

BL O-0528-23

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED PROCEEDINGS

UK TRADE MARK NO 3469826 IN THE NAME OF BHAEDDIN AMLESH  
IN RESPECT OF THE TRADE MARK:

**Get In Law**

AND

AN INVALIDATION THEREOF UNDER NO 504322  
BY MEIBERS.RECHTSANWÄLTE RECHTSANWALTSGESELLSCHAFT MBH

AND

IN THE MATTER OF UK TRADE MARK NO 918191070  
IN THE NAME OF MEIBERS.RECHTSANWÄLTE  
RECHTSANWALTSGESELLSCHAFT MBH  
IN RESPECT OF THE TRADE MARK :

**getLaw**

AND

AN INVALIDATION THERETO UNDER NO 504476  
BY BHAEDDIN AMLESH

## **Background and pleadings**

1. On 25 February 2020, Bahaeddin Amlesh (hereinafter 'BA') applied to register **Get In Law** as a trade mark under no. 3469826. It was subsequently registered on 10 August 2020, for the following goods and services:<sup>1</sup>

### **Class 9**

Downloadable social media mobile applications; mobile phone applications; telecommunication applications; downloadable social media provided via a website; computer software; publications; media content; digital publications, downloadable publications; audio visual recordings; pre-recorded software; instructional and teaching apparatus and instruments; audiovisual teaching apparatus; education software; downloadable educational course materials; computer software; application software; pre-recorded CDs; pre-recorded DVDs; computer hardware; CD-ROMs, DVDs; videos; databases; ancillary parts for all the aforementioned goods.

### **Class 41**

Educating news relating to legal careers; training in the legal sector; legal education; educational services regarding legal careers; career services for legal careers; teaching members of the public interested in a legal career; training lawyers; seminars; teaching; news updates; educating lawyers; education and instruction; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; providing facilities for educational training; consultancy, information, electronic publishing; publications (not downloadable) from databases or the Internet; publication of educational teaching materials; production of educational sound and video recordings; rental of educational materials; rental of recorded education; provision of education on-line from a computer

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<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and competitions; advisory and ancillary services relating to all the aforementioned services.

2. Meibers.rechtsanwalte Rechtsanwaltsgesellschaft mbH (hereinafter 'MRR') seeks invalidation of the registration under the provisions of section 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under section 5(2)(b) of the Act.

3. MRR relies on trade mark 918191070 for the mark **getLaw** against all of the goods and services contained in the specification of the contested trade mark.

4. It relies on the following goods and services in its own registered specification:

**Class 9**

Recorded content; information technology and audio-visual, multimedia and photographic devices.

**Class 41**

Publishing and reporting; Education, entertainment and sport services; translation and interpretation.

5. In summary, the grounds are that BA's use of its contested mark **Get In Law** would cause confusion with MRR's earlier registration **getLaw**, for identical goods and services.

6. BA filed a counterstatement in which he denies the grounds of invalidation.

7. On 3 February 2020, MRR applied to register '**getLaw**' as a comparable trade mark under 918191070. It was registered on 22 May 2020 for the following goods and services:

**Class 9**

Recorded content; Information technology and audio-visual, multimedia and photographic devices.

### **Class 35**

Advertising, marketing and promotional services; Business assistance, management and administrative services; Business analysis, research and information services; Retail services in relation to information technology and audio-visual, multimedia and photographic devices; Wholesale services in relation to information technology and audio-visual, multimedia and photographic devices; Online retail services in relation to information technology and audio-visual, multimedia and photographic devices; Retail services in relation to recorded content; Wholesale services in relation to recorded content; Online retail services in relation to recorded content.

### **Class 38**

Telecommunication services; Provision and rental of telecommunications facilities and equipment.

### **Class 41**

Publishing and reporting; Education, entertainment and sport services; Translation and interpretation.

### **Class 42**

IT services; Science and technology services; Testing, authentication and quality control; Design services.

### **Class 45**

Safety, rescue, security and enforcement services; Legal services.

8. BA seeks invalidation of the registration under the provisions of section 47 of the Act. He does so on grounds under sections 5(4)(a) and 3(6) of that Act.

9. He relies on the sign **Get In Law** used since at least 2018 throughout the UK, 'with a focus in Manchester'. He claims goodwill in respect of educational services, namely in the legal sector and seeks invalidation of the contested mark in respect of 'recorded content' in class 9 and 'publishing', 'reporting' and 'education' services in class 41.

10. BA makes the following claim:

*“4. The Applicant enjoys goodwill in its earlier UK unregistered trade mark Get In Law (which has been used as a sign in the course of trade and identified in the Form TM26(I)). This mark has been in use in the United Kingdom by the Applicant since at least as early as 2018. The Applicant enjoys goodwill in its business which is associated with this unregistered trade mark. Use of the mark subject of UK Registration No. 918191070 (in the goods and services set out in Section C of the Applicant's Form TM26(1)) is likely to cause a misrepresentation to consumers resulting in damage to the Applicant, its brand, and unregistered trade mark such that the use of the Registrant's Mark is liable to be prevented by virtue of the law of passing off.”*

11. With regard to his claim under section 3(6) of the Act, BA submits:

*”7...the Registrant acted in bad faith at the time of filing the application for the Registrant's Mark because the application was filed without any intention to use the trade mark in relation to some of the goods and services in the application (as set out set out in Section D of the Applicant's Form TM26(1)). The Registrant instead had the intention of undermining, in a manner inconsistent with honest practices, the interests of other applicants, and of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark, namely for the purposes of obtaining leverage against members of the public.*

*8. The Registrant deliberately obtained very broad protection regardless of whether this was commercially justified. It obtained the Registrant's Mark in superfluous goods and services to use it as a legal weapon against other applicants/members of the public.”*

12. On 21 March 2022, MRR filed a counterstatement in which it denied the pleaded grounds relied on by BA. It submits:

*"The term 'Get In Law' used by the Applicant, does not have the necessary goodwill to claim the right of passing off.*

*The plaintiff has the burden of proving goodwill in its goods or services and get-up of goods. Such proof is requested.*

*It is denied that the term 'Get In Law' has been used by the Applicant in the United Kingdom since the beginning of 2018. The term is used by the Applicant -if at all- only to a very limited extent. The use is not sufficient to generate goodwill. In particular, the alleged and locally to Manchester limited use of the term is not sufficient to generate goodwill."*

13. BA filed evidence. MRR filed submissions. A hearing was held by video conference on 23 March 2023 at which both parties represented themselves.

14. Both sides seek an award of costs on the usual tribunal scale, which can be found in tribunal practice notice (TPN) 2/2016.

15. I will deal first with BA's application to invalidate MRR's registered trade mark 918191070 and the case raised under sections 47 and 5(4)(a) of the Act.

16. The relevant part of section 47 reads:

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

(a) ...

or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

17. Section 5(4)(a) of the Act states that:

“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...

(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.”

18. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,<sup>2</sup> Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, [the plaintiff] 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 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.”

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<sup>2</sup> [1990] RPC 341, HL, page 406.

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

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

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

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

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



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

### **Relevant date**

20. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>3</sup> Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:<sup>4</sup>

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

21. The filing date of the contested trade mark is 2 February 2020. There is no claim to earlier use by MRR, so this is the relevant date for the purpose of this assessment.

### **Goodwill**

22. The first hurdle for BA is to show that he had the requisite goodwill at the date of MRR’s application for the contested mark. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

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<sup>3</sup> BL O-410-11

<sup>4</sup> BL O-212-06

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

23. BA must show that he had goodwill in a business at the relevant date and that the sign relied upon, **Get In Law**, is associated with, or distinctive of, that business. The relevant evidence is contained in the witness statement of Bahaeddin Amlesh and attached exhibits BA1- BA5. His witness statement is dated 15 September 2022. The relevant evidence and my conclusions from it follow.

### **BA’s evidence**

24. Mr Amlesh states that he has used the sign **Get In Law** since August 2018. Initially this was through his website [www.getinlaw.com](http://www.getinlaw.com), and then via Instagram and live seminars in Manchester. He describes **Get In Law** as:

*“5...an active initiative that students use to improve their prospects of becoming a solicitor in England & Wales...”*

*6...Since 2018, students have been referencing Get In Law as a useful resource on third party sites such as the student room (one of the most successful student led websites in the world). Through word of mouth, the good quality services provided and marketing, the intended customer base (the demographic) has been organically and objectively recommending the services and using the Trade Mark when doing so...This also led to students applying to be our brand ambassador.”*

25. Mr Amlesh bought the domain name [getinlaw.com](http://getinlaw.com) on 11 August 2018.<sup>5</sup> He provides forty-seven examples of what he describes as client engagements and

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<sup>5</sup> See exhibit BA1.

enquiries.<sup>6</sup> These are messages received by Mr Amlesh via his website [www.getinlaw.com](http://www.getinlaw.com). They are dated between 19 August 2018 and 20 July 2019.

26. The enquiries are made by students and graduates who are pursuing legal careers. Most are seeking assistance concerning applications for vacation schemes and training contracts, along with requests for law firm specific assistance with interviews and preparation for assessment centre days. It is clear from the evidence that assessment centre days are attended by those seeking training contracts with a particular law firm.

27. There are four examples of payments made to BA via PayPal. Two of these are dated in August 2018 and two in September 2018. They are for £99.99, £60.00, £30.00 and £60.00. It is not clear which services were provided in consideration of these payments.

28. In terms of exposure to BA's sign, some of those enquiring about BA's services have seen advertising, others have discovered the 'getinlaw' website by word of mouth. For example, the first enquiry provided by Mr Amlesh is dated 19 August 2018 and makes clear that the enquirer has 'found you on Google Ads' and is very keen to use GetInLaw's services.

29. An enquiry dated 18 October 2018 reads, 'one of your past clients referred me to this website and she told me you helped her with her application'. Another, dated 23 December 2018, reads, 'My colleague told me about this website, I am currently applying for vacation schemes'. A further example dated 12 February 2019 says, 'I saw this website recommended on a legal forum and they said you'd been really helpful'. Finally, an enquiry dated 20 July 2019 begins, 'I found the link to your website from a blog'.

30. Some of the enquiries made via the Get In Law website refer to services offered. For example, an email to the 'getinlaw' website dated 17 September 2018 reads:<sup>7</sup>

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<sup>6</sup> See exhibit BA2.

<sup>7</sup> I have redacted names of particular law firms that are present in the enquiries as filed in BA's evidence.

*“Hi*

*I am looking at your full One Cycle Service Package. I am interested in your services for the ‘buddy assigned’ and ability to provide insight throughout the application process. If you could answer a few questions that would greatly help my decision. Can you tell me more about the sources you have for buddies in different law firms? I am interested in TC opportunities with F-----, C----- C-----, M----- B-----, and L-----. I want to be sure ALL of these firms are firms you have resources and available buddies in...”*

31. An email to getinlaw dated 16 September 2018 finishes:

*“...Could I sign up for your service. Also, which is the best package for a whole year’s support?”*

32. Another dated 18 October 2018 includes:

*“I am currently applying for vacation schemes and training contracts in London, and would really benefit from extra help. I’m interested in the Full service...”*

33. Finally, one dated 19 July 2019 reads:

*“I’m interested to know what the assessment centre package for R----- S----- entails and what is the pricing?”*

34. A review has been provided, though it is not clear where this was written. It is introduced by an email, dated 16 September 2018 and reads:

*“Hi team,  
Please see below a brief review of your services so far...”*

35. The review itself reads:

*“Get in Law has been a helpful resource for training contract applications and assessment centres.*

*The team have provided great assistance with preparation for assessment centres which has been tailored to the firm and personal to me. This has meant that I felt prepared for what the AC day consisted of and how I would tackle each component.*

*They have also been very responsive and efficient in answering my questions and queries along the way.*

*I feel confident that the team have the knowledge and expertise to help me secure a training contract in the near future.”*












36. Mr Amlsh provides examples of discussion threads on The Student Room website/forum which refer to **Get In Law**. He describes The Student Room as “one of the most successful student-led websites in the world.” As I understand it the Student Room is an online student community. The first two examples are as follows:<sup>8</sup>

The image shows two screenshots of discussion threads from The Student Room forum. The first thread is by user TCapplicant92, posted 3 years ago (#7564). The user's profile shows 5 badges and a reputation of 1. The thread content reads: "Hey, just want to say thanks guys for all the help. Finally got a TC. I also want to bring [www.getinlaw.com](http://www.getinlaw.com) to your attention - that website worked wonders for me! And they really do try and help you as much they can. Like if you need insights into what comes in ACs or interviews etc etc they're amazing. Thanks again dudes and dude'ets!". There are 2 replies and buttons for quote and reply. The second thread is by user Heyala, posted 2 years ago (#522). The user's profile shows 3 badges and a reputation of 1. The thread content reads: "hey all, quick question - just wondering - anyone who's used Getinlaw.com can you please DM me! I've heard really good reviews online about their assessment centre prep, however, I would like more of an insight, thankss peopleee!". There is 1 reply and buttons for quote and reply.

<sup>8</sup> See exhibit BA05(i).

37. Mr Amlsh’s evidence appears to have been printed contemporaneously with his witness statement, namely 15 September 2022. I note the dates of these two comments are 2 years ago and 3 years ago, so likely in the relevant period.

38. The following list of discussions from The Student Room has been provided. These refer to Get In Law and are dated in the right hand column:<sup>9</sup>

Re: The Official Vacation Scheme Thread 2019! <b>getinlaw.com</b> (as part of my package) so they've guided me on how to nail the answer. I also recommend using	 by blueflame8 05-09-2018	in Legal
Re: The Official Vacation Scheme Thread 2019! I'll PM you, I've done my own research and I also have been working with a trainee from <b>getinlaw.com</b>	 by ManchesterApp 05-09-2018	in Legal
Re: The Official Vacation Scheme Thread 2018! Hey, just want to say thanks guys for all the help. Finally got a TC. I also want to bring <b>www.getinlaw.com</b>	 by TCinTraining 30-08-2018	in Legal
Re: The Official Vacation Scheme Thread 2019! their VS. Try using <b>Getinlaw.com</b> and lawcareers.net for really sound application advice, they helped me	 by Sandtrooper 30-08-2018	in Legal
Re: The Official Vacation Scheme Thread 2019! & Elkins, FBD, Gibson Dunn, Skadden recruit predominantly from their VS. Try using <b>Getinlaw.com</b>	 by laurenodge 29-08-2018	in Legal
Re: The Official Vacation Scheme Thread 2019! from their VS. Try using lawcareers.net / <b>getinlaw.com</b> / allaboutlaw.com for really sound application	 by TCinTraining 29-08-2018	in Legal
Re: The Official Vacation Scheme Thread 2018! Hey, just want to say thanks guys for all the help. Finally got a TC. I also want to bring <b>www.getinlaw.com</b>	 by mac99 28-08-2018	in Legal
Re: The Official Vacation Scheme Thread 2019! ---- (a) I was in a similar situation to you and engaged <b>Getinlaw.com</b> and they advised me to do	 by Sandtrooper 26-08-2018	in Legal
Re: The Official Vacation Scheme Thread 2019! consultancy ( <b>getinlaw.com</b> ) to do both but to focus more on VS for my primary firms of choice. They said	 by ManchesterApp 26-08-2018	in Legal
The Official Vacation Scheme Thread 2019! confident & organised from the experiences I gained last cycle and I was told about <b>getinlaw.com</b> towards	 by ManchesterApp 25-08-2018	in Legal
Re: Training Contract for International Students. IMPORTANT QUERY and the like haha. I also want to bring <b>www.getinlaw.com</b> to your attention - that website worked wonders	 by TCapplicant92 23-08-2018	in Legal

39. One month after starting the **Get In Law** business, on 25 September 2018, BA received the following email from The Student Room Group:

“Dear Get in Law,  
Our business development team has noticed **www.GetInLaw.com** receive[s] much traction on our website forums. We'd be interested in forming a partnership with Get In Law. Our customer service representatives would like to schedule an interview as soon as possible.  
Kind regards,  
Customer Service Team”

<sup>9</sup> See exhibit BA05(ii).

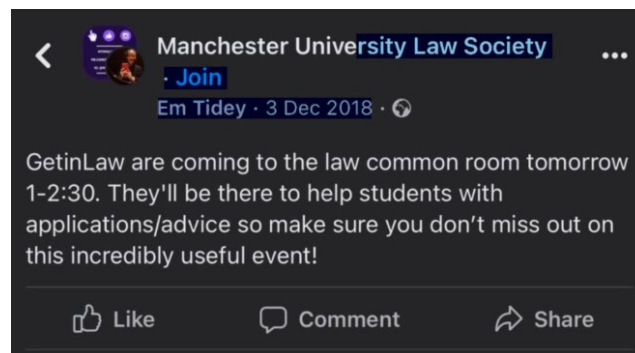
40. On 19 November 2018 BA received an email from Manchester University Law Society (MULS) careers officers. It includes the following:

*“...we are keen to have you come in for maybe a few hours one afternoon so that students can talk to you in a more relaxed environment and find out about Get in Law.*

*We would probably do this in the Law Common Room in the Williamson building.*

*Thursday 6th December from 1pm would be a good time, as lots of students finish lectures at 1pm so I think this would get good student engagement. If this doesn't work for you, we could do Friday 7th from 11am.”*

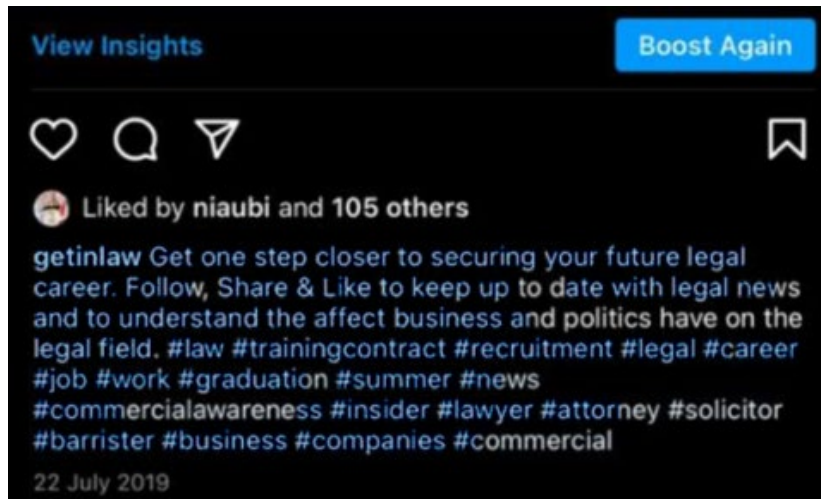
41. Mr Amlesh provides the following, to show the event being promoted on MULS's social media:



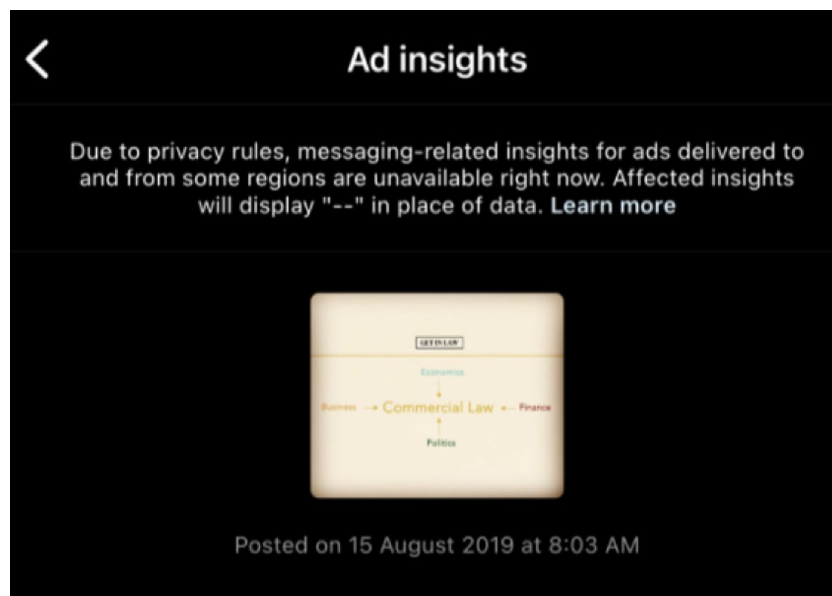
42. Mr Amlesh submits that Get In Law has had a presence on Instagram since 22 July 2019. The sign is used in the following form on social media advertising:



43. The following text is shown below the sign:



44. He provides three examples of advertising insights from Instagram. The first is for an advertisement dated 15 August 2019, which shows the GET IN LAW sign at the top. The rest of the advertisement is unclear though the words ‘Commercial Law’ appear in the centre. The advert has been ‘loved’ 280 times, bookmarked 29 times and reached 1014 people. It appears as follows:<sup>10</sup>

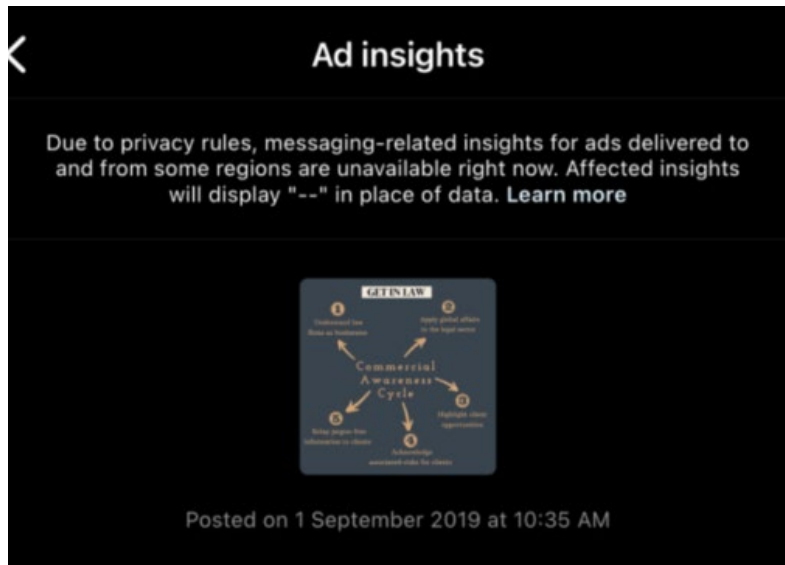


45. The second example is the insight figures for an advertisement posted on 1 September 2019. It shows the GET IN LAW sign at the top and relates to the

<sup>10</sup> See exhibit BA04(i).



'Commercial Awareness Cycle'.<sup>11</sup> It has been 'loved' 111 times, has 3 comments and has been bookmarked 54 times. The 'people reached' figure is not provided. It appears as follows:<sup>12</sup>



46. The third advertisement for which 'insight' has been provided is the GET IN LAW sign, with no additional text. It was posted on 21 July 2019. It has been 'loved' 105 times, bookmarked twice and reached 237 people.<sup>13</sup>

47. Mr Amlsh refers to Get In Law's brand ambassador scheme. In 2019, BA advertised for Brand Ambassadors on campus. The following advertisement was placed on Instagram:

<sup>11</sup> Assistance with 'commercial awareness' questions has been raised in some of the customer enquiries already referred to at BA02.

<sup>12</sup> See exhibit BA04(ii).

<sup>13</sup> See exhibit BA04(iii).



48. Mr Amlsh provides two examples of applications for the position of brand ambassador. One is from a student at Leeds University, dated 7 September 2019. The other is from a student at Manchester University and is dated 8 September 2019.

49. MRR submits that the evidence filed by BA is insufficient to meet the required goodwill threshold. In particular, it submits that a domain registration does not give rise to any trade mark rights. Whilst this is of course correct, it can provide a date when a particular web domain was purchased which may be helpful in establishing a timeline. In this case BA purchased the Get In Law domain in August 2018 and was attracting enquiries from potential customers in the same month via that website.

50. MRR says of the customer enquiries filed by BA that 'less than 50 enquiries' were made through the website in the period of about a year and that this is extremely low

and therefore does not support BA's claim that it has used Get In Law in the UK to a sufficient degree to give rise to a finding of goodwill. MRR concludes this by saying that Get In Law 'is now likely to be known by fewer than 50 people who have interacted with the website'. It also claims that the evidence relating to partnerships does not show whether there was any cooperation nor the extent to which Get In Law was used in that context. MRR also draws my attention to the lack of figures for marketing spend and to the low numbers of people reached in the ad insights provided by BA.

51. In *Hart v Relentless Records*,<sup>14</sup> Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

52. In *Smart Planet Technologies, Inc. v Rajinda Sharma*,<sup>15</sup> Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British*

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<sup>14</sup> [2002] EWHC 1984 (Ch),

<sup>15</sup> (BL O/304/20).

*Sky Broadcasting Group Plc*,<sup>16</sup> *Reckitt & Colman Product v Borden*<sup>17</sup> and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd.*<sup>18</sup> After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

53. In terms of the sufficiency of goodwill necessary to permit a party ultimately to rely on any subsequent misrepresentation by use of the other side’s sign, BA referred me to *Stannard v Reay*,<sup>19</sup> in which goodwill was found to be sufficient even though turnover related to one fish and chip van on the Isle of Wight, for a short period of time.

54. It is certainly the case that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others*,<sup>20</sup> the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant’s goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant’s sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, “*very limited*”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under LUMOS.

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<sup>16</sup> [2015] UKSC 31, paragraph 52.

<sup>17</sup> [1990] RPC 341, HL.

<sup>18</sup> [1980] R.P.C. 31.

<sup>19</sup> [1967] FSR 140 (HC).

<sup>20</sup> [2013] EWCA Civ 590.

55. What the evidence does show me is that on 11 August 2018 BA purchased a domain name and began operating a website. By 19 August 2018, BA had received an enquiry from someone who had seen BA's 'google ad' and wanted to use Get In Law's services. It is clear from the 47 enquiries provided by BA that by as early as October 2018 new enquirers were making reference to recommendations from past clients for Get In Law legal services. One month after launch, via the Get In Law website, The Student Room contacted BA and said that, 'Our business development team has noticed www.GetInLaw.com receive[s] much traction on our website forums.' This is supported by examples of Get In Law being referred to in conversation threads on the same website in the relevant period.

56. In December 2018 Get In Law was offered the chance to talk about its services to Manchester University Law students. The talk was advertised by the university as a chance to talk to **Get In Law**.

57. The problem for BA is that the evidence I have outlined above is the high point of its evidence which represents a starting point for further information which would assist in proving its claimed goodwill, but in this case, no further detail has been provided. For example, BA was invited to speak at Manchester University Law School about its services. Details of those services have not been provided and I have no idea how many people attended the event or what the outcome of it was in terms of the Get In Law business. No advertising spend or turnover figures have been provided. I have receipts for a few hundred pounds for unidentified goods and services. None of the Instagram advertising mentions BA's services which are offered under the sign. Two of the adverts look like slides from a presentation rather than an advertisement aimed at attracting customers. The third advertisement is BA's trade mark, with no additional text and no mention of the services being offered.

58. The 47 contacts received via BA's website include people who have had Get In Law recommended to them, but it is not clear which services have been provided and how much they cost. There are some references to 'the full service', but no explanation of what that means. Several enquirers ask about buddy schemes and request information from get in law about whether they can help with 'magic circle' law firms in London. There is no evidence of any responses from BA to these enquiries.

59. With regard to The Student Room, the evidence shows threads from six different contributors. There is no evidence of who the contributors are and there is no evidence that the enquiry from The Student Room to BA actually resulted in any collaboration between those parties.

60. In order to succeed in showing goodwill in respect of any business it is essential that the decision maker should be able to identify the nature and scale of the business. I do think that BA probably has a business in the Manchester area which assists law students. However, without cogent evidence to show the services offered, the cost of and range of those services, the level of turnover generated by the business and its marketing efforts, I cannot begin to assess the nature or size of that business and accordingly, to what extent any goodwill may rest in that business. Consequently, this claim falls at the first hurdle due to failure to prove the requisite goodwill necessary to begin a claim under 5(4)(a) of the Act.

61. BA's claim under section 5(4)(a) of the Act fails.

### **BA's claim under section 3(6) of the Act**

62. The claim under this ground is essentially that MRR filed its trade mark application 'getLaw' for goods and services which it had no intention to use. There are two reasons why this claim is bound to fail.

63. The first is that MRR did not file its application through the UK trade mark application route which requires the applicant to sign its application form with an explicit agreement that it intended to use the mark for the goods and services for which it applied. MRR's mark relied on here is a comparable mark which was created when the UK left the EU, which means MRR has not signed a declaration of an intention to use.

64. The second reason is that a bad faith claim is a serious one and the burden is on the claimant, BA, to prove its case. BA has filed no evidence which goes to its claim under the 3(6) ground and so it cannot possibly hope to succeed.

65. In making this finding I note that on 17 January 2023 the tribunal wrote to the parties to notify them that the 3(6) claim in this case would be suspended to await the decision from the Supreme Court in *Sky Limited (formerly Sky Plc) (and others) v Skykick, UK Ltd (and others)*. That letter was sent after BA had filed its evidence in chief and had no bearing on the content of that evidence. In other words, the letter from the tribunal could not have affected the evidence which BA elected to file. In light of my findings above, there is no need to suspend the 3(6) part of this decision as the 3(6) claim made by BA cannot succeed.

66. Accordingly, BA's 3(6) claim fails.

### **MRR's invalidation under sections 47 and 5(2)(b)**

67. MRR relies on trade mark 918191070 for the mark **getLaw** (applied for on 3 February 2020 and registered on 22 May 2020). It does so against all of the goods and services contained in the specification of BA's contested trade mark, number 3469826 which was registered on 10 August 2020.

68. MRR relies on the following goods and services in its own registered specification:

#### **Class 9**

Recorded content; information technology and audio-visual, multimedia and photographic devices.

#### **Class 41**

Publishing and reporting; Education, entertainment and sport services; translation and interpretation.

69. MRR claims that BA's use of its contested mark **Get In Law** would cause confusion with MRR's earlier registration **getLaw**, for identical goods and services. BA denies all such claims.

70. The relevant part of section 47 of the Act reads:

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

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

or

(b) ...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

71. Under Section 6(1) of the Act, the opponent’s trade mark qualifies as an earlier trade mark. However, proof of use is not relevant in these proceedings because registration of the opponent’s earlier mark was completed fewer than five years before the application date of the contested mark.<sup>21</sup>

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

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

(a)...

(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,

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

73. 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,

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<sup>21</sup> See section 6A of the Act.



*Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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**

74. The goods to be compared are as follows:

<b>MRR's goods and services</b>	<b>BA's goods and services</b>
<b>Class 9</b> Recorded content; information technology and audio-visual, multimedia and photographic devices.	<b>Class 9</b> Downloadable social media mobile applications; mobile phone applications; telecommunication applications; downloadable social media provided via a website; computer software; publications; media content; digital publications, downloadable publications; audio visual recordings; pre-recorded software; instructional and teaching apparatus and instruments; audiovisual teaching apparatus; education software; downloadable educational course materials; computer software; application

	software; pre-recorded CDs; pre-recorded DVDs; computer hardware; CD-ROMs, DVDs; videos; databases; ancillary parts for all the aforementioned goods.
<p><b>Class 41</b> Publishing and reporting; Education, entertainment and sport services; translation and interpretation.</p>	<p><b>Class 41</b> Educating news relating to legal careers; training in the legal sector; legal education; educational services regarding legal careers; career services for legal careers; teaching members of the public interested in a legal career; training lawyers; seminars; teaching; news updates; educating lawyers; education and instruction; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; providing facilities for educational training; consultancy, information, electronic publishing; publications (not downloadable) from databases or the Internet; publication of educational teaching materials; production of educational sound and video recordings; rental of educational materials; rental of recorded education; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and competitions; advisory and ancillary services relating to all the aforementioned services.</p>

75. In *Gérard Meric v OHIM*,<sup>22</sup> the General Court (“GC”) stated that:

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<sup>22</sup> Case T-133/05.

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

76. In *Canon*,<sup>23</sup> the Court of Justice of the European Union (CJEU) 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”.

77. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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;

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<sup>23</sup> Case C-39/97.

(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.”

78. Terms in the respective specifications should be given their ordinary and natural meanings. In *YouView Ltd v Total Ltd*,<sup>24</sup> Floyd J stated:

“...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”.

79. With regard to broad terms in specifications, I bear in mind *Sky v Skykick* [2020] EWHC 990 (Ch), in which Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

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<sup>24</sup> [2012] EWHC 3158 (Ch) at [12].

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

80. On the matter of complementarity, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

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

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

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

82. Whilst on the other hand:

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

83. The parties have given me nothing beyond broad statements when it comes to the comparison of the respective goods and services. Accordingly, I make my own judgement.

#### Class 9

84. MRR’s recorded content is, in my view, audio or visual material that has been captured. It clearly includes BA’s ‘audio visual recordings’, ‘pre-recorded CDs’ and ‘pre-recorded DVDs’, which are identical goods. Similarly, ‘media content’ refers to different media forms consumed or produced and as such includes recorded content. These are identical goods.

85. BA’s ‘CD ROMs’, ‘DVDs’ and ‘videos’ are primarily used to record content or can be purchased with recorded content already on them. They are at least highly similar to MRR’s ‘recorded content’. Similarly, ‘downloadable educational course materials’ are materials which have already been created and recorded in such a way as to make them available via, inter alia, a computer or mobile phone. MRR’s recorded content could be content related to education or to a particular course or subject and would, in that case, share users, uses, nature, trade channels and possibly be in competition. I find these goods to be at least highly similar to MRR’s recorded content.

86. ‘Publications’, ‘digital publications’ and ‘downloadable publications’ in BA’s specification could be considered a type of recorded content. Moreover, these goods also have a complementary relationship with MRR’s publishing services in class 41, being the end product of those services, such that the average consumer may

consider them to be provided by the same undertaking. I find these goods to possess at least a medium degree of similarity with MRR's goods and services.

87. BA has a number of 'software' terms in its specifications such as, 'Downloadable social media mobile applications; mobile phone applications; telecommunication applications; downloadable social media provided via a website; computer software; pre-recorded software; education software; computer software and application software'. MRR clearly has no registration for software, but does have a registration for information technology devices, which would include computers. The uses, nature and trade channels differ for computer devices versus software goods and they are not in competition. However, it is certainly the case that the information technology devices in MRR's specification require software in order to operate and will include devices that use applications in order to function, giving rise to a complementary relationship where the software is indispensable for the use of the device itself, and where customers may think that the responsibility for those goods - say, a multimedia device and the software that runs on it - lies with the same undertaking. I find these goods similar to a low degree.

88. MRR's Information technology devices and multimedia devices are types of computer hardware and as such fall within the broader term, 'computer hardware' in BA's specification resulting in identity in accordance with the decision in *Meric*.

89. BA's 'audiovisual teaching apparatus' could certainly be included in MRR's 'audiovisual devices' which are not limited to a particular purpose but would include such items used for teaching. I find these to be identical terms.

90. BA's 'instructional and teaching apparatus and instruments' could include MRR's IT, audiovisual and multimedia devices but also includes other items. Given that the goods are in class 9 they will not include physical stationery goods which would be classified elsewhere. The users and uses could overlap where both sides' goods are used for teaching, though MRR's will also have other uses such as entertainment and display. The nature of the goods may coincide and they may reach the market by the same trade channels; they may also be in competition. I find these goods similar to a medium degree.



91. BA's 'databases' are data sets held within a computer. They can relate to any subject and take many different forms including, inter alia, text, audio and visual content. They may have some cross-over with MRR's recorded content. For example, a database of birdsong and audio recordings of birdsong will have similar users, uses and natures and may be in competition, the primary difference being that data stored in databases can be more easily interrogated by the user. Having considered all of the relevant factors I find these goods to be similar to a low to medium degree.

#### Class 41

92. MRR has 'education services' in its earlier specification and I find similarity between that term and the following services in BA's specification:

Educating news relating to legal careers; training in the legal sector; legal education; educational services regarding legal careers; career services for legal careers; teaching members of the public interested in a legal career; training lawyers; seminars; teaching; educating lawyers; education and instruction; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; providing facilities for educational training; production of educational sound and video recordings; rental of educational materials; rental of recorded education; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and advisory and ancillary services relating to all the aforementioned services.

93. BA's 'publications (not downloadable) from databases or the Internet', 'publication of educational teaching materials' and 'electronic publishing' are publication services in class 41 which fall within MRR's broad term publishing and are identical terms under the *Meric* principle.

94. BA's 'news updates' could be included within MRR's broad term 'reporting' and is therefore identical on the *Meric* principle.

95. BA's 'competitions', may relate to sporting competitions or competitions in the field of entertainment and to that extent are identical to MRR's broader services of sport and entertainment.

96. BA's terms, 'consultancy' and 'information' could relate to any subject matter, which could include the services for which MRR has a registration. For example, they may include sports consultancy, or information relating to publishing or entertainment and as such may be similar to the terms contained in MRR's specification.

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

97. In accordance with the case law cited at paragraph 73 above, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

98. 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*<sup>25</sup>, Birss J. (as he then was) 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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

99. The goods and services include normal everyday goods provided to members of the general public and also specialised goods and services likely to be purchased by

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<sup>25</sup> [2014] EWHC 439 (Ch)

professional or business users. For example, BA's legal education services and MRR's publishing services could be purchased by a member of the public or a business/professional. The purchase is likely to be primarily visual, the consumer encountering such goods and services online, through a website or in the case of goods such as CDs or recorded software, in a bricks and mortar store. I do not rule out an aural element where word of mouth recommendation plays a part. The frequency of purchase is likely to vary as the goods and services range from a fairly cheap mobile phone application, which might be bought on a fairly regular basis, to legal education services which are likely to be much less frequently bought. Across the range of goods and services, the consumer is likely to pay at least a medium degree of attention to the purchase, as, even at the cheaper end of the spectrum, they will need to ensure the goods and services are fit for their particular purpose.

### Comparison of marks

100. The marks to be compared are:

MRR	BA
<b>getLaw</b>	<b>Get In Law</b>

101. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>26</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

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<sup>26</sup> *Sabel v Puma AG*, para.23

102. MRR's mark is the conjoined words 'get and 'Law'. The capital L at the start of the second word 'Law' serves to make a division in the mark which means that the average consumer will clearly identify the two separate words making up the whole mark, rather than it creating a new or invented word. The mark is presented in a black standard typeface, in lower case. The overall impression of MRR's earlier mark rests in the whole mark.

103. BA's mark is the three words 'Get In Law', with the first letter of each word being in upper case. It is presented in a plain black typeface with no additional stylisation. The overall impression of the BA's contested mark rests in the whole mark.

104. Visual similarity rests in the fact that the first word of each mark is the word 'Get' or 'get' and the last word in each mark is 'Law'. Generally speaking, the case in which the words are presented is of no relevance as fair and notional use of a plain text mark includes use in upper or lower case and reasonable combinations thereof.<sup>27</sup> However, as I have said, the capitalisation of the letter L in MRR's mark does serve here to make a clear distinction between the two words in the mark.

105. Visual differences rest in the addition of the word 'In' between the words 'Get' and 'Law' in BA's contested mark. The additional word is noticeable and will not be ignored. Overall, I find the competing marks to be visually similar to a medium to high degree.

106. BA's mark is three known words which the average consumer will know how to pronounce. It will result in three syllables, GET-IN-LAW. MRR's mark will be identified as two known words and will be pronounced, GET-LAW, resulting in two syllables, which are identical to the first and third in the contested mark. Overall, I find the competing marks to be aurally similar to a medium to high degree.

107. Conceptually, both marks include the words 'Get' and 'Law' which appear in the same order and will be clearly understood. They will have the same meaning in both marks. BA's mark includes the word 'In' to make the whole mark, 'Get In Law'. Neither

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<sup>27</sup> See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41, paragraph 22.

party's mark has a clear meaning, both have an odd construction that does not make immediate sense to the average consumer. Quite how one 'gets law', or 'gets in law' is not clear. To the extent that they share common well-known words in the same order, and will be given the same meaning in both marks, there will be a degree of conceptual similarity, which I put at a medium level.

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

108. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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* [1999] ECR I-0000, paragraph 49).

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

109. I have no evidence from MRR, so can only make the assessment of inherent distinctiveness.

110. The earlier mark is 'getLaw', registered for a range of goods and services for which it has no obvious meaning, being neither descriptive nor allusive. I find it to be a normal trade mark possessed of a medium degree of inherent distinctive character.

### **Likelihood of confusion**

111. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>28</sup> I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.

112. I have made the following findings:

- The average consumer is likely to be a member of the general public or a business/professional.
- The goods and services are identical or similar.
- The level of attention paid to the purchase will be at least medium.
- The purchase will be primarily a visual one, though I do not rule out an aural element.
- MRR's mark is visually and aurally similar to the applicant's mark to a medium to high degree and conceptually similar to a medium degree.
- The earlier mark has a medium degree of inherent distinctive character.

113. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same,

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<sup>28</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

114. The similarity between the respective marks and the likelihood of imperfect recollection, reinforced by the unusual grammatical construction of the marks means that the parties' marks are confusingly similar in respect of all goods and services where I have found there to be some degree of similarity. In other words, a consumer encountering either mark would, when encountering the other sometime later, for similar goods or services, simply mistake it for the other mark.

## **CONCLUSION**

115. BA has failed to invalidate MRR's trade mark 'getLaw' under section 47 and sections 5(4)(a) and 3(6) of the Act.

116. MRR has succeeded in invalidating BA's mark under sections 47 and 5(2)(b) for all of the goods and services for which it is registered.

## **COSTS**

117. Turning to the matter of costs, MRR has succeeded in invalidating BA's mark, in its entirety. I have borne in mind that BA filed a small amount of evidence and MRR filed submissions only. I award costs on the following basis:<sup>29</sup>

Official fees:	£200
Preparing the notice of cancellation and considering the other side's statement of case and defence:	£300
Considering the other side's evidence:	£200

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<sup>29</sup> The scale of costs applicable to proceedings before the Comptroller can be found in Tribunal Practice Notice 2/2016.

Preparation for and attendance at a hearing: £400

**TOTAL £1100**

**Dated this 7<sup>th</sup> day of June 2023**

**Al Skilton**

**For the Registrar,**

**The Comptroller-General**