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No likelihood of confusion between LEGALROOM and LEGALZOOM

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Introduction

In a recent judgment,⁽¹⁾ the Patent and Market Court of Appeal (PMCA) emphasised the conceptual differences between the trademarks LEGALROOM and LEGALZOOM. The Court considered the relevant Swedish public to have good knowledge of English and therefore to be capable of grasping the different meanings of "room" and "zoom". The Court concluded that the visual and phonetic similarities between the trademarks did not outweigh their conceptual differences.

This is only one of several recent Swedish court judgments where the limited trademark protection of descriptive elements of an earlier trademark played a decisive role in the overall assessment of likelihood of confusion.

Facts

In January 2019, a Swedish company applied to register the word mark LEGALROOM for goods and services in Classes 9 and 45. The application covered legal services, among other things.

The claimant, a US company named LegalZoom.com, Inc filed an opposition based on its earlier registered word marks for LEGALZOOM (stylised as "LegalZoom" with a capital L and Z) in Classes 35, 42 and 45, also covering legal services.

PRV

The Patent and Registration Office (PRV) concluded that there was no likelihood of confusion between the trademarks in light of the weak distinctive character of the term "legal" and since the terms "room" and "zoom" gave rise to different associations.

PMC

The claimant appealed the decision to the Patent and Market Court (PMC), which dismissed the appeal in its entirety and confirmed the findings of the PRV. The PMC also held that conceptual differences could counteract the visual and phonetic similarities under the condition that at least one of the trademarks has a clear and specific meaning so that it can be grasped immediately by the relevant public.

PMCA

The claimant requested that the PMCA set aside the decision of the PMC.

The Court initially confirmed that both LEGALROOM and LEGALZOOM covered legal services in Class 45 and thus identical services. Furthermore, the Court stated that the average user seeking legal advice should be considered to have good knowledge of English to that extent that the words "legal", "room" and "zoom" have a clear meaning.

Distinctiveness of trademarks

As to the distinctiveness of the trademarks, the Court held that both marks had a somewhat diluted distinctiveness for legal services.

The Court then went on to assess the level of similarity between the trademarks. It stated that both marks shared the initial element "legal" and that the marks differed in their second element, "room" and "zoom", respectively, and that the meaning of these words should, as stated above, be considered as known to the relevant public.

Dominant element of trademarks

In its determination of the dominant element of the trademarks, the Court stated that the shared element "legal" was considered a commonly used term to describe or refer to legal services. It therefore concluded that "room" and "zoom" were the distinctive and dominant components of the marks.

Nevertheless, the Court stated that although the word "legal" was found to be descriptive for the services in question, it could not be considered completely negligible in the overall assessment.

Trademark comparison

When comparing the trademarks, the Court stated as follows.

Visual comparison

Visually, the marks coincided in the presence of the element "legal" and the last part of the words "room" and "zoom" ("oom"). Also, the marks consisted of the same number of letters. The mark LEGALZOOM (stylised as "LegalZoom") was registered with a capital L and Z, which affected the similarity of the marks, according to the Court.

Phonetic comparison

Phonetically, the Court stated that there were similarities, since both marks shared the same number of vowels and consonants.

Conceptual comparison

As to the conceptual comparison, the Court concluded that neither the composition "LEGALROOM" nor the composition "LegalZoom" existed in the English language. However, the words "room" and "zoom" had a clear and definite meaning for the relevant public. Therefore, the second elements of the trademarks – "room" and "zoom" – were sufficient to conceptually differentiate the marks.

Overall assessment

In conclusion, the Court stated that the marks gave rise to different conceptual associations within the field of legal services, which to a large extent outweighed the visual and phonetic similarities.

In its overall assessment, the Court concluded that there was no likelihood of confusion between the trademarks at issue. Therefore, the appeal was rejected.

Comment

The outcome of this case is in line with existing Swedish case law, according to which descriptive elements enjoy minimal trademark protection, even if the trademark as a whole is sufficiently distinctive for registration. On the other hand, the trademarks in this case were highly similar and may actually be confused by non-observant consumers on the marketplace.

The Court's reasoning serves as an illustrative example of the fact that conceptual differences may outweigh visual and phonetical similarities. The decision also emphasises the importance of choosing a strategically suitable trademark if the aim is to build a strong brand with a wide legal protection.

Keeping in mind the principle of unitary character of EU trademarks, it is worth considering whether the EU institutions would have come to the same conclusion in this case, considering that both earlier trademark registrations used as grounds for opposition were protected via the EU Intellectual Property Office (EUIPO) (one as an EU designation of an international registration and one as an EU trademark).

The EUIPO trademark guidelines state that when dealing with the distinctiveness of an earlier registered mark as a whole, the latter should always be considered to have at least a minimum degree of inherent distinctiveness. The question remains in this case whether LegalZoom really enjoyed this minimum degree.

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Endnotes

(1) PMÖÄ 11204-20.