

**O-546-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3448869**

**BY XIAOBIN ZHAO**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**ULEGAL**

**IN CLASSES 9, 42 AND 45**

**AND**

**OPPOSITION THERETO UNDER NO. 600001374**

**BY THE UNIVERSITY OF LAW LIMITED**

## **BACKGROUND AND PLEADINGS**

1. On 03 December 2019, Xiaobin Zhao (“the Applicant”) filed trade mark application number UK00003448869 for the mark **ULEGAL**. The application was published for opposition purposes on 03 January 2020, in respect of the following goods and services:

Class 9 Computer software applications, downloadable; Electronic publications, downloadable; Laptop computers; Data processing apparatus; Computer game software, downloadable; Computer programs, downloadable; Computer programs, recorded; Computer operating programs, recorded; Computer software, recorded; Computer memory devices.

Class 42 Maintenance of computer software; Computer system design; Creating and maintaining web sites for others; Packaging design; Consultancy in the design and development of computer hardware; Software as a service [SaaS]; Technical writing; Computer programming; Providing search engines for the internet; Information technology [IT] consultancy.

Class 45 Security screening of baggage; Dating services; Mediation; Arbitration services; Intellectual property consultancy; Copyright management; Monitoring intellectual property rights for legal advisory purposes; Legal research; Litigation services; Alternative dispute resolution services.

2. The University of Law Limited (“the Opponent”) filed a Fast Track opposition, opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon United Kingdom trade mark (“UKTM”) number UK00003380220 (a series of two marks), the pertinent details of which are as follows:

### **Representation:**

(i) ULAW

(ii) ULaw

**Filing date:** 04 March 2019

**Registration date:** 24 May 2019

**Goods and services:**

Class 9      Sound recordings; video recordings; tapes; cassettes; compact discs; DVDs and other electronic media; films; CD ROMS; computer games; computer software; Application software (Apps); Apps for mobile devices; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies, photographic films; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; mouse pads; screen savers; downloadable publications in electronic form.

Class 16      Stationery; printed matter; books, periodicals, newspapers, magazines, pamphlets, manuals, journals; printed and/or published materials; text books; guides; course notes; case studies; articles; reports of conferences; teaching materials; diaries; writing implements, drawing implements; artists' materials; photographs, postcards, calendars, posters, greeting cards; paper and plastic packaging materials; stickers.

Class 41      Educational and training services; teaching; examination services; organisation of exhibitions for educational purposes; organisation of conferences, tutorials, seminars and symposia; publishing services; university services; provision of information relating to education, teaching, instruction and research; academic services and conferral of educational degrees; teaching, lecturing and tutorial services; lending libraries and library services; provision of sporting, entertainment and cultural activities and events.

3. For the purposes of these proceedings, the Opponent relies upon all its registered goods and services. The Opponent's mark qualifies, under section 6 of the Act, as an earlier trade mark. Given its registration date, it is not subject to the proof of use provisions contained in section 6A of the Act.

4. The Opponent's case under section 5(2)(b) is that its earlier mark and the applied-for mark are closely similar, and the respective goods and services are either similar or identical, resulting in a likelihood of confusion.

5. The Applicant filed a counterstatement in which it denies a likelihood of confusion on the basis that the marks at issue are not similar, and the parties' goods and services are "for the most part" different.

6. Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply in fast track oppositions but Rule 20(4) does. It reads:

"The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

7. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary.

9. The Opponent is represented by HGF Limited; the Applicant is represented by Trademarkit LLP. Only the Opponent filed written submissions. A hearing was not requested and so this decision is taken following a careful perusal of the papers.

## **DECISION**

### **Section 5(2)(b)**

10. Section 5(2)(b) of the Act states that:

"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.”

## **Relevant law**

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

### The principles

(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.

### **Comparison of goods and services**

12. The competing goods and services are shown in the table below:

<b>Earlier mark</b>	<b>Applied-for mark</b>
Class 9: Sound recordings; video recordings; tapes; cassettes; compact	Class 9: Computer software applications, downloadable; Electronic

<p>discs; DVDs and other electronic media; films; CD ROMS; computer games; computer software; Application software (Apps); Apps for mobile devices; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies, photographic films; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; mouse pads; screen savers; downloadable publications in electronic form.</p> <p>Class 16: Stationery; printed matter; books, periodicals, newspapers, magazines, pamphlets, manuals, journals; printed and/or published materials; text books; guides; course notes; case studies; articles; reports of conferences; teaching materials; diaries; writing implements, drawing implements; artists' materials; photographs, postcards, calendars, posters, greeting cards; paper and plastic packaging materials; stickers.</p> <p>Class 41: Educational and training services; teaching; examination services; organisation of exhibitions for educational purposes; organisation of</p>	<p>publications, downloadable; Laptop computers; Data processing apparatus; Computer game software, downloadable; Computer programs, downloadable; Computer programs, recorded; Computer operating programs, recorded; Computer software, recorded; Computer memory devices.</p> <p>Class 42: Maintenance of computer software; Computer system design; Creating and maintaining web sites for others; Packaging design; Consultancy in the design and development of computer hardware; Software as a service [SaaS]; Technical writing; Computer programming; Providing search engines for the internet; Information technology [IT] consultancy.</p> <p>Class 45: Security screening of baggage; Dating services; Mediation; Arbitration services; Intellectual property consultancy; Copyright management; Monitoring intellectual property rights for legal advisory purposes; Legal research; Litigation services; Alternative dispute resolution services.</p>
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<p>conferences, tutorials, seminars and symposia; publishing services; university services; provision of information relating to education, teaching, instruction and research; academic services and conferral of educational degrees; teaching, lecturing and tutorial services; lending libraries and library services; provision of sporting, entertainment and cultural activities and events.</p>	
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13. In its written submissions, the Opponent has provided a table and submissions relating to the comparison of the parties' goods and services. I have considered this in coming to the conclusions that I have reached.

14. The Applicant states, in its counterstatement, that the goods and services at issue are "for the most part" different but has not gone into any further detail on this point. The Applicant has also included a table in its submissions, in which it has simply reproduced the parties' respective specifications and not made submissions on the similarity or difference between the goods and services.

15. The General Court confirmed in *Gérard Meric v OHIM*<sup>1</sup> that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

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

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<sup>1</sup> Case T-133/05



16. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,<sup>2</sup> the court stated at paragraph 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”.

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>3</sup> for assessing similarity were:

(a) the respective uses of the respective goods or services;

(b) the respective users of the respective goods or services;

(c) the physical nature of the goods or acts of service;

(d) the respective trade channels through which the goods or services reach the market;

(e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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<sup>2</sup> Case C-39/97

<sup>3</sup> [1996] R.P.C. 281

18. In *Kurt Hesse v OHIM*,<sup>4</sup> the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,<sup>5</sup> the General Court stated that “complementary” means:

“...there is 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”.

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

20. Where there is a lack of evidence or submissions from the parties relating to the definitions of some of the terms in their respective specifications, I rely on my own knowledge of those terms, where necessary.<sup>6</sup>

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<sup>4</sup> Case C-50/15 P

<sup>5</sup> Case T-325/06

<sup>6</sup> *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842 [56]-[57]

## Applicant's Class 9

21. Due to their wording, I find the Applicant's "*electronic publications, downloadable*" and the Opponent's "*downloadable publications in electronic form*" identical.

22. In accordance with *Meric*, I find the Applicant's "*computer software applications, downloadable; computer game software, downloadable; computer programs, downloadable, computer programs, recorded; computer operating programs, recorded; computer software, recorded*" identical to the Opponent's "*computer software*".

23. I understand a computer memory device to be a device that is used to store information for use in a computer or related computer hardware. There are several different types of computer memory, but one of which (secondary memory) includes such things as hard disk drives and optical (CD or DVD) drives. The Applicant's "*computer memory devices*" therefore encompasses the Opponent's "*compact discs; DVDs and other electronic media*". In accordance with *Meric*, I find these goods to be identical.

24. In order to use computer software you need something to install it on; in order to use a laptop, you need software. The average consumer is also likely to expect them to be provided by the same undertaking. Consequently, there is a degree of complementarity between them. There is also similarity in user, although I acknowledge that the method of use and nature of the goods are different. I find the Applicant's "*laptop computers*" similar to a medium degree to the Opponent's "*computer software*".

25. It is my understanding that data processing involves the storing, retrieving and processing of data by means of various software programs, and that apparatus refers to the technical equipment used for that purpose. Like laptop computers, data processing apparatus requires software and software needs to be installed on something. As per my reasoning at paragraph 24, I find the Applicant's "*data processing apparatus*" similar to a medium degree to the Opponent's "*computer software*". If I am wrong in this finding, then I consider there to be overlap in user, trade

channels and nature with “*apparatus for recording, transmission, reproduction of sound or images*” in the Opponent’s specification, in that these are all types of apparatus used for the recording of and processing of information. I consider these goods to be similar to a medium degree.

#### Applicant’s Class 42

26. The following services in the Applicant’s class 42 are services relating to computer software (a term covered by the Opponent’s class 9 goods): “*Maintenance of computer software; Computer system design; Creating and maintaining web sites for others; Software as a service [SaaS]; Computer programming; Providing search engines for the internet*”. I group these goods together in accordance with *Separode Trade Mark*.<sup>7</sup> Bearing in mind that the comparison here is between goods and services, I am of the view that the nature and use of these will differ. However, there may be an overlap in user and trade channels, and they can be considered complementary in that computer software is important for services relating to computer software (and vice versa) to the extent that it is reasonable that customers may think that one undertaking provides both the goods and the services. Overall, I find a medium degree of similarity between the Opponent’s class 9 “*computer software*” and the aforementioned services in the Applicant’s specification.

27. “*Technical writing*”, “*packaging design*”, “*consultancy in the design and development of computer hardware*” and “*IT consultancy*” in the Applicant’s specification are all either very broad terms, or there is some ambiguity in the meaning of the terms. I therefore treat the class number as relevant to the interpretation of these terms and the subsequent comparison with the Opponent’s specification.<sup>8</sup> The aforementioned services in class 42 all have some association with technology. However, the only term in the Opponent’s specification for which it has suggested similarity is “*computer software*”. I do not agree that the Applicant’s services are complementary to computer software to the extent that consumers would believe the responsibility for the goods and services lies with the same undertaking. Simply

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<sup>7</sup> BL O-399-10

<sup>8</sup> *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 (COA)

because a person might use computer software and also require IT-related services, it does not automatically follow that those goods and services are similar. Having considered the factors outlined in the case law in relation to each of these terms, I can see no other point of similarity with the Opponent's specification. I find no similarity between the Applicant's "*technical writing*", "*packaging design*", "*consultancy in the design and development of computer hardware*" and "*IT consultancy*" and the Opponent's specification.

#### Applicant's Class 45

28. In its notice of opposition, the Opponent states that it opposes all goods and services of the application. However, in its written submissions (specifically, in its comparison table at Annex 1) the Opponent makes no reference to the following services in the Applicant's specification: "*security screening of baggage; dating services*". I can see no obvious similarity between these services and the Opponent's entire specification relied upon and so, in the absence of submissions on the matter, having considered the necessary factors, I find no similarity.

29. I turn to the remaining services in class 45 of the Applicant's specification. It is submitted by the Opponent that these services are all legal services, which are similar to the Opponent's "*organisation of conferences, tutorials, seminars and symposia*" in class 41. The reasons given are as follows:

"The two sets of services could coincide in their providers; for example, law firms often provide consulting and training services to the public. Legal advice clinics are an example of such tutorials/seminars.

Further there can be overlap with respect to the end users for the two sets of services. Members of the public seeking legal advice may also be interested in tutorials seminars or other events in the field of law."

30. The Opponent also refers to a decision of the EUIPO Board of Appeal<sup>9</sup> in which similarity was found between ‘organising of training sessions, arranging seminars and colloquiums’ and ‘legal services’. Firstly, I am not bound by this decision, and secondly, the reasoning given (which does not differ greatly from the reasoning put before me by the Opponent) I disagree with.

31. I bear in mind the *YouView* case and that words in specifications should be given their ordinary meaning and not be strained as to cover a wider group of goods or services. The Opponent’s “*organisation of conferences, tutorials, seminars and symposia*” does not make any reference to law firms, legal training or legal advice clinics, neither do the other class 41 services in the Opponent’s specification. I am not of the view that legal advice clinics would even fall into the category of organising conferences, tutorials, seminars or symposia. The fact that it is conceivable for one provider to offer all of these services does not mean that the average consumer would deem it to be the norm, nor does it automatically follow that the services are similar. I think the Opponent’s line of reasoning requires a stretching of the normal interpretation of the terms in the parties’ respective specifications. I do not find any similarity between the services in accordance with the factors in the *Treat* case, nor do I consider them to be complementary. Taking everything into account, I find no similarity between the Applicant’s class 45 services and the Opponent’s services (in class 41 or otherwise).

### **The average consumer and the nature of the purchasing act**

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

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

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<sup>9</sup> Case R 598/2018-2 *Magellan Rechtsanwälte Säugling und Partner mbB v GMG*

34. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

35. The average consumer of the goods and services for which I have found similarity (or identity) will be either a member of the general public or a business requiring use of computer software related goods or IT services. The goods in class 9 are purchased frequently (though they are not an everyday purchase), prices of which will vary considerably. The services in class 42, on the other hand, are purchased less frequently and are likely to cost more. Consumers will consider the content of the computer software-related goods and the nature of the services, as well as the suitability of both for their needs. Overall, the level of attention paid to the purchase of the goods and services will be medium. The goods and services will likely be selected from websites, so the visual element will be of most importance, although word-of-mouth recommendations will mean that the aural element also has a role in the selection process.

### **Comparison of marks**

36. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU 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 relevant 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.”

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

38. The trade marks to be compared are as follows:

Earlier marks	Applied-for mark
ULAW  ULaw	ULEGAL

39. In its notice of opposition, the Opponent stated:

“The parties’ marks are closely similar, visually, aurally and conceptually. Both marks start with the letter ‘U’ and the elements ‘LAW’ and ‘LEGAL’ are linked. [...]”

40. In its counterstatement, the Applicant stated:

“[...] In particular, the marks ULAW and ULEGAL are not similar. The endings of the marks “LAW” and “LEGAL” are different visually and phonetically. The Opponent’s mark ULAW is a shorter word consisting of two syllables as against the three syllables of ULEGAL.”



### Overall impression

41. The earlier marks consist of the letter “U” and the ordinary dictionary word “LAW”, conjoined. One mark in the series is presented in all upper-case, the other is presented with “UL” in upper-case and “aw” in lower-case. This difference is not material to my decision since protection of a word mark registration extends to the word in upper- or lower-case in any standard font. The overall impression of both marks rests in ULAW as a whole.

42. The applied-for mark consists of the letter “U” and the ordinary dictionary word “LEGAL”, conjoined. The overall impression rests in ULEGAL as a whole.

### Visual comparison

43. Visually, the first two letters of the marks are the same – UL. The marks differ in that the earlier marks end in -AW and the applied-for mark ends in -EGAL. As a general rule, the beginnings of marks tend to make more of an impact than the ends<sup>10</sup>. Given that the marks are fairly short, and the first two letters are identical, I find a medium degree of visual similarity between them.

### Aural comparison

44. I consider that the earlier marks will be broken down into the letter “U”, and the ordinary dictionary word “LAW”. The word LAW will be given its ordinary English pronunciation, as will the letter U. The applied-for mark will be broken down into the letter “U” and the ordinary dictionary word “LEGAL”, both of which will be given their ordinary English pronunciations. The similarity lies in the first syllable of the marks and that the second syllable starts with the letter “L”. The endings of the marks sound different and are one syllable (the earlier marks) versus two syllables (the applied-for mark). In my view, the marks share a medium degree of aural similarity.

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<sup>10</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

## Conceptual comparison

45. Conceptually, the earlier marks are likely to be seen as the words “you” and “law” which, together, have no meaning as such, but do create a concept of something that is related to law and specifically for the user. The same applies to the applied-for mark, which is likely to be seen as the words “you” and “legal”, creating a concept of something connected with the law and aimed at the user. Given that the words “law” and “legal” have very similar definitions:<sup>11</sup> “the system of rules of a particular country, group, or area of activity” for the former and “connected with the law” for the latter, in my view, the marks are conceptually similar to a very high degree.

## **Distinctive character of the earlier mark**

46. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

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

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

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<sup>11</sup> Cambridge English Dictionary

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

47. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

48. The Opponent, in its written submissions, stated:

“24. ULAW is an invented word which does not describe the Opponent’s goods and services.

25. The average consumer will not dissect the mark to its individual elements and ULAW, in its totality, is clearly distinctive. It is submitted that ULAW enjoys an average degree of inherent distinctiveness.”

49. I do not agree that the average consumer would see ULAW as an invented word; it is not necessary to dissect the mark in order to clearly recognise the ordinary dictionary word “LAW” preceded by the letter “U”. I am not of the view that ULAW should be afforded the same degree of inherent distinctive character as a completely invented word. I do, however, accept that ULAW is not descriptive of, or allusive for, the goods and services for which the marks are registered. I find the earlier marks to possess an average degree of inherent distinctiveness.

### **Likelihood of confusion**

50. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have referred in paragraph 11 of this decision. Such a global assessment is not a mechanical exercise. I must keep in mind the average consumer of the goods and services and the nature of the purchasing process. I remind myself that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind: see *Lloyd Schuhfabrik Meyer*, paragraph 27.

51. There are two types of confusion: direct and indirect. The distinction between the two was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>12</sup>

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

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

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

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

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<sup>12</sup> BL O/375/10

(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).”

52. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>13</sup>

53. The marks have been found to be visually similar to a medium degree, aurally similar to a medium degree and conceptually similar to a very high degree. I have found the similarity between the goods and services to range from no similarity to identical.

54. Taking into account the common elements between the marks (i.e. the letters UL), the fact that these letters appear at the beginning of the marks, the very high degree of conceptual similarity, and bearing in mind the concept of imperfect recollection, I consider it likely that the average consumer will mistake one mark for the other, resulting in a likelihood of direct confusion. Bearing in mind that a high degree of similarity between the marks can offset a low degree of similarity between goods and services, I find this to be the case even for the goods and services which are similar to a low degree.

55. For the sake of completeness, and in case I am found to be wrong with my finding of direct confusion, I go on to consider indirect confusion and whether the average consumer, if they do recognise that the marks are different, considers the common element of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

56. In this case, I consider that the concept that is conjured by the presence of the letter “U” followed by LAW or LEGAL (words that have an almost identical meaning) and in relation to identical or similar goods and services will lead the consumer to consider that they are provided by the same or economically linked undertakings. That the word LAW is replaced with the word LEGAL (or vice versa) is likely to cause

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<sup>13</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

consumers to see the difference as logical with a sub-brand or brand extension, for example. I consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

57. The opposition under section 5(2)(b) has been partially successful. The application is refused for the goods in class 9 and the following services in class 42:

Maintenance of computer software; Computer system design; Creating and maintaining web sites for others; Software as a service [SaaS]; Computer programming; Providing search engines for the internet.

58. The application may proceed for the services in class 45 and the following services in class 42:

Packaging design; Consultancy in the design and development of computer hardware; Technical writing; Information technology [IT] consultancy.

## **COSTS**

59. The Opponent has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. For Fast Track opposition proceedings, costs are capped at £500, excluding the official fee. Bearing in mind that the Applicant has been successful in defending part of its application, I award costs to the Opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the other side's statement:	£100
Preparing written submissions:	£200
Total:	£400

60. I therefore order Xiaobin Zhao to pay The University of Law Limited the sum of £400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 3rd day of November 2020**

**Emily Venables**  
**For the Registrar**