

O-087-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3322132
BY MUZMATCH LIMITED FOR THE TRADE MARK:**

muzmatch

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 413729
BY MATCH GROUP, LLC**

Background and pleadings

1. On 3 July 2018, muzmatch Limited (“the applicant”) applied to register **muzmatch** as a trade mark, under number 3322132. The mark was published for opposition purposes on 20 July 2018 in respect of the following goods and services:

Class 9: Computer software; downloadable computer software for accessing, managing, controlling and interacting with third parties; downloadable computer software for databases; mobile phone app for sending messages; mobile phone app software to facilitate introductions and dating; computer software development tools for social networking and building social networking applications; software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network; apparatus for recording, transmission or reproduction of sound or images; recorded and unrecorded sound and image media of all kinds; downloadable software for use with wireless telecommunications and GPS devices, namely software for displaying information relating to the position and physical presence of persons and objects for wireless telecommunications devices; computer software in the nature of a mobile application enabling users to share their geographical location and locate other users, to exchange electronic messages, to download, view, annotate and share data, information, images and digital content; equipment, computers and software for the interaction of persons based on their position; equipment, computers and software for the locating of objects and persons and the digitised representation thereof; equipment, computers and software for the collating, transmission and storage of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet; equipment, computers and software for the constructing and operating of social networks and communities; downloadable computer software for use on wireless devices and computers related to applications promoting the discovery and sharing of music and filmed entertainment and dating; downloadable computer software for sending and receiving virtual gifts; downloadable computer software for uploading and downloading electronic files to share with others; podcasts, audio and video recordings;

downloadable electronic music, images, text and audio content; computer software platforms and applications for managing bookings including for events, food and drink and sporting, entertaining, cultural and educational activities; downloadable software in the nature of a mobile application for booking and viewing events; downloadable software in the nature of a mobile application in the field of entertainment, namely, for purchasing tickets and viewing a timetable for future events; apparatus for recording, transmission or reproduction of sound or images; magnetic recording carriers and data carriers, and magnetic data carriers, optical data carriers; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites); instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites).

Class 35: Compilation of information into databases; maintaining databases of personal information for social networking, dating and introduction services; management, systematic ordering and collation of data in computer databases; services with regard to processes for the collating and storage of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet; electronic data processing consultancy; advertising; display services for merchandising; online networking services, namely business and social networking; mobile and electronic commerce services, namely, providing information about events, services and products via telecommunication networks for advertising and sales purposes; promoting the events, goods and services of others by allowing users to recommend, rate and review the aforementioned events, services and products; providing an online directory information service featuring information regarding, and in the nature of, individuals and interests, classifieds, virtual community and social networking; updating of advertising material; merchandising, namely promotional placement of goods; retail services connected to computer software, mobile applications, printed matter, books, downloadable books and help guides, jewellery, flowers, cards, clothing, headgear,

bags, purses, ties; creation and maintenance of databases; collection, compilation, storage, handling, systemisation, management, preparation, processing, analysis, dissemination and retrieval of information, data and statistics on, in or out of computer databases; database services provided over the Internet; business management and business information services; business administration; preparation of statistics; statistical services; organisation and operating of promotions events; presentation (promotion) of individuals on the Internet and other media; market research and information research services; the collection, analysis and dissemination of information about individuals; computerised file management services; storage of location-related and person-related data; operation of loyalty schemes and incentive awards programs to users of a computer dating or social networking website to promote the sale of consumer goods and travel, hospitality and entertainment services for others; information, consultancy and advice about any of the aforesaid services.

Class 38: Telecommunications; transmission of sound, text and/or images; internet access provider services; electronic on-line services for the receipt and delivery of messages, documents, images and other data by electronic transmission; electronic mail services; providing multiple-users access to a global computer information network; providing personal electronic web pages and featuring user-provided content; providing an online searchable database of individuals sharing of photographs and data, namely electronic transmission of digital photographic files, graphics and audio content between internet users; electronic messaging services; providing access via a global computer network to electronic bulletin boards; providing communication services to web communities; electronic on-line services for the receipt and delivery of messages, documents, images and other data by electronic transmission; provision of internet portals to facilitate uploading of text, images and videos; providing access to a global computer network for the transfer and dissemination of information; collection and supply of news, including electronic news; providing access to e-commerce platforms on the Internet; providing access to hotlines; computer-aided electronic information and communication services for private users; delivery of digital audio and/or video by telecommunications; arranging access to databases on the Internet; ; arranging and

leasing access time to computer databases; Internet provider services, namely the leasing and arranging of access time to databases, in particular to the Internet and/or intranets; providing access to computer databases in the fields of social networking, social introduction and dating; providing access to weblogs; communication by online blogs; transfer of information and data via online services and the Internet; providing on-line chatrooms and electronic bulletin boards for transmission of messages amongst users; access to content, websites and portals; services with regard to processes for the transmission of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet; constructing and operating of web portals; services with regard to processes for the constructing and operating of local and global social networks and communities; information, advice and consultancy relating to the aforesaid.

Class 41: Publication services, namely, photo-sharing and video-sharing services; on line publishing services including information relating to publications via a computer database or via the Internet; publication of directories; publication of directories containing contact details of businesses and individuals; publication of information; educational services, namely, conferences, training courses, testing, workshops, and distributing course materials in connection therewith; educational services relating to personal safety and security, lifestyle and emotional wellbeing; educational services relating to dating and social introduction, and social networking; arranging of competitions; provision of social events and cultural activities; ticket agency services; booking services; organization of cultural, sporting, musical events and other forms of entertainment; ticket reservation services; booking services for users to search for and book tickets for attendance at events, all provided online; community event services; organising community and cultural events; entertainment services for communities; electronic game services and competitions provided by means of the internet; information, advice and consultancy relating to the aforesaid.

Class 42: Computer services; providing a website featuring technology in the field of social media, namely, a website enabling users to send status updates to subscribers of

web feeds, upload and download electronic files to share with others; hosting electronic facilities for others for organising and conducting meetings, events and interactive discussions via communication networks; computer services in the nature of customised web pages featuring user-defined information, personal profiles and information; providing a website featuring technology that enables online users to create personal profiles featuring social networking information; providing use of software applications through a website; providing non-downloadable software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks; software enabling user verification through mobile phones; data transmission and instant messaging services; maintenance of computerised records; information provided on-line from a computer database or the Internet; providing of memory space on the Internet; providing computer programs on data networks, including for downloading; operating an Internet search engine; electronic data processing by application service providers (ASPs) on social networks, namely constructing and operating of web portals and applications for mobile technical devices with community functionality; display of electronic geographical maps; information, advice and consultancy relating to the aforesaid.

Class 45: Matchmaking services; personal introduction services; providing information, advice and assistance about personal introduction and matchmaking; providing information, advice and assistance about personal introduction and matchmaking via wireless mobile devices, satellite, cable and global computer networks; social networking services and online social networking services in the fields of personal introduction and matchmaking; providing web sites on the Internet for the purposes of social networking; personal introduction and marriage agency services; dating agency services; internet dating services; personal advice services relating to matrimonial matters (non-legal); providing information and advice on relationships and marriage; organising and arranging marriages; online social networking services accessible by means of downloadable mobile applications; organization of religious meetings; social introduction agencies; social networking services; on-line social networking services;

online social networking services accessible by means of downloadable mobile applications; identity verification services; services for corroboration of personal information; computer software licensing; exploitation of copyright protected material; advisory services relating to security ; provision of interactive personal calendars from a computer database or over the Internet; personal and social services rendered by others to meet the needs of individuals, namely provision of online personal, lifestyle and emotional tracking; personal network services; contact agencies; personal advice services, namely, advice relating to personal appearance, relationships and friendships; arrangement, reservation, information, research, advice and assistance relating to all the aforesaid; including (but not limited to) all the aforesaid services provided online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless and/or wired communication networks.

2. The application is opposed by Match Group, LLC (“the opponent”). The opposition was filed on 14 September 2018 and is based upon ss. 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). Under each of these grounds, the opposition is directed against all of the goods and services in the application.

3. Under s. 5(2)(b), the opponent relies upon the trade marks detailed below. In each case, it relies upon all of the goods and services for which the marks are registered:

(i) European Union trade mark (“EUTM”) number 182253 **MATCH.COM**

Filing date: 1 April 1996; date of entry in register: 9 March 2004.

Class 42: Information and consultancy services in the nature and field of on-line dating and introduction services.

(ii) UK trade mark (“UKTM”) number 3097217

match[♥]

Filing date: 3 March 2015; date of entry in register: 30 October 2015.

Class 45: Providing social introduction and date-arranging services; administering personality and physical attractiveness testing and creating personality and physical attractiveness profiles of others; dating agency services; match-making services; computer dating services; provision of dating agency services via the Internet; provision of dating agency services via television, radio and telephone; agency services which arrange personal introductions; social escorting services; information and advisory services relating to the aforesaid services; providing information regarding on-line dating and introduction services.

(iii) EUTM 16246639 **MATCH.COM**

Filing date: 13 January 2017; date of entry in register: 13 November 2019.¹

Class 9: Downloadable software in the nature of a mobile application for internet-based dating and introduction; downloadable software in the nature of a mobile application in the field of social media, namely, for sending status updates to subscribers of web feeds, uploading and downloading electronic files to share with others.

Class 42: Providing a website featuring technology in the field of social media, namely, a website that enables users to send status updates to subscribers of web feeds, upload and download electronic files to share with others.

Class 45: Dating services; internet based social networking, introduction and dating services; administering personality and physical attractiveness testing and creating personality and physical attractiveness profiles of others.

4. The opponent claims that, due to the similarity between the marks and the goods and services, there will be a likelihood of confusion, including the likelihood of association, on the part of the average consumer.

¹ At the date of the hearing, this mark had not been registered and there was discussion of whether my decision ought to be deferred until the mark achieved registration (there was no suggestion that the hearing should not go ahead). As the mark has now been registered, the issue is moot and I need say no more about it.

5. Under s. 5(3), the opponent relies upon EUTM 182253, the details of which are at paragraph 3(i), above. It claims that it has a reputation for all of the services for which the mark is registered and relies upon all of those services under this ground. It claims that the average consumer will wrongly assume an economic connection between the applicant and opponent. It claims that use of the contested mark would result in the applicant riding on the coat tails of the opponent's reputation and enjoy enhanced recognition in respect of the applicant's goods and service offering. The opponent also claims that the distinctiveness of the opponent's mark would be diluted by such freeriding. Further, the opponent claims that its reputation would be tarnished, should the applicant's offering be substandard in any way.

6. The opponent's first claim under s. 5(4)(a) is based upon its use of the sign **MATCH.COM** throughout the UK since January 1995. The second sign relied upon under this ground is shown below; the opponent claims to have used this sign throughout the UK since March 2015:



Use of both signs is claimed in respect of "online dating and introduction services". The opponent claims that it has accrued substantial goodwill in connection with the signs and that the use of the contested mark would cause a misrepresentation leading to damage "either in terms of a substandard goods or/and service offering by the applicant, or through the diversion of revenue".

7. Lastly, under s. 3(6), the opponent claims that the applicant is "fully aware that the Opponent would take issue with this application", having previously filed an application for an EUTM which the opponent successfully opposed. The opponent also relies upon the filing by the applicant of UK trade mark application number 3293695 ("muzmatch"), which the opponent opposed. That application was subsequently withdrawn. The opponent claims that filing "for the same mark again [...] falls short of acceptable

commercial behaviour” and that the applicant “knew the Opponent would consider this application to cause confusion and take unfair advantage of its reputation in MATCH.COM in the United Kingdom”.

8. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of its claims.

9. Given their dates of filing, the opponent’s trade marks qualify as earlier marks in accordance with s. 6 of the Act. Neither UKTM 3097217 nor EUTM 16246639 had been registered for five years at the date of publication of the contested application. These marks are not, therefore, subject to the use conditions in s. 6A of the Act. EUTM 182253, however, had been registered for the prescribed length of time by the contested mark’s publication date and is subject to proof of use. The opponent provided a statement of use in respect of all of the services relied upon and it was put to proof of such use by the applicant. The relevant period for demonstrating use of this mark is 21 July 2013 to 20 July 2018.

10. Both parties filed evidence. The applicant also filed written submissions during the evidence rounds, which I will bear in mind. A hearing took place before me on 4 November 2019, at which the opponent was represented by Victoria Jones of counsel, instructed by Barker Brettell LLP and the applicant by Eleanor Coates for Murgitroyd & Company.

Evidence

11. I have read all of the evidence but will summarise it only to the extent I consider necessary.

Opponent's evidence

12. The opponent's evidence consists of five witness statements, being two witness statements of Evdokia Moustaka, and the statements of Victor Abbey, Pascal Poncet and Rosalyn Newsome.

Evdokia Moustaka's evidence

13. Ms Moustaka was at the time of her statements the Legal Affairs Manager of Match.com International Limited, which she states is part of the same group as the opponent. Her first statement is dated June 2016, her second statement January 2019. The exhibits to Ms Moustaka's first witness statement have in these proceedings been filed as a single exhibit (i.e. without exhibit numbers); as a consequence, it is not always clear how the exhibited documents relate to the narrative evidence in Ms Moustaka's first statement.

14. Ms Moustaka gives market share in the UK as 13.08% as at March 2016, up from 6.09% in March 2012 and 8.49% in March 2013.² The results of "trials" by Ipsos measuring the popularity of various dating providers between 2014 and 2018 show the opponent consistently in the top four in the UK and in the top five in Sweden.³

15. Apart from 2016, where the figure was over 350,000, the website www.uk.match.com had in excess of 460,000 monthly active users (i.e. a unique user who has been active on the website in the past 28 days) for October 2013 to October 2018.⁴ Figures are provided for other European websites, including the Swedish site (www.se.match.com) which had over 65,000 monthly active users and the Danish site (www.dk.match.com) over 17,000.

² Moustaka 1, §2.4 and Moustaka 2, §7.

³ Moustaka 2, §8. See also UKEM2, pp. 177-178.

⁴ Moustaka 1, §2.7 and Moustaka 2, §19.

16. Marketing spend per EU country each year is said to have been tens of millions of euros, on average.⁵ A television campaign for Match.com is said to have resulted in over 144 million “opportunities to see” (“OTS”) (the calculation of which takes account of the time the advertisement is shown and the estimated audience) each year in the period 2013 to 2015.⁶ A large number of UK television channels, both free to air and subscription services, are listed as having shown these advertisements.⁷ Television and radio “opportunities to see” during the relevant period are provided for Sweden and Denmark, all of which are in the tens of millions.⁸ A UK PR campaign, which appears to include advertisements in publications such as *Mail Online*, *Express Online* and *Marie Claire*, is said to have resulted in over 100 million opportunities to see annually in 2012 and 2015, with over 200 million in 2013 and over 500 million in 2014.⁹ There is some evidence of promotions on sites such as Topcashback, Quidco and www.freedating.co.uk.¹⁰

17. What appear to be screenshots relating to advertising campaigns dated 2015 to 2017 are in evidence.¹¹ Although the legend indicates the brand as “Match (Match.com)”, only the figurative mark is visible. There are also screenshots of television advertisements in which the figurative mark is visible, including but not exclusively in white on a darker background.¹² These are dated between May 2015 and 6 July 2018. A list of UK-based campaigns is provided, some of which feature “Match” in their title.¹³ “OTS” figures for “TV creatives” between May 2015 and August 2018, at their lowest 17.3 million, are given; the supporting exhibit contains the statement “Match.com & Heart Logo first appeared on May 2nd and featured in all TV creatives to present”.¹⁴ Again, a large number of UK television channels, both free to air and

⁵ Moustaka 1, §2.9.

⁶ Moustaka 1, §3.1

⁷ Ibid.

⁸ Moustaka 1, §§3.1.3-3.1.4.

⁹ Moustaka 1, §3.3.

¹⁰ Moustaka 1, §3.5 and UKEM2, pp. 173-174.

¹¹ Moustaka 2, §11.

¹² Moustaka 2, §12.

¹³ Moustaka 2, §13.

¹⁴ Moustaka 2, §14 and UKEM3.

subscription services, are listed as having shown these advertisements.¹⁵ There is a reproduction of a “rolling internet banner” which was placed on the itv.co.uk website in June 2015.¹⁶ It shows the figurative mark.

18. Ms Moustaka also explains that the opponent has run advertising campaigns in London, including on the underground, in the relevant period.¹⁷ The images of the advertisements themselves are not clear but it is stated that all of the campaigns use the “MATCH.COM” and figurative mark.

19. The opponent’s Facebook, YouTube, Instagram and Twitter web site details for the UK, Sweden, Denmark and Finland are provided.¹⁸ Both “Match.com” and the figurative mark are visible. YouTube total viewing figures from 2009 are shown; television advertisements which aired in the UK and which featured both “Match.com” and the figurative mark are said to have been available on the site.¹⁹

20. There is evidence that the opponent has provided an “app” since 2010 which has, since 2013, been downloaded an average of 35,000 times per month in the UK.²⁰ An image of the download page includes “Match.com” and the figurative device.

21. An article entitled “Dating advice from match.com”, dated 16 September 2013, is exhibited.²¹ It focuses on the practicalities of online dating, such as communicating within the site, how to write a profile and personal safety advice, though there are tips such as “[a] first email is about getting the conversation started, not revealing your entire life story- so leave something for you both to chat about next time”. The same article is said to have been replicated in various EU countries.²² There is evidence that various articles written by a contributor appeared on the uk.match.com website in

¹⁵ Moustaka 2, §17.

¹⁶ Moustaka 2, §23.

¹⁷ Moustaka 2, §§27-28.

¹⁸ Moustaka 1, §3.4.1 and UKEM2, pp. 152-170.

¹⁹ Moustaka 1, §3.4.4.

²⁰ Moustaka 2, §§25-26.

²¹ UKEM10.

²² Moustaka 2, §39 and UKEM11.

December 2016.²³ They include topics such as “body language signs she’s into you” and “why she didn’t reply to your email”. Screen prints of the opponent’s YouTube channel dated December 2014 show the same contributor, described as “relationship expert for match.com”, offering videos containing dating advice.²⁴ Ms Moustaka’s evidence is that twelve such videos were uploaded, the most recent being in October 2016.

22. A number of press articles are in evidence, dated between September 2012 and August 2017, including national publications.²⁵ “Match.com” is referenced as a dating site throughout and the articles include comments from “Match.com’s dating expert”/a “dating and relationship expert at match.com”. The opponent is referred to as both “Match” and “Match.com”. There are several references to the opponent’s large “dating pool” and the site’s success: an article from *Marie Claire* dated February 2016 describes the opponent as “the most widely-used online dating site in the world” and specifically mentions that the opponent arranges singles events and offers online dating advice.²⁶ An article from the *Telegraph*, dated December 2014, references the “millions of members” and “large user base” for Match.com.²⁷ The same article describes the experiences of a “customer care agent” (at an unspecified earlier date) who “spent all of [her] time on the phone to our members listening to them and giving them advice”, and who gives the specific example of helping a man with his profile. The article mentions that in 2015 the opponent started to hold events, such as bowling, cookery classes, escape rooms and happy hour events, as well as events which are specifically for members to meet and get advice about dating.

23. Ms Moustaka states that the opponent has offered targeted services, including for the black, Asian, Christian, Polish, gay and lesbian communities, under the “MATCH.COM” mark, since early 2012.²⁸ Prints are provided showing examples of

²³ UKEM12.

²⁴ Moustaka 2, §40.

²⁵ UKEM13, UKEM2 (pp. 121-129 and 142-150)

²⁶ UKEM2, p. 127.

²⁷ Moustaka 1, §2.2.

²⁸ Moustaka 2, §29.

these sites which are said to be dated between 2012 and July 2018; both “match.com” and the figurative sign are visible.²⁹ Examples of advertisements which feature individuals from these specific communities are provided, said to have been aired between December 2014 and November 2016, and on the opponent’s UK YouTube channel; one is dated July 2017.³⁰

24. Ms Moustaka’s evidence is that the applicant filed an application at the EUIPO, under number 14794325, for the mark “muzmatch”, which was refused following an opposition by the opponent.³¹ The applicant subsequently applied for UK trade mark number 3293695 “muzmatch”, in classes 42 and 45. Following an opposition filed by the opponent, that application was withdrawn.

Victor Abbey’s evidence

25. Mr Abbey was UK Legal Affairs Manager at the time of his statement, which is dated January 2012. Given that this statement pre-dates the application date by over six years and the relevant period, I will not summarise it in detail, though I have read it all.

26. Mr Abbey explains that Match.com’s revenue is almost €254,728 million, although this is not broken down.³² Match.com Europe’s sales figures in 2008 were, however, €60 million and it had 270,000 subscribers.³³ Mr Abbey estimates marketing spend as €30 million, though the period which this covers is not clear.³⁴ Details of TV and internet campaigns are also provided.³⁵

²⁹ Moustaka 2, §30 and UKEM6.

³⁰ Moustaka 2, §31 and UKEM7.

³¹ Moustaka 2, §34.

³² Abbey, p. 1.

³³ VA10, p. 4.

³⁴ Abbey, p. 2.

³⁵ Abbey, pp. 4-6 and associated exhibits.

Pascal Poncet's evidence

27. Mr Poncet is the Global Controller of Meetic, which is part of the same group as the opponent. His evidence was filed in response to the applicant's evidence.

28. Mr Poncet exhibits extracts from subscribers' profile pages in the UK, Ireland, Sweden, Finland and Denmark in the period 2013 to 2018.³⁶ Unsurprisingly, these are heavily redacted but they cover various locations across the UK and Ireland. Individual amounts paid are not vast, though some show repeat purchases. "match.com" is visible at the top of the pages. This is supplemented by subscriber information, which is broken down by country.³⁷ It is not, however, presented in a very helpful way: the total sales per subscriber do not correlate with the sums given in the columns for 2013-2018 and totals for those years are not given.

29. Mr Poncet provides turnover figures for Match.com International Limited for the period 2013 to 2017.³⁸ The figures are in excess of £38 million annually. The financial statements exhibited all indicate that the business "consists primarily of Match.Com and related brands".

Rosalyn Newsome's evidence

30. Ms Newsome is a Chartered Trade Mark Attorney at the opponent's firm of professional representatives. Her evidence was also filed in response to the applicant's evidence.

31. Ms Newsome exhibits lists of trade marks in the UK and throughout the EU where the specification has been amended following an approach or opposition by the

³⁶ PP1 to PP5.

³⁷ PP6.

³⁸ Poncet, p. 1 and PP7.

opponent.³⁹ There is also exhibited a list of trade mark applications which have been withdrawn following a similar objection from the opponent.⁴⁰

Applicant's evidence

32. This consists of the witness statement of Eleanor Coates, a Chartered Trade Mark Attorney at the applicant's firm of professional representatives.

33. Ms Coates provides screen prints of a range of dating sites which include the word "match", alone or in combination (e.g. matchmaker).⁴¹ These are said to be on-line dating websites operating for UK consumers in the UK. Some have a .co.uk or .uk suffix (or one .eu address) to their site address but others refer to zip codes (pp. 6, 13) or have, for example, Canada as the default country (p. 10). Others have only a .com suffix and no other information to clarify the territory concerned. Only three are clearly dated before the filing date.⁴²

34. There are prints of third parties' dating websites, which Ms Coates describes as "the main competitor's websites" [sic].⁴³ All bear only the printing date of April 2019. Tinder shows the strap line "Match.Chat.Date", whilst eharmony refers to the "perfect match for you", an "eharmony match" and "How to Know if You Should Meet Your Match". EliteSingles refers to "matchmaking" and "potential matches", whilst Muslima and liveabout.com refer to finding one's "perfect match" and LoveAgain discusses finding "your match" online.

35. Ms Coates also provides prints from the Google Play app store which shows a variety of dating apps with "match" in their name.⁴⁴ A printing date of March 2018 is visible.

³⁹ RN1.

⁴⁰ RN2.

⁴¹ EC1.

⁴² pp. 5-7.

⁴³ Coates, §5 and EC2.

⁴⁴ EC3

36. There are two screen prints of articles dated 2013 and 2016 with “Perfect Match” in the title; other prints of undated articles containing “Love Match” and “Tinder Match” are also provided.⁴⁵ In addition, one full article from soulmates.theguardian.com refers to “your online dating match”.⁴⁶ The only visible date is 2019. There are also undated Google search results, it appears from searches for “match” in companies’ advertisements, showing “match” used in phrases such as “find a match” and “find your perfect match”.⁴⁷

Proof of use

37. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

⁴⁵ EC4.

⁴⁶ Ibid.

⁴⁷ EC5.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

38. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

39. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

40. In *Leno Merken BV v Hagelkruis Beheer BV*, EU:C:2012:816, Case C-149/11, the Court of Justice (“CJEU”) of the European Union noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at

the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use”.

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity”.

41. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a

general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use”.

42. The General Court (“GC”) restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

43. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown.

44. There can be little doubt that the opponent has used the mark “MATCH.COM” in relation to dating services. The applicant accepts that “the Opponent is a trading entity, operating in the field of online dating”.⁴⁸ The reason the applicant put the opponent to proof of use of its trade mark is, it says “because the specification does not cover online

⁴⁸ Applicant’s skeleton argument, §28.

dating services”.⁴⁹ It appears, therefore, that the only matter for me to decide is whether the use which has been made of the mark concerns the registered specification.

45. The mark is registered for “information and consultancy services in the nature and field of on-line dating and introduction services”. The applicant’s position is that these are distinct from the dating services provided by the opponent and that the opponent does not provide “information and consultancy services”. The opponent’s members, according to the applicant, “do not sign up to be provided with information and consultancy services in the field of on-line dating and introduction services”.⁵⁰ It claims that any use on such services is “incidental” and points to the absence of invoices in relation to the specific services for which this mark is registered.⁵¹

46. The opponent relies upon two decisions on this point, one at the EUIPO (B 2 658 741) and the other before this tribunal (O/054/17). It also claims that, irrespective of whether I agree with the reasoning in those decisions, the opponent has demonstrated use in relation to the specific services of the trade mark at issue.

47. It is clear from the evidence that part of the online dating service offered by the opponent involves providing individuals with profiles of potential mates, which includes information about individuals’ characteristics and preferences. There is also evidence that the opponent provided in the relevant period information about how to use its services, which includes both practical advice (e.g. staying within the site to communicate) and tips on issues such as how to make a profile more attractive. In addition, the opponent appears to have offered more general dating advice through its relationship/dating expert, which appears both on the opponent’s sites and in press articles, attributed to the opponent’s relationship/dating expert. In such circumstances, the consumer is likely to consider the opponent responsible for the advice. My view is that the provision of information to members concerning their potential compatibility with other users of the service is an intrinsic part of the dating services provided by the

⁴⁹ Ibid.

⁵⁰ Written submissions, §6.

⁵¹ Written submissions, §§7-8.

opponent; indeed, it is difficult to see how any dating service could function without some level of exchange of information. I note the applicant's point that members pay for a dating service rather than an information service but I cannot agree with it: the users of the opponent's services visit the opponent's website for the very purpose of obtaining information about prospective partners, which is provided by the opponent. I accept that "information" and "consultancy" may not be interchangeable terms. However, even here, my view is that the opponent has demonstrated that it provides consultancy services. The evidence shows that the opponent offers advice such as assistance with writing profiles. Further, the opponent's site suggests potential matches. These may be based on an algorithm but the end user's experience is that the opponent provides a list of members with whom it thinks the user will be most compatible, based on their profile. Again, it seems to me that it is an essential part of the opponent's dating services. Further, there is evidence that the opponent also offered advice in the relevant period about how to use its services effectively and safely, as well as more general dating advice. I am satisfied that genuine use has been made of "MATCH.COM" in respect of the registered specification. Given that the services are already limited to those concerning on-line dating and introduction services, it seems to me that that is how the services would be described by the average consumer and that there is no appropriate sub-category to which the services might reasonably be limited: see *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10 and *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). The opponent may rely upon "information and consultancy services in the nature and field of on-line dating and introduction services".

Section 5(2)(b)

48. 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”.

49. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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.

50. I will begin by considering the position under this ground in respect of EUTM16246639, as it has the widest specification. I will return to the other marks if it becomes necessary.

Comparison of goods and services

51. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

52. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

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

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

53. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, EU:T:2006:247, the GC stated that:

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

54. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

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

55. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore

similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. “chicken” against “transport services for chickens”. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the GC stated that “complementary” means:

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

56. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

57. It is appropriate to group terms where the goods/services are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons: *Separode Trade Mark* BL O-399-10 (AP).

58. The opponent submits that the contested services in classes 42 and 45 of the application are identical or similar to the specifications in classes 42 and 45 of EUTM

16246639. The goods in class 9 of the application are said to be identical or similar the class 9 goods of EU 16244639 and the contested services in classes 35, 38 and 41 are said to be similar to the goods and services in classes 9, 42 and 45 of EU 16246639. This is based upon the goods and services being similar in nature and/or purpose or complementary.

59. The applicant has conceded that some of the goods and services are identical, highly similar or complementary. However, Ms Coates did not specify the level of similarity which applies to the goods and services in respect of which this concession was made. Nor is it clear which goods/services in the earlier mark caused the applicant to make its concession, although it appears that the concessions in all but class 45 are because of EU16246639 and its specifications in classes 9 and 42.⁵² It therefore remains necessary for me to determine how similar the goods and services are, albeit with the applicant's concessions in mind. In circumstances where the opponent's submissions are of a highly general nature, it would not be appropriate for me to challenge myself to find all of the arguments which the opponent could have made. My examination of the similarity between the goods and services can, therefore, only take account of factors which are obvious to me from a comparison of the respective goods/services.

Class 9 of the contested specification

Computer software; downloadable computer software for accessing, managing, controlling and interacting with third parties; mobile phone app for sending messages; mobile phone app software to facilitate introductions and dating; software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network; downloadable software for use with wireless telecommunications and GPS devices, namely software for displaying information relating to the position and physical presence of persons for wireless telecommunications devices; computer software in the

⁵² Applicant's skeleton, §

nature of a mobile application enabling users to share their geographical location and locate other users, to exchange electronic messages, to download, view, annotate and share data, information, images and digital content; software for the interaction of persons based on their position; software for the locating of persons and the digitised representation thereof; software for the collating, transmission and storage of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet; software for the constructing and operating of social networks and communities; downloadable computer software for use on wireless devices and computers related to applications promoting the discovery and sharing of music and filmed entertainment and dating; downloadable computer software for uploading and downloading electronic files to share with others

60. These services are identical to “downloadable software in the nature of a mobile application for internet-based dating and introduction; downloadable software in the nature of a mobile application in the field of social media, namely, for sending status updates to subscribers of web feeds, uploading and downloading electronic files to share with others” in class 9 of the earlier mark. Where these goods are not self-evidently identical or are simply different ways of expressing the same goods, the goods are broadly framed and identical on the principle outlined in *Meric*. In terms of a mobile phone app for sending messages, a status update is a message. For those goods related to locating individuals, a “status update” is also a broad enough term to cover location status messages/information. As far as “downloadable computer software for use on wireless devices and computers related to applications promoting the discovery and sharing of music and filmed entertainment” goes, I see no reason why the earlier specification’s mobile app for “sending status updates to subscribers of web feeds” would not include web feeds concerning music and/or filmed entertainment.

Downloadable computer software for sending and receiving virtual gifts

61. These goods are similar to a medium degree the earlier mark’s “downloadable software in the nature of a mobile application for internet-based dating and introduction”.

The specific purpose is not the same but the later goods have clear application in the field of online dating. Both users and channels of trade may intersect and there is a potentially complementary relationship between these goods.

Computer software development tools for social networking and building social networking applications

62. The applicant accepts a degree of similarity between these goods and those of the earlier mark. They do not coincide in nature or purpose, but they have a complementary relationship with the opponent's social media applications and may coincide in users and channels of trade. They are similar to a medium degree.

Downloadable computer software for databases

63. The opponent's software applications are likely to use databases to store information about users. Whilst both goods are software products, they do not have the same nature and have different aims. Their method of use will be different. However, the contested "computer software for databases" suggests software which is used in the construction/operation of databases and which is likely to play an important part in the opponent's dating application software. This will give rise to a complementary relationship and, as users and channels of trade may intersect, a medium degree of similarity overall.

Apparatus for recording, transmission or reproduction of sound or images; equipment, computers for the interaction of persons based on their position; equipment, computers for the locating of persons and the digitised representation thereof; equipment, computers for the collating, transmission and storage of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet; equipment, computers for the constructing and operating of social networks and communities

64. These goods have some similarity of purpose to “downloadable software in the nature of a mobile application in the field of social media, namely, for sending status updates to subscribers of web feeds, uploading and downloading electronic files to share with others” but are different in nature. There may be a degree of complementarity. They are similar to a low degree.

Computer software platforms and applications for managing bookings including for events, food and drink and sporting, entertaining, cultural and educational activities; downloadable software in the nature of a mobile application for booking and viewing events; downloadable software in the nature of a mobile application in the field of entertainment, namely, for purchasing tickets and viewing a timetable for future events

65. Whilst both these and the earlier goods in class 9 are all software, their particular nature and purpose will be different. Despite the evidence that the opponent arranges dating events (it is a reasonable inference that these are booked through its website/app), there is no real competitive relationship: one would only book events through a dating app in the course of trying to find a date, and one would not use an event booking site to search for potential partners. There may, however, be a degree of complementarity, as software to book events may be important for the use of the earlier applications, enabling users to book events through the same application, and the consumer may suppose that both are provided by the same undertaking, though I do not consider the complementarity to be particularly pronounced. Users may be the same but there is unlikely to be a significant overlap in channels of trade, save at a very superficial level. There is a low degree of similarity overall.

Recorded and unrecorded sound and image media of all kinds; podcasts, audio and video recordings; downloadable electronic music, images, text and audio content; magnetic recording carriers and data carriers, and magnetic data carriers, optical data carriers; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web

pages and web sites); instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites).

66. I can see no similarity between the above remaining goods in class 9 and any of the earlier goods or services. Even where the goods are used together, there is not, in my view, an obvious complementary relationship where the respective goods would be considered the responsibility of the same undertakings.

Class 35 of the contested specification

Online networking services, namely business and social networking

67. The applicant accepts that there is some similarity between these services and those of the earlier specification. In *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), Carr J. came to the provisional conclusion that the class number should only be taken into account where the meaning of the disputed term is not sufficiently clear and precise. It is not obvious to me how “online networking services, namely social networking services” may be construed as a service proper to class 35, distinct from “social networking services” in class 45. However, the opponent has not raised the point and its position is that there is not identity but similarity between the applicant’s class 35 services and those of the earlier mark.⁵³ Consequently, I will proceed on the basis that these are social networking services with a business slant, proper to class 35, essentially being business-focused social media spaces. Accordingly, both these and “business networking” services are similar in purpose to “internet based social networking”, as both are intended to connect users online, though the specific aim is different (professional as opposed to social contact). Their nature and method of use are likely to be similar. Users may intersect and there may be a degree of competition. I think it unlikely that these services will have a complementary relationship: they are not

⁵³ Opponent’s skeleton, §20.

important for one another's use in the sense described in the case law. They are similar to a high degree.

Providing an online directory information service featuring information regarding, and in the nature of, individuals and interests, classifieds, virtual community and social networking

68. Both these and "internet based social networking" services in the earlier specification involve the provision of online space for users to place advertisements and announcements of various sorts. There is therefore some similarity in nature and purpose, though the class 35 services are essentially business services (again, no point regarding classification/interpretation is taken by the opponent and only similarity is asserted) and a directory information service suggests a repository of information which can be accessed but that does not go further than presentation of the information. They are not complementary but there may be a competitive aspect. These services are similar to a medium degree.

Retail services connected to computer software, mobile applications

69. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said that:

"9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable

under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut".

70. However, on the basis of the European courts' judgments in *Sanco SA v OHIM* and *Assembled Investments (Proprietary) Ltd v. OHIM*,⁵⁴ upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd and OHIM*,⁵⁵ Mr Hobbs concluded that:

- i) 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;
- ii) 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;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The GC'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).

⁵⁴ Case C-411/13P and Case T-105/05, at paragraphs [30] to [35] of the judgment

⁵⁵ Case C-398/07 P, EU:C:2009:288 (CJEU).

71. The earlier mark is registered for mobile application software, for various purposes. I see no reason why the channels of trade would not overlap for these goods and services, since an operator offering retail services connected to software will offer a range of software products for sale, amongst the other services provided. The opponent's mobile application software is obviously essential to a retail service for the same goods. I am of the view that the relationship will give rise to complementarity sufficiently pronounced for there to be a medium degree of similarity overall.

Operation of loyalty schemes and incentive awards programs to users of a computer dating or social networking website to promote the sale of consumer goods and travel, hospitality and entertainment services for others

72. These services are obviously connected to “dating services” and “social networking services” and are offered to the users of those sites but are different in nature and purpose. They are complementary and share channels of trade. They are similar to a fairly low degree.

Compilation of information into databases; maintaining databases of personal information for social networking, dating and introduction services; management, systematic ordering and collation of data in computer databases; services with regard to processes for the collating and storage of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet; creation and maintenance of databases; collection, compilation, storage, handling, systemisation, management, preparation, processing, analysis, dissemination and retrieval of information, data and statistics on, in or out of computer databases; database services provided over the Internet; the collection, analysis and dissemination of information about individuals; computerised file management services; storage of location-related and person-related data

73. The applicant has accepted that “maintaining databases of personal information for social networking, dating and introduction services” is similar to the specification of

EUTM 16246639, though it does not say which goods/services or why. The remaining services listed above are terms which involve or include the maintenance, creation and management of information on databases. The creation and upkeep of databases containing members' details is likely to be important for the functioning of the opponent's dating/social networking services and a user of the opponent's services in class 45 may perceive the services as linked and complementary as defined in the case law. These services are similar to a low degree.

Presentation (promotion) of individuals on the Internet and other media

74. Whether it was the applicant's intention or not, by dint of their classification in class 35, these services cannot be construed as other than public relations services, i.e. promotion of individuals for business purposes. I accept that dating services will feature individuals on website but both the purpose and the nature of the service/presentation is entirely different, channels of trade are unlikely to intersect in any meaningful respect and there is neither competition nor complementarity. I do not think that the services are similar to any of the earlier goods and/or services.

75. The remaining services in class 35, save for "information, consultancy and advice about any of the aforesaid services" are not obviously similar to any of the earlier goods or services. I find accordingly. As far as "information, consultancy and advice about any of the aforesaid services" are concerned, and in the absence of any submissions on the point, I consider that these services are similar to earlier specification to the same extent as the relevant services considered above.

Class 38 of the contested specification

Telecommunications; transmission of sound, text and/or images; electronic on-line services for the receipt and delivery of messages, documents, images and other data by electronic transmission; electronic mail services; providing personal electronic web pages and featuring user-provided content; electronic messaging services; providing

access via a global computer network to electronic bulletin boards; providing communication services to web communities; electronic on-line services for the receipt and delivery of messages, documents, images and other data by electronic transmission; computer-aided electronic information and communication services for private users; delivery of digital audio and/or video by telecommunications; transfer of information and data via online services and the Internet; providing on-line chatrooms and electronic bulletin boards for transmission of messages amongst users; services with regard to processes for the transmission of data, in particular texts, images and audio and video files, on mobile terminals and on systems on the Internet

76. The above services are all concerned with the provision of means of communication to users online. It is common for social networking or dating websites, as covered by the earlier specification in class 45, to allow users to create personal profile pages and to feature a messaging function within the site; it is entirely plausible that messages could be written, video or audio. Whilst it may be less likely for dating sites where personal security is more of a concern, I see no reason why a social networking site would not also incorporate electronic bulletin boards. There is, therefore, similarity in both nature and purpose, users will be the same and there is clear potential for complementarity. These services are similar to a fairly high degree.

Providing an online searchable database of individuals sharing of photographs and data, namely electronic transmission of digital photographic files, graphics and audio content between internet users

77. The earlier dating and social networking services in class 45 all depend upon the centralised online storage of individuals' information which can be searched by users of the sites. As with the services considered above, there is an overlap in nature and purpose, the channels of trade intersect and there will be a pronounced complementary relationship between these services, which are similar to a fairly high degree.

Provision of internet portals to facilitate uploading of text, images and videos; constructing and operating of web portals; services with regard to processes for the constructing and operating of local and global social networks and communities

78. As I understand it, a portal is simply a type of website which draws together content from different sources. Given that the terms above apply to any type of portal, there may be some similarity of both purpose and nature with the earlier website provision services in class 42. Such services may reach the market through the same channels. These services also seem likely to be used together in such a way that they are perceived as complementary. These services are similar to a reasonably high degree.

Communication by online blogs

79. These services differ in nature from the earlier class 42 services but have some similarity of purpose, as both services offer the means through which individuals can share information with others. Channels of trade may be shared. These services are similar to a fairly low degree.

Arranging access to databases on the Internet; arranging and leasing access time to computer databases; Internet provider services, namely the leasing and arranging of access time to databases, in particular to the Internet and/or intranets; providing access to computer databases in the fields of social networking, social introduction and dating.

80. A degree of similarity is accepted between “providing access to computer databases in the fields of social networking, social introduction and dating” and the specification of the earlier mark. As all of the above are or encompass database access services, the concession must, as a matter of logic, be extended to these services. Databases and access to them are undoubtedly important for the operation of the opponent’s dating services in class 45 and it is possible that a user would consider the access provider and the provider of a website collecting and allowing the sharing of personal information

via dating databases to be the same but I cannot see any other potential areas of similarity, save for users at a general level. They are similar to a low degree.

Providing access to weblogs; access to content, websites and portals

81. A degree of similarity is accepted between “providing access to weblogs” and the specification of the earlier mark. It is not clear which goods or services have caused the applicant to make this concession. It is possible that there might be some overlap in channels of trade and that users might consider the provider of social media website services in class 42 to be complementary to the above services, given that a social media website might feature a blog. I will proceed on the basis that these services are similar to a low degree. Given that weblogs are content, construed widely, and that a website may be a weblog, the same reasoning applies to these terms. A portal draws content from various sources and it is unlikely that weblogs would be the sole content of a portal, though they may well be part of the content offered by a portal. However, there may be overlap in channels of trade with the opponent’s website provision services, and there may be some complementarity. These services are similar to a low degree.

Internet access provider services; providing multiple-users access to a global computer information network; providing access to a global computer network for the transfer and dissemination of information

82. These services appear to offer the first step in internet connectivity, i.e. internet provider services. Whilst they are clearly important for anyone wishing to offer or access a website, it does not seem to me that they would be perceived as the responsibility of the same company that provides web content. They differ in all other respects save for users but the overlap there is too superficial for there to be overall similarity on that basis alone. These services are not similar to any of the earlier goods and services.

Collection and supply of news, including electronic news; providing access to e-commerce platforms on the Internet; providing access to hotlines

83. It is not obvious to me how these services might be similar to the goods and services of the earlier specification. The nature and purpose of the services differ and it would be stretching the ordinary meaning of “news” too far to construe it as a reference to individuals’ status updates, whilst e-commerce websites and hotlines appear to have no connection to social media sites. There is no similarity.

84. I consider that “information, advice and consultancy relating to the aforesaid” are similar to the earlier specification to the same extent as the relevant services considered above.

Class 41 of the contested specification

Publication services, namely, photo-sharing and video-sharing services; on line publishing services including information relating to publications via a computer database or via the internet

85. Similarity is denied for these services. The opponent’s services in class 42 involve providing a website that enables users to share files, which would include videos and photographs. There is some similarity of purpose and there may be similarity in nature. As photo-/video-sharing sites may be used together with social media sites of the type covered by the earlier specification, there may be an expectation that the same provider delivers both services, and complementarity will result. These services are similar to a medium degree.

Provision of social events and cultural activities; organization of cultural, sporting, musical events and other forms of entertainment; organising cultural events

86. These services are different in purpose from the opponent's dating services. They are not in competition. However, there is some evidence that, as part of its dating services, the opponent offers events such as cookery classes, bowling and happy hour events. It does not seem to me to be stretching the term "dating services" inappropriately to conclude that a dating service may well offer a range of social events at which its clients can meet. There is, therefore, a degree of overlap in nature and a connection between the services which will induce users to believe that the services are offered by the same business, albeit with different end goals in mind. These services are similar to a fairly low degree.

Ticket agency services; booking services; ticket reservation services; booking services for users to search for and book tickets for attendance at events, all provided online

87. I have indicated, above, that one aspect of the opponent's dating/introduction services may include events for individuals to meet for dating purposes. There will necessarily be some sort of ticketing/booking arrangement for such services. The core services are different in the majority of respects but there may be a degree of complementarity because of the scope of the opponent's services, described above. These services are similar to a low degree.

Publication of directories; publication of directories containing contact details of individuals; publication of information.

88. The applicant concedes some similarity in relation to "publication of directories containing contact details of individuals"; the other terms above all encompass these services and the concession must extend to them. It is not immediately obvious to me how these services are similar. Although the opponent's dating/social networking services will include individuals' details and allow them to be searched by other users,

the purpose of the service is to facilitate introductions, which is different from the purpose of a publication service, whose aim is to make information available to the public. To the limited extent that both offer information about individuals, there may be some similarity. However, their nature differs in other respects: a directory is usually a list in alphabetical order and, while contact details would be a normal part of a directory listing, it is doubtful that the opponent's services would publicise individuals' contact details; they are more likely to offer a means through which individuals can be contacted without revealing their personal information. I can see no other basis for similarity; users will intersect but this is a very general point of similarity. I will proceed on the basis that these services are similar to a low degree. It does not seem to me that there is any similarity with the other goods/services in the earlier specification.

Educational services, namely, conferences, training courses, testing, workshops, and distributing course materials in connection therewith; educational services relating to lifestyle and emotional wellbeing; educational services relating to dating and social introduction, and social networking.

89. Similarity is conceded for "educational services relating to dating and social introduction, and social networking". As "educational services, namely, conferences, training courses, testing, workshops, and distributing course materials in connection therewith;" includes all types of educational service and the other services above could include events/services relating to dating, social introduction and social networking, they must also be considered similar on the same basis. Whilst the purpose of all of the above services is to educate and that of dating/social networking services in class 45 is to facilitate introductions, there is evidence that the opponent provides general dating advice as part of its services. That does not strike me as likely to be atypical of the type of service offered. Therefore, whilst there are significant differences between the services, it is possible that there is a complementary relationship which will result in a low degree of similarity.

Educational services relating to personal safety and security

90. I acknowledge that there is some evidence that the opponent gives tips regarding personal safety when meeting strangers/dates through its site. However, it would, I think, be stretching the core meaning of its services too far to say that this amounts to an educational service. These services are different in purpose, nature and channels of trade. I do not think there is any real complementarity: although the opponent may offer occasional common-sense advice about meeting safely, the services are not important or used together in the way required for complementarity in the case law; certainly if there is any complementarity it is insufficiently pronounced for there to be overall similarity on that basis alone.

Publication of directories containing contact details of businesses

91. I can see no meaningful similarity between these services and the opponent's goods and services. While there might be a possibility of complementarity if directories are concerned with individuals, I see no reason why the public would perceive a connection between the opponent's dating/social networking services and the publication of business information. Nor do I consider the position in either class 9 or 42 to be any stronger for the opponent. Class 42 in particular concerns computer services which differ in nature and purpose and for which there is no other clear point of similarity.

Community event services; organising community events; entertainment services for communities

92. These services strike me, on a normal reading of the terms, as concerned with organising local events for those living in a particular area. Further, whilst the arrangement of the events may take place online, "events" and "entertainment services" would on a normal reading be taken to mean anything other than real-world activities. I see no reason why these services would be similar to those of the earlier mark: unlike

the event services above, the nature of the events is very different and is unlikely to give rise to a complementary relationship.

Arranging of competitions; electronic game services and competitions provided by means of the internet

93. I can see no obvious reason for similarity between these services and any of those in the earlier specification. In the absence of any helpful submissions, I find that these services are not similar.

94. “Information, advice and consultancy relating to the aforesaid” are similar to earlier specification to the same extent as the relevant services considered above.

Class 42 of the contested specification

Computer services; providing a website featuring technology in the field of social media, namely, a website enabling users to send status updates to subscribers of web feeds, upload and download electronic files to share with others; providing use of software applications through a website; data transmission and instant messaging services

95. “Computer services” are identical to the earlier class 42 services on the inclusion principle described in *Meric*. “Providing a website featuring technology in the field of social media, namely, a website enabling users to send status updates to subscribers of web feeds, upload and download electronic files to share with others” are self-evidently identical to the same earlier services. “Providing use of software applications through a website” is a wide term and I see no reason why it would not include the software which allows users to use the social media technology of the website described in the earlier specification. These services are also identical under *Meric*. As the earlier services allow the transmission of messages (status updates) and electronic files (data), “data transmission and instant messaging services” are also identical to the earlier term in class 42. If that is not right, these services are highly similar.

Computer services in the nature of customised web pages featuring user-defined information, personal profiles and information; providing a website featuring technology that enables online users to create personal profiles featuring social networking information; providing non-downloadable software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks; providing computer programs on data networks, including for downloading

96. These services are, if not identical, at least highly similar to the earlier services in class 42, all being website services which enable the posting and sharing of personal information. The only potential difference I can see is that that “profiles” may not equate precisely to electronic files and status updates, while “streaming” etc. may not be identical to the upload and download of files. These differences are only slight.

Electronic data processing by application service providers (ASPs) on social networks, namely constructing and operating of web portals and applications for mobile technical devices with community functionality.

97. “Community functionality” in the context of website services suggests technology which allows users of that online community to interact; “mobile technical devices” would cover not only phones but items such as laptops and notebook computers. It therefore appears that these services concern any type of website/application which allows its users to interact via various types of device. The earlier class 42 specification is not limited to any particular type of device, whether fixed or mobile. Further, the parties have not provided any submissions which would cause me to believe that the social media users of the opponent’s services would not be a “community”. These services are at least highly similar, having at least a good degree of similarity in nature and purpose, sharing users and channels of trade, and being in competition and complementary.

Information provided on-line from a computer database or the Internet

98. This term suggests a service where information is held online and is provided in an accessible format for users to search or otherwise interrogate. "Information" is an extremely wide term and I see no reason why it would not include the information about members of the opponent's dating/social networking services in class 45 held on a database. Although not identical in purpose and nature, there is an overlap. The services are unlikely to be in competition as straight alternatives but it seems likely that there is a reasonably strong complementarity, as they are intrinsically linked and the provider is likely to be considered the same. They are similar to a medium degree.

Maintenance of computerised records; providing of memory space on the Internet

99. There is a complementary relationship between these services and the website services offered by the opponent in class 42, as the above services are likely to be key for the functioning of the opponent's social media website. Channels of trade may intersect. These services are similar to a fairly low degree.

Software enabling user verification through mobile phones

100. These services are not similar in nature or purpose to the earlier services in class 42. However, there may be shared channels of trade and there may also be a complementary relationship with the earlier services in class 42, as user verification (which, as I understand it, would include services as simple as sending a verification email to a new account registration) may be used alongside, for example, account activation, changes or password reminders for users of the opponent's services. These services are similar to a low degree.

Hosting electronic facilities for others for organising and conducting meetings, events and interactive discussions via communication networks

101. As I understand the term, a “hosting” service makes resources, services and applications available via a computer network (commonly servers),⁵⁶ essentially the place where a website is stored and from which the website’s files are delivered to internet users’ browsers. Differing in nature and purpose from the opponent’s class 45 internet based social networking services, it nevertheless seems to me that these services might share channels of trade and that the connection between the website provision services and hosting of websites is such that the two might be—and might be perceived to be—provided by the same service provider. Some similarity is accepted for the above term insofar as it relates to interactive discussions. However, there is nothing to suggest either that hosting services for which similarity is conceded are materially different from the other hosting services specified, or that “internet based social networking” would not allow for the arranging of meetings and events in the same way that it allows for interactive discussions. I find these services similar to a low degree.

Operating an Internet search engine; display of electronic geographical maps

102. Neither of these services strike me as having any similarity with the earlier services. They differ in nature and purpose, are unlikely to have shared channels of trade or users, save at a very superficial level, are not in competition and are not complementary.

103. I consider that “information, advice and consultancy relating to the aforesaid” are similar to earlier specification to the same extent as the relevant services considered above.

⁵⁶ See <https://www.oed.com/view/Entry/88744?rkey=vewkPg&result=2&isAdvanced=false#eid> [accessed 31 January 2020].

Class 45 of the contested specification

Matchmaking services; personal introduction services; social networking services and online social networking services in the fields of personal introduction and matchmaking; providing web sites on the Internet for the purposes of social networking; personal introduction agency services; dating agency services; internet dating services; online social networking services accessible by means of downloadable mobile applications; social introduction agencies; social networking services; on-line social networking services; online social networking services accessible by means of downloadable mobile applications; personal network services; contact agencies

104. These services are identical to “dating services; internet based social networking, introduction and dating services” in class 45, either literally, because they are alternative ways of describing the same services or because they are identical on the principle outlined in *Meric*.

Providing information, advice and assistance about personal introduction and matchmaking; providing information, advice and assistance about personal introduction and matchmaking via wireless mobile devices, satellite, cable and global computer networks; personal advice services relating to matrimonial matters (non-legal); providing information and advice on relationships and marriage; personal advice services, namely, advice relating to relationships

105. I have already indicated that dating and introduction services will include information and advice about potential partners, as well as general dating advice and information about using the services. I do not consider that advice about matrimonial matters and marriage would be excluded from these services, as dating and introduction services at large will include dating and introduction services for those seeking matrimony. These services are identical to “dating services; internet based social networking, introduction and dating services”.

Marriage agency services; organising and arranging marriages

106. These services will coincide in nature and purpose with dating and introduction services but suggest services which also involve the mechanics of arranging a marriage, which would not, in my view, be the ordinary understanding of a dating service. Nevertheless, they are highly similar, as they are also potentially in competition with the earlier services and reach the market through the same channels. There is also potential for complementarity, as introduction services are likely to be important for the contested services and are likely to be perceived as the responsibility of the same provider.

Personal and social services rendered by others to meet the needs of individuals, namely provision of online personal, lifestyle and emotional tracking

107. These terms suggest services which offer individuals the means of recording and tracking various aspects of their lives. There is a degree of overlap in nature and purpose with the earlier “administering personality testing [...] creating personality profiles of others”, and there is potential for overlap in the way these services reach the market. There may also be a competitive relationship between these services. They are similar to a reasonably high degree.

Personal advice services, namely, advice relating to friendships

108. The opponent’s internet-based social networking and introduction services are not restricted to romantic relationships. The services are likely to include some information about connecting with potential friends online, though unlike dating services the provision of advice in relation to friendships does not strike me as likely to be an integral part of the services; there is no evidence on the point. The services are all concerned with enabling individuals to establish friendships and there is to that extent overlap in their purpose. There may be some overlap in their nature, they may be provided

through the same channels and there is a complementary relationship between these services. They are similar to a medium degree.

Personal advice services, namely, advice relating to personal appearance

109. It seems to me that advice about one's personal appearance is likely to go hand in hand with dating advice, which I have already indicated is an essential part of dating services at large. These services are complementary, to a reasonably strong degree and will share channels of trade. They are similar to a fairly low degree.

Provision of interactive personal calendars from a computer database or over the Internet

110. The closest terms in the earlier specification appear to be the social networking services in class 45. These services differ in nature and purpose but there is potential for complementarity, given that an interactive calendar may be used with social networking services in such a way that the same provider might be perceived to be responsible for both. There is a fairly low degree of similarity.

Organization of religious meetings

111. It seems to me that social networking would include social networks for individuals of the same faith or religious belief. However, a social networking site provides the means for others to connect, including potentially organising meetings amongst themselves, rather than providing the organisational service itself. The services differ in nature and purpose. They do not strike me as obviously competitive services, nor are they complementary. These services are not similar.

Identity verification services; services for corroboration of personal information

112. I have no evidence or submissions to explain what these services are. The terms imply a service which verifies personal information, such as by inspection and authentication of identification documents for individuals, whether in person or online. I can see no similarity with the opponent's goods or services: even where there is some type of user verification in using the goods or services, it is only likely to involve a password protection of an account, which is an almost universal feature of sites/apps where a user has an account. I do not think that, in such circumstances, the average consumer is likely to perceive any meaningful overlap or to consider the providers of the goods/services one and the same. These services are not similar.

Computer software licensing; exploitation of copyright protected material

113. Although the opponent's goods and services include software applications and, at least potentially, copyrighted material, this does not amount to offering software licensing or copyright exploitation as services. The nature and purpose of the respective goods and services differ. Further, software licensing and copyright exploitation services are business-to-business services and it is unlikely that the average consumer would consider these complementary as defined in the case law. These services are not similar to any of the goods and/or services in the earlier specification.

Advisory services relating to security

114. "Security" suggests the protection of a place.⁵⁷ I cannot see that there is any similarity between these services and any of the earlier goods and services, even bearing in mind that dating services might include advice about personal safety for those meeting strangers. That does not, in my view, equate to advice on "security": the nature of the advice will differ, as will its purpose (personal safety as opposed to protection of property) and there is no other obvious point of similarity.

⁵⁷ See <https://www.collinsdictionary.com/dictionary/english/security> [accessed 5 February 2020]

Arrangement, reservation, information, research, advice and assistance relating to all the aforesaid

115. These seem to be to be an integral part of the relevant services considered above. They are similar or not similar to the same extent, for the same reasons.

The average consumer and the nature of the purchasing act

116. It must be determined who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik*.

117. Ms Coates made no specific comments on the identity of the average consumer. Ms Jones submitted that the average consumer is a member of the public who will pay a normal level of attention. I agree that this one relevant group of consumer. I also consider that some of the similar goods and services, for example software development tools, may also be purchased by professional users. It is likely that, for both groups, a medium level of attention will be paid to the selection of the goods and services, with factors such as ease of use, range of tools and the reach of the goods and services being borne in mind. The goods and services are likely to be purchased by predominantly visual means, following consideration of websites and promotional material, mainly online but potentially, for example, on television or in print. There is some potential for aural exposure to the marks, which I will bear in mind.

Distinctive character of the earlier trade mark

118. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

119. Ms Jones submitted that the earlier mark has a “high degree of enhanced distinctiveness”.⁵⁸ Ms Coates submitted that “MATCH” is descriptive of dating or matchmaking agencies. I do not think that “MATCH” is inherently distinctive in relation to

⁵⁸ Opponent’s skeleton, §26.

dating services; it is little better for social media services more widely, concerned as they are with connecting people for a range of purposes. The only other element of the mark is “.COM”, which is not distinctive, as it is likely to be perceived as no more than indicating a top-level domain name. However, given the registered status of the mark, it must be accorded a minimum degree of distinctive character: *Formula One Licensing BV v OHIM*, Case C-196/11P. Given the non-distinctiveness of the individual elements, that distinctiveness is contained in the mark as a whole.

120. The opponent has filed a good deal of evidence to show use of the mark. I have no hesitation in finding that the use of MATCH.COM has enhanced its distinctive character in relation to dating services: the press reports, evidence of advertising, subscriber numbers and the market share data all point to this. The reach of the mark is such that it has become distinctive to a medium degree. Given the interdependence of the application software with the dating services, this finding extends to software for internet dating in class 9 of the earlier mark. The evidence does not show that the mark has been used in relation to wider social networking services or software such that its distinctiveness has been enhanced. It is distinctive to a low degree for the remaining goods and services in classes 9, 42 and 45.

Comparison of trade marks

121. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and

of their 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”.

122. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Contested mark
MATCH.COM	muzmatch

123. The earlier mark consists of “MATCH.COM” presented in capital letters. I have already indicated that the distinctiveness of the mark rests in its whole: neither element dominates.

124. The contested mark consists of the combination “muzmatch”, presented in lower case. Given that “match” is a common word, the average consumer, in my view, will identify the elements “muz” and “match” within the contested trade mark, though neither dominates and it will be seen as a unified whole. Ms Jones referred me to the *Urban Dictionary* to show that “muz” is slang for “Muslim”. I am doubtful that the average consumer would be aware with any certainty that “muz” is a known slang term. However, it seems likely that the average consumer would readily perceive “muz” as a shortened version of or alternative to the word “Muslim”. That being the case, “muz” has limited, if any, distinctiveness.

125. The marks share the word “MATCH”/“match” but it is at the beginning of the earlier mark and the end of the later mark. There are additional elements in both marks (“.COM” and “muz”). Bearing in mind the (non-)distinctiveness of the respective elements, these marks are visually similar to a medium degree.

126. Whilst it would be common for “.COM” suffixes not to be articulated, my view in this case is that the consumer may pronounce the earlier mark in full. As the later mark will be articulated as “muzmatch”, the pronunciation will share the identical element “match” but differ because of “DOT-COM” and “muz”. They are aurally similar to a fairly low degree in this instance. Should the earlier mark’s suffix not be articulated, the only point of aural difference is “muz” at the start of the contested mark. This results in a medium degree of aural similarity.

127. “Match” has a number of meanings, the most relevant of which are one of a pair, or to make a match (i.e. pair romantically). The same meaning will be attributed to the word in both marks. I have already indicated that “muz” is likely to be construed as a reference to “Muslim”. Accordingly, the contested mark will be interpreted as matching Muslims together. The earlier mark will be construed as matching people online. The marks are conceptually similar to a medium degree.

Likelihood of confusion

128. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct or indirect. Direct confusion involves the average consumer

mistaking one mark for the other, whilst indirect confusion involves the consumer recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC explained that:

“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 recognized 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”.

129. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

130. Where there is no similarity between the goods and services, there can be no confusion and the opposition against the dissimilar goods and services is dismissed accordingly.⁵⁹

131. The remaining goods and services are similar to varying degrees. However, they are all likely to be purchased with a medium level of attention. My view is that,

⁵⁹See, for example, *Waterford Wedgwood*.

notwithstanding the weakness of the element “MATCH”, this is a case where indirect confusion will apply, even for those goods/services which are similar to a low degree and even where the earlier mark is distinctive only to a low degree. That is because the “muz” element in the contested mark is insufficiently distinctive to detract from and to enable the consumer to draw a clear distinction between marks which would cause them to believe that the goods and services are manufactured/provided by different entities. The “.COM” element of the earlier mark is also lacking in distinctiveness and does not assist in distinguishing the economic operators: at best, it indicates an online business which, in the context of the goods and services at issue, is of no assistance to the applicant. It follows that where there is greater similarity between the goods and services, or where the earlier mark benefits from enhanced distinctiveness, confusion is only more likely. There is a likelihood of confusion where there is any similarity between the goods and services.

132. The opposition is successful under this ground except in respect of the following goods and services:

Class 9: Recorded and unrecorded sound and image media of all kinds; podcasts, audio and video recordings; downloadable electronic music, images, text and audio content; magnetic recording carriers and data carriers, and magnetic data carriers, optical data carriers; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites); instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites).

Class 35: Electronic data processing consultancy; advertising; display services for merchandising; mobile and electronic commerce services, namely, providing information about events, services and products via telecommunication networks for advertising and sales purposes; promoting the events, goods and services of others by

allowing users to recommend, rate and review the aforementioned events, services and products; updating of advertising material; merchandising, namely promotional placement of goods; retail services connected to printed matter, books, downloadable books and help guides, jewellery, flowers, cards, clothing, headgear, bags, purses, ties; business management and business information services; business administration; preparation of statistics; statistical services; organisation and operating of promotions events; presentation (promotion) of individuals on the Internet and other media; market research and information research services; information, consultancy and advice about any of the aforesaid services.

Class 38: Internet access provider services; providing multiple-users access to a global computer information network; providing access to a global computer network for the transfer and dissemination of information; collection and supply of news, including electronic news; providing access to e-commerce platforms on the Internet; providing access to hotlines.

Class 41: Publication of directories containing contact details of businesses; educational services relating to personal safety and security; arranging of competitions; community event services; organising community events; entertainment services for communities; electronic game services and competitions provided by means of the internet; information, advice and consultancy relating to the aforesaid.

Class 42: Operating an Internet search engine; display of electronic geographical maps; information, advice and consultancy relating to the aforesaid.

Class 45: Organization of religious meetings; identity verification services; services for corroboration of personal information; computer software licensing; exploitation of copyright protected material; advisory services relating to security; arrangement, reservation, information, research, advice and assistance relating to all the aforesaid; including (but not limited to) all the aforesaid services provided online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via

communications, telephone, mobile telephone and/or wireless and/or wired communication networks.

133. The opponent has been successful in respect of a large number of goods and services under s. 5(2)(b) insofar as the opposition is based on EU16246639. I am aware that appellate bodies have on occasion been critical of the tribunal's approach to "procedural economy" (see, for example, O/332/19). I also acknowledge that there are differences between the specifications of the earlier marks and that considered above, and that UK3097217 is a different mark which is arguably closer to the contested application. However, it would not improve the opponent's case if I were to reconsider the position in respect of all of the goods/services nor, given that the opponent has provided little more than outline submissions regarding the similarity between the goods and services, do I think it would be proportionate. From this point, I will therefore only consider the goods/services which I have found to be dissimilar.

Opposition under s. 5(2)(b) based on UK3097217

134. With the exception of "social escorting services", the specification of UK3097217 is subsumed within the services in class 45 of EU16246639, and I have already assessed similarity for these services. I do not think that "social escorting services" offer the opponent an improved position in respect of the goods and services which I have found dissimilar: there is no obvious point of similarity introduced by these services which would not apply to the earlier class 45 services already considered. The opposition against the dissimilar goods and services is also dismissed insofar as it is based upon UK3097217.

Opposition under s. 5(2)(b) based on EU182253

135. This mark is registered for "Information and consultancy services in the nature and field of on-line dating and introduction services" in class 42. I do not think that these services take the position further. I accept that the content of, for example, podcasts,

might concern dating. However, there is no evidence that this is a usual feature of dating consultancy (the opponent has been able to furnish evidence of only twelve videos over the whole relevant period) and it does not seem to me that there is a sufficient connection for there to be a materially complementary relationship. The opposition against the dissimilar goods and services also fails in respect of this mark.

Section 5(3)

136. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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”.

137. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*. 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.

(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*, paragraph 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*).

138. In *General Motors*, the CJEU considered the assessment of reputation as follows:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the

market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it".

139. As the earlier mark is an EUTM, I also keep in mind the guidance of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, EU:C:2009:611, at [20] to [30] and *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at [69].

140. My view is that the opponent has a strong reputation for dating services, for the reasons given at paragraph 120. "Information and consultancy services in the nature and field of on-line dating and introduction services" can legitimately be construed as indistinguishable from dating services, for the reasons given above. However, even if there is a difference, the scale of the opponent's reputation is such that it will still have a strong reputation for these services.

141. The question of whether a link will be established was considered in *Intel*, the factors being outlined at paragraph 123(d), above.

142. I adopt here my findings in relation to the similarity between the marks at paragraphs 125 to 127, above and my remarks at paragraph 135 in relation to the dissimilarity between the goods and services. I have found above that the mark's distinctiveness has been enhanced through use and that it is distinctive to a medium degree.

143. I do not consider that there would be any confusion in this case: the distance between the respective goods and services is sufficient to avoid such a likelihood.

144. Taking all these factors together, I find that the average consumer will make a link between the marks if the later mark is used on the following goods and services:

Class 9: Recorded and unrecorded sound and image media of all kinds; podcasts, audio and video recordings; downloadable electronic text and audio content; electronic publications, newsletters, magazines, periodicals, pamphlets, leaflets, instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites); instructional materials and teaching materials, provided on-line from computer databases, computer networks, global computer networks or the Internet (including web pages and web sites).

Class 35: Retail services connected to printed matter, books, downloadable books and help guides.

145. This is because all of these goods and services could be concerned with media, publications or instructional material relating to dating. Given the strength of the reputation and the similarities between the marks, as well as what I consider to be a sufficiently close relationship between the fields of activity, use of the later mark on these services is liable to bring the earlier mark to mind despite the dissimilarity between the goods and services and the only medium distinctiveness of the earlier mark.

146. I do not think that the earlier mark would be brought to mind for the remaining goods and services. The fields of activity here are, in my judgement, too remote for the reputation and distinctiveness of the earlier mark to bridge the gap, despite the similarities between the marks. The opposition against these services under s. 5(3) is dismissed.

Unfair advantage

147. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

148. The evidence shows that the opponent has a strong reputation for dating services. It strikes me as the sort of reputation which would attract potential users to services which are perceived as being related to MATCH.COM. The similarity of the contested mark to the earlier mark, when used on the services listed at paragraph 144, all of which could concern dating and be perceived as related to the opponent's MATCH.COM business, is sufficient to result in an unfair advantage being taken of the reputation of the earlier mark. Even where consumers did not think that the user of the later mark did so under licence or via a consent agreement with the earlier mark's owners, the use of the later mark would still attract consumers to the applicant's services on the back of the opponent's reputation in the MATCH.COM trade mark. This is likely to benefit the applicant economically without any financial compensation being paid to the opponent.

Detriment to distinctive character

149. The opponent claims that the earlier mark will be diluted by use of the contested mark. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment)”.

It went on:

“42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.⁶⁰

150. There is no evidence that there has been a change in the economic behaviour of the opponent’s customers or that there is a serious likelihood of such a change. There is also not, in my view, an obvious reason why in this case the presence of another mark,

⁶⁰ See also *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch) at [133], in which the judge held that a change in consumers’ economic behaviour could be inferred from the inherent probabilities of the situation and para. 137 of - *Ziff Management Europe Ltd v Och Capital LLP* [2011] F.S.R. 11 (HC).

albeit similar to a degree to the earlier mark, would result in a change in the economic behaviour of the opponent's customers for the services at issue. The services are too far removed for there to be an adverse effect on the earlier mark's ability to designate the services in which it has a reputation. Nor has the opponent provided persuasive reasons why its customers would switch allegiance if the contested mark were used on the dissimilar services. The s. 5(3) ground based on damage to distinctive character is rejected.

Detriment to reputation

151. In *Unite The Union v The Unite Group Plc*, BL O/219/13, Anna Carboni, sitting as the Appointed Person, considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She said:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to repute of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps

for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account”.

152. I reject the tarnishing pleading for the following reasons:

- i) There is nothing in the provision of the services at issue which would cause any form of negative reaction;
- ii) The claim of tarnishing is no more than hypothetical;
- iii) There is no evidence that the applicant already has a negative reputation.

Section 5(4)(a)

153. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or


(b) [.....]

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”.

154. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. 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 (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)”.

155. For all of the reasons given above, I am satisfied that the opponent had at the relevant date goodwill in a business providing dating services, with which the sign MATCH.COM is associated. I extend that finding to , which the evidence shows has been used on various advertising material and the opponent’s own website. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Whilst there is no requirement, under section 5(4)(a), for the parties to be in the same field of activity, the distance between the parties’ goods and services remains a relevant factor. The distance between the goods and services for which the opponent was unsuccessful under s. 5(2)(b) remains too great for there to be a misrepresentation under s. 5(4)(a).

The opposition based upon this ground against these goods and services is also dismissed.

Section 3(6)

156. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

157. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

158. In *John Williams and Barbara Williams v Canaries Seaschool SLU*, BL O-074-10, Mr Geoffrey Hobbs QC as the Appointed Person stated that:

"21. I think it is necessary to begin by emphasising that a decision taker should not resort to the burden of proof for the purpose of determining the rights of the parties in civil proceedings unless he or she cannot reasonably make a finding in relation to the disputed issue or issues on the basis of the available evidence, notwithstanding that he or she has striven to do so: *Stephens v. Cannon* [2005] EWCA Civ. 222 (14 March 2005)."

159. In *Holzer y Cia de CV v EUIPO*, joined cases T-3/18 and T-4/18, the GC held (at paragraph 36 of the judgment) that although there is a presumption of good faith, the objective circumstances of a particular case may lead to the rebuttal of that presumption. In that event, it is for the applicant or proprietor of the trade mark to provide plausible explanations on the objectives and commercial logic pursued by the application for registration of the trade mark.

160. The opponent's pleaded case under this ground is that, having filed EUTM 14794325 (which the opponent successfully opposed) and UK 3293695 (withdrawn following a without notice opposition from the opponent), the filing of UK3322132 falls short of the standards of acceptable commercial behaviour. Although Ms Jones repeated the claim that the repeated filing of the same application is an abuse of process, she added the claims that in making the application the applicant is trying to

trade off the opponent's reputation, that "at least some" of the specification for which registration is sought is impossibly broad and there can be no intention to use.

161. It is well established that parties must make their claims clearly and, if not at the start of proceedings, as soon as possible. Ms Jones made no application to amend the opponent's pleadings at the hearing. The claims that the specification is impossibly broad and that there is no intention to use have no precursor in the notice of opposition.

162. In my view, it would be unfair to allow these claims into the proceedings at this stage, when the applicant has no opportunity to respond properly. The claim to overly broad specifications is, in any event, not clear: the goods/services identified in the skeleton argument appear to be examples only. The CJEU has also recently confirmed in *Sky plc and Others v Skykick UK Limited and Skykick Inc*, Case 371/18 EU:C:2020:45 that a trade mark cannot be declared wholly or partially invalid on the ground that terms used to designate the goods and services in respect of which that trade mark was registered lack clarity and precision (i.e. this is not an absolute ground of invalidity). I see no reason why this point would not be applicable by analogy to opposition proceedings. I will therefore consider only the complaint raised in the notice of opposition as served on the applicant.

163. Only one of the other cases has proceeded to a final determination and, as Ms Coates pointed out in her witness statement, consideration of the average consumer may differ between the UK and the EU. I also note, as Ms Coates did at the hearing, that the three trade mark applications are not for the same goods and services: the instant application is much wider in scope than either of the earlier applications. Whilst I have some sympathy for the opponent's position, and I do not rule out that repeated attempts to register substantially the same mark might amount to bad faith, I do not consider that the hurdle has been cleared in this case. The ground under s. 3(6) is dismissed.

Conclusion

164. The application will proceed to registration for the following goods and services:

Class 9: Downloadable electronic music and images; magnetic recording carriers and data carriers, optical data carriers.

Class 35: Electronic data processing consultancy; advertising; display services for merchandising; mobile and electronic commerce services, namely, providing information about events, services and products via telecommunication networks for advertising and sales purposes; promoting the events, goods and services of others by allowing users to recommend, rate and review the aforementioned events, services and products; updating of advertising material; merchandising, namely promotional placement of goods; retail services connected to jewellery, flowers, cards, clothing, headgear, bags, purses, ties; business management and business information services; business administration; preparation of statistics; statistical services; organisation and operating of promotions events; presentation (promotion) of individuals on the Internet and other media; market research and information research services; information, consultancy and advice about any of the aforesaid services.

Class 38: Internet access provider services; providing multiple-users access to a global computer information network; providing access to a global computer network for the transfer and dissemination of information; collection and supply of news, including electronic news; providing access to e-commerce platforms on the Internet; providing access to hotlines.

Class 41: Publication of directories containing contact details of businesses; educational services relating to personal safety and security; community event services; organising community events; entertainment services for communities; electronic game services and competitions provided by means of the internet; information, advice and consultancy relating to the aforesaid.

Class 42: Operating an Internet search engine; display of electronic geographical maps; information, advice and consultancy relating to the aforesaid.

Class 45: Organization of religious meetings; identity verification services; services for corroboration of personal information; computer software licensing; exploitation of copyright protected material; advisory services relating to security; arrangement, reservation, information, research, advice and assistance relating to all the aforesaid; including (but not limited to) all the aforesaid services provided online, and/or provided for use with and/or by way of the Internet, the world wide web and/or via communications, telephone, mobile telephone and/or wireless and/or wired communication networks.

165. The opposition has succeeded in relation to all of the remaining goods and services for which registration will be refused.

Costs

166. The lion's share of success has gone to the opponent, which is entitled to an award of costs. Costs are sought on the scale (Tribunal Practice Notice (2/2016) refers), though I will reduce the award by ten per cent to reflect the partial success of the applicant. I award costs to the opponent as follows:

Official fee:	£200
Filing the notice of opposition and considering the counterstatement:	£200
Filing evidence and considering the other party's evidence	£600
Preparing for and attending a hearing:	£800
Sub-Total:	£1,800

Less 10% (£180)

£1,620

Total:

£1,620

167. I order muzmatch Ltd to pay Match Group LLC the sum of **£1,620**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of February 2020

Heather Harrison

For the Registrar

The Comptroller-General