O/0939/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3754581
BY MARK LYNCH

TO REGISTER:

MatchMate

MATCHMATE

Match Mate

AS A SERIES OF TRADE MARKS IN CLASSES 9, 38, 41, 43 & 45

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 433897 BY
MATCH GROUP, LLC

BACKGROUND AND PLEADINGS

1. On 14 February 2022, Mark Lynch ("the applicant") applied to register **MatchMate**, **MATCHMATE** and **Match Mate** as a series of three trade marks in the United Kingdom in respect of the following goods and services:

> *Class 9*
> *Mobile apps; Mobile app's; Mobile software; Communication, network and social networking software; Social software.*
>
> *Class 38*
> *Chat room services; Forums [chat rooms] for social networking; Operating chat rooms; Chat room services for social networking; Providing Internet chat rooms; Providing on-line chat rooms for social networking; Providing voice chat services; Providing online chat rooms and electronic bulletin boards; Providing on-line chat rooms for transmission of messages among computer users.*
>
> *Class 41*
> *Social club services for entertainment purposes; Entertainment services in the nature of organizing social entertainment events; Entertainment services in the nature of arranging social entertainment events.*
>
> *Class 43*
> *Hiring of rooms for social functions; Rental of rooms for social functions.*
>
> *Class 45*
> *Online social networking services; Online social networking services accessible by means of downloadable mobile applications; On-line social networking services; Dating services provided through social networking; Internet-based social networking services; Internet based matchmaking services; social introduction agency services; Social introduction services.*

2. On 30 May 2022, the application was opposed by Match Group LLC ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and concerns all the goods and services in the application.

3. Under section 5(2)(b), the opponent is relying on the following earlier marks:

UKTM No. 3415177 ("the 177 mark") match Filing date: 19 July 2019 Registration date: 11 October 2019 *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 updated 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.*
UKTM No. 916246639 ("the 639 mark") MATCH.COM Filing date: 13 January 2017 Registration date: 13 November 2019 *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 updated 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.

UKTM No. 3638131 ("the 131 mark")

MatchGroup

Filing date: 7 May 2021

Registration date: 26 November 2021

Class 9

Downloadable software in the nature of a mobile application for internet-based dating and matchmaking; 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; Downloadable software for enabling instant messaging; downloadable software for enabling social networking; downloadable software for accessing, sending, receiving, posting, and sharing images, audio, video, text, links, data, and information via the internet; downloadable software for use in communications between speakers of different languages by means of language translation and subtitling; Downloadable software for creating, producing, editing, manipulating, transmitting, uploading, downloading, and sharing electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks.

Class 35

Advertising consultation; Advertising and promotional services; Advertising and publicity services; Advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through on-line medium; Advertising services, namely, promoting the brands, goods and services of others.

Class 38

Telecommunication services, namely, providing on-line chat rooms for the transmission of messages among users in the fields of current events, elections, public affairs, world affairs, national affairs, local affairs, television programs, radio programs, movies, entertainment programming, media programming, podcasts, lectures, music and to engage in social networking; Providing on-line forums for transmission of real-time messages among computer users; Transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks; Providing interactive electronic voice messaging by means of the Internet; providing online voice messaging in the field of dating, friendships and social relationship via computer services; telecommunications services, namely, personal communication services; text messaging services; telecommunication services, namely, anonymous relay of voice and text messages; Instant messaging services; providing on-line chat rooms for social networking; videoconferencing services for social networking; telecommunication services, namely, electronic transmission and delivery of images, audio, video, text, links, data, and information via the internet; Transmission of sound, video and information from web cams, video cameras or mobile phones, all featuring live or recorded materials.

Class 41

Provision of non-downloadable publications in the nature of articles in the fields of mobile application dating, internet-based dating, matchmaking, interpersonal relationships, social introduction and social networking; Entertainment services, namely, providing on-line non-downloadable interactive game software; Entertainment services, namely, providing temporary use of non-downloadable interactive game software for use with personal computers and mobile devices for the purpose of accessing online dating services; Provision of an online journal in the nature of a blog featuring articles in the fields of mobile application dating, internet-based dating, matchmaking, interpersonal relationships, social introduction and social networking; Educational and entertainment services, namely, continuing programs about dating and relationships accessible by means of Internet streaming, video

on demand, web-based applications, computer networks, and other forms of transmission media, namely, radio, television, satellite, audio and video; entertainment, namely, live music concerts, arranging and conducting of concerts; Organizing and arranging social entertainment events; providing a web site featuring information and recommendations about social entertainment events; providing graphics, music, audio, video clips, multimedia content, and visual and audio performances; Providing non-downloadable music videos over the Internet or other communications networks; Ongoing multimedia program featuring advice and stories about dating, modern love, interpersonal relationships, social introduction, and social networking.

Class 42

Providing temporary use of non-downloadable software for use in posting, transmitting, retrieving, accessing, receiving, reviewing, sharing, organizing, searching and managing text, audio, data, visual and multimedia data, information and content; providing temporary use of non-downloadable software for online introduction, dating and social networking services; providing temporary use of non-downloadable software for use in soliciting feedback; providing temporary use of non-downloadable software that enables users to send status updates and to share content and electronic files with others; providing temporary use of non-downloadable software for calculating, mapping, transmitting and reporting information relating to the location, movement, proximity, departure and arrival of individuals and objects via computers, mobile phones, wired and wireless communication devices, and optical and electronic communications networks; Providing customized on-line web pages and data feeds featuring user-defined information on dating, matchmaking, relationships, entertainment, social issues, beauty, current events, events and popular culture which also include blog posts, new media content, other on-line content, and on-line web links to other websites; Creating a virtual environment in the nature of an online community for registered users to create, produce, edit, manipulate, transmit, share, and comment on videos or other electronic media.

Class 45

Dating services; Computer dating services; Dating services provided via mobile applications; Dating services, namely, providing information in the field of dating via an on-line computer database featuring single people interested in meeting other single people; Internet-based social networking, social introduction, and dating services; Online social networking services.

4. The above marks qualify as earlier marks pursuant to section 6(1) of the Act by virtue of their earlier filing dates. As all of them were registered less than five years before the application date of the contested mark, the opponent may rely on all the goods and services for which they stand registered.

5. The opponent claims that the marks are similar, containing the identical element "MATCH", and that the goods and services covered by the marks are either identical or similar. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. Under section 5(3), the opponent is relying on the 177 and the 639 marks, which it claims have a reputation for all the goods and services for which they stand registered. It claims that use of the contested marks would take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks.

7. Under section 5(4)(a), the opponent claims to have used the following signs throughout the UK for *Dating services; online dating and introduction services; internet based social networking*:

Sign	**Date of first use**
MATCH.COM	January 1995
	March 2015
	March 2015

8. The opponent claims that it has accrued substantial goodwill in the signs, such that it is consistently recognised as being in the top 5 dating service providers in the UK. The use of the contested mark would cause a misrepresentation which could lead to damage, either through lower quality goods and services or a diversion of revenue.

9. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of reputation and goodwill.

10. Only the opponent filed evidence in these proceedings. It comes from Julien Chouteau, Vice President Finance & Analytics for Meetic SAS, a wholly-owned indirect subsidiary of the opponent that is exclusively licensed to use the earlier marks in the UK and the EU. His witness statement, dated 13 January 2023, goes to the reputation and goodwill of the earlier marks and signs.

11. Neither side requested a hearing, and the opponent filed final written submissions on 25 April 2023. The applicant made no submissions.

12. In these proceedings, the opponent is represented by Barker Brettell LLP and the applicant by Revomark.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act is as follows:

> "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."

14. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union

("CJEU") in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):[1]

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

[1] Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269, Schedule 5. Further information is provided in Tribunal Practice Notice 2/2020.

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 greater 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; and

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

Average consumer and the purchasing process

15. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 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*, paragraph 26.

16. The average consumer of the goods and services at issue would be a member of the general public. The opponent's submissions focus on *Dating services* and the related Class 9 goods. It argues that the average consumer would be paying a lower degree of attention, as they would be accessing the services through portable

handheld devices and doing so while they were at the same time engaged in another activity, such as commuting or watching television. This raises a question about when the purchasing process takes place. In my view, it is when the average consumer decides that they will sign up to a dating or social networking service. At this point, they will be required at the very least to enter some personal details. I find that the process will be relatively considered and, in my view, the average consumer will be paying at least a medium degree of attention.

17. The purchasing process will largely be visual, as the average consumer will see the mark used on the internet or in an App Store, or have seen promotional material in print, online or on television. I shall not, however, discount the aural aspects of the marks, as the average consumer may also have received word-of-mouth recommendations. I consider that these findings apply to all the goods and services at issue, not just dating or social networking services.

Comparison of marks

18. It is clear from *SABEL* (particularly at paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

19. The respective marks are shown below:

Contested series of marks	Earlier mark
MatchMate MATCHMATE Match Mate	<u>The 177 mark:</u>  <u>The 639 mark:</u> MATCH.COM <u>The 131 mark:</u> 

20. The contested series of marks consists of the words “MATCH” and “MATE” presented in three different ways: joined as a single word with each letter “M” in capitals; joined as a single word with all letters in capitals; and as two words in title case. I consider that, even in the fully capitalised version, the average consumer is likely to identify the two words, as, although they do not analyse the various details of a mark, they tend to break down verbal signs into elements that resemble known words or have a concrete meaning: see *Usinor SA v OHIM*, Case T-189/05, paragraph 62. The overall impression of each of the marks in the series lies in the juxtaposition of the words “MATCH” and “MATE”, with neither word playing an independent distinctive role. In my view, nothing turns on the different presentations of the marks in the series and so I shall refer to them in the singular from now on.

21. The 177 mark consists of the word “MATCH” in bright blue, lower case letters. To the right of the word a small heart in the same shade of blue is level with the ascender of the letter “H”. The word is considerably larger and also appears at the beginning of

the mark. In the context of the goods and services connected with dating, the heart is allusive of the purpose of the good and services, which is to find a romantic partner. As such, the word “MATCH” is the dominant and distinctive element of this mark. Where the goods and services are related to social networking and social media more generally, the heart is not allusive, but its position at the end of the mark and its relative size lead me to find that it plays only a small part in creating the overall impression of the mark. In my view, the colour also makes only a minor contribution.

22. The 639 mark consists of the words “MATCH.COM”. The suffix “.COM” is likely to be perceived as indicating that the goods and services in respect of which the mark stands registered are provided online. Consequently, I find that “MATCH” is the dominant and distinctive element of the mark.

23. The 131 mark is a composite mark consisting of the words “Match” and “Group” joined into a single word, with a capital “M” and “G”, and a device. This device appears to be a highly stylised “MG” with two dots above the “M”. The presence of the two dots means that the average consumer might perceive the device to include two people. Turning to the words, I consider that “Group” will be perceived as a reference to the corporate structure of the opponent and so it is “Match” that is the distinctive part of the verbal element. The device is relatively large and appears at the top of the mark. However, verbal elements tend to be regarded as more distinctive than figurative elements: see *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37. In my view, both the verbal and figurative elements have independent distinctive roles, with greater weight attaching to the words. I find that the contribution made by the device is, however, far from negligible.

Comparison with the 177 mark

24. The contested mark is a word mark and fair and notional use of that mark would include its use in the same bright blue of the 177 mark and with all letters in lower case: see *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, paragraph 39. The first five letters of the marks are identical, with points of difference being the additional letters in the contested mark and the heart in the 177 mark. I find that the marks are visually similar to a medium degree.

25. The verbal elements of the marks are standard English words and will be pronounced in the usual way. The 177 mark has one syllable and the contested mark has two. I find that the marks are aurally similar to a medium degree.

26. The word "match" has a number of different meanings. The opponent submits that it does not have a meaning in relation to the goods and services at issue:

> "Quite simply, people are not a 'match' for one another, for as complex human beings there are simply too many variables for a 'match' to really be possible. References to people being a 'match' are generally in a specific medical sense, for attributes that are definable and quantifiable, a 'blood type match' or a 'donor match' for example."[2]

27. I disagree with the opponent. The average consumer would not, in my view, assume that describing one person as a match for another meant that these people were identical or even nearly identical. Rather, in the context of the goods and services, they would understand the term to refer to a person who was well-suited to another. I consider that it would be interpreted in the same way in both marks. As I have already found, the heart in the 177 mark suggests that the match would be a romantic one. I agree with the opponent that "MATE" in the contested mark would be understood to mean a friend, or someone who shares activities or facilities (such as a workmate or a housemate), or a spouse or sexual partner. In my view, it is the last of these meanings that is most likely to be brought to mind when used with the word "MATCH". I find that the marks are highly conceptually similar.

Comparison with the 639 mark

28. The visual differences between the marks come down to the suffixes ".COM" and "MATE". The length of these is similar. Bearing in mind the non-distinctiveness of ".COM", I find the marks to be visually similar to a medium to high degree.

[2] Written submissions, paragraph 24.

29. Turning to the aural comparison, I note that a non-distinctive element cannot automatically be assumed to be disregarded: see *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd (PURITY HEMP COMPANY IMPROVING LIFE AS NATURE INTENDED)*, BL O-115-22, paragraph 31. In my view, the 639 mark is likely to be articulated as "MATCH-DOT-COM", with three syllables as opposed to the two of the contested mark. The first of these syllables is identical. I find that the marks are aurally similar to a medium degree.

30. The average consumer is likely to perceive the word "MATCH" in the 639 mark in the same way as in the 177 mark, with the ".COM" element merely indicating that the goods and services are provided online. I find that the marks share a medium to high degree of conceptual similarity.

Comparison with the 131 mark

31. The device is a clear point of difference between the 131 and the contested marks. The suffixes "MATE" and "GROUP" also differ. Again, I note that the non-distinctiveness of "GROUP" does not mean that it should be disregarded. I find that the marks are visually similar to a low degree.

32. The verbal element is the only part of the 131 mark that is likely to be spoken and the words would be given their standard English pronunciation. The number of syllables in the marks is the same and I find that they are aurally similar to a high degree.

33. As with the other earlier marks, "MATCH" is likely to bring to mind a person well-suited to another. This meaning may be reinforced if the average consumer sees the device as depicting two people. If they do not see it in this way, the device is unlikely to have any conceptual content. "GROUP" is, as I have already found, likely to be understood as a reference to the corporate structure of the opponent. I find that the marks share a high degree of conceptual similarity.

Distinctive character of the earlier marks

34. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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)."

35. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

36. In the context of *Dating services* and other goods and services connected with dating, the word "MATCH" is descriptive, or at least allusive, as is the heart device from the 177 mark. However, a registered trade mark must be assumed to have at least some inherent distinctive character: see *Formula One Licensing BV v OHIM*, Case C-196/11 P, paragraphs 41-44. I find that the inherent distinctiveness of the mark for these services is very low. I consider that it is not much higher in relation to goods and services associated with social networking as these goods and services are intended to connect people. The heart device is not necessarily allusive, and so I find that the inherent distinctiveness of the 177 mark for these services is low to medium. For reasons that shall become apparent, I do not consider it necessary to make a

specific finding on the distinctiveness of the 177 and 639 marks in relation to the Class 42 services.

37. Turning to the 639 mark, the suffix ".COM" is not distinctive, as I found that it would be perceived as indicating a website from which the consumer can obtain the goods and services. I find the inherent distinctiveness of the mark for the Class 9 goods and Class 45 services is very low for goods and services related to dating and low for goods and services associated with social networking.

38. The presence of the device in the 131 mark increases the inherent distinctive character of "MatchGroup", which on its own is very low, to a low to medium level for goods and services connected with dating. I find the level of inherent distinctive character would also be medium for *Downloadable software in the nature of a mobile application for enabling social networking; Telecommunication services, namely, providing on-line chat rooms for the transmission of messages among users in the fields of current events, elections, public affairs, world affairs, national affairs, local affairs, television programs, radio programs, movies, entertainment programming, media programming, podcasts, lectures, music and to engage in social networking;* and *Online social networking services* because social networking, as I have already found, is a way of connecting people and the device elevates the otherwise low distinctiveness of "MatchGroup". I consider that "Match" is not descriptive or allusive for some of the Class 35 and Class 41 services, such as *Social club services for entertainment*, and so I find that the inherent distinctiveness of the mark for these services is slightly above medium, thanks to the part played by the device.

39. The opponent submits that the inherent distinctiveness of the 177 and 639 marks has been enhanced through the use made of them. Mr Chouteau states that the 639 and 177 marks have been used in the UK since 1995 and 2015 respectively.[3] A mobile phone application was launched in 2008.[4] The table below shows the number of UK downloads of that application since 2015:[5]

[3] Witness statement, paragraph 4.
[4] *Ibid*, paragraph 11.
[5] Witness statement, paragraph 25.

Year	UK
2015	383 194
2016	458 418
2017	403 789
2018	377 956
2019	360 711
2020	476 366
2021	408 279
2022	359 974

40. Mr Chouteau states that not all UK users access the opponent's services through a mobile app. The following table shows the number of active users who have visited its UK website during the 28 days ending on 31 October for each of the given years:[6]

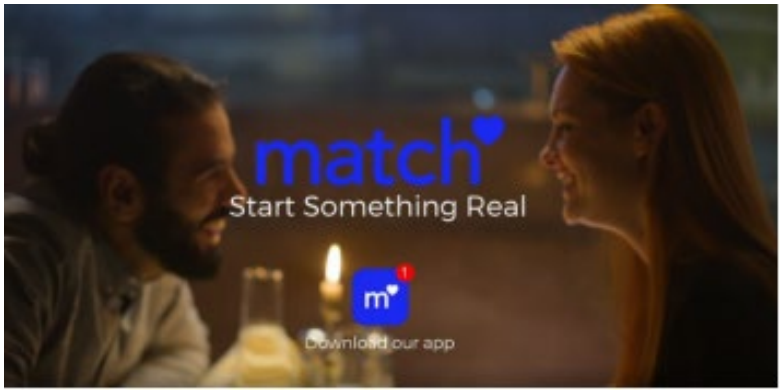
Domain	2016	2017	2018	2019	2020	2021	2022
uk.match.com	564 080	462 481	358 826	366 863	364 990	294 149	266 877

41. Subscription revenue, which is derived from users of both the website and the mobile app, is shown in the table below:[7]

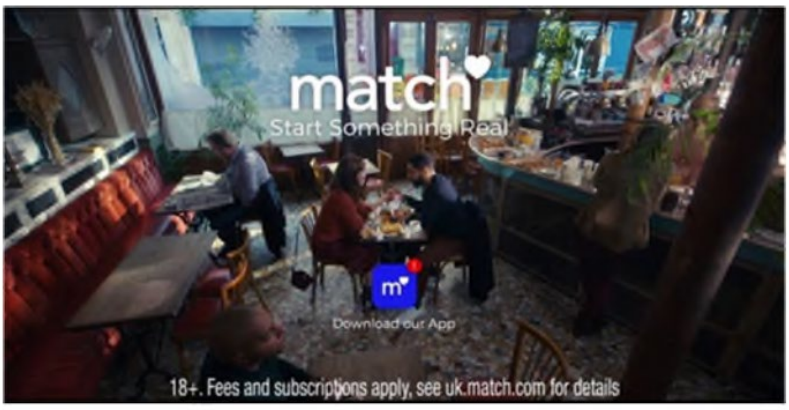
Year	Match UK Subscription Revenue (£)
2021	21 351 710
2020	21 902 234
2019	21 569 081
2018	23 511 575
2017	27 235 631
2016	29 223 124
2015	28 117 724
2014	30 534 640
2013	30 196 959

[6] *Ibid*, paragraph 26.
[7] *Ibid*, paragraph 28.

42. Dating services have been advertised on television since 2015 when the Match and heart logo was introduced, and the following still from a January 2019 advert shows that logo as it is registered in the 177 mark:



A still from a further advert from January 2021 shows the website address, which includes the 639 mark and the Match and heart logo in white.[8]



43. Mr Chouteau's witness statement contains further examples of advertisements dating between 2015 and 2022. All contain the Match and heart logo and some the 639 mark. The former is sometimes shown in blue, as in the 177 mark; sometimes, as above, it appears in different colours. The General Court ("GC") held in *adidas AG v EUIPO*, Case T-307/17, that:

[8] *Ibid*, paragraph 19.

> "59. It follows that the forms of use of a mark referred to in Article 15(1) of Regulation No. 207/2009, including those which differ only by 'elements which do not alter the distinctive character of [that] mark', must be taken into account not only in order to determine whether that trade mark has been put to genuine use within the meaning of that provision, but also for the purpose of determining whether that mark has acquired distinctive character through the use which has been made of it within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009."

44. In my view, the use of a different colour for the Match and heart logo does not alter the distinctive character of the 177 mark and so I consider that such use is relevant for the purposes of determining whether the distinctive character of the 177 mark has been enhanced through use.

45. Mr Chouteau states that the advertisements were shown on ITV, E4, Channel 4, Channel 5, MTV, Sky One, 5Star and TLC.[9] UK advertising expenditure is shown in the table below:[10]

UK € (000s)	2015	2016	2017	2018	2019	2020	2021
TV	10 745	8 595	7 100	3 330	465	1 470	618
Video On Demand/ Catch Up TV	950	905	600	520	375	484	250
Video On Line	755	395	210	595	255	288	179
Radio/ Web Radio	0	305	155	-	465	889	637
Press	10	-	-	190	255	-	-
Out of Home/ Digital Out of Home	300	200	105	-	225	-	-
Cinema	15	15	-	140	-	-	-

46. This table shows expenditure on other forms of advertising and Mr Chouteau says that the marks are promoted through social media campaigns on Facebook, Twitter, Instagram and YouTube.[11] He also states that the opponent engages in online

[9] *Ibid*, paragraph 21.
[10] *Ibid*, paragraph 22.
[11] *Ibid*, paragraph 18.

advertising which would have had an impact on the UK, although it would not have been restricted to this territory.[12]

€ (000s)	*Advertising*	*Affiliation*	*Brandname Match*	*Sponsored Links*
2015	2 543	2 541	728	1 934
2016	3 218	2 063	740	1 566
2017	3 274	2 495	537	1 699
2018	1 709	2 766	p722	2 173
2019	1 465	2 427	461	1 917
2020	1 249	3 490	621	2 330
2021	933	3 414	363	2 170

47. Mr Chouteau has also provided the results of studies carried out by IPSOS on awareness of the brand. Among single people aged between 25 and 65 in the UK, the opponent was consistently in the top three providers of dating services between 2014 and 2021 and in the top two of brands either tried or considered during the same period. Between 2014 and 2019, the opponent was in the top four brands used, ninth in 2020 and seventh in 2021.[13]

48. Exhibit JC5 contains a collection of articles from 2015 to 2021 from websites and newspapers, including *Metro, Birmingham Live*, hitched.co.uk and *The Observer*, featuring match.com in lists of dating sites and apps.

49. I am satisfied that the evidence shows that the distinctive character of both marks has been enhanced to a medium to high degree for *Dating services* and for *Downloadable software in the nature of a mobile application for internet-based dating*. I find that it has not been enhanced for the remaining goods and services.

Comparison of goods and services

50. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services,

[12] *Ibid*, paragraph 23.
[13] *Ibid*, paragraphs 13-15.

their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].

51. As I found that the 177 and 639 marks provided the closest comparison to the contested mark, I shall focus on these marks for the comparison of the goods and services, except where I consider that the 131 mark improves the opponent's position.

Class 9

52. The contested *Mobile apps; Mobile app's; Mobile software* are all broad terms that would include the opponent's *Downloadable software in the nature of a mobile application for internet-based dating and introduction* (177 and 639 marks). Where goods (or services) in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. Consequently, I find that the goods are identical.

53. I turn to *Social software*. In construing the meaning of terms in the specifications, I am required to consider their ordinary and natural meanings: see *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraph 12. In my view, *Social software* is software that enables people to make social connections. Consequently, it is my view that it would include the opponent's *Downloadable software in the nature of a mobile application for internet-based dating and introduction* and so be identical per *Meric.*

54. The final term in Class 9 is *Communication, network and social networking software*. I understand this to denote software that enables users to make connections, communicate with others and form relationships. I find that it includes the opponent's *Downloadable software in the nature of a mobile application for internet-based dating* and *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* (177 and 639 marks). They are identical per *Meric*.

Class 38

55. These services are *Chat room services; Forums [chat rooms] for social networking; Operating chat rooms; Chat room services for social networking; Providing Internet chat rooms; Providing on-line chat rooms for social networking; Providing voice chat services; Providing online chat rooms and electronic bulletin boards; Providing on-line chat rooms for transmission of messages among computer users.* I understand that a chat room is an online means of enabling users to comment on and discuss particular issues.

56. All these services include the opponent's *Telecommunication services, namely, providing on-line chat rooms for the transmission of messages among users in the fields of current events, elections, public affairs, world affairs, national affairs, local affairs, television programs, radio programs, movies, entertainment programming, media programming, podcasts, lectures, music and to engage in social networking* from the specification of the 131 mark. I find that these services are identical per *Meric*.

57. I shall also compare these services with *Internet based social networking* from the 177 and 639 marks. These services would be targeted towards the same users as the applicant's Class 38 services and their method of use would be highly similar. Both services would be used by people who want to interact with others online. The trade channels are likely to be similar, as the services will all be accessed through the internet. I consider that there is a degree of complementarity which the General Court said in paragraph 82 of *Boston Scientific Ltd v OHIM*, Case T-325/06, means that there is a close connection between the services in that one is important or indispensable for the use of the other in such a way that customers think that they are the responsibility of the same undertaking. I consider that would be the case here. I find that the services are highly similar.

Class 41

58. The contested *Entertainment services in the nature of organising social entertainment events* and *Entertainment services in the nature of arranging social entertainment events* are identical to the opponent's *Organizing and arranging social*

entertainment events in the specification of the 131 mark. The opponent's services would also fall under the broader heading of *Social club services for entertainment purposes* as the organisation and arranging of social entertainment events is a service provided by social clubs. I find that they are identical, but, if I am wrong in this, they are highly similar.

59. The opponent submits that the contested Class 41 services are highly similar to its Class 45 services as *"social networking is a form of entertainment which often involves the arranging of social entertainment events … and so there is an obvious overlap in the nature, intended purpose and trade channels"*.[14] I note, however, that the term in the opponent's specification is in fact *Internet based social networking*. I am required not to be overly liberal in my interpretation of terms, particularly where they apply to services, but rather confine them to the *"core of the ordinary and natural meaning"*: see *FIL Limited & Anor v Fidelis Underwriting Limited & Ors* [2018] EWHC 1097 (Pat), paragraph 86. Nevertheless, I consider that the arrangement or organisation of an event may be done through internet-based social networking and so there is likely to be some degree of overlap in the factors mentioned by the opponent. I also consider that there will be an overlap in user. Overall, I find that there is a medium degree of similarity between the services. However, I do not consider that there is any similarity between *Social club services for entertainment purposes* and *Internet-based social networking*.

Class 43

60. The opponent submits that the contested *Hiring of rooms for social functions* and *Rental of rooms for social functions* are similar to its social networking services for the same reasons. The purpose of the applicant's services is to provide facilities in which social functions can take place. The user of the services is therefore the entity that is arranging the social function. The nature of the service is different, as is the purpose. I do not consider that there will be an overlap in trade channels or that the services are in competition or complementary. I find them to be dissimilar.

[14] Written submissions, paragraph 36.

Class 45

61. The contested *Online social networking services; Online social networking services accessible by means of downloadable mobile applications; On-line social networking services; Internet-based social networking services* are self evidently identical to the opponent's *Internet based social networking* (177 and 639 marks) and *Online social networking services* (131 mark).

62. I also consider that they are similar to the opponent's *Dating services* as they overlap in user and may have a similar method of use and nature, as the opponent's term includes services provided on the internet. They are not complementary and I have been provided with nothing to tell me whether there are shared trade channels. There may be some degree of competition, as users seek potential partners through both services. Overall, I find the degree of similarity to be medium.

63. The contested *Dating services provided through social networking* are included in the opponent's *Dating services* and so are identical per *Meric. Internet based matchmaking services* may also be included in *Dating services*, but if I am wrong in this, they are highly similar.

64. The contested *Social introduction agency services* and *Social introduction services* includes the opponent's *Dating services* and so there are also identical per *Meric.*

65. Where there is no similarity between the goods and/or services, there can be no likelihood of confusion under section 5(2)(b) of the Act: see *eSure Insurance Limited v Direct Line Insurance Plc* [2006] EWCA Civ 842 CA, paragraph 49. The opposition under this ground fails with respect to the following services:

Class 43
Hiring of rooms for social functions; Rental of rooms for social functions.

Conclusions on likelihood of confusion

66. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I 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 they have in their mind.

67. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

68. Although the opponent submits that both types of confusion are likely to occur, I consider that its arguments on direct confusion actually describe indirect confusion. It submits that the average consumer, on seeing the contested mark, would assume that it was another of the opponent's brands. It does not attempt to persuade me that the average consumer would mistake the contested mark for any of the earlier marks. This is, in my view, sensible. The differences between the marks as wholes are, in my view, too marked for them to be mistaken for each other, even where the goods and services are identical, and taking account of the imperfect recollection of the average consumer. I find there is no likelihood of direct confusion.

69. In paragraph 17 of his decision in *L.A. Sugar*, Mr Iain Purvis QC, sitting as the Appointed Person, said that the following situations were examples of when indirect confusion would tend to occur:

> "(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else

but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

70. These are not the only ways in which indirect confusion could arise, as Arnold LJ said in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 at paragraph 12. He went on to stress the importance of having a *"proper basis"* for any conclusion that there was a likelihood of indirect confusion, in the absence of direct confusion: see paragraph 13.

71. I shall deal first with the contested *Dating services* and *Internet-based matchmaking services*, which appear in both parties' specifications. It will be recalled that I found that the 177 and 639 marks had a medium to high degree of distinctive character for these services because the inherent distinctiveness had been enhanced through the use made of them. I also found that the word "MATCH" was the dominant and distinctive element of both these marks. A person using dating services might be looking to find a "mate", if that term is understood to mean a spouse or sexual partner. For this reason, and given the medium to high degree of distinctiveness of the earlier marks, I find that it is likely that the average consumer will assume that the contested mark is another brand of the opponent and so there is a likelihood of indirect confusion.

72. I consider that the same rationale applies in the case of *Social introduction agency* and *Social introduction services*, as I found that these services include the opponent's *Dating services*, and *Internet based matchmaking services* as these would be included in, or be highly similar to, *Dating services*.

73. Earlier in my decision, I found that the contested Class 9 goods included the opponent's *Downloadable software in the nature of a mobile application for internet-based dating and introduction*. I also found that the distinctiveness of the 177 and 639 marks had been enhanced for these goods in so far as they related to internet-based dating. The average consumer is likely to assume that the marks belong to the opponent for the reasons already set out in paragraph 71 above. Even if the word "MATE" makes them think of a friend rather than a sexual partner, this is a suitable allusion for applications used to make dating and meeting other people easier. I find that there is a likelihood of indirect confusion.

74. I turn now to the remaining contested Class 45 and the Class 38 services. I found that these were highly similar to the opponent's *Internet-based social networking* in Class 38. However, I also found the distinctiveness of the 177 and 639 marks for these services to be low. In such circumstances, I find that it is unlikely that the average consumer would assume that the services come from the same undertaking. The earlier mark may be called to mind, but that is mere association, not indirect confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.3.3.

75. I also compared the contested Class 38 services to *Telecommunication services, namely, providing on-line chat rooms for the transmission of messages among users in the fields of current events, elections, public affairs, world affairs, national affairs, local affairs, television programs, radio programs, movies, entertainment programming, media programming, podcasts, lectures, music and to engage in social networking* from the specification of the 131 mark, and found them to be identical. However, I found that the degree of similarity between the marks was low visually and high aurally. I recall that I found that the purchasing process would be largely visual, while noting that there would be a role for the aural element. I also found that the distinctiveness of the 131 mark was at a medium level, but that it was the presence of the device that raised it from what would have been a low level if the verbal element had been the only element in the mark. What gives the 131 mark its level of distinctiveness has no counterpart in the contested mark, and so, if anything, the distinctiveness of the 131 mark reduces the likelihood of confusion: see *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraph 39. I consider that the earlier mark may be brought to mind, but do not find a likelihood of indirect confusion.

76. The final services to consider are the Class 41 services that I found to be identical to *Social club services for entertainment* in the specification of the 131 mark. The distinctiveness of the earlier mark for these services is higher than for the services I considered in the previous paragraph and I found "MatchGroup" to play an independent distinctive role within the mark. This finding does not automatically mean that there is a likelihood of confusion: see *Whyte and Mackay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch), paragraph 21. I do not consider that "MATCH" is sufficiently distinctive that the average consumer would assume that only the opponent would be using it for the Class 41 services and it does not seem to me that the contested mark is a logical brand extension. I find no likelihood of indirect confusion.

Outcome of section 5(2)(b)

77. The opposition under section 5(2)(b) is successful for all goods in Class 9 and the following services in Class 45: *Dating services provided through social networking; Internet-based matchmaking services; social introduction agency services; Social introduction services.*

78. The opposition fails for the remaining services.

Section 5(3)

79. Section 5(3) of the Act is as follows:

> "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 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."

80. The conditions of section 5(3) are cumulative. First, the application must be similar to the earlier mark(s). Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

81. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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 Salomon*, 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 and/or services, the extent of the overlap between the

relevant consumers for those goods and/or 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 that 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

82. Earlier in my decision, I found the contested mark to be similar to the 177 and 639 marks that are relied on under section 5(3), and so the first condition has been satisfied.

Reputation

83. In *General Motors*, the CJEU held that:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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."

84. The relevant date for assessing reputation is 14 February 2022.

85. Earlier in my decision, I found that the distinctive character of both the 177 and 639 marks had been enhanced to a medium to high degree through the use made of them for *Dating services* and *Downloadable software in the nature of a mobile application for internet-based dating*. The same factors are relevant to my assessment of reputation. It is important to note that while the 177 mark is a UKTM, the 639 mark is a comparable mark and so the relevant territory until IP completion day (31 December 2020) is the EU. The evidence filed by the opponent concerns use and reputation in the UK. However, the courts have held that, depending on the facts of the case, a reputation in the territory of a single Member State (which the UK was) may be considered to constitute a reputation in a substantial part of the EU: see *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, paragraph 30. The levels of usage, advertising and awareness among the relevant public in the UK were consistently high. I am satisfied that both marks had a strong reputation for *Dating services* and *Downloadable software in the nature of a mobile application for internet-based dating*. I find no reputation for any other goods and services relied upon.

Link

86. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

87. I found the contested mark to be visually and aurally similar to the 177 mark to a medium degree and conceptually similar to a medium to high degree. I found the contested mark to be visually similar to the 639 mark to a medium to high degree, aurally similar to a medium degree and conceptually similar to a medium to high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

88. Earlier in my decision, I found the Class 9 goods to be identical to the opponent's *Downloadable software in the nature of a mobile application for internet-based dating and introduction.* I do not consider that it makes a different to this assessment if the comparison is based on *Downloadable software in the nature of a mobile application for internet-based dating* alone, given the broad nature of the applicant's terms.

89. The contested Class 38 services would have the same users as the opponent's *Dating services* and, in so far as the opponent's services were provided through the internet, would share some similarity with regards to the method of use and nature. The services have different purposes and are neither complementary nor in competition with each other. I find that they are similar to a low degree.

90. Turning now to the Class 41 services, I note that the opponent has provided some evidence to show that it had, prior to the Covid pandemic, offered social events such as quiz and comedy nights.[15] It does not seem to me to be unlikely that a dating service would also offer social events at which its clients could meet. Consequently, I find that there is some overlap in nature and users. There may also be some overlap in trade channels. I find that the services are similar to a low degree.

[15] Exhibit JC9.

91. I found that the Class 43 services were dissimilar to any of the opponent's services under section 5(2)(b). However, for the purposes of section 5(3), it is not essential that the goods are similar: see *Puma SE v EUIPO*, Case T-62/16, paragraph 100.

92. I found that *Dating services provided through social networking; Internet based matchmaking services; social introduction agency services; Social introduction services* were identical to the opponent's *Dating services*.

93. I also found that *Online social networking services; Online social networking services accessible by means of downloadable mobile applications; On-line social networking services; Internet-based social networking services* were similar to *Dating services* to a medium degree.

The strength of the earlier marks' reputation

94. I found that the earlier marks had a strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

95. I adopt here my earlier findings, that the earlier marks have a medium to high degree of distinctive character, acquired through use, for *Dating services* and *Downloadable software in the nature of a mobile application for internet-based dating*.

Whether there is a likelihood of confusion

96. Under section 5(2)(b), I found that there was a likelihood of confusion for those goods and services I considered to be identical.

Conclusions on link

97. Where there is a likelihood of confusion, there is automatically a link. This applies to the Class 9 goods and *Dating services provided through social networking; Internet*

based matchmaking services; social introduction agency services; Social introduction services.

98. Turning to the remaining services, I remind myself that the level of similarity between the marks that is required for the relevant public to make a link for the purposes of section 5(3) may be less than the level of similarity required to create a likelihood of confusion: see *Intra-Presse SAS v OHIM*, Joined cases C-581/13 P and C-582/13 P, paragraph 72. I find that the strong reputation and medium to high degree of enhanced distinctiveness of both earlier marks are such that the marks are likely to be brought to mind by the relevant public when they see the contested mark on the services that I found to be similar.

99. This leaves the Class 43 services. In my view, the dissimilarity between these services means that it is not likely that the earlier marks will be brought to the mind of the relevant public when they encounter the contested mark used for these services. As I have not found a link, there can be no damage. The section 5(3) ground fails in respect of the Class 43 services.

Damage

100. The opponent claims that damage would occur in each of the three ways described in points g) – j) of the summary in paragraph 81 above. I shall begin with unfair advantage. This means that consumers are more likely to buy the goods and services sold under the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. I found that the earlier marks had a strong reputation for *Dating services* and *Downloadable software in the nature of a mobile application for internet-based dating*. The articles in Exhibit JC5 refer to it as one of the biggest dating websites, with a wide demographic, *"a pretty fail-safe way of doing things"* and with a website that is *"very well managed"* and has a *"new, clean design"*.[16] These would be attractive qualities for the applicant's goods and services. There is likely to be a transfer of image to the applicant's goods and services which would make

[16] Pages 28 and 7.

consumers more likely to purchase them. Damage, in the form of unfair advantage, is made out for the goods and services for which I found a link.

101. I shall very briefly consider the other heads of damage. The claim of detriment to reputation appears to be based on the hypothetical lower quality of the goods and services that may be offered by the applicant. In *Unite The Union v The Unite Group Plc*, BL O/219/13, Ms Anna Carboni, sitting as the Appointed Person, doubted whether such a hypothetical claim could succeed in opposition proceedings: see paragraphs 46 and 47 of that decision. The opponent's claim on detriment to distinctive character is based on the relevant public being confused as to the origin of the goods and services. I have already considered whether there will be a likelihood of confusion, so I shall say no more on this point.

Outcome of section 5(3)

102. The applicant has not claimed to have due cause to use the contested mark, and so the opposition succeeds under section 5(3) for the goods and services in Classes 9, 38, 41 and 45.

Section 5(4)(a)

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

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> (a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met
>
> …"

104. Subsection 4(A) is as follows:

> "The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

105. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described at [406] the 'classical trinity' that must be proved in order to reach a finding of passing off:

> "First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

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

> "Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

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

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged are likely to be deceived and all other surrounding circumstances.

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

107. The relevant date for assessing a claim of passing off is the date of commencement of the conduct complained of: see *Cadbury-Schweppes Pty Ltd v The*

Pub Squash Co Ltd [1981] RPC 429. In opposition proceedings, this is the date of the application for registration or, if relevant, a priority date. Where the applicant has used the mark before application it is also necessary to consider the position at the point of first use. It does not claim, and there is no evidence to say, that it has done so, and therefore the relevant date is 14 February 2022.

Goodwill

108 The opponent must show that it had goodwill in a business at the relevant date and that the signs relied upon are associated with, or distinctive of, that business. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

109. I am satisfied on the basis of the evidence I have already described that the opponent has substantial goodwill associated with *Dating services* and *Online dating and introduction services*. There is no evidence that the opponent provides more general social networking services. I also consider that the opponent has shown that the signs are distinctive of that goodwill.

Misrepresentation

110. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

> 'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

111. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely, in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. Consequently, I find that there would be misrepresentation if the contested mark were used for the following Class 45 services for which I found a likelihood of confusion under section 5(2)(b): *Dating services provided though social networking; Internet based matchmaking services; social introduction agency services; Social introduction services*. I also consider that there would be misrepresentation for the Class 9 goods, as these could all be used in the provision of online dating services.

112. With regard to the remaining services, I adopt the findings on similarity that I made in paragraphs 89-91 and 93 above. I found that the remaining Class 45 services were similar to *Dating services* to a medium degree, the Class 38 and Class 41 were similar to *Dating services* to a low degree and that the Class 43 services were dissimilar.

113. It is not necessary for the parties to operate in a common field of activity, but the courts have held that there is an additional burden on the plaintiff to establish misrepresentation and damage when they do not: see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 at [714]-[715]. I must be satisfied that a substantial number of members of the public would be misled into purchasing the applicant's services on the assumption that they are those of the opponent. As the extract from *Halsbury's Laws* cited above makes clear, this is a multifactorial assessment. I also note that where the fields of activity are far removed, the burden of proving misrepresentation and damage is a heavy one: see *Stringfellow v McCain Foods (G.B.) Ltd* [1984] RPC 501 at [535].

114. I consider that there is sufficient similarity between the services in relation to which the opponent has a protectable goodwill and the remaining contested Class 45 services for there to be misrepresentation, when all the relevant factors, such as the similarity of the signs and the strength of the goodwill, are taken into account. With regard to the Class 38, Class 41 and Class 43 services, the contested mark is in my view not so close to the sign that the public would be deceived into thinking that the applicant's services are those of the opponent. Some may wonder if there is a connection, but as the courts have held this is not enough for a passing off claim to succeed: see *Phones 4U Ltd v Phone4U.co.uk Internet Ltd* [2007] RPC 5 at [16]-[17].

115. I find there is no misrepresentation for the contested services in Classes 38, 41 and 43.

Damage

116. In *Harrods Limited*, Millett LJ described the requirements for damage in passing off cases at [715]:

> "In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff.

> But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

117. Where the parties operate in the same field of activity, I consider that there is a risk that potential customers of the opponent would choose the applicant's services instead. Where the fields of activity are different, there is, in my view, a risk of damage through injurious association. Damage is made out for all the goods and services still in play.

Outcome of section 5(4)(a)

118. The opposition under section 5(4)(a) succeeds with respect to the goods in Class 9 and the services in Class 45.

OUTCOME

119. The opposition has been partially successful and Application No. 3754581 is refused registration for the following goods and services:

> *Class 9*
> *Mobile apps; Mobile app's; Mobile software; Communication, network and social networking software; Social software.*
>
> *Class 38*
> *Chat room services; Forums [chat rooms] for social networking; Operating chat rooms; Chat room services for social networking; Providing internet chat rooms; Providing on-line chat rooms for social networking; Providing voice chat services;*

Providing online chat rooms and electronic bulletin boards; Providing on-line chat rooms for transmission of messages among computer users.

Class 41

Social club services for entertainment purposes; Entertainment services in the nature of organizing social entertainment events; Entertainment services in the nature of arranging social entertainment events.

Class 45

Online social networking services; Online social networking services accessible by means of downloadable mobile applications; On-line social networking services; Dating services provided through social networking; Internet-based social networking services; Internet based matchmaking services; social introduction agency services; Social introduction services.

120. Subject to a successful appeal, Application No. 3754581 will proceed to registration for the following services:

Class 43

Hiring of rooms for social functions; Rental of rooms for social functions.

COSTS

121. Both parties have enjoyed some success in these proceedings. The greater part of this success has gone to the opponent, who is entitled to a contribution towards the costs of the proceedings in line with the scale set out in Tribunal Practice Notice No. 2/2016. In the circumstances, I award the opponent the sum of £2050 which has been calculated as follows:

Preparing a statement and considering the other side's statement: £450
Preparing evidence: £1000
Preparing submissions in lieu of a hearing: £400
Official fees: £200
TOTAL: £2050

122. I therefore order Mark Lynch to pay Match Group, LLC the sum of £2050. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of October 2023

Clare Boucher
For the Registrar,
Comptroller-General