

O-340-13

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 2 548 894

IN THE NAME OF TRADING TERMS LIMITED

OF THE TRADE MARK: Off to see my lawyer

IN CLASSES 09, 16, 18, 41 AND 45

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO 84357

BY EPOQ GROUP PLC

The background and pleadings

1. "Off to see my lawyer" is a trade mark standing in the name of Trading Terms Limited. It was applied for on 28 May 2010 and completed the registration procedure on 24 September 2010. It is registered in respect of the following goods and services:

Class 9

recorded media, computer software; software downloadable from the Internet; downloadable electronic publications; web applications

Class 16

Printed matter; paper and cardboard and goods made out of these materials; publications; brochures; manuals; leaflets; booklets; business cards; books; magazines; periodicals; reports; instructional and teaching materials; stationery; printed promotional materials; notepads; pens; pencils;

Class 18

Umbrellas

Class 41

Arranging and conducting conferences, seminars and workshops; publishing and providing on-line electronic publications; translation services.

Class 45

Legal services relating to company law and commercial law; provision of information and documents over the Internet, preparation of reports and opinions all relating to company law and commercial law.

2. Epoq Group Ltd ("the applicant") filed an application on 15 March 2012 to have the trade mark declared invalid under section 47(2) of the Trade Marks Act 1994 ("the Act"). Section 47(2) states:

(2) 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.....

3. The applicant for invalidity argues that the registered trade mark should be declared invalid under Section 5(2) (b) of the Act as it is similar to its earlier trade mark and is registered for similar goods. As such, it argues there is a likelihood of confusion. With the exception of "umbrellas" in class 18, all of the goods and services of the registered trade mark are attacked. It relies upon its earlier trade mark My Lawyer, filed on 14 May 2007 and registered on 9 November 2011 in respect a wide range of goods and services, the following of which are relied upon in these proceedings:

Class 9

Computer software including packaged software; application software; software provided from a computer network; publications downloaded in electronic format from the Internet; computer software supplied from the Internet;

Class 41

Education and training services; publishing; arranging and conducting colloquiums, conferences, seminars, symposiums, workshops and exhibitions;

Class 45

Legal services.

4. In its counterstatement, the Registered Proprietor denies the claims made. Specifically, it argues that the trade marks are sufficiently different to avoid confusion.
5. Both parties filed evidence. A Hearing took place on 20th June 2013, with the Applicant for Invalidity represented by Mr John Reddington of Williams Powell and the Registered Proprietor by Mr Aaron Wood of Briffa. The submissions made during the Hearing have been fully considered in reaching this decision and will be referred to as and when appropriate during this decision.

The Applicant's evidence

6. This is a witness statement, from Mr Richard Cohen, a solicitor and director of the applicant. The following relevant information is contained therein:
 - The applicant's business mission has always been, and remains, to transform the way in which legal services are delivered. This has led to investment in technology which in turn has led to the development of web platforms for the delivery of legal services, principally legal documents via a website. Mr Cohen asserts that it is this area which brings the respective businesses of the applicant and the registered proprietor into conflict as the applicant's MyLawyer website uses these platforms to deliver legal services direct to consumers especially in respect of documents.
 - Exhibit RCC2 shows examples of the publicity the applicant has generated in regard of its products. It is noted that these materials overwhelmingly show use of EPOQ or refer to Mr Cohen rather than My Lawyer.
 - The MyLawyer website was launched in November 2008 and a selection of the publicity generated is included in Exhibit RCC4. It is noted that this publicity includes, amongst other materials, press releases, a launch at a Law Society Seminar and press articles appearing in the Law Society Gazette.
 - Though the website has generated some interest in respect of the number of hits, customer registrations and sales levels have been disappointing (2,530 and 404 by 2012 respectively).

The Registered Proprietor's evidence

7. This is a witness statement from Joanna Tall, a solicitor and director of the Registered Proprietor. A significant proportion of the witness statement is concerned with distinguishing its business from that of the applicant. This point will be considered further below. Further, much of the witness statement contains comments regarding the conduct of the Applicant (for example, reference to the Legal Services Act), which is not relevant to the issues in hand here and so will not be summarised. The remainder of the witness statement contains the following relevant information:
 - In November 2009, she decided to start a new line of business aimed at female entrepreneurs setting up in business. The name and accompanying logo was therefore chosen as an appropriate way to enhance the brand further and attract female entrepreneurs.
 - The business is like a standard law firm though does not have a high street presence. Rather, it attracts people through its website. Pre-prepared legal documents can be purchased via the website but 30 minutes of free advice from a lawyer is included with every document purchased.
 - Gross profit of the business is increasing, from £143,693 in 2010 to £154,629 in 2011.
 - Details of Ms Tall's own personal marketing activities are provided and examples are included within Exhibits JST 2 and 3. These are legal articles which also, by and large, promote the Off to see my lawyer business.

- At Exhibit JST8 results of a search on search engine Google are included. According to Ms Tall, these demonstrate how commonplace the phrase “my lawyer” is. Further, Ms Tall displays, in Exhibit JST12 copies of the respective trade marks which are, according to her, clearly different. In this respect it is noted that it is a stylised version of the earlier trade mark being compared with the registered trade mark, the subject of these proceedings. However, the comparison to be made in this case is in respect of the earlier word only earlier trade mark, namely My Lawyer.

Applicant’s evidence in reply

8. This is a witness statement from Mr Richard Cohen. Mr Cohen responds to the submissions by Ms Tall to distinguish the parties’ respective businesses in the marketplace. In short, he does not consider that they can be so readily distinguished. The remainder of the witness statement contains replies to points raised in Ms Tall’s witness statement which are, in any case, not considered to be directly relevant to the matter in hand here. As such, though they have (as with all the evidence filed) been carefully assessed, they will not be summarised here, but will be referred to if appropriate during this decision.

DECISION

Likelihood of confusion – Section 5(2) (b) of the Act.

Preliminary remarks

9. In response to the arguments of the Registered Proprietor as regards the nature of the respective businesses in the marketplace, the current, or past, marketing undertaken by the parties is not relevant to the issues to be determined, as the General Court (GC) stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”¹

10. The net effect of this is that the matter must be considered based upon the trade marks and their respective specifications as they appear on the Register.

11. The relevant parts of section 5 of the Act read as follows:

(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,

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

12. The leading authorities which guide me in this ground are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn- Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

The average consumer

13. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). *The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in Inter- Ikea Systems BV v OHIM (Case T-112/06))*.
14. The average consumer in these proceedings will be both the professional customer such as the business sector but will also be the public at large. The level of attention likely to be displayed during the purchasing process will vary from relatively low in respect of the class 16 goods in dispute, to high in respect of, for example, legal services which often involve a significant monetary outlay or will otherwise be sought out in respect of an important life event. In any case, the level of attention is unlikely to ever be very low (as is the case with perishable or everyday items) and is therefore likely to be at least reasonably considered.

Comparison of the goods and services

15. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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,

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their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

16. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

17. The following guidance is also taken into account: Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 where he stated:

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

18. The definition of complementary is also borne in mind. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06 GC* explained when goods are complementary:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

The earlier goods and services are:

Class 9

Computer software including packaged software; application software; software provided from a computer network; publications downloaded in

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electronic format from the Internet; computer software supplied from the Internet;

Class 41

Education and training services; publishing; arranging and conducting colloquiums, conferences, seminars, symposiums, workshops and exhibitions;

Class 45

Legal services.

The contested goods and services are:

Class 9

recorded media, computer software; software downloadable from the Internet; downloadable electronic publications; web applications

Class 16

Printed matter; paper and cardboard and goods made out of these materials; publications; brochures; manuals; leaflets; booklets; business cards; books; magazines; periodicals; reports; instructional and teaching materials; stationery; printed promotional materials; notepads; pens; pencils;

Class 41

Arranging and conducting conferences, seminars and workshops; publishing and providing on-line electronic publications; translation services.

Class 45

Legal services relating to company law and commercial law; provision of information and documents over the Internet, preparation of reports and opinions all relating to company law and commercial law.

Contested goods in class 9:

19. The earlier goods include computer software at large, a term which also appears in the contested goods. They are identical. The earlier term is very wide and clearly includes the following contested goods: recorded media, software downloadable from the internet; web applications as they are all types of software. They are also identical. Each specification also contains downloadable electronic publications (though expressed slightly differently). They are also identical.

Contested services in class 41:

20. The earlier specification contains the very broad term education and training services. The contested term arranging and conducting conferences, seminars and workshops are examples of the kinds of activities that occur as part of the provision of the earlier services. They are identical. The earlier specification also includes publishing at large. The contested publishing and providing on-line electronic publications is therefore clearly identical. The remaining contested term is translation services whereby interpreters are provided and documents translated from one language to another. This bears no resemblance to any of the earlier goods and services in respect of nature and purpose, nor would one expect them to be provided by the same undertakings. At the hearing, Mr Reddington conceded that they are not similar.

Contested goods in class 16:

- 21. At the hearing, Mr Reddington conceded that the following contested terms were not similar to any of the earlier terms: paper and cardboard and goods made out of these materials; business cards; stationery; notepads; pens; pencils.
- 22. The remaining goods are, in Mr Reddington's view, means of transmitting written information and both feature, or may feature, the same subject matter, namely legal advice, information and assistance.
- 23. It is noted that the earlier specification includes electronic publications. These seek to inform, instruct and entertain and so can be the same in nature and purpose as the following contested goods: printed matter, publications, manuals, booklets, books, magazines, periodicals, reports, instructional and teaching materials. They are considered highly similar.
- 24. The remaining contested terms are leaflets and printed promotional materials. These can also be available in an electronic format. There is a degree of similarity here, though this degree is on the low side.

Contested services in class 45:

- 25. The earlier term is legal services. The entire contested specification is comprised of services which are either clearly legal services or which are examples of the kinds of activities that legal services include such as the provision of information and the preparation of reports. They are considered to be identical.

Comparison of the marks

- 26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer *normally perceives a mark as a whole* and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.
- 27. The respective trade marks are shown below:

My Lawyer	Off to see my lawyer
Earlier trade mark	Contested trade mark

- 28. As regards dominant and distinctive components, specific submissions were made at the hearing. Mr Reddington, for the applicant, asserts that the earlier trade mark is the dominant and distinctive element of the trade mark applied for and so the

comparison between the marks should fully take account of this and consider the element “off to see” as being merely filler elements which perform a function only to emphasise the element “my lawyer”. Mr Wood for the registered proprietor strongly disagrees and argues that my lawyer is part of a complete phrase and so the correct comparison is as between the respective trade marks as wholes. It is considered that in respect of the earlier trade mark, it will be understood instantly as a whole and so the answer is straightforward. There is no stand alone distinctive and/or dominant element. In the trade mark applied for, none of the elements are presented in a manner which ensures one has dominance over the other. In this regard, the guidance of the CJEU in Case C-3/03P, *Matratzen Concord v OHIM*, paragraph 32 is helpful:

“The Court rightly pointed out, in paragraph 34 of the contested judgment, that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. It also held that that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components”.

29. Bearing in mind the above guidance, it is considered that Mr Wood’s position is the preferred approach and so the correct comparison to be made is between the respective trade marks as wholes.

30. Visually and aurally, the marks coincide in respect of the elements my lawyer but differ in respect of the elements off to see which appear in the contested trade mark but which have no counterpart in the earlier trade mark. There is therefore a degree of similarity, though this is considered to be at the lower end of the spectrum.

31. In terms of conceptual comparison, it is noted that in Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* (2003) ECR at paragraph 54, the CFI stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately....
The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

32. The CJEU reached the same conclusion, expressed in similar terms, in the *Picasso and others v DaimlerChrysler AG Picarro/Picasso* case (C- 361/04P).

33. Conceptually, the earlier trade mark is likely to be seen as describing a professional person. The contested trade mark, though it contains the words my lawyer is more likely to be seen as a complete phrase, perhaps referring to a meeting which is yet to

take place or maybe as a threat. It is considered that these concepts are quite distinct from one another despite each containing coincidental words. They are not considered to be conceptually similar.

Distinctiveness of the earlier trade mark

34. The degree of distinctiveness of the earlier trade mark must also be assessed. This is important because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The evidence filed by the opponent is an attempt at persuading the tribunal that the earlier trade mark has become highly distinctive as a result of the use made of it. It is noted that there is some publicity material in respect of My Lawyer, such as the launch at a Law Society seminar and an article in the *Law Society Gazette*. It is noted that there have, to date, been just 404 sales in respect of My Lawyer products/services. Further, as a whole the evidence overwhelmingly contains references to EPOQ and/or Mr Cohen without any direct linkage to My Lawyer. As the average consumer will include the public at large, it is considered that the evidence filed does not demonstrate that this consumer has been exposed to the earlier trade mark to the extent necessary for it to be considered to have become highly distinctive.
35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings (*Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97). It is considered that My Lawyer is certainly allusive for many of the goods and services for which it is registered, perhaps strongly so in respect of those directly related to the law. As such, its degree of distinctiveness is considered to be at the lower end of the spectrum for those goods and services relating to the law. For those goods and services that do not directly relate to the law, My Lawyer is averagely distinctive

Global Assessment – Conclusions on Section 5(2)(b)

36. It is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.
37. In considering this, the guidance in Case C-120/04 *Medion* is taken into account where it was stated:

“28 The global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, in particular, *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and *Matratzen Concord*, paragraph 29).

29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

38. Applying the above guidance, it is considered that My Lawyer does not play an independent and distinctive role in the contested trade mark. The later trade mark is a complete phrase with a differing meaning within which the earlier trade mark is unlikely to be picked out in isolation.
39. Having said that, the presence of the words my lawyer in each of the trade marks creates an obvious point of visual and aural similarity and so it is accepted that there is a degree of similarity between the marks. However, it is considered that this similarity is significantly reduced by the presence of “off to see” which will not go unnoticed and which is considered to have an important visual and aural impact. Further, these additional words ensure that the contested trade mark is likely to be seen and understood as a complete phrase which creates a concept quite different from My Lawyer. Though it is true that the relevant public rarely has the opportunity to compare the trade marks side by side and so relies on an imperfect picture of them, the idea created by the phrase “off to see my lawyer”, which is different from “My Lawyer”, is likely to provide a strong point of recollection. Further, the purchases in question here are always likely to be at least reasonably considered, on occasion highly so. This negates against imperfect recollection, despite the identical nature of some of the goods and services here. As regards the identical goods and services,

the interdependency principle referred to above has been fully considered¹. However, it is felt that the degree of difference between the respective trade marks is high². Bearing in mind all of the foregoing, it is considered that the trade marks create a different overall impression. As such, the differences between them are clear and noticeable and will enable the relevant public to accurately distinguish between them even where the goods and services are identical. Further, the differences are such that the relevant public will not believe them to be economically linked. There is no likelihood of confusion.

COSTS

40. The Registered Proprietor has been successful and so is entitled to a contribution towards its costs. At the hearing, Mr Wood argued that his client had been put to extra trouble in considering the evidence filed by the applicant for invalidity, much of which did not contain My Lawyer. Mr Wood argued that should the decision go against the Registered Proprietor, then any award of costs should be reduced. Mr Reddington commented that all of the applicant's evidence had been filed in good faith and in a manner which it felt best supported its case. Mr Wood's point about the evidence has been noted and borne in mind in considering the level of this costs award.
41. The Registered Proprietor is awarded the sum of £1700 as a contribution towards the cost of the proceedings. This is comprised as follows:
 - Considering application - £200
 - Statement of Case in Reply - £300
 - Considering Evidence - £350
 - Preparing and Filing Evidence - £350
 - Preparation for and attendance at Hearing - £500
42. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 21st day of August 2013

Louise White

**For the Registrar,
The Comptroller-General**

¹ *Canon Kabushiki Kaisha v Metro-Goldwyn- Mayer Inc* [1999] RPC 117: a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa

² *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-505/11