

o/028/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3406888

BY AMARJIT SINGH DHANDA FOR

LOVE AT FIRST SWIPE

FOR GOODS AND SERVICES IN CLASSES 9,14,18,25,35,42,45

AND

OPPOSITION THERETO UNDER NO. 417873

BY MATCH GROUP, LLC

Background and pleadings

1. On 14 June 2019 (“**the Relevant Date**”) Amarjit Singh Dhanda (“**the Applicant**”) filed an application to register the words “LOVE AT FIRST SWIPE” as a UK trade mark in respect of the following lengthy list of goods and services in Classes 9, 14, 18, 25, 35, 42 and 45.

Class	Applied-for goods and services
9	Downloadable computer and mobile phone software for use in posting, transmitting, retrieving, accessing, receiving, reviewing, organizing, searching and managing text, audio, data, visual and multimedia data, information and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks; downloadable computer and mobile phone software for online introduction, dating and social networking services; software for use in soliciting feedback; downloadable computer and mobile phone software that enables users to send status updates and to share content and electronic files with others; computer software for calculating, mapping, transmitting and reporting information relating to the location, movement, proximity, departure and arrival of individuals and objects via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks. Eyewear and parts and fittings therefor; spectacles; sunglasses; frames for spectacles and sunglasses; chains, straps and cords for sunglasses and spectacles; protective bags and cases for eyewear; cases for sunglasses and spectacles; covers and cases for mobile phones, computers and tablets; computer software; application software; audio and/or video recordings; publications in electronic format; downloadable electronic publications.
14	Jewellery; costume jewellery; precious and semi-precious stones; rings; earrings; bracelets; brooches; necklaces; chains; jewellery charms; pendants; jewellery boxes; horological and chronometric instruments; clocks and watches;

	watch straps; watch boxes; key rings; key fobs; ornamental pins; badges of precious metals; parts and fittings for all of the aforesaid goods.
18	Luggage and carrying bags; travelling bags and cases; suitcases; garment bags for travel; luggage label holders; luggage tags; luggage straps; leather straps; bags; bags of leather or imitation leather; bags of skin or hide; textile bags; canvas bags; cloth bags; knitted bags not of precious metals; mesh bags; towelling bags; handbags; shoulder bags; tote bags; shopping bags; satchels; back packs; holdalls; sports bags; shoe bags; toilet bags; wallets; purses; card wallets; credit card cases and holders; key cases; umbrellas; parts and fittings for all of the aforesaid goods.
25	Clothing; footwear; headgear.
35	Advertising; business management; business administration; office functions; marketing; promotional services; organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes; fashion show exhibitions for commercial purposes; presentation of goods on communication media, for retail purposes; retail and wholesale services and online retail and wholesale services, all relating to cosmetics, make-up, face, lip and cheek make-up, cosmetic kits, compacts, foundations, concealers, make-up primers, blushers, rouges, face powder, face glitter, lipstick, lip gloss, lip liner, non-medicated lip balm, pencils for cosmetic purposes, lip pencils, eye pencils, eye make-up, eye shadow, mascaras, eyeliners, eye creams, eye gels, eye balms, eyebrow cosmetics, highlighter, make-up remover, non-medicated soaps, toiletries, body cleaning and body care preparations, shower and bath preparations, shower and bath gels, bath foams, bath oils, bubble baths, talcum powder, hand washes, facial washes, non-medicated oils, creams, lotions, gels and powders for the skin and body, cosmetic preparations for skin care, beauty creams, face creams, moisturisers, cleansers, toners, clarifiers, exfoliators,

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beauty serums, night creams, anti-ageing creams, perfumery, fragrances and fragrance products for personal use, perfumes, body sprays, personal deodorants, antiperspirants, essential oils, scented oils, non-medicated massage oils and creams, aromatherapy preparations, hair lotions, hair care products, shampoo, hair conditioners, hair styling products, styling lotions, hair spray, dry shampoo, hair dyes, hair masks, hair creams, nail care preparations, nail polish, nail strengtheners, nail polish remover, nail art stickers, nail glitter, artificial nails, adhesives for artificial nails, false eyelashes, adhesives for affixing false eyelashes, eyelash tint, shaving preparations, shaving creams, foams, lotions and gels, after-shave preparations, depilatory preparations, sun tanning and sun protection preparations, cosmetic preparations for skin tanning, artificial tanning preparations, self-tanning preparations, toothpaste, potpourri, fragrance sachets, room fragrances, candles and wicks for lighting, scented candles, razors, eyewear and parts and fittings therefor, spectacles, sunglasses, frames for spectacles and sunglasses, chains for sunglasses and spectacles, straps and cords for sunglasses and spectacles, protective bags and cases for eyewear, cases for sunglasses and spectacles, covers and cases for mobile phones, covers and cases for computers and tablets, computer software, application software, audio and/or video recordings, publications in electronic format, downloadable electronic publications, vehicles and parts and fittings therefor, apparatus for locomotion by land, air or water, motor vehicles, electric vehicles, cycles, scooters, prams, pushchairs, car seats for babies or children, jewellery, costume jewellery, precious and semi-precious stones, rings, earrings, bracelets, brooches, necklaces, chains, jewellery charms, pendants, jewellery boxes, horological and chronometric instruments, clocks and watches, watch straps, watch boxes, key rings, key fobs, key holders, ornamental pins, badges of precious metals, printed matter, paper, cardboard, photographs, stationery, artists' materials, paint brushes, plastic materials for packaging, printed publications, books, periodical publications, printed publicity and promotional material, catalogues, brochures, photograph albums, posters, pictures, prints, diaries, calendars, address books, stickers, transfers, decalcomanias, stencils, cards, greeting cards, postcards, wrapping paper, gift bags, gift tags, carrier bags, bags and articles for packaging, bags and articles

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for wrapping and storage, boxes of cardboard, hat boxes of cardboard, book covers, bookmarks, writing pads, notebooks, envelopes, labels, paperweights, book ends, writing instruments, pen and pencil cases, pen and pencil holders, gift vouchers, clothing patterns, embroidery patterns, paper flags and pennants, paper banners, advertising signs of paper or cardboard, paper table linen, paper tablecloths, paper and cardboard place mats, paper and cardboard coasters, paper napkins, paper towels, tissues, paper tissues for cosmetic use, cases for passports, luggage and carrying bags, travelling bags and cases, suitcases, garment bags for travel, luggage label holders, luggage tags, luggage straps, leather straps, bags, bags of leather or imitation leather, bags of skin or hide, textile bags, canvas bags, cloth bags, knitted bags not of precious metals, mesh bags, towelling bags, handbags, shoulder bags, tote bags, shopping bags, satchels, back packs, holdalls, sports bags, shoe bags, toilet bags, wallets, purses, card wallets, credit card cases and holders, key cases, umbrellas, furniture, furniture fittings, mirrors, picture frames, picture stands, photograph frames, plaques, statuettes, figurines, works of art and ornaments, curtain tie backs, curtain rails, curtain poles, curtain rings, curtain hooks, cushions, pillows, bolsters, mattress cushions, seat pads, chair pads, blinds, bedding, airbeds, bean bags, coat hangers, non-metallic clothes hooks, hat and coat stands, clothes covers, baskets, non-metallic bins, magazine racks, book shelves, non-metallic name plates, non-metallic boards and panels for keys, trays, not of metal, display stands and boards, signboards of wood or plastics, containers, casks, chests, cases and boxes of wood or plastics, plastic packing containers, beds for animals, decorative mobiles, decorations of plastic for foodstuffs, non-electric fans for personal use, household or kitchen utensils and containers, combs, sponges, brushes, glassware, porcelain, pottery, earthenware, chinaware, cookware, tableware, crockery, plates, saucers, dishes, bowls, pots, jugs, egg cups, tea pots, coffee pots, cooking pots, non-metallic cookery moulds, storage jars, rolling pins, drinking vessels, cups, mugs, drinking glasses, tankards, bottles, drinking bottles, sports bottles, bottle openers, corkscrews, decanters, drinking flasks, vacuum flasks, bottle covers, food and drink containers, insulated food and drink containers, lunchboxes, non-electric coolers for food and drinks, ice cube moulds, bottle buckets, glass stoppers,

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cocktail shakers, drinking straws, juice squeezers, strainers, siphons for carbonated water, stands for bottles, napkin holders, cutlery holders, condiment holders, salt cellars, serving trays, coasters not of paper or textiles, fitted picnic baskets, picnic ware, decorative objects made of glass, decorative objects made of ceramic, decorative objects made of china, decorative objects made of earthenware or porcelain, enamelled glass, vases, perfume bottles, perfume sprayers, candlesticks, candle holders, non-metallic money boxes and piggy banks, toothbrushes, holders for toothbrushes, soap boxes and holders, fitted vanity cases, hair brushes, nail brushes, cosmetic utensils, cosmetic powder compacts, household gloves, ironing boards, shaped ironing board covers, clothes drying racks, clothes pegs, shoe horns, shoe brushes and shoe trees, refuse bins, litter bins, flower pots, non-metallic watering cans, baskets for domestic use, storage boxes for household use, textiles, fabrics, textile piece goods, textiles for making articles of clothing, textile handkerchiefs, household textile articles, household linen, soft furnishings, textiles for furnishings, unfitted covers for furniture, textile goods for use as bedding, bed covers, bed linen, sheets, pillow cases, duvet covers, valances, bedspreads, duvets, quilts, mattress covers, blankets, lap rugs, throws, bed throws, sleeping bags, travelling rugs, textile materials for making curtains and blinds, curtains, curtain tie-backs of textile, shower curtains, cushion covers, cushion pads, furniture covers, chair covers, table covers, table linen, table cloths, table runners, napkins, serviettes, place mats of textile, table mats, not of paper, textile coasters, kitchen linen, tea towels, cloths, bath linen, towels, flannels, face cloths, beach towels, banners, flags of textile, bunting, textile wall hangings, wall decorations of textile, clothing, footwear, headgear, clothing accessories, badges for wear, patches, belt clasps, buckles, hat ornaments, hair ornaments, shoe ornaments, lanyards for wear, floor coverings, rugs, mats, wall coverings, wallpaper, games, toys and playthings, gymnastic and sporting articles, exercise and fitness apparatus, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, oils and fats for food, fresh meat, frozen meat and meat products, prepared meat and meat products, prepared meat dishes, prepared meals consisting primarily of meat, frozen meals consisting

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primarily of meat, fresh fish, frozen fish and fish products, prepared fish and fish products, prepared fish dishes, prepared meals consisting primarily of fish, frozen meals consisting primarily of fish, seafood, frozen seafood and seafood products, prepared seafood and seafood products, prepared seafood dishes, prepared meals consisting primarily of seafood, frozen meals consisting primarily of seafood, fresh game, frozen game and game products, prepared game and game products, prepared game dishes, prepared meals consisting primarily of game, frozen meals consisting primarily of game, fresh poultry, frozen poultry and poultry products, prepared poultry and poultry products, prepared poultry dishes, prepared meals consisting primarily of poultry, frozen meals consisting primarily of poultry, protein for food for human consumption, food products made primarily from protein, meat substitutes, food products made primarily from meat substitutes, cooked meats, cured meats, sausages, burgers, prepared vegetables, prepared vegetable products, frozen vegetable products, prepared fruits, prepared fruit products, frozen fruit products, processed vegetables and fruits, vegetable and fruit purees, fruit and vegetable spreads, vegetable oils, prepared vegetable dishes, prepared meals consisting primarily of vegetables, frozen meals consisting primarily of vegetables, vegetable-based snack foods, fruit-based snack foods, fruit salads, prepared salads, dairy products and dairy substitutes, cream, cheeses, cheese products, dairy spreads, butter, dairy desserts and puddings, dairy-based drinks, yoghurts, yoghurt desserts, yoghurt-based drinks, egg products, prepared meals consisting primarily of eggs, desserts, fruit desserts, crisps, potato crisps, vegetable crisps, processed nuts, prepared nuts, processed seeds, prepared seeds, soups and stocks, meat extracts, extracts for soups, preparations for making soups, prepared and frozen meals, snack foods, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastries and confectionery, edible ices, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice (frozen water), bakery products, bread products, pies, sandwiches, sandwich wraps, pizzas, prepared pizza meals, garlic bread, pasta, pasta sauces, pasta dishes, prepared pasta meals, noodles, prepared meals consisting primarily of noodles, rice-based snack foods, prepared meals consisting primarily of rice,

	<p>rice cakes, popcorn, pastry products, cakes, muffins, biscuits, puddings, desserts, custards, mousses, pancakes, waffles, ice cream, ice cream products, frozen confections, frozen yoghurt, sweets, chocolate, chocolate products, chocolate and cocoa beverages, breakfast cereals, muesli, cooking sauces, fruit and vegetable sauces, dressings for food, salad dressings, mayonnaise, relish, cereal-based snack foods, cereal bars, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, vegetable juices, fruit and vegetable drinks, soft drinks, flavoured water, energy drinks, alcoholic beverages, wines, sparkling wines, fortified wines, distilled beverages, spirits, liqueurs, cider, perry, cocktails; information, advisory and consultancy services in relation to all of the aforesaid.</p>
42	<p>Providing temporary use of nondownloadable software for use in posting, transmitting, retrieving, accessing, receiving, reviewing, sharing, organizing, searching and managing text, audio, data, visual and multimedia data, information and content; providing temporary use of nondownloadable software for online introduction, dating and social networking services; providing temporary use of nondownloadable software for use in soliciting feedback; providing temporary use of nondownloadable software that enables users to send status updates and to share content and electronic files with others; providing temporary use of nondownloadable software for calculating, mapping, transmitting and reporting information relating to the location, movement, proximity, departure and arrival of individuals and objects via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks.</p>
45	<p>Dating services; computer dating services; dating agency services; dating and social introduction services provided via online personal advertisements. Online social networking services; online dating services; information in relation to</p>

	dating, personal relationships and social introduction provided via an online website and computer networks.
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2. The application was published on 28 June 2019, and on 27 September 2019 Match Group, LLC (“**the Opponent**”) commenced opposition proceedings based on **sections 5(2)(b), 5(3) and 5(4)(a)** of the Trade Marks Act 1994 (“**the Act**”). Relevant details of the Opponent’s claims and earlier-filed trade marks and claimed earlier rights – (i) to (v) - are set out in the following few paragraphs.

(i) The EU Swipe Registration

EUTM 13979547: “SWIPE”

Filing date: 23 April 2015

Registration date: 12 March 2019

Relying on **Class 25**: Clothing; headwear; all being casualwear and not technical sportswear.

3. The EU Swipe Registration is relied on to oppose, under **section 5(2)(b)**, the applied-for goods and services in Classes 9, 14, 18, 25 and 35. The Opponent states that this earlier registration covers “clothing” which is identical to the class 25 goods in the opposed application and further claims: *“The retailing of clothing could be seen as an associated service offering, resulting in a likelihood of confusion, including a likelihood of association. Clothing is a standard merchandise product and thus similar or complementary to the opposed goods in classes 9, 14 and 18 of the opposed application which are also possible merchandise items. The retailing of the goods in classes 9, 14 and 18 could be seen as an associated service offering, resulting in a likelihood of confusion, including a likelihood of association.”*¹

(ii) The UK Swipe Registration

UK Trade Mark No. 3362400 “SWIPE”

Filing date: 20 December 2018

¹ The Statement of Grounds in the Form TM7 referred to a class “28” – but since there are no Class 28 goods at issue, I understand that simply to have been a typographical error, where the intended reference was to Class 18.

Registration date: 26 June 2020

Relying on **Class 45**: Dating services; internet based social networking, introduction and dating services

4. The UK Swipe Registration is relied on under **section 5(2)(b)** to oppose the applied-for goods and services in Classes 9, 42 and 45. The Opponent claims its Class 45 services are identical or highly similar to the class 45 services in the opposed application, and that *“in order to provide online services, the Opponent uses software and provides an online hosting environment and so the goods in class 9 and services in class 42 of the opposed application a highly similar to the earlier services in class 45 being complementary and a necessary facilitator of the opponent's service offering. Consequently, there exists a likelihood of confusion, including a likelihood of association on the part of the relevant public.”*
5. It is noted that the opposition had initially relied additionally on EUTM 14900310, to oppose, under **section 5(2)(b)**, the applied-for goods and services in Classes 9, 42 and 45. That EUTM was for the word “SWIPE” in respect of: **Class 9**: *Computer application software for mobile devices, namely, software for social introduction and dating services* and **Class 45**: *Dating services; internet based social networking, introduction and dating services*. The Opponent had relied on both those registered goods and services. However, that EU registration no longer forms part of the present UK proceedings since it has been cancelled following proceedings on absolute grounds brought by the Applicant before the EUIPO.
6. The UK Swipe Registration is also relied on for the **section 5(3)** grounds to oppose registration of all of the applied-for goods and services. The claims under this ground are:
 - (a) that the Opponent has a **reputation** for the word “**swipe**” in respect of its Class 45 services;
 - (b) that “the marks are highly similar, such that use of the applied-for mark would bring to mind the Opponent’s earlier “swipe” mark,
 - (c) “such that the Applicant would be able to **ride on the coattails** of the Opponent’s reputation in the “Swipe” mark, which means the Applicant would enjoy an enhanced

recognition in relation to its goods and services offering.” This freeriding is the claimed **unfair advantage**;

- (d) “Free riding on the Opponent’s reputation in the mark would dilute and blur the **inherent distinctiveness** of the Opponent’s mark swipe, which it has **worked so hard to create** over the years. Should the Applicant’s offering be sub-standard in any way this could cause immediate detriment to the quality of the online dating services associated with the Opponent’s service offering.” This is the claimed **detriment to the reputation**;
- (e) the relevant public will no longer be able to distinguish the Opponent’s mark as being that of the Opponent, which will cause detriment to the Opponent’s brand by **compromising the essential function** of the trade mark which is to distinguish the origin of the goods and services provided.
- (f) **The claimed detriment to the distinctive character** - and how it would affect the economic behaviour of the relevant public – was expressed as follows:
- the relevant public will no longer be able to distinguish the Opponent’s mark as being that of the Opponent, which will cause detriment to the Opponent’s brand by **compromising the essential function** of the trade mark which is to distinguish the origin of the goods and services provided.
 - To **free ride** on the back of the claimed reputation in the mark swipe would dilute and blur the unique reputation and distinctive character of the Opponent’s trade mark which would cause detriment to the Opponent.
 - Due to the public no longer being able to distinguish the Opponent’s mark as being that of the Opponent, the public may believe that the Opponent and the Applicant are in fact related undertakings or that a commercial connection exists. Consequently they may assume that the services of the Opponent are in fact the services of the Applicant and vice versa. This may lead the public to use the Applicant’s goods or services believing them to be those of the Opponent, leading to detriment in the Opponent’s business through loss of subscribers to the dating agency services and thus an economic loss.

(iii) **The ASCCYL Registration**

EUTM 13979588: “ANY SWIPE CAN CHANGE YOUR LIFE”

Filing date: 23 April 2015

Registration date: 24 September 2015

Relying on: **Class 9:** Computer application software for mobile devices, namely, software for social introduction and dating services;

Class 25: Clothing; footwear; headwear.

Class 45: Dating services; internet based social networking, introduction and dating services

7. This registration is relied on under section 5(2)(b) to oppose registration of **all of the applied for goods and services.**

(iv) **The Swipe Sessions Registration**

UK Trade Mark No. 3344502 “SWIPE SESSIONS”

Filing date: 10 October 2018

Registration date: 28 December 2018

Relying on: The TM7 states that all goods and services registered under this mark are relied on, which are:

Class 35: Promotion of concerts.

Class 41: Entertainment services; concert services; organisation of concerts; production, distribution and exhibition of video and audio content; entertainment services in the nature of audio and video programs provided through the Internet, streaming video-on-demand, and other forms of transmission media.

Class 45: Dating services; internet dating services; internet-based social networking, social introduction and dating services; online social networking between pre-selected groups of users; personal introduction services; information, advice and consultation relating to the aforesaid services

8. This registration is relied on to oppose, under section 5(2)(b) the applied-for goods and services in Classes 9, 42 and 45. The Opponent’s submissions/claims as to identity and similarity with those goods and services refer only to the Opponent’s earlier Class 45 services (not its earlier services in Classes 35 and 41), and mirror the submissions advanced under the UK Swipe Registration above.

(v) **The claimed common law rights**

9. The Opponent also opposes the full scope of the Applicant's goods and services on the basis of section 5(4)(a) of the Act. In this regard, the Opponent claims that use of the contested application was liable to be prevented on the basis of the law of passing off. The Opponent claims to have used throughout the UK, since 2012 the signs "**SWIPE**" and "**SWIPE RIGHT**" in relation to a wide range of services relating to online dating and social introduction services, which it claims has accrued to the Opponent substantial goodwill and reputation. The statement of claim set out in its response at Q4 of the Form TM7 is then phrased: "*The use of a highly similar mark causes a misrepresentation of the established goodwill of the opponent which could lead to damage either in terms of substandard goods/services offered by the Applicant, or through diversion of revenue. The above scenario would be contrary to the law of passing-off in the United Kingdom.*" While I find this part of the claim to be expressed in rather hypothetical terms, it is clear that the Opponent objects to the contested application premised on the provisions of section 5(4)(a) of the Act.

The Applicant's defence

10. The Applicant filed a Form TM8 notice of defence and counterstatement – at that point acting without legal representation - from which I note the following points:
- i. In respect of **section 5(2)(b)** the counterstatement acknowledged that the applied-for mark "does have similar goods or services to the mark owned by the opponent", but it did not specify which or to what extent. The Applicant argued however that the word "swipe" is integral to the ease of use and operation of its mobile application, which relies on the swipe gesture being used by the user of the mobile application.
 - ii. The Applicant "disagreed entirely" with the claim under **section 5(3)**. It stated that "the word "swipe" is used by many companies in advertising campaigns and tag lines with similar goods and services." The counterstatement refers to an **Exhibit A** which was appended to the Form TM8, which, it stated, detailed a sample of the various uses of the word "swipe" by other companies within the Apple App store marketplace which have similar goods and services. I shall refer to the content of Exhibit A later in this decision.

- iii. The Applicant stated “the Opponent has registered marks with a recognised reputation “SWIPE LEFT” “and “SWIPE RIGHT”. Our mark does not infringe upon these well-known tag lines nor is it our intention to incorporate these tag lines into our mobile application. It should be noted that the aforementioned tag lines are descriptions of the pre-set parameters defined by the mobile hand-held device manufacturers.”
- iv. In respect of the **section 5(4)(a)** claim the Applicant denied there would be a valid claim under the law of passing off because the applied-for mark did “not infringe upon the Opponent’s activity within our specific service or goods.” In support of this position, the counterstatement referred to an **Exhibit B** which was appended to the Form TM8, which, it stated, is “an example from the Apple App store marketplace displaying results using the terms “SWIPE DATE” and “SWIPE DATING”. It should be noted that the searches do not reveal any marks registered to the opponent.” I shall refer to the content of Exhibit B later in this decision.

Papers filed, hearing and representation

11. Both parties filed evidence. I will refer to aspects of the evidence and of the parties’ submissions or claims where I consider it warranted to do so. An oral hearing took place before me by video-conference on 25 October 2021. Victoria Jones attended as counsel for the Opponent, instructed by Barker Brettell LLP; Mr Lee Curtis of the Applicant’s legal representatives (HGF LLP) attended for the Applicant;² both filed skeleton arguments in advance.
12. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act 1994 relied on in these proceedings are derived from an EU Directive. This is why this decision includes references to the trade mark case law of EU courts and the related EU legislation.

² The Applicant acted initially as a litigant in person, engaging legal representation only after the filing of his counterstatement.

EVIDENCE

The Opponent's evidence

13. None of the Opponent's earlier registered marks relied on in these proceedings had been registered for more than five years at the Relevant Date, so are not subject to the use provisions under section 6A of the Act. The Opponent is consequently entitled to rely on all of its registered goods and services identified at **(i) – (iv)** above, without having to show that the registrations have been used at all.
14. However, the Opponent filed evidence that is relevant not only to the grounds under sections 5(3) (reputation) and 5(4)(a) (goodwill etc), but also to the claim, pursued at the hearing,³ that the UK Swipe Registration enjoyed, at the Relevant Date, an enhanced distinctiveness in relation to “dating services including internet based social networking, introduction and dating services” (for the word SWIPE).
15. The Opponent's position on those three aspects relies on the evidence of **Evan Bonnstetter**, the Director of Strategic Partnerships and Communications of the Opponent and former Director of Communications, responsible for the Tinder mobile application. His evidence is given via two Affidavits: the First dated 21 August 2020; the Second dated 25th June 2021. Each involved thirteen exhibits. The two affidavits and sets of exhibits were to a great extent directly duplicative, with the Second filed merely to update matters during the course of the proceedings. I highlight below some points from the evidence and will refer to other aspects where warranted later in this decision.
16. The Opponent owns Tinder, which is an app that provides online dating and social introduction services. Tinder was launched in 2012 and is listed consistently in the top UK dating apps as demonstrated by articles from the BBC dated 12th February 2016 and The Independent dated 23rd July 2018.⁴ The Tinder app is downloaded via the Apple App Store and Google Play Store. The numbers of downloads of Tinder in the UK are presented at paragraph 27 of the Second Affidavit, and range between over 3.4 million in 2015 and over 2.4 million in 2019. Mr Bonnstetter refers to UK-specific revenue for Tinder, based on the analytics of App Annie, which is a global provider of mobile data. Those

3 See paragraph 45 of Ms Jones's Skeleton Argument
4 Annexure UKEB1

figures indicate UK revenue for Tinder in 2018 as over £32 million and nearer £35 million in 2019.

17. Mr Bonnstetter states that Tinder is famously characterised by a stack of cards containing profiles of potential matches nearby. To indicate an interest in the person shown, the user makes a gesture to the right (if using a mobile device). Mr Bonnstetter states: “we have coined this a “SWIPE RIGHT” selection. If the user is not interested in the potential match, they would use a left gesture to remove the possible match from the stack of cards. We have coined this a “SWIPE LEFT” selection. If two users both make a “SWIPE RIGHT” selection, then a match is made, and the users are then permitted to communicate with each other through the app.

The Applicant’s evidence

18. I have referred in the pleadings section of this decision to the annexed Exhibits A and B enclosed with the counterstatement to the Applicant’s Form TM8 Notice of Defence, which includes a statement of truth signed by Mr Dhanda and dated 16 January 2020. I am content to regard those annexed items as included within the evidence in these proceedings and note that they are filed to indicate that the word “SWIPE” is not associated exclusively with the Opponent in the field of dating apps. During the evidence rounds, the Applicant’s evidence comprised (i) a witness statement dated 4 March 2021 in the name of the Applicant, Mr Dhanda, with four exhibits and (ii) a witness statement from Suzan Ure, who is an attorney with the Applicant’s representatives.
19. Mr Dhanda’s Witness Statement emphasises the role of the ‘swipe’ action in touch screen technology. He also provides evidence of the launch of the Applicant’s LOVE AT FIRST SWIPE app a few months after the filing date of the contested trade mark (the Relevant Date), including some online coverage in The Sun and OK Magazine. He states that LOVE AT FIRST SWIPE has not been confused with other dating apps, nor has its press coverage drawn comparison with any other dating app.
20. Ms Ure gives evidence outlining the proceedings brought by Bumble at the EUIPO that I mentioned earlier, which cancelled the Opponent’s SWIPE registration based on their finding that it was descriptive for dating software and services. Ms Ure gives examples of SWIPE used as a standard verb to describe the action deployed to interact with

electronic devices like smart phones, including Steve Jobs using the term at the launch of the Apple iPhone (“I can just swipe through my photo library”).

DECISION

21. Ms Jones explained at the hearing that whereas in some proceedings there may commonly be a focus on a lead mark or ground, this not such a case, since each brings a different element to the bases of opposition. I note in that regard that the Opponent’s earlier marks have in common that they comprise or include the word SWIPE, but that they differ in the goods and services they are registered for, and that they vary in respect of which of the applied-for goods and services they are used to oppose.

The Section 5(2)(b) claim

22. Section 5(2)(b) of the Act, reads as follows:

“5. – [...]

(2) A trade mark shall not be registered if because – [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

23. Determination of a section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The principles are:

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

- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of the goods/services

24. Since the list of goods and services applied for is quite lengthy, while I do not lose sight of the full list of specified terms as I set out in the background section of this decision, I find it useful, only as an easy ready point of reference, to condense here, in general terms, the broad brush content of the goods and services specified across the seven classes of the application under the Applicant’s mark LOVE AT FIRST SWIPE.

Summary of Applicant’s contested goods and services	
Class 9:	various software goods eyewear
Class 14:	jewellery goods
Class 18:	Bags, luggage, wallets
Class 25:	Clothing; footwear; headgear
Class 35:	Advertising and promotional services, including fashion shows Business administration and business management Office functions Retail and wholesale services for goods including: software; cosmetics; homeware; vehicles; food and drink
Class 42	Providing temporary use of non-downloadable software for online introduction, dating and social networking services (and use of related software)
Class 45	Dating services and social introduction services

25. In considering the extent to which there may be similarity between the goods and services, I take account of the guidance from relevant case law. Thus, in *Canon* the Court of Justice of the European Union (“**the CJEU**”) stated that:

“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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".⁵

26. In *Boston Scientific*, the General Court described goods as "complementary" in circumstances where "... *there is a close connection between [the goods], 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*".⁶ I also take note that in *Kurt Hesse v OHIM*, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.⁷
27. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁸ for assessing similarity were:
- (a) The respective uses of the respective goods or services;
 - (b) The respective users of the respective goods or services;
 - (c) The physical nature of the goods or acts of service;
 - (d) The respective trade channels through which the goods or services reach the market;
 - (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
 - (f) The extent to which the respective goods or services are competitive.
28. I also bear in mind that terms used to specify services should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.⁹

5 Case C-39/97, at paragraph 23.

6 *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06 Case C-50/15 P

7 *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

8 See, for example, Lord Justice Arnold at paragraph 47 of *Sky v Skykick* [2020] EWHC 990 (Ch).

Comparison with the goods under the Opponent's EU Swipe Registration

29. The goods under the Opponent's EU Swipe Registration are **Class 25: Clothing; headwear; all being casualwear and not technical sportswear**. The EU Swipe Registration targets the Applicant's goods and services in Classes 9, 14, 18, 25 and 35.
30. I'll deal first with the applied-for Class 25 goods, since these present the most obvious points of similarity.
31. The Opponent's *Clothing .. being casualwear and not technical sportswear* is encompassed in the unqualified term "*clothing*" in the contested application. I find those goods **identical** on the basis of the principle expressed in *Meric*.
32. I consider applied-for *headgear* to refer to hats, helmets, and other items worn on the head. The applied-for term *headgear* is unqualified in the application, and is in my view broad enough to encompass the Opponent's *headwear .. being casualwear and not technical sportswear*, such that those goods may be considered **identical** on the basis of the principle expressed in *Meric*. At any rate I find them to be **at least similar to medium degree** on the basis of nature and method of use as part of a complete apparel.
33. The applied-for goods in Class 25 also include *footwear*. There is no equivalent term in the application, but I find there is **a medium degree of similarity** between *Clothing .. being casualwear and not technical sportswear*. This is on the basis that they overlap in purpose (being to cover the body for practical purposes) and may commonly overlap in producer, relevant public and distribution channels.

I turn now to the goods in Classes 9, 14, 18.

34. At least by the time of the hearing, the EU Swipe Registration was not invoked against all of the applied-for goods in Class 9 (notably the applied-for software goods were not addressed). Ms Jones argued that the following of the **Applicant's goods in Class 9** are all highly similar to the Opponent's Class 25 goods: "*Eyewear and parts and fittings therefor; spectacles; sunglasses; frames for spectacles and sunglasses; chains, straps and cords for sunglasses and spectacles; protective bags and cases for eyewear; cases for sunglasses and spectacles; covers and cases for mobile phones, computers and tablets.*" Ms Jones argued that those goods "are similar in nature in the sense of being something worn on the body and/or they are carried/used as an accessory which has a

'fashion impact' and/or they are complementary to such products e.g. cases for sunglasses and spectacles. They also often have the same manufacturers, distribution channels and/or will be sold in the same retail outlets." Ms Jones referred to retail chains such as Primark, H&M and Marks & Spencer.

35. There is no evidence filed in support of those submissions. At best I accept that some eyewear may be seen as a wearable fashion item and that some shops that sell clothing may also sell sunglasses, perhaps with a case, too. However, the Opponent's *Clothing; headwear; all being casualwear and not technical sportswear* are different in essential purpose, nature and method of use. There is no evidence to support the position that makers of eyewear also typically make clothing or headwear. The goods do not compete. I therefore find the following to be **similar to a very low degree** at best: *Eyewear and parts and fittings therefor; spectacles; sunglasses; frames for spectacles and sunglasses; chains, straps and cords for sunglasses and spectacles; protective bags and cases for eyewear; cases for sunglasses and spectacles.*
36. While *covers and cases for mobile phones, computers and tablets* may be made to look attractive and "fashionable", when I have regard to the relevant factors from case law that I have enumerated, those goods are in my view **not similar** to the clothing and headwear goods relied on by the Opponent.
37. Ms Jones argued on the same premises that the Opponent's Class 25 goods are highly similar to all of the **Applicant's goods in Class 14**, namely "*Jewellery costume jewellery; precious and semi-precious stones; rings; earrings; bracelets; brooches; necklaces; chains; jewellery charms; pendants; jewellery boxes; horological and chronometric instruments; clocks and watches; watch straps; watch boxes; key rings; key fobs; ornamental pins; badges of precious metals; parts and fittings for all of the aforesaid goods.*" There is no evidence in support of this position. At best I accept that jewellery may be worn to complement casual clothing or headwear and that some shops that sell clothing may also sell items of jewellery. However, the Opponent's *Clothing; headwear; all being casualwear and not technical sportswear* are different in purpose, nature and method of use. They do not compete. There is no evidence to support the position that makers of jewellery also typically make clothing or headwear. I therefore find the following to be **similar to a very low degree** at best: *Jewellery costume jewellery; rings; earrings;*

bracelets; brooches; necklaces; chains; jewellery charms; pendants; ornamental pins; badges of precious metals.

38. Having regard to the relevant factors from case law that I have enumerated, I find the remainder of the goods in Class 14 **not similar** to the clothing and headwear goods relied on by the Opponent. Those remaining goods are: *precious and semi-precious stones; jewellery boxes; horological and chronometric instruments; clocks and watches; watch straps; watch boxes; key rings; key fobs; parts and fittings for all of the aforesaid goods.*
39. Ms Jones argued on the same premises – i.e. complementarity of an accessory for fashion impact and shared manufacturers, distribution channels and/or retail outlets - that the Opponent’s Class 25 goods are highly similar to all of the **Applicant’s goods in Class 18**, namely “*Luggage and carrying bags; travelling bags and cases; suitcases; garment bags for travel; luggage label holders; luggage tags; luggage straps; leather straps; bags; bags of leather or imitation leather; bags of skin or hide; textile bags; canvas bags; cloth bags; knitted bags not of precious metals; mesh bags; towelling bags; handbags; shoulder bags; tote bags; shopping bags; satchels; back packs; holdalls; sports bags; shoe bags; toilet bags; wallets; purses; card wallets; credit card cases and holders; key cases; umbrellas; parts and fittings for all the aforesaid goods.*” There is no evidence filed in support of this position. It is possible that some bags (typically handbags) may be chosen to go with casual clothing and that some shops that sell clothing may also sell some types of bags, but in my view clothing and bags/luggage/wallets are different in nature, purpose and method of use. They are not in competition, nor is it clear to me that the goods are closely connected in the sense that one is indispensable or important for the use of the other. There is no evidence to support the position that makers of the applied-for Class 18 goods also typically make clothing or headwear. I find the applied-for Class 18 goods include many that are **not similar** - *luggage label holders; luggage tags; luggage straps; suitcases; toilet bags; key cases and umbrellas*. If some similarity may said to exist, on the basis, say, of trade channels and some wide notion of fashion accessorising, then I nonetheless find such similarity to be to essentially **low**; if *handbags tote bags* or *shoulder bags* were suggested to rank more strongly in similarity, still I should find them similar to less than a medium degree.
40. I turn now to consider the **applied-for services in Class 35**. In respect of some of the services under this Class, Ms Jones did not address any claim of similarity neither in her

skeleton argument nor at the hearing. Nor are there any submissions in the statement of grounds in support of the claimed similarity, for instance, in respect of: “*Advertising; business management; business administration; office functions; marketing; promotional services; organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes.*” When I have regard to the relevant factors from case law that I have enumerated, these latter services are in my view **not similar** to the clothing and headwear goods relied on by the Opponent.

41. Ms Jones argued that the applied-for “*Fashion show exhibitions for commercial purposes*” are similar to an average or high degree to the Opponent’s Class 25 goods on the basis that they could be provided by the manufacturer of the clothing, so have the same origins, and/or because they are complementary such that a consumer will perceive the same undertaking to be responsible for both the goods and the service. I note these points, but note too that fashion show services are different in nature, purpose and method of use from clothing and headwear goods. No evidence has been filed in support of the points submitted by Ms Jones, but I acknowledge a natural connection between fashion show exhibitions and clothing and therefore find those services to be **similar to a low degree**.
42. In respect of the applied-for “*Presentation of goods on communication media, for retail purposes*”, Ms Jones noted that the “goods” presented in this service could include precisely the goods specified in Class 25 under the EU Swipe Registration. Ms Jones argued that those services are similar to an average or high degree to the Opponent’s Class 25 goods on the basis that they could be provided by the manufacturer of the clothing, so have the same origins and/or because they are complementary such that a consumer will perceive the same undertaking to be responsible for both the goods and the service. Ms Jones submitted that the applied-for “*Presentation of goods on communication media, for retail purposes*” may be considered as essentially online selling. I shall align my findings on this applied-for service with the more expansively expressed services “*retail and wholesale services and online retail and wholesale services, all relating to ...*” the very long list of goods that I set out in the pleadings section of this decision.

43. As I understand it, the sale of goods is not a service within the meaning of the Nice Classification.¹⁰ Rather, the activity of retail in goods as a service for which protection of a trade mark is obtainable does not consist of the mere act of selling the goods, but in the services rendered around the actual sale of the goods, which are defined in the explanatory note to Class 35 of the Nice Classification by the terms ‘the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods’. The principles on retail services “apply to services rendered in connection with different forms exclusively consisting of activities around the actual sale of goods, such as retail store services, wholesale services, internet shopping, catalogue or mail order services, etc. (to the extent that these fall into Class 35).”¹¹
44. Ms Jones fully recognised at the hearing that the assessment of the level of similarity that may exist between the applied-for “*retail and wholesale services and online retail and wholesale services, all relating to ...*” the specified goods, required a fact-sensitive analysis. Nonetheless, Ms Jones argued that more or less as a rule of thumb (“a starter principle”), the degree of similarity between such services in relation to goods that are identical to the Opponent’s goods in Class 25 will be “average”, and that in relation to goods that are similar (which Ms Jones submitted included the goods in Classes 9, 14 and 18), the degree of similarity may be assessed as “low”. I note the following relevant case law that considers issues of similarity between goods and the retailing of goods.
45. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use from goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In *Oakley* the goods covered by the earlier mark, found to be complementary, were identical to those to which the applicant’s services related, but I also note the following points from that case:
- at paragraph 49, “the fact that the retail services are provided at the same sales points as the goods is a relevant criterion for the purposes of the examination of the similarity between the services and goods concerned”;

10 EUIPO Guidelines for Examination in the Office, Part C, Opposition
11 paragraph 7.3 of the EUIPO guidance

- at paragraph 50, “manufacturers of the goods in question often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold”.

46. In the MissBoo case¹², Geoffrey Hobbs Q.C. as the Appointed Person commented that “the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.” Mr Hobbs reviewed the law concerning goods as against retail services and, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹³ and *Assembled Investments (Proprietary) Ltd v. OHIM*¹⁴, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*¹⁵, his conclusions included that:

- i) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- ii) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- iii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).¹⁶

I note the following further extracts from Mr Hobbs’ appeal decision in MissBoo:

“3. Both as between marks and as between goods and services, the evaluation of ‘*similarity*’ is a means to an end. It serves as a way of enabling the decision taker to

12 *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14; see paragraph 9 of that ruling.
 13 Case C-411/13P
 14 Case T-105/05, at paragraphs [30] to [35] of the judgment
 15 Case C-398/07P
 16 See paragraph 24 of MissBoo decision

gauge whether there is '*similarity*' of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer (who is taken to be reasonably well-informed and reasonably observant and circumspect) would have attached to them at the relevant point in time.

4. [...] The relatedness or otherwise of the trading activities involved in the comparison is ultimately a matter of consumer perception.

[...]

25. [...] In evaluating whether and, if so, to what degree retail services across the spectrum covered by the Listed Services were '*similar*' to '*handbags*' in Class 18 and '*shoes for women*' in Class 25, it was necessary, in keeping with the principle of proportionality, to consider the greater or lesser likelihood that a single economic undertaking would naturally be regarded as responsible for providing not only goods of that kind, but also retail services of the kind in question. The degree to which retail services within the spectrum were found on evaluation to be '*similar*' to such goods would be a co-variable with the degree of '*similarity*' between the signs in the overall assessment of the existence or otherwise of a likelihood of confusion."
47. It seems clear, therefore, that as part of the overall assessment of '*similarity*' it is necessary to consider whether there is '*complementarity*' between the goods and services in issue – i.e. whether the goods and services in issue are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or providing those services. I also bear in mind the principle of proportionality. Taking into account the principles from case law, and comparing the Class 25 goods under the EU Swipe Registration – i.e. *Clothing; headwear; all being casualwear and not technical sportswear* - I find that there is little in the long list of goods specified in relation to the applied-for retail and wholesale services in Class 35 that would incline me to find any similarity for the purposes of a section 5(2)(b) claim. However, I find there may be considered to be **a medium degree of similarity** between the

Opponent's Class 25 goods and the applied-for *retail and wholesale services and online retail and wholesale services, all relating to ... clothing, [...], headgear, clothing accessories ...*". This represents the highest points of similarity between the respective goods and services. I allow too that there may be a **low degree of similarity** in relation to the applied-for retail and wholesale services relating to *footwear*. The same findings apply in respect of *Presentation of goods on communication media, for retail purposes*.

48. However, although I have earlier found degrees of similarity between the Opponent's Class 25 goods and some of the applied-for goods in Classes 9, 14 and 18 (such as *sunglasses*, and *jewellery*), those degrees of similarity are so low that I find they give rise to no similarity in relation to the Class 35 services. Plainly, the majority of the other goods specified in relation to the Class 35 services – including, for instance, the homeware-type goods (mattress cushions etc) and the foods (fresh fish etc) – give rise no similarity whatever with the Opponent's Class 25 goods.

Comparison with the services under the Opponent's UK Swipe Registration

49. Under its UK Swipe Registration the Opponent relies on services in **Class 45: *Dating services; internet based social networking, introduction and dating services***, to oppose the Applicant's goods and services in Classes 9, 42 and 45.
50. I'll deal first with the applied-for Class 45 services, since these present the most obvious points of similarity. I find the Opponent's Class 45 services to be **identical** to the following applied-for services: *Dating services; computer dating services; dating agency services; dating and social introduction services provided via online personal advertisements. Online social networking services; online dating services*. I find the following applied-for services to be **highly similar**: *information in relation to dating, personal relationships and social introduction provided via an online website and computer networks* – based on a strong degree of complementarity, shared users, and channels of trade.
51. Turning next to the contested Class 9 goods; Ms Jones clarified that under this earlier mark she advanced no case for similarity in respect of the eyewear elements, and I duly find **no similarity** to arise (on the basis of Class 45 services) in relation to *Eyewear and parts and fittings therefor; spectacles; sunglasses; frames for spectacles and sunglasses; chains, straps and cords for sunglasses and spectacles; protective bags and cases for*

eyewear; cases for sunglasses and spectacles; covers and cases for mobile phones, computers and tablets.

52. Ms Jones argued similarity between the Opponent's Class 45 services and the applied-for software goods in Class 9. Ms Jones highlighted in particular "*downloadable computer and mobile phone software for online introduction, dating and social network services*". Clearly the Opponent's Class 45 services *introduction, dating and social network services* encompass those provided online. Ms Jones argued that the nature of those Class 45 services is such that the app, the software and the service itself are likely to be seen by the end user, who is the same in each case, as coming from the same undertaking. Ms Jones also submitted that there is also a very high complementarity between these goods and services as they are, in fact, indispensable to the services. I accept those lines of argument and I find that there is a **high degree of similarity** between the Opponent's Class 45 services and the applied-for Class 9 goods *downloadable computer and mobile phone software for online introduction, dating and social network services*.

53. Ms Jones argued that all of the software specified in the applied-for Class 9 either will be used as part of the class 45 services or, alternatively, is extremely similar to those services. Those further specified services are:

Downloadable computer and mobile phone software for use in posting, transmitting, retrieving, accessing, receiving, reviewing, organizing, searching and managing text, audio, data, visual and multimedia data, information and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks; downloadable computer and mobile phone software for online introduction, dating and social networking services; software for use in soliciting feedback; downloadable computer and mobile phone software that enables users to send status updates and to share content and electronic files with others; computer software for calculating, mapping, transmitting and reporting information relating to the location, movement, proximity, departure and arrival of individuals and objects via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks.; computer software; application software; audio and/or video recordings; publications in electronic format; downloadable electronic publications.

54. Some of those terms may not at once suggest an obvious connection to a conventional conception of dating services, but I understand that in the context of dating and social

networking apps prevalent these days, all of the elements do in fact have a role in facilitating the bringing together of people interested in meeting one another (for example, those elements concerned with information about departure and arrival of individuals). I am therefore content to find all of those goods also similar to the Opponent's Class 45 services, to **degrees between medium and high**.

55. Turning to the contested Class 42 services:

Providing temporary use of nondownloadable software for use in posting, transmitting, retrieving, accessing, receiving, reviewing, sharing, organizing, searching and managing text, audio, data, visual and multimedia data, information and content;

providing temporary use of nondownloadable software for online introduction, dating and social networking services;

providing temporary use of nondownloadable software for use in soliciting feedback;

providing temporary use of nondownloadable software that enables users to send status updates and to share content and electronic files with others;

providing temporary use of nondownloadable software for calculating, mapping, transmitting and reporting information relating to the location, movement, proximity, departure and arrival of individuals and objects via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks.

56. Ms Jones characterised these services as broadly a form of providing use of software. Ms Jones highlighted in particular "*providing temporary use of non-downloadable software for online introduction, dating and social networking services*", which she submitted may be considered as simply another way of describing the provision of the Opponent's online dating services in Class 45, such that they may be considered identical or at least highly similar services. I agree that those highlighted Class 42 services are integral to the Opponent's Class 45 services such that they are **at least highly similar**; indeed I also accept that the remainder of the applied-for services in Class 42 may be so complementary to the Opponent's Class 45 services (which are commonly provided in the form of an app) that they may all be considered **similar to a degree between medium and high**.

Comparison with the goods and services under the Opponent's ASCCYL Registration

57. The goods and services under the mark ANY SWIPE CAN CHANGE YOUR LIFE are in Classes 9, 25 and 45, and are invoked to oppose all of the applied-for goods and services – i.e. those in Classes 9, 14, 18, 25, 35, 42 and 45.
58. I have above, considered the similarity of the contested goods and services with the EU and UK SWIPE Registrations, which, on the bases of their specifications in Classes 25 and 45 respectively, have, between them, also been relied on against all of the applied-for goods and services. I'll begin the comparison under the ASCCYL Registration in light of those relevant earlier findings.
59. The Class 25 goods of the ASCCYL Registration – clothing; footwear; headwear - differ slightly from the specification under the EU SWIPE Registration, and I find that all the goods in this class are **identical** to the applied-for *clothing; footwear; headgear*. As regards the applied-for goods in Classes 9, 14, 18 and the applied-for services in Class 35, my earlier findings based on the Opponent's Class 25 goods read across as follows:
- the Opponent's Class 25 goods are at best similar to a **very low degree** to the sunglasses-related elements within the applied-for Class 9 goods. (The ASCCYL mark has its own Class 9 goods that I compare below.)
 - the Opponent's Class 25 goods are similar to a **very low degree** to the following (only) of the applied-for Class 14 goods: *Jewellery costume jewellery; rings; earrings; bracelets; brooches; necklaces; chains; jewellery charms; pendants; ornamental pins; badges of precious metals*.
 - the Opponent's Class 25 goods are similar to some of the applied-for Class 18 goods but only to a **lower than medium degree** at best, and are **not similar** to some of the applied-for Class 18 goods such as *toilet bags; key cases and umbrellas*.
 - the Opponent's Class 25 clothing goods are similar to a **low degree** to the applied-for *fashion show exhibitions for commercial purposes* in Class 35 and to a **medium** degree to the applied-for *retail and wholesale services and online retail and wholesale services, all relating to ... clothing, footwear headgear, clothing accessories*.
60. The Class 45 services of the ASCCYL Registration exactly mirror the Class 45 services of the UK SWIPE Registration and my earlier findings accordingly read across as follows:

- some of the applied-for Class 45 services are **identical** and some are **highly similar** to the Opponent's Class 45 services;
- some of the applied-for Class 42 services are **identical** and some are at least **highly similar** to the Opponent's Class 45 services.
- the applied-for Class 9 goods include software elements that are similar to the Opponent's Class 45 services to degrees **between medium and high** (but there is **no similarity** between the eyewear elements of applied-for Class 9 goods and the Opponent's Class 45 services).

61. The ASCCYL Registration additionally specifies the following goods in **Class 9**: *Computer application software for mobile devices, namely, software for social introduction and dating services*. These earlier Class 9 goods are **identical**, whether on a plain reading, or based on the principle from Meric - to the applied-for downloadable computer and mobile phone software for online introduction, dating and social networking services; computer software; application software.

62. Based on the nature of the goods, the end user and a great degree of complementarity, I also find the Opponent's Class 9 goods **at least highly similar** to the other software goods applied for in Class 9, namely: *computer and mobile phone software for use in posting, transmitting, retrieving, accessing, receiving, reviewing, organizing, searching and managing text, audio, data, visual and multimedia data, information and content via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks; software for use in soliciting feedback; downloadable computer and mobile phone software that enables users to send status updates and to share content and electronic files with others; computer software for calculating, mapping, transmitting and reporting information relating to the location, movement, proximity, departure and arrival of individuals and objects via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks*. Comparable considerations lead to me to find that the applied-for Class 9 goods: *audio and/or video recordings; publications in electronic format; downloadable electronic publications* are, at least similar to a **degree between medium and high**, since they may commonly and centrally feature in dating software applications.

Comparison with the goods and services under the Opponent's SWIPE SESSIONS Registration

63. The SWIPE SESSIONS Registration is registered for the following services:

Class 35: *Promotion of concerts*

Class 41: *Entertainment services; concert services; organisation of concerts; production, distribution and exhibition of video and audio content; entertainment services in the nature of audio and video programs provided through the Internet, streaming video-on demand, and other forms of transmission media.*

Class 45: *Dating services; Internet dating services; internet-based social networking, social introduction and dating services; online social networking between pre-selected groups of users; personal introduction services; information, advice and consultation relating to the aforesaid services.*

64. These services under the SWIPE SESSIONS Registration are relied on to oppose the applied-for goods and services in Classes 9, 42 and 45. The Opponent's Class 45 services are here worded a little differently from those under the ASCCYL Registration, but I find they are substantially the same, and as such my earlier findings again read across – i.e. that the Opponent's Class 45 services are identical / highly similar to the applied-for Class 45 and Class 42 services, and similar to the software elements of the applied-for Class 9 goods to degrees between medium and high.

65. Ms Jones made no argument as to any similarity based on the Opponent's Class 41 services. In my view, confining the Opponent's Class 41 services to their core meanings, **I do not find them to be similar** to the applied-for goods and services in Classes 9, 42 and 45 – dating services and the surrounding software that facilitates such social introductions are not properly regarded as “entertainment”.¹⁷ Likewise, Ms Jones made no argument as to any similarity based on the Opponent's Class 35 services, and in my view, the services of promotion of concerts are **not similar** to applied-for goods and services in Classes 9, 42 and 45.

66. I have noted, in the pleadings section of this decision, the claimed similarity premised on “*standard merchandise products*”. This was not a line argued by Ms Jones at the hearing

¹⁷ An article in The Independent at UKEB1 suggested that some consumers do use dating apps for fun and entertainment. If I am wrong to find no similarity with entertainment services, then I would still consider any similarity to remain at a low level bearing in mind the core purpose of the services and the differences between goods and services.

and nor do I consider it a basis for similarity, and at any rate not one that improves any of my findings on similarity in this case.

The average consumer and the purchasing process

67. It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.¹⁸ (A lower level of attention may tend to increase a likelihood of confusion, whereas an elevated degree of attention may tend to reduce a likelihood of confusion.) In *Hearst Holdings Inc*,¹⁹ Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect ... the 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... [it] does not denote some form of numerical mean, mode or median.”

68. The Opponent's position is that the average consumer in this case is the general public who will pay a “normal” level of attention when purchasing the relevant goods/services. The parties' goods and services at issue range across Classes 9, 14, 18, 25, 35, 41, 42 and 45; some of those goods/services such as the wholesale services will be relevant to a business public who will typically pay a greater degree of attention, but I agree that by and large the average consumer in this case is a member of the general public.
69. The Applicant's position is that all of the applied-for goods and services would be bought with “no less than average” attention. The parties appear in agreement to that extent, and **I find the level of attention for the goods and services at issue will be at least medium.**
70. However, the Applicant argued that for dating services and apps relating to dating services the consumer would apply a high degree of attention to the trade marks in view

18 *Lloyd Schuhfabrik Meyer*, Case C-342/97

19 *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

of the nature of those services, including issues of personal safety and that a dating app or service is a particularly personal service to a consumer.²⁰ The Opponent disagreed, referring to the evidence of the article in The Independent at UKEB1 that “being on dating apps is incredibly commonplace, and that for some people being on them is merely for a bit of fun and entertainment”. Ms Jones also highlighted that most dating apps are free, and that there is absolutely no commitment when using these services, such that one could sign up and delete it all within five minutes. Ms Jones also argued that the services are not particularly personal in the sense that they are not a tailor-made service and that in terms of personal safety the services are no different from any form of social media. While I note the Opponent’s arguments, I nonetheless consider that there is some substance to points from the Applicant and **I find that the dating services and related software will be chosen with a degree of care that is above medium.**

71. The Opponent argued that some of the relevant goods/services will be purchased online and therefore the purchasing act will be visual, but that aural considerations remain important based on word of mouth recommendations. I agree. I also note Ms Jones’s reminder as to the role of any conceptual similarity.

Distinctive character of the earlier marks

72. The distinctive character of an earlier mark must be considered. The more distinctive an earlier mark, either by inherent nature or by use, the greater the potential for a likelihood of confusion (*Sabel*) – although it must be borne in mind that it is the distinctiveness of the common element that is often key. In *Lloyd Schuhfabrik*²¹ 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 ...

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

²⁰ Paragraph 8(e) of the Applicant’s skeleton argument
²¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

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).”

73. In the present case, the issue of the distinctiveness of the word SWIPE, present in all the signs at issue, is of particular importance; it bears not only on this section 5(2)(b) ground, but also touches on the section 5(3) claim and on a consideration of goodwill under section 5(4)(a).
74. There is no doubt that the term SWIPE is entirely commonplace in the functionality of mobile phones (Exhibit SU3) and apps (Exhibit SU5 refers to Twitter, Snapchat and The Guardian, and Exhibits SU6 and SU7 show the iPhone includes various references to swipe left and swipe right to activate tasks). Ms Ure contends in her witness statement that in that context the public would not view such terms as trade marks or at the least would view them as having very low distinctive character in relation to any goods and services which can be provided via devices such as mobile telephones and software applications. I treat that position with some caution, since it is well established case law that the distinctive character of a trade mark can be appraised only, first, by reference to the goods/services on which the party is able to rely and, secondly, by reference to the way it is perceived by the relevant public.²² The goods and services under the earlier marks are:

SWIPE
Class 25 (EU Registration): Clothing; headwear; all being casualwear and not technical sportswear.
Class 45 (UK Registration): Dating services; internet based social networking, introduction and dating services
ANY SWIPE CAN CHANGE YOUR LIFE

²² *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91

Class 9: Computer application software for mobile devices, namely, software for social introduction and dating services;

Class 25: Clothing; footwear; headwear.

Class 45: Dating services; internet based social networking, introduction and dating services

SWIPE SESSIONS

Class 35: Promotion of concerts.

Class 41: Entertainment services; concert services; organisation of concerts; production, distribution and exhibition of video and audio content; entertainment services in the nature of audio and video programs provided through the Internet, streaming video-on-demand, and other forms of transmission media.

Class 45: Dating services; internet dating services; internet-based social networking, social introduction and dating services; online social networking between pre-selected groups of users; personal introduction services; information, advice and consultation relating to the aforesaid services

Inherent distinctiveness

75. For dating services and their related software applications - **the goods and services in Classes 9 and 45** – I agree with the Applicant that **the word SWIPE is of very low distinctiveness**. The exhortation to swipe is an instruction as to how to interact with the software and to make a dating choice. It is by two users swiping compatibly that the social introduction is made. Mr Bonnstetter states that he has seen many alternatives used by other dating service providers to show a like or dislike of a possible match, including yes / no, tick / cross.²³ Mr Bonnstetter also states that dating apps and online dating services are not exclusively accessed via mobile devices and desktop access is still the preferred method for some users. Neither of either points materially affects my conclusion on how the average consumer will perceive the word SWIPE in the earlier marks; the descriptive aspect remains, notwithstanding that there are other ways to action a selection.²⁴ There is nothing in the evidence to show how a consumer makes selection via a desktop – or how it is invited to do so, and in any event, the evidence strongly indicates that the

²³ **Annexure UKEB3 shows** examples of alternative selection means.

²⁴ There is perhaps a degree of analogy here to the point at paragraph 39 of the CJEU ruling in *Agencja Wydawnicza Technopol sp. z o.o.* (C-51/10 P) [2011] E.T.M.R. 3439, concerning objections to the registration of descriptive trade marks, where it is irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration.

Opponent's goods and services are primarily accessed by mobile phone or similar interface.²⁵

76. I would also consider SWIPE to be have a lower than medium degree of distinctiveness for the services in Class 41, as those might rely on an online interface, but since I have found no similarity between the Opponent's services in Class 41, nor its concert promotion services in Class 35, and any of the contested goods and services of the Applicant, it is unnecessary for me to make findings as to the distinctiveness of the earlier marks in relation to the services in those two classes.
77. In respect of **the registered goods in Class 25** - essentially clothing and headwear – I do not consider the distinctiveness of the word SWIPE diminished by the characteristics of those goods; the mark will be used, for instance, to label the goods themselves and there is no obvious connection between the word SWIPE solus and clothing or headwear. While the word is an ordinary English word, I consider it to have **at least a medium degree of distinctiveness on an inherent basis** in respect of those goods.
78. Two of the marks of course have additional words, but I do not consider the impact of those extra elements especially significant. The ASCCYL reads more or less as a plain narrative message about the potential consequences of acting on the word SWIPE, which does not materially increase the distinctiveness of the mark for any of the goods or services in Classes 9, 25 or 45. Likewise, the additional word SESSIONS does not materially increase the distinctiveness of that mark for the services in Class 45, since it simply implies a period of time dedicated to engagement with those services.

Enhanced distinctiveness:

79. Ms Jones argued that the mark 'SWIPE' solus mark enjoys an enhanced distinctiveness for Class 45 services, for reasons she states to be based on the same evidence relied on for its claimed reputation under section 5(3).
80. Ms Jones referred me to the judgment of the court in an appeal from the Registrar in *Yellow Bulldog*,²⁶ and the principles that free-standing evidence should be part of the primary facts of the case to be considered, unless contradicted by the exhibits; that in the

²⁵ The various references in particular to App Annie, google and app stores
²⁶ *Yellow Bulldog Ltd v. AP and Co Ltd* [2021] E.C.C., paras 40 and 41

absence of cross-examination, witness statements and exhibits should be taken for what they are; and that the evidence must be looked at collectively, to take a measured approach.

81. Ms Jones also referred me to the findings in *Purina One*,²⁷ where the General Court stated: "it is true that the proprietor of a registered mark may, in order to establish the reputation of that mark, rely on evidence of its reputation under a different form, in particular under the form of another registered mark, provided that the relevant public continues to perceive the goods at issue as originating from the same undertaking" and that "in order to determine whether that is the case, it should be ascertained that the components which differentiate the two marks do not prevent the relevant public from continuing to perceive the goods at issue as originating from a particular undertaking".
82. Ms Jones argued that the Tinder business uses more than one mark, referring me to references in the evidence to 'SWIPE SESSIONS', 'ANY SWIPE CAN CHANGE YOUR LIFE', 'SWIPE RIGHT', 'SWIPE NIGHTS' and 'SWIPE LIFE', and submitted that I may take all of these uses into account when considering whether 'SWIPE' solus has a reputation.
83. Mr Bonnstetter states that "'SWIPE' and 'SWIPE RIGHT' will be visible to the users of the app" and that "Every time the app is downloaded there will be an opportunity to see the SWIPE and SWIPE RIGHT branding whether on its own or in combination with other matter." I do not consider that evidence to be expressed in strong terms and I must consider what will users make of the word SWIPE, encountering it in the context of the Tinder app.
84. The Applicant's skeleton argument emphasised that the opposition has not been based on any registrations for SWIPE RIGHT or SWIPE LEFT, and that the evidence of use in respect of the terms such as SWIPE SESSIONS and ANY SWIPE CAN CHANGE YOUR LIFE is limited. For instance, Annexure UKEB7 shows a single example of use of the ASCCYL slogan in a marketing campaign from April 2015 on gotinder.com. The Applicant argues that there are relatively limited references to SWIPE and none particularly

27 *Amigüitos Pets & Lifeveujo - Société Des Produits Nestlé*, Case T-40/19 (at paragraph 108). While I note the point is made in terms of "reputation", my reading of the case is that it carries across to enhanced distinctiveness.

establishing it as a trade mark, such that it would not be seen as a standalone badge of trade origin.

85. I of course recognise that a trade mark may be used in conjunction with another trade mark, but I am not satisfied that the evidence has shown trade mark use of the word SWIPE solus. This position is not changed by it appearing within the usages I have mentioned (SWIPE SESSIONS, SWIPE LIFE etc). There is little clear information on reach or duration of the use of swipe phrases, and I find the phrases change the distinctive character of the word alone, and that it does not retain independent distinctive character when coupled with another word that then forms a logical unit.²⁸
86. It seems to me that the word is so entwined with the functional directions in the matching process, that to establish the trade mark exclusive designation for the word alone presents a very substantial challenge. In my view the evidence is insufficient to connect SWIPE to the source of the goods or services to the Opponent distinctively. The brand is beyond doubt Tinder – that is the badge of origin for the goods and services.
87. Against this, Mr Bonnstetter states that he has seen the Opponent’s use of “SWIPE” and “SWIPE RIGHT” recognised as designating the online dating services of Tinder, through entry in independent reference material, namely Lexico (the online dictionary powered by Oxford English Dictionary). He is referring there to the evidence at Annexure UKEB4, which shows the following:

2.1 Move (one's finger) across a touchscreen in order to activate a function.

'simply swipe a finger across the phone's display screen to switch to another program'

+ More example sentences

This reflects the understanding I have ascribed previously in this decision, and informs my assessment of the inherent low distinctiveness of the word in the context of the dating app. Thus, appearances in the evidence of phrases such as “EAT SLEEP SWIPE REPEAT” and “Swipe. Match. Chat.” will be understood in the line of instructions or encouragement to engage with the software and their underpinning services. The same exhibit continues:

28 See CJEU in *Bimbo* at paragraphs 16 and 37.

Phrases

swipe left

(on the online dating app Tinder) indicate that one finds someone unattractive by moving one's finger to the left across an image of them on a touchscreen.

'if they have a creepy bio or not a great picture then I usually swipe left'

+ More example sentences

swipe right

(on the online dating app Tinder) indicate that one finds someone attractive by moving one's finger to the right across an image of them on a touchscreen.

'I swiped right, but sadly for me, she swiped left'

+ More example sentences

88. I note firstly that those phrases are two-word phrases, neither of which phrase is one of the earlier registered marks relied on, and secondly that the phrases use the word “swipe” in a descriptive manner. Moreover, it is not clear that the references in the above definitions to the online dating app Tinder, are intended as designating the services *only* of that app; the references may be only for the purpose of example. Not only is the word swipe shown to be prevalent (in general) to describe a movement to interact with a touchscreen, but there is some evidence of its use in connection with other dating services applications. The Applicant’s **Exhibit A**, which I mentioned earlier, shows reference to “Ellie: Meet Disabled Singles” which uses the words (descriptively) in its slogan “Swipe. Match. Chat.” And reference to “JSwipe - #1 Jewish Dating App”, where “JSwipe” is used as a trade mark. **Exhibit B** (again mentioned earlier) is said to show app search results using the terms “SWIPE DATE” and “SWIPE DATING”, revealing the offer of an app called Zoosk and another called OK Cupid. I acknowledge of course that these exhibits are undated, and give no information about the extent of use, but the Opponent has filed no evidence to show that the content is not from a relevant time, and the exhibits at least indicate use of the word “swipe” by third parties offering similar goods and services and where it features within trade mark use (JSwipe).
89. The Opponent states that it has used SWIPE and SWIPE RIGHT for a significant period of time in relation to the provision of dating and social introduction services. Mr Bonnstetter assesses the Applicant’s main argument, (by reference to the Applicant’s evidence statements) to be that “swipe” will not “be viewed as a trade mark as it would be seen as a function of a mobile phone or computer software application”. As against

that view, Mr Bonnstetter states that “that is not what I have seen from within the online dating industry” and he asserts that SWIPE and SWIPE RIGHT are synonymous with the Opponent. In support of his viewpoint, Mr Bonnstetter refers to data from GoogleTrends on the use of those terms by the 13 top UK dating apps. The Opponent states that it shows active promotion of use of SWIPE since July 2013. Although I note the Annexures UKEB11 and UKEB12 which showed graph results for search terms including Tinder swipe, Tinder swipe right and Bumble swipe, I did not find this evidence entirely clear (either in methodology or print quality or significance). Nonetheless, I note the Opponent’s statement that aside from the Opponent one other of the top ranking UK dating apps – Bumble – used the terms – and its appears from the table at paragraph 25 of the First Affidavit that Bumble had used the term to a greater extent than the Opponent. The Second Affidavit shows lower figures for Bumble (reflecting a slightly different, though largely overlapping period). Paragraph 26 of the Second Affidavit refers to “reasons which are confidential” that account for Bumble's use of the term SWIPE during that period and that an agreement exists between the parties. The Applicant’s skeleton argument notes that no details are given of what those provisions are, that it was Bumble who invalidated the SWIPE EUTM No. 014900310, and that the central question remains how the public see the term SWIPE.

90. In light of my deliberations above, my finding is that the evidence fails to establish the claim that the mark 'SWIPE' solus mark enjoys an enhanced distinctiveness for Class 45 services.

Comparison of the marks

Contested mark	Earlier Marks
LOVE AT FIRST SWIPE	SWIPE ANY SWIPE CAN CHANGE YOUR LIFE SWIPE SESSIONS

91. Ms Jones offered guidance as to what aspects of distinctiveness are to be considered and when. Her skeleton argument referred to the EUIPO Guidelines, from which Ms Jones concluded that (i) when comparing similarity of marks, the only distinctiveness that

a decision-taker should consider is the distinctiveness of each element within a composite mark to ascertain what is the dominant or distinctive component and (ii) the distinctiveness of an earlier mark per se, (inherent or enhanced) is to be considered only at the point of assessing the likelihood of confusion.

92. The position emphasised by Ms Jones is not at odds with the well-known statement by the CJEU stated in *Bimbo* that: “.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”²⁹ Similarly, it settled case law that it would be wrong to dissect the trade marks artificially, but it is necessary to take into account their distinctive and dominant components and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks.
93. I also note that in *Bimbo*, the CJEU found, at paragraph 37, the expressions ‘unitary whole’ and ‘logical unit’ (used by the General Court), to correspond to the expression used previously by the CJEU in the context of a component forming “a unit having a different meaning” as compared with the meaning of those components taken separately.
94. In respect of the earlier mark SWIPE (on its own), clearly that word alone gives the total of the overall impression of the mark and is dominant and distinctive. However, in my view, for each of the three other marks at issue, the two, four and six words of which they are comprised all contribute significantly to their overall impressions, forming a unit in each instance.
95. I will first consider the position as between the 'SWIPE' solus mark and the contested mark. Ms Jones argued that although the words LOVE AT FIRST within the Applicant's mark are additional words that the consumer will hear and see, they do not have that great an impact either visually or aurally, because the mark is dominated by the word SWIPE. It was common ground between the parties that the Applicant's mark is a play on the phrase 'love at first sight' and Ms Jones submitted that it is the word SWIPE that

²⁹ *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

gives the mark its distinctiveness and that “SWIPE” is also more distinctive generally as a word than the other words which appear within that mark. Ms Jones argued that, consequently, the eyes will be drawn to the word and, that aurally, the emphasis will be placed on it.

96. On behalf of the Applicant, it was emphasised that the contested mark will clearly be pronounced as four separate words, and that the overlap is limited to just one of those four words, and that since that shared word is at the end of the mark, the aural differences are all the more clear.
97. In my view, it may be fair to ascribe to the word swipe within the contested mark – and indeed in the other two earlier marks – a degree of dominance in the overall impression. But since the average consumer normally perceives a mark as a whole, and does not proceed to analyse its various details, the presence of an additional three words, totalling an additional eleven letters at the beginning of the mark, has a significant visual impact and I consider the marks to be **visually similar to a low degree**. In my view, the **aural similarity** may be considered slightly higher – to a degree falling between **low and medium** – because the word will be heard as an unexpected turn of the phrase “love at first sight”, with which the average consumer will be familiar and the changed word (“sight” to “swipe”) will be more striking to the ear.
98. The issue of conceptual similarity is perhaps more complicated since there is an extent to which the conceptual implications will vary according to the underlying goods or services. The word swipe has meanings other than that given in evidence as set out at my paragraph 87 above. It may, for instance, commonly be understood to signify (i) a swinging blow (ii) the passing of a card through an electronic device designed to read and process the information encoded on it, and (iii) informally, to steal. There is also (iv) the earlier referenced meaning of moving (one's finger) across a touchscreen in order to activate a function. I find, on the one hand, that there is a clear conceptual difference between the word swipe on its own and the elaborated expression “love at first swipe”, which brings in the concept of love and its prompt attainment. This difference exists whatever concept is attached to the word on its own. On the other hand, where goods or services are commonly accessed by moving one's finger across a touchscreen, and all the more where services are dating services (one object of which may be love), the distance between the concepts is perhaps reduced.

99. I note another point made by Ms Jones in the context of conceptual similarity. Whereas one meaning of SWIPE is a touch-screen gesture, Ms Jones submitted that in relation to dating services and software used for those services, it is as a result of the Opponent's use of the word 'SWIPE' on the dating app Tinder, that the word has acquired another, further meaning. In that regard, Ms Jones submitted that the Opponent has "coined" the meaning of 'swipe' in the online-dating industry, essentially as an indication of whether one likes someone or not. I have previously highlighted Mr Bonnstetter's statement that the Opponent "coined" a "SWIPE RIGHT" selection" to indicate interest in a potential dating partner, and that the Opponent "coined" a "SWIPE LEFT selection" to indicate the opposite. **Annexure UKEB4a** shows the front cover of Cosmopolitan magazine dated May 2018 which includes "SWIPE RIGHT! The most fancied people on Tinder", where the article within profiles "The most fancied people on Tinder". I have also noted the Applicant refers to the Opponent having registered marks with a recognised reputation "SWIPE LEFT" "and "SWIPE RIGHT". I do not know whether the Opponent does have such registered trade marks, but clearly neither of those marks is relied on for the section 5(2)(b) claim. In my view, those phrases sound like instructions and less a coinage as such more a use of a pre-existing English words in line with their standard meaning. I have already commented on the low distinctiveness of word SWIPE (solus) in the context of dating services and software, so if Tinder has an association with the phrase SWIPE RIGHT or the phrase SWIPE LEFT, I do not see that it would materially affect the conceptual similarity between SWIPE (alone) and the contested mark. The upshot of my consideration of the conceptual similarity is that there is **some conceptual overlap, but also some conceptual difference**, the significance of which will be greater in respect of some goods and services.

100. Turning to the other two earlier marks, ANY SWIPE CAN CHANGE YOUR LIFE and SWIPE SESSIONS. The marks have only one word in common with the LOVE AT FIRST SWIPE trade mark, are structured in different ways, such that the shared word appears in different positions, they have different numbers of words, different numbers of syllables and combine additional words (not shared). Even allowing a degree of dominance to the shared word, I find **those marks visually and aurally similar to a low degree** (at best).

101. SWIPE SESSIONS implies periods of time focused on swiping, and as such I find the mark has **little conceptual similarity** to LOVE AT FIRST SWIPE, since each conveys a different message, albeit that they share the swipe element. As to the conceptual similarity between ANY SWIPE CAN CHANGE YOUR LIFE and LOVE AT FIRST SWIPE, Ms Jones argued that 'LOVE' and 'LIFE' are closely-related concepts, and each slogan is suggesting that they are each affected by a SWIPE. Ms Jones elaborated on this point, including to argue that some say that love is the meaning of life. Mr Curtis's argument was that ANY SWIPE CAN CHANGE YOUR LIFE and LOVE AT FIRST SWIPE have different literal meanings and different conceptual ideas and that the marks would anyway not be confused. I recognise that each is a phrase alluding to the life-changing impact of a swipe, but the ASCCYL mark is not only semantically different, but lacks the conceptual resonance of the play on the familiar phrase 'love at first sight'. In my view, the **conceptual similarity** may be considered no higher than a degree falling between **low and medium**.

Conclusion as to likelihood of confusion

102. In view of my analysis and findings in the foregoing sections above, I must reach a conclusion as to a likelihood of confusion as between "LOVE AT FIRST SWIPE" in respect of the applied-for goods and services. For ease of digestion, I repeat the broad-brush summary of those goods and services here:

Summary of Applicant's contested goods and services	
Class 9:	various software goods eyewear
Class 14:	jewellery goods
Class 18:	Bags, luggage, wallets
Class 25:	Clothing; footwear; headgear
Class 35:	Advertising and promotional services, including fashion shows Business administration and business management Office functions Retail and wholesale services for goods including: software; cosmetics; homeware; vehicles; food and drink

Class 42	Providing temporary use of non-downloadable software for online introduction, dating and social networking services (and use of related software)
Class 45	Dating services and social introduction services

103. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.
104. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public;³⁰ occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is not laid down by law, but is a matter of judgment for the tribunal on the particular facts of each case.³¹ The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person; it involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade and, it is often very difficult to make such prediction with confidence.³²
105. Determining whether a likelihood of confusion exists is not an arithmetical or scientific process; it is a matter of making a global assessment of all relevant factors in accordance with case law principles, notably those outlined at my paragraph 23 above. As I have earlier signalled, the issue of the distinctiveness of the word SWIPE, present in all the signs at issue, is of particular importance in this case.
106. Before I come on to the global assessment of the likelihood of confusion, I note that since some similarity of goods/services is essential to a claim under section 5(2)(b) of the Act, the opposition based on this ground must fail in respect of the goods and services where I have no similarity.³³ (As I set out previously, these include, for instance: *covers and cases for mobile phones, computers and tablets* in Class 9; *precious and semi-precious*

30 Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34

31 See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).

32 Again see comments of Iain Purvis as the Appointed Person, *ibid*.

33 See, for instance, Patten J (as he then was) in *Intel Corp v Sihra* [2004] ETMR 44 at [12]

stones in Class 14; *umbrellas* in Class 18, *business administration*; *office functions* in Class 35, as well as most of the applied-for retail and wholesale services in Class 35 relating, for instance, to homeware-type goods and foods.)

107. Between other goods and services I have found similarity in varying degrees, ranging from very low similarity to identity. That some of the goods and services at issue are identical (or even similar to a medium or high degree) is a factor to attend to since, in line with the principle of the interdependency of considerations, it may have the potential to offset a lesser degree of similarity between the marks - and in general terms my findings are that the similarity between the marks is limited, as the following paragraphs recap.
108. The purchasing act in this case entails primarily visual considerations, although aural considerations remain important based on word of mouth recommendations. From a visual perspective I have found SWIPE, ANY SWIPE CAN CHANGE YOUR LIFE and SWIPE SESSIONS to be similar only to a low degree. That conclusion takes account of the overall impressions of the marks, which the average consumer will perceive as wholes. While my findings on similarity allow for a degree of dominance of the word SWIPE in the marks, for the composite marks the two, four and six words of which they are composed all contribute significantly to their overall impressions, forming a unit in each instance.
109. From an aural perspective I have found only a low degree of similarity between LOVE AT FIRST SWIPE compared with ANY SWIPE CAN CHANGE YOUR LIFE and SWIPE SESSIONS. The aural similarity with the SWIPE (solus) mark may be considered slightly higher – to a degree falling between low and medium.
110. Conceptually, between the contested LOVE AT FIRST SWIPE and the Opponent's SWIPE SESSIONS I have found little similarity, and with the Opponent's ANY SWIPE CAN CHANGE YOUR LIFE the degree of conceptual similarity is no higher than between low and medium. In relation to the word SWIPE (alone) and the contested LOVE AT FIRST SWIPE, I have given my view that the significance of the overlap in concept will be lesser or greater according to the goods and services. By this I mean to recognise that in respect of some of the goods and services at issue the word SWIPE has no obvious connection or allusive or descriptive message, and is therefore more distinctive. The

Class 25 goods are an example of such goods. I find that in such circumstances the occurrence of the same distinctive concept takes on more significance.

111. I note the following extracts from the judgment in Sabel:

“23. That global appreciation of 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 marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

24. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.

25. However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.”

112. In my view, on a global assessment, the generally low degrees of similarity between the marks tend to weigh against a likelihood of confusion. At any rate, the presence of the additional words, the different compositions and configurations of the marks rule out any prospect of *direct* confusion. The average consumer will be paying at least a medium degree of attention in the purchasing process and even where the goods or services are identical, will be unlikely to mistake the marks at issue, whether through imperfect recollection or otherwise. The contested mark is all the more memorable by virtue of its play on the familiar phrase love at first sight.

113. I turn therefore to consider whether the same average consumer, deemed reasonably well informed, and reasonably circumspect and observant would be subject to a risk of

indirect confusion. Iain Purvis QC, sitting as the Appointed Person, considered indirect confusion (and the difference between direct confusion) in *L.A. Sugar Limited v By Back Beat Inc*,³⁴ stating as follows:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.)*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

114. Sitting as the Appointed Person in *Eden Chocolat*,³⁵ James Mellor QC stated as follows:

³⁴ Case BL-O/375/10
³⁵ Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017)

“81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining³⁶ in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

115. Among the factors I have in mind in considering the likelihood of indirect confusion in this case are:
- (i) the impact of a greater degree of similarity of some of the goods and services potentially to offset the low degrees of similarity between the marks;
 - (ii) the degree to which the shared element may be considered distinctive of a particular undertaking; and
 - (iii) the attention levels of the average consumer.
116. The Opponent’s **EU SWIPE Registration** involves a mark of low visual similarity, and between low and medium aural similarity. However, in respect of my factor (i) from the paragraph above, I note that the Class 25 goods under that registration include goods that are identical to the applied-for *clothing*, identical or similar to at least similar to a medium degree to the applied-for *headgear*, and similar to medium degree to the applied-for *footwear*. Those, in my view, are the high points of similarity of the goods and services under that Registration, although I have also found some similarity flowing to the *retail and wholesale services and online retail and wholesale services, all relating to ... clothing, footwear, headgear, clothing accessories* and in respect of *Presentation of goods on communication media, for retail purposes* insofar as they too may relate to those same goods.
117. In respect of my factor (ii) above, I note that I have found that SWIPE solus has at least a medium degree of distinctiveness on an inherent basis in respect of *clothing; headwear; all being casualwear and not technical sportswear*. And in respect of my factor (iii) above, the average consumer may pay as little as a medium level of attention (or “normal” level as the Opponent put it).

36 In *L.A. Sugar* – above.

118. Weighing all those considerations in the global appreciation, and particularly noting the distinctiveness of the word SWIPE in this context – having no obvious connection to the Class 25 goods – I find that there is a likelihood of indirect confusion the contested Class 25 goods and Class 35 services that I have just referred to. As to the other contested goods and services, I do not find that the interdependence principle operates to counterbalance the low similarity of the marks, so no further likelihood of indirect confusion arises based on the Opponent’s EU SWIPE Registration.
119. The Opponent’s **UK SWIPE Registration** involves the same mark of low visual similarity, and between low and medium aural similarity. It is registered in Class 45 for *Dating services; internet based social networking, introduction and dating services*, which I have found to be identical or highly similar to some of the applied-for services in Class 45 and Class 42 and similar to the software elements of the applied-for Class 9 goods in degrees between medium and high. Such identical or similar goods/services weigh towards counterbalancing the lower levels of similarity of marks. However, unlike the Class 25 goods, I have found that SWIPE solus is of very low distinctiveness in respect of dating services and their related software applications - the goods and services in Classes 9 and 45. That factor is significant and I conclude that there is no good basis for a finding of a likelihood of indirect confusion. I also note my finding the dating services and related software will be chosen with a degree of care that is above medium. This reinforces my view that there is no likelihood of confusion in respect of these goods and services, notwithstanding that some are identical.
120. The ASCCYL and the SWIPE SESSIONS Registrations also involve identical goods and services across Classes 9 and 45 but neither is strongly distinctive for those goods and services. Those marks are visually and aurally similar to a low degree at best and although ANY SWIPE CAN CHANGE YOUR LIFE may be involve a conceptual similarity (between low and medium), I note again the observation in *Sabel*, extracted above, that the mere fact that two marks may share some conceptual similarity is not sufficient. Consequently, neither of those registrations leads me to a different conclusion on likelihood of indirect confusion than that for SWIPE solus.

Overall outcome under section 5(2)(b)

121. The opposition on the basis of section 5(2)(b) succeeds only partially, namely in respect of the following goods and services:

Class 25: *Clothing; footwear; headgear*

Class 35: *retail and wholesale services and online retail and wholesale services, all relating to ... clothing, footwear, headgear, clothing accessories*

The specification *Presentation of goods on communication media, for retail purposes* shall expressly exclude *clothing, footwear, headgear, clothing accessories*.

The section 5(3) claim

122. The Opponent relies on its UK Swipe Registration to claim a reputation under the mark SWIPE in respect of Class 45: *Dating services; internet based social networking, introduction and dating services* to oppose registration of all of the applied-for goods and services.

123. Section 5(3) of the Act reads as follows:

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b)

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

124. Section 5(3A) states that those provisions apply “irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.” The Relevant Date at which the Opponent must establish reputation is again 14 June 2019.

125. General relevant case law principles can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*

and Case C383/12P, *Environmental Manufacturing LLP v OHIM*, Case C-383/12P. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, para. 40.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

126. Success under this ground requires several conditions, (i) identity or similarity between the contested mark and the earlier mark; (ii) evidence that the earlier registered mark has a reputation in the relevant territory (in this case, the UK); (iii) that use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark; and (iv) that such use must be without due cause. These conditions are cumulative and failure to satisfy any one of them is sufficient to defeat the claim.

127. I have found the earlier mark SWIPE to be similar to the applied-for mark, albeit to a generally low degree. However, as Ms Jones acknowledged, the evidential considerations and arguments that arose in relation to enhanced distinctiveness, and which I have dealt with in some detail earlier in this decision, relate similarly to reputation.

128. There is no need to revisit that analysis in detail; it is enough to note that I agree with Mr Curtis that the evidence is not sufficient to demonstrate a reputation based on the word SWIPE as a trade mark on its own. I have previously noted Ms Jones's references to *Purina One*; however, the evidence of use of other trade marks that feature the word

SWIPE- such as SWIPE SESSIONS - is very limited. The extent to which the UK public has been exposed to those marks is unclear, such that I do not find those marks to be known by a significant part of that relevant public. More significantly, in line with my previous findings, (such as at my paragraph 86 above) to show that the word SWIPE has a reputation as a trade mark is made challenging by the low distinctiveness of the word in the context of the services claimed. The evidence does not show that the word is known as a trade mark operating as an exclusive badge of origin for the Opponent for those services.

129. Since I find that Opponent has not shown the necessary reputation in respect of the UK Swipe Registration, the section 5(3) ground inevitably fails. That said, I also find force in the submissions by Mr Curtis to the effect that the low distinctiveness of the UK Swipe Registration tends to diminish the prospect of mental link between the signs at issue or that use of the sign applied for would take unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark. The evidence shows the word used descriptively by third party dating apps (including in tag lines such as “Swipe. Match. Chat”). Mr Curtis submitted that there is no free-riding where a term is so low in distinctiveness that there is no brand to free-ride on. In my view, even if the evidence had established that the mark had a reputation, it would have been fair to argue that the inclusion of the word SWIPE in the applied-for mark is not without due cause, since its role therein is essentially descriptive, referencing a basic interaction with the contested goods/services, and giving rise to a pun on the familiar phrase “love at first sight”.³⁷

Outcome: The opposition based on section 5(3) of the Act fails.

The section 5(4)(a) claim

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

“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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

³⁷ *Leidseplein Beheer BV v Red Bull* [Case C-65/12], cited in the Applicant's skeleton argument, refers at its paragraph 46 to the concept of 'due cause' assisting to balance the interests of the third party in the use of sign similar to a mark with reputation.

Section 5(4) also states that “A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of ‘an earlier right in relation to the trade mark’.”

131. The essential requirements that a claimant must establish to sustain a passing off claim are:³⁸

- (a) a protectable goodwill in the UK owned by the claimant at the relevant date;
- (b) a misrepresentation made by the defendant which is liable to deceive the public; and
- (c) damage to the claimant’s goodwill caused by the misrepresentation.

132. The concept of goodwill has been described as “*the benefit and advantages of the good name, reputation and connection of a business*” and “*the attractive force which brings in custom*”.³⁹

133. In relation to deception, the court must assess whether ‘a substantial number’ of the claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived.⁴⁰ Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff 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 feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be

³⁸ The “classical trinity” per Lord Oliver in *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 HL, the “Jif Lemon” case.

³⁹ House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217

⁴⁰ *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21; see too *Morritt LJ in Neutrogena Corporation and another v Golden Limited and another* [1996] RPC 473.

completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;*
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;*
- (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 confusion of 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."

134. The Opponent claims that use of the contested application was liable to be prevented on the basis of the law of passing off. The Opponent essentially claims to be the proprietor of an earlier right in relation to the applied-for trade mark, arising from its use throughout the UK, since 2012, of the signs "SWIPE" and "SWIPE RIGHT" in relation to a range of services relating to online dating and social introduction services, which it claims has accrued to the Opponent substantial goodwill and reputation.

135. The Applicant submitted in its skeleton argument:

- that the Opponent has not established goodwill in either "SWIPE" and "SWIPE RIGHT";
- that the Opponent's own evidence shows that the terms are not exclusively associated with the Opponent;
- that SWIPE is descriptive and such a finding is open to me in a section 5(4)(a) claim;
- that given the descriptive significance of the term "swipe", 'a substantial number' of consumers would simply not be deceived for the reasons outlined under the section

5(2)(b) and 5(3) grounds, and that as a result no damage or a likelihood of damage arises.

136. I note that there is no requirement in the law of passing off that a claimant's reputation/goodwill has to be exclusive,⁴¹ but it is settled case law that a sign relied on must, in the eyes of the public or class of public, be distinctive of the goods or services of the plaintiff.⁴² My analysis around the distinctiveness of the earlier marks similarly informs my consideration of the claimed goodwill based on the signs "SWIPE" and "SWIPE RIGHT". As I have previously indicated, the Opponent is a significant presence in the field of dating apps, notably through its Tinder brand. However, I have no hesitation in rejecting the Opponent's claim to actionable goodwill based on the sign SWIPE alone. I note that since a section 5(4)(a) claim is not based on a trade mark registration, my decision is free of the constraint captured in *Formula One*, to the effect that a registered trade mark must be assumed to have at least some distinctive character.⁴³ Nonetheless, I do not consider it necessary to make a finding that the word "swipe" is descriptive in this context. It is enough that I find that it may safely be said to be inherently of very low distinctiveness for the reasons I have previously. The evidence does not establish that the sign SWIPE alone has developed distinctiveness through its inclusion in phrases used by the Opponent. Since I find the Opponent has no goodwill in the sign SWIPE, its section 5(4)(a) claim inevitably fails. That said, in line with my analysis as to the low similarity between that claimed sign and the applied-for trade mark, there would be no misrepresentation and thus no consequent damage.

137. Turning to the claimed sign SWIPE RIGHT, I find that the inherent distinctiveness is little greater than the word SWIPE alone. However, there is some evidence of Tinder's association with the phrase – for instance, its inclusion on the cover of *Cosmopolitan*, the dictionary examples and a variation of it used on the publicity blimp ("Tinder swipes right on Manchester"). There are also references in the counterstatement (the Applicant at that point without legal representation) to the effect the Opponent has a "recognised reputation" for SWIPE RIGHT, which the Applicant describes as a well-known tag line. However, even proceeding on the basis that the sign "SWIPE RIGHT", through its use

41 paragraph 28 *Associated Newspapers Ltd v Express Newspapers* [2003] FSR 51 (HC), Laddie J. at.

42 For instance: *AG Spalding & Bros v AW Gamage Ltd* [1915] 32 RPC (HOL)

43 *Formula One Licensing BV v OHIM*, Case C-196/11P

and association, may be considered distinctive of the Opponent's goodwill ("the attractive force that brings in custom"), I find that even in the same field of activity (dating apps), use of the applied-for mark would give rise to no misrepresentation. There are very obvious visual and aural differences from the contested mark and the sign entails a conceptually different message. There is no deception because consumers will not rely on the presence of the shared word to make purchasing decisions. Absent misrepresentation, there is no consequent damage and the claim fails. For the avoidance of doubt, I find that the section 5(4)(a) claim fails in relation to all of the contested goods and services. If there were considered to be actionable goodwill based on the claimed sign, its scope of protection would not extend beyond dating app services. The absence of a common field of activity, is not fatal of itself; but it is an important and highly relevant consideration.⁴⁴ Where parties do not operate in a common field of activity the burden of establishing misrepresentation and damage is all the greater.

138. Despite identical goods and services, I do not find that when the Applicant applied for its contested mark, its use would have been liable to have been prevented by the law of passing off.

Outcome: The opposition based on section 5(4)(a) of the Act fails.

OVERALL OUTCOME OF THE OPPOSITION

139. The trade mark application under No. 3406888 may proceed to registration in respect of all of the goods and services applied-for in Classes 9, 14, 18, 42 and 45.
140. In view of the partial success of the opposition under section 5(2)(b), the application is refused in respect of all of the applied-for goods in **Class 25: *Clothing; footwear; headgear.***
141. In respect of the services in Class 35, the application is refused in respect of *retail and wholesale services and online retail and wholesale services, all relating to ... clothing, footwear, headgear, clothing accessories.* The application may proceed to registration in respect of all other services under Class 35 including *retail and wholesale services and online retail and wholesale services, all relating to* [the goods listed other than ... *clothing,*

⁴⁴ See, for example, Millet L.J. in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

footwear, headgear, clothing accessories]. The Class 35 specification *Presentation of goods on communication media, for retail purposes* shall also expressly exclude *clothing, footwear, headgear, clothing accessories*.

COSTS

142. The opposition has succeeded in part, to the extent indicated above. However, the Applicant has succeeded in defending the larger part of the application and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice 2/2016. I award costs as follows, which reflect a 20% reduction apportioning the parties' success:

<i>Preparing a statement and considering the other side's statement:</i>	<i>£200</i>
<i>Considering and commenting on the other side's evidence and preparing evidence:</i>	<i>£1000</i>
<i>Preparation for and attending hearing:</i>	<i>£1000</i>
	<i>Total: £2200</i>

143. I order Match Group, LLC to pay Amarjit Singh Dhanda the sum of £2200. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of January 2022

Matthew Williams

For the Registrar
