never have been made.

198. In summary, although the second limb of the bad faith claim fails, the first limb succeeds and the application will be refused in full.

Costs

199. The opponent has been successful and is entitled to a contribution towards its costs. The opponent appears to have attended as an observer only at the joint hearing; its submissions were a brief letter accompanied by prints from the register and correspondence from the applicant which it subsequently included in its evidence. The second hearing was convened at the opponent’s request to discuss the tribunal’s preliminary refusal of its request for confidentiality. I do not consider a separate award

for the procedural hearings appropriate. I award £2,300 to the opponent, calculated as follows:

Preparing a statement and considering the counterstatement:	£400
Preparing evidence and consider the other side's evidence:	£1,200
Preparing written submissions in lieu:	£500
Official fee:	£200
Total:	£2,300

200. I therefore order Legaltech ApS to pay Thelawyer.com Limited the sum of £2,300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16th day of September 2025

Heather Harrison

For the Registrar

ANNEXE 1

THE CONTESTED MARK'S SPECIFICATION

UK3793453

Class 35

Advertising; Business management; Business administration; Media relations services; Consultancy regarding public relations communication strategies; Corporate communications services; Demonstration of goods; Arranging and conducting of displays for advertising purposes; Arranging and conducting of demonstrations for advertising purposes; Demonstration of photographic equipment [for advertising purposes]; Demonstration of goods for promotional purposes; Demonstration of goods and services by electronic means, also for the benefit of the so-called teleshopping and homeshopping services; Sales demonstration [for others]; Organization of exhibitions for commercial or advertising purposes; Arranging of demonstrations for advertising purposes; Arranging of demonstrations for advertising purposes; Organisation of exhibitions and trade fairs for business and promotional purposes; Arranging and conducting business fairs; Organisation of events for commercial and advertising purposes; Administration of consumer loyalty programs; Administration of customer loyalty and incentive schemes; Customer loyalty services for commercial, promotional and/or advertising purposes; Organisation of customer loyalty programs for commercial, promotional or advertising purposes; Customer relationship management; Dissemination of advertising matter; Promoting the sale of goods and services of others through the distribution of printed material and promotional contests; Dissemination of advertising for others via an on-line communications network on the internet; Dissemination of advertisements via the Internet; Dissemination of advertising, marketing and publicity materials; Dissemination of advertising via online communications networks; Consultancy regarding advertising communication strategies; Marketing assistance; Business advice relating to marketing; Business advice relating to strategic marketing; Advisory services relating to corporate identity; Business consultancy services relating to the promotion of fund raising campaigns; Market segmentation consultation; Consultancy relating to demographics for marketing purposes; Consultancy relating to advertising and promotion services;

Consulting services in the field of Internet marketing; Consultancy services in the field of affiliate marketing; Business marketing consultancy; Marketing advice; Rental of advertising space; Rental of advertising time on communication media; Provision of space on web-sites for advertising goods and services; Provision and rental of advertising space, time and media; Provision of advertising space on a global computer network; Rental of advertising space on the Internet for employment advertising; Rental of advertising space on the internet; Rental of advertising space on the internet; Auctioneering provided on the internet; Auctioning via telecommunication networks; On-line trading services in which seller posts products to be auctioned and bidding is done via the Internet; Accountancy, book keeping and auditing; Business auditing; Financial auditing; Book-keeping; Tax filing services; Tax preparation; Administration, billing and reconciliation of accounts on behalf of others; Book-keeping; Book-keeping and accounting services; Computerised accounting; Preparation of documents relating to taxation; Financial statement preparation and analysis for businesses; Tax preparation and consulting services; Preparation and completion of income tax returns; Business advice relating to accounting; Consultancy and information services relating to accounting; Advice on tax preparation; Consulting and information concerning accounting; Taxation [accountancy] consultation; Business accounting advisory services; Consultancy relating to auditing; Tax return advisory [accountancy] services; Administrative support and data processing services; Compiling indexes of information for commercial or advertising purposes; Compilation of information into computer databases; Compilation of statistics; Updating and maintenance of data in computer databases; Data search in computer files for others; Systemization of information into computer databases; Data processing; Business administration; Management and compilation of computerised databases; Administrative services relating to the management of legal dockets; Arranging of presentations for business purposes; Arranging of presentations for business purposes; Automated data processing; Business administration assistance; Computerised data verification; Data processing, systematisation and management; Document preparation; Collection and systematisation of information into computer databases; Mail sorting, handling and receiving; Providing an on-line commercial information directory on the internet; Provision of initial company secretarial services on company formation; Business administration; Updating and maintenance of information in registries; Personnel recruitment; Personnel selection using

psychological testing; Personnel management assistance; Human resources management and recruitment services; Advisory services relating to personnel placement; Recruitment consultancy for lawyers; Consultancy relating to the selection of personnel; Consultancy relating to management selection; Provision of advice relating to the recruitment of graduates; Personnel recruitment advertising; Testing to determine employment skills; Temporary personnel services; Work analysis to determine worker skill sets and other worker requirements; Employment agency services; Employment agency services for people skilled in the use of computers; Personnel management assistance; Job matching services; Career advisory services (other than education and training advice); Cost price analysis; Competitive intelligence services; Business research; Business investigations; Consumer profiling for commercial or marketing purposes; Market studies; Market analysis and research; Professional business consultancy; Business management and organization consultancy; Providing business information via a web site; Updating of business information on a computer data base; Assistance, advisory services and consultancy with regard to business management; Computerised business information services; Business analysis and information services, and market research; Consultancy relating to the establishment and running of businesses; Business information services provided on-line from a computer database or the internet; Commercial information services provided by access to a computer database; Consultancy and advisory services in the field of business strategy; Business appraisal consultancy; Business organization and management consultancy including personnel management; Business management and organization consultancy; Business management consultancy via the Internet; Providing business information, also via internet, the cable network or other forms of data transfer; Market analysis and research; Market research by means of a computer data base; Market research services regarding customer loyalty; Consultancy regarding business organisation and business economics; Advisory services relating to the corporate structure of businesses; Advisory services relating to business organisation and management; Strategic business analysis; Provision of computerised data relating to business; Provision of business data; Providing online commercial directory information services; Provision of information and advice to consumers regarding the selection of products and items to be purchased; Providing information about commercial business and commercial information via the global computer network; Providing business information directory

services, via a global computer network; Provision of computerised data relating to business; Provision of business information via global computer networks; Providing commercial information relating to companies; Business and market research; Evaluation of business opportunities; Business analysis services; Rental of office machines; Rental of office equipment in co-working facilities; Advertising, including on-line advertising on a computer network; Commercial lobbying services.

Class 36

Finance services; Insurance underwriting; Real estate brokerage; Rental of offices for co-working; Rental of offices [real estate]; Assisting in the acquisition of real estate; Assisting in the acquisition of and financial interests in real estate; Real estate acquisition services; Computerised information services relating to real estate; Provision of information relating to the property market [real estate]; Provision of information relating to property [real estate]; Apartment locating services for others [permanent accommodation]; Arranging of shared ownership of real estate; Real estate consultancy; Advisory services relating to real estate valuations; Research services relating to real estate acquisition; Rental of real estate and property; Providing on-line stock exchange information from a computer database or the Internet; Debt collection; Financial advisory services relating to insolvency; Bailiff services (debt collection); Debt counseling services; Debt recovery; Consultancy for clients with regard to the organisation of debt recovery; Capital investment; Fund investment services; Investment management; Administration of funds and investments; Financial consultancy relating to real estate investment; Financial underwriting and securities issuance (investment banking); Financial services relating to investment; Financing of investments; Providing financing to emerging and start-up companies; Providing information relating to securities underwriting; Commercial property investment services; Investment banking consulting and advisory services; Real estate investment planning; Real estate investment advice; Investment portfolio management services; Underwriting of shares (Services for the -); Development of investment portfolios; Financial consultancy; Financial valuation of intellectual property assets; Financial analysis; Financial research; Providing financial information via a web site; Financial analysis and consultancy; Financial information services provided by access to a computer database; Financial consultancy and information

services; Financial planning services; Financial and investment consultancy services; Financial information provided by means of a computer database; Information services relating to finance, provided on-line from a computer database or the Internet; Consultancy services relating to corporate finance; Consultancy services relating to credit; Provision of credit information; Financial appraisal services; Evaluation of the credit worthiness of companies and private individuals; Financial appraisals and valuations; Crowdfunding; Venture capital services; Venture capital (Services for the provision of -); Charitable fund raising; Arranging charitable collections [for others]; Organization of monetary collections; Financial sponsorship; Fundraising; Charitable fund raising; Real estate appraisal; Real estate appraisal; Intellectual property valuation services; Valuations and financial appraisals of property; Arranging of insurance; Brokerage; Warranty services; Consultancy services relating to insurance; Consultancy services relating to insurance; Arranging of insurance; Insurance consultancy; Providing information relating to non-life insurance underwriting; Underwriting of insurance (Services for the -); Warranty programme services.

Class 41

Entertainment services; Sporting and cultural activities; Publishing, reporting, and writing of texts; Provision of video recording studio services; Publishing of reviews; Publication of work manuals for business management; Services for the publication of travel guides; Publication of manuals; Digital video, audio and multimedia entertainment publishing services; Coaching [training]; Rental of audio equipment; Videotaping; Conducting of business conferences; Conducting instructional courses; Conducting of courses relating to business management; Arranging of demonstrations for training purposes; Arranging of demonstrations for educational purposes; Arranging of courses of instruction; Arranging of conferences relating to business; Arranging of presentations for educational purposes; Audio, video and multimedia production, and photography; Audio-visual display presentation services for entertainment purposes; Coaching in economic and management matters; Demonstration of photographic equipment [for training purposes]; Preparation of educational courses and examinations; Provision of instruction relating to communications techniques; Provision of instruction courses in finance; Provision of courses of instruction in the management of information technology; Online interactive

entertainment; Education and training consultancy; Consultancy services relating to academic subjects; Consultancy relating to vocational skills training; Provision of training courses; Provision of facilities for tuition; Audio and video recording services; Audio and video editing services; Sound recording and video entertainment services; Production of sound recordings; Organisation of conferences, exhibitions and competitions; Organising of education exhibitions; Production of audio-visual recordings; Production of audio/visual presentations; Live entertainment production services; Production of video and/or sound recordings; Production of educational sound and video recordings; Production of audio tapes for entertainment purposes; Professional consultancy relating to education; Provision of entertainment via podcast; Telephone conversation services for entertainment purposes; Provision of video recording studio facilities; Provision of training facilities; Studio services for the recording of videos; Audio, film, video and television recording services; Production of course material distributed at professional courses; Providing training courses on business management; Provision of recording studio facilities; Providing multi-media entertainment via a website; Providing video entertainment via a website; Provision of instruction relating to computer programming; Management education services; Advisory services relating to education; Education services relating to the use of computers in business; Educational services for providing courses of instruction; Educational services relating to information technology; Education services relating to the application of computer systems; Rental of audio/visual and photographic equipment and facilities; Rental of sound and video recording apparatus; Rental services relating to equipment and facilities for education, entertainment, sports and culture; Developing educational manuals; Development of educational materials; Staff training services relating to modern office technology; Staff training in the use of electrical equipment; Training in the use of photographic equipment; Training services relating to the use of information technology; Training in the operation of software systems; Training in the operation of computer programs; Provision of instruction relating to computer programming; Training relating to computer hardware; Training in computer programming; Training in business management; Industrial relations training; Training services relating to management consultancy; Provision of training courses in personal development; Training services in the field of computer software development; Teaching services relating to business assistance; Training services concerned with the use of computer software; Video production services; Video

editing; Video entertainment services; Adult education services relating to finance; Adult education services relating to management; News reporters services; Computer training; Providing of training, teaching and tuition; Training relating to the provision of legal services.

Class 42

Industrial analysis services; IT security, protection and restoration; Internet security consultancy; Design of information systems relating to management; Design of information systems relating to finance; Design of software for processing and distribution of multimedia contents; Computerised business information storage; Providing temporary use of non-downloadable software for analyzing financial data and generating reports; Hosting multimedia educational content; Hosting multimedia entertainment content; Hosting of transaction platforms on the internet; Provision of technical information in relation to computers; Compilation of information relating to information systems; Information services relating to information technology; Consultancy services for analysing information systems; Consultancy relating to the creation of homepages and Internet pages; Consultancy in the field of security software; Consultancy relating to the design of homepages and Internet pages; Information technology [IT] consultancy; Computer and information technology consultancy services; Technical consultancy relating to the installation and maintenance of computer software; Provision of expert appraisals relating to computing; Provision of information relating to information technology; Testing of computer programs; Website load testing services; New products (Testing of -); Analysis of product design; Analysis and testing services relating to electrical engineering apparatus; Analysis and evaluation of product design; Analysis and evaluation of product development; Computer aided diagnostic testing services; Design and testing of new products; Evaluation of performance of computer systems against bench-mark references; Evaluation of product design; Product quality evaluation; Evaluation of product development; Quality audits; Quality checking; Quality control; Quality control relating to computer systems; Quality control relating to computer software; Material testing; Material testing; Product testing; Product quality testing; Testing of computer programs; Testing of computing equipment; Website usability testing services; Design services relating to the reproduction of

documents; Web site design consultancy; Development, design and updating of home pages; Testing, authentication and quality control; Hosting services, software as a service, and rental of software; Platform as a service [PaaS]; Software as a service [SaaS].

ANNEXE 2

EARLIER RIGHTS: GOODS AND SERVICES

UK 918001810

Class 9

Electronic publications; publications downloadable including by electronic means and from the Internet; pre-recorded optical and magnetic recording media including CD ROM, audio tapes and discs and video tapes; information recorded on electronic media; videos; computerised directories; text and sound data banks; image banks; databases; training guides in electronic format; application software for mobile devices, wireless devices and cloud computing services; software applications; recorded content; media content; downloadable publications; downloadable electronic publications; customer relation management [CRM] software; parts and fittings for all the aforesaid goods.

Class 16

Printed publications; newspapers; periodicals; journals including professional journals; newsletters; bulletins; magazines; books; directories; manuals; brochures; pamphlets; printed research reports; leaflets; guides; case studies; printed consumer reports; printed guides; charts and tables; publicity materials; posters; postcards; stationery; advertising materials and display materials; photographs; instructional and teaching materials (other than apparatus); plastic materials for packaging, namely bags and sachets; pens and pencils; stickers and transfers (stationery articles); printers' type; calendars; printed schedules; bookmarks; paper or cardboard securitised scratch cards; graphic representations and reproductions.

Class 35

Market analysis reports; provision of marketing reports; market reports and studies; strategic business analysis; analysis of business trends; electronic collection and processing services for data, images and electronic messages; data management; online commercial information and directory services; information compilation

services; provision of commercial information from online databases; business information services; business and commercial information provided by access to a computer database; data collection services; database marketing and management; online direct electronic marketing services and advertising services; preparation and issuing of publicity materials; publicity services; advertising services; marketing services; exhibition services; arranging, conducting and organising exhibitions, road shows, demonstrations and trade shows for commercial business or trade purposes; business and commercial trade shows and business events; conducting public opinion polls; subscriptions to electronic journals, magazines and newsletters; arranging subscriptions of the online publications of others; subscription to an information media package; providing on-line employment information; information services relating to jobs and career opportunities; arranging of commercial and business contacts; providing lead generation activities and services; provision of commercial and business contact information; conducting of business research; conducting of market research; business networking services; customer relationship management [CRM] services; sales promotion, administration and management services; information, consultancy and advice relating to these services.

Class 38

Provision of access to an electronic marketplace [portal] on computer networks; access to content, websites and portals; telecommunications services; digital transmission of reports, data and information; providing online access to databases; data streaming and data transmission; transmission of news; operating web logs (blogs); providing access to multimedia content online; electronic transmission and streaming of digital media content for others via global and local computer networks; information, consultancy and advice relating to these services.

Class 41

Electronic publishing; digital publishing; publishing; news reporting; entertainment; arranging, conducting and organising conferences, consumer shows, exhibitions, events, placements, courses, training, seminars, tutorials, workshops and award ceremonies; education; training; business training; provision of electronic publications, including online magazines, periodicals and newsletters, accessible via databases

and the Internet; publication of texts, illustrations, calendars of events, schedules, books, magazines, newspapers, periodicals and more generally all types of publication, including electronic and digital publishing; photographic reporting; news reporters services; publication of the editorial content of sites accessible via a global computer network; providing an Internet news portal featuring links to news stories and articles in the field of current events; information, consultancy and advice relating to these services.

UK 2179699

Class 9

Publications in electronic forms supplied on-line from databases or from facilities provided on the internet (including web sites) relating to legal matters and/or the legal profession.

Class 16

Journals, magazines, leaflets, catalogues, newspapers and newsletters; all relating to legal matters and/or the legal profession.

Class 41

Provision of information relating to legal matters and/or the legal profession; provision of information on-line from a computer database or the internet; all relating to legal matters and/or the legal profession; organisation, arrangement and conduct of conferences, award ceremonies and fairs; all relating to legal matters and/or the legal profession.

Unregistered sign “THE LAWYER”

Electronic publications; publications downloadable including by electronic means and from the Internet; pre-recorded optical and magnetic recording media including CD ROM, audio tapes and discs and video tapes; information recorded on electronic media; videos; computerised directories; text and sound data banks; image banks; databases; training guides in electronic format; application software for mobile

devices, wireless devices and cloud computing services; software applications; recorded content; media content; downloadable publications; downloadable electronic publications; customer relation management [CRM] software; parts and fittings for all the aforesaid goods.

Printed publications; newspapers; periodicals; journals including professional journals; newsletters; bulletins; magazines; books; directories; manuals; brochures; pamphlets; printed research reports; leaflets; guides; case studies; printed consumer reports; printed guides; charts and tables; publicity materials; posters; postcards; stationery; advertising materials and display materials; photographs; instructional and teaching materials (other than apparatus); plastic materials for packaging, namely bags and sachets; pens and pencils; stickers and transfers (stationery articles); printers' type; calendars; printed schedules; bookmarks; paper or cardboard securitised scratch cards; graphic representations and reproductions.

Market analysis reports; provision of marketing reports; market reports and studies; strategic business analysis; analysis of business trends; electronic collection and processing services for data, images and electronic messages; data management; online commercial information and directory services; information compilation services; provision of commercial information from online databases; business information services; business and commercial information provided by access to a computer database; data collection services; database marketing and management; online direct electronic marketing services and advertising services; preparation and issuing of publicity materials; publicity services; advertising services; marketing services; exhibition services; arranging, conducting and organising exhibitions, road shows, demonstrations and trade shows for commercial business or trade purposes; business and commercial trade shows and business events; conducting public opinion polls; subscriptions to electronic journals, magazines and newsletters; arranging subscriptions of the online publications of others; subscription to an information media package; providing on-line employment information; information services relating to jobs and career opportunities; arranging of commercial and business contacts; providing lead generation activities and services; provision of commercial and business contact information; conducting of business research; conducting of market research; business networking services; customer relationship management [CRM]

services; sales promotion, administration and management services; information, consultancy and advice relating to these services.

Provision of access to an electronic marketplace [portal] on computer networks; access to content, websites and portals; telecommunications services; digital transmission of reports, data and information; providing online access to databases; data streaming and data transmission; transmission of news; operating web logs (blogs); providing access to multimedia content online; electronic transmission and streaming of digital media content for others via global and local computer networks; information, consultancy and advice relating to these services.

Electronic publishing; digital publishing; publishing; news reporting; entertainment; arranging, conducting and organising conferences, consumer shows, exhibitions, events, placements, courses, training, seminars, tutorials, workshops and award ceremonies; education; training; business training; provision of electronic publications, including online magazines, periodicals and newsletters, accessible via databases and the Internet; publication of texts, illustrations, calendars of events, schedules, books, magazines, newspapers, periodicals and more generally all types of publication, including electronic and digital publishing; photographic reporting; news reporters services; publication of the editorial content of sites accessible via a global computer network; providing an Internet news portal featuring links to news stories and articles in the field of current events; information, consultancy and advice relating to these services.