

**O-278-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3192390**

**BY ALAMEX LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 38, 42  
& 45:**

**NAUGHTY DATING**

**AND**

**OPPOSITION THERETO (No. 408455) BY TOGETHER NETWORKS  
HOLDINGS LIMITED**

## Background and pleadings

1. On 20 October 2016, Alamex Ltd ('the applicant') applied to register the word trade mark 'NAUGHTY DATING' in the UK. It was accepted and published in the Trade Marks Journal on 4 November 2016 in respect of the following services.

*Class 38: Telephone and mobile telephone services, cellular telephone communication, communications by telephone, facsimile transmission, paging services [radio, telephone or other means of electronic communication], teleconferencing services, telephone services, voice mail services. Computer communication and Internet access, communications by computer terminals, communications by fiber [fiber] optic networks, computer aided transmission of messages and images, electronic mail, electronic bulletin board services [telecommunications services], providing telecommunications connections to a global computer network, providing internet chatrooms, providing user access to global computer networks, providing online forums, rental of access time to global computer networks, transmission of greeting cards online, transmission of digital files, videoconferencing services. Access to content, websites and portals, providing access to databases. Telecommunication services, communications by telegrams, information about telecommunication, message sending, news agencies/wire service, satellite transmission, telecommunications routing and junction services, telegraph services, telex services, transmission of telegrams.*

*Class 42: IT services, computer system analysis, computer system design, monitoring of computer systems by remote access. Software development, programming and implementation, computer programming, computer software design, updating of computer software, computer software consultancy, creating and maintaining web sites for others, installation of computer software, maintenance of computer software. Hosting services and software as a service and rental of software, hosting computer sites [web sites], providing search engines for the internet, rental of computer software, rental of web servers, server hosting, software as a service [SaaS]. IT consultancy,*

*advisory and information services, information technology [IT] consulting services.*

*Class 45: Dating services, dating services, marriage agencies, chaperoning/escorting in society [chaperoning], planning and arranging of wedding ceremonies.*

2. On 6 February 2017, Together Networks Holdings Limited ('the opponent') opposed the trade mark on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). The opposition, insofar as it is based upon s.5(2)(b) and 5(3) of the Act, is based upon the following five earlier marks (the last two earlier marks, namely EU numbers 10175578 and 10175073, are not relied upon for the s.5(3) of the Act claim):

<b>Mark details and relevant dates</b>
EU 9951682 <b>naughty</b> Filing date: 9 May 2011 Date of entry in register: 21 September 2011
<b>Specification of services</b>
<i>Class 38: Telecommunications; Forums [chat rooms] for social networking; Chatroom services for social networking.</i>
<i>Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Provision of an Internet platform for social networking services.</i>
<i>Class 45: Legal services; Security services for the protection of property and individuals; Personal and social services rendered by others to meet the needs of individuals; Dating services; Dating agency services; Dating services provided through social networking; Computer dating services; Marriage partner introduction</i>

*or dating services; Dating services provided through social networking.*

**Mark details and relevant dates**

EU 8560971



Mark description: The mark consists of a heart shape with horns and a curved, spiked tail. The word 'Be Naughty' are incorporated into the design.

Colours claimed: Red, black and orange

Filing date: 18 September 2009

Date of entry in register: 22 February 2010

**Specification of services**

*Class 38: Telecommunications.*

*Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.*

*Class 45: Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals, Dating agency services, Dating services, dating services provided through social networking.*

**Mark details and relevant dates**

EU 8224685

**benaughty**

Filing date: 17 April 2009

Date of entry in register: 7 October 2009

**Specification of services**

*Class 38: Telecommunications.*

*Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.*

*Class 45: Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.*

#### **Mark details and relevant dates**

EU 10175578



Colours claimed: Black, red and orange

Filing date: 4 August 2011

Date of entry in register: 14 December 2011

#### **Specification of goods and services**

*Class 9: Computer software and hardware; computer programmes; software for online messaging; electronic publications (downloadable); software downloadable from the internet; digital media; computer software for use in profiling facial features and characteristics; facial recognition and attractiveness rating software; computer programs for accessing, browsing and searching online databases and the Internet; computer software and hardware to enable searching of data and connecting to databases and the Internet; games software; CDs, videos, DVDs and MP3s; optical and magnetic discs and other recordable media; digital imaging devices and digital signal processors; data-processing equipment and computers; recorded media; computer accessories; screen savers; mouse mats; mobile phone software; mobile phone accessories; screensavers; apparatus for recording, transmission and reproduction of sound and images; magnetic data carriers; parts and fittings for all the aforesaid goods.*

*Class 38: Telecommunications; chat room services; chat room services for social networking; forums (chat rooms) for social networking; provision and operation of internet chat rooms and on-line forums; providing on-line chat rooms for transmission of messages among computer users; providing on-line electronic bulletin board services and chat rooms; virtual chat rooms established via text messaging; providing chat lines utilising the internet; mobile communication services; mobile telephone communication services; transmission of interactive entertainment software; transmission of information; broadcasting by television, radio and satellite; broadcasting and transmission of programmes; message sending services; electronic communication services; electronic mail and messaging services; video messaging services; providing user access to the internet; provision of telecommunications access and links to computer databases and the Internet; providing access to MP3 websites on the Internet; provision of wireless telecommunications via electronic communication networks; electronic sending of data via the Internet; electronic transmission of audio and video files via communications networks; provision of access time to web-sites featuring multimedia materials; instant messaging services; providing users with access time to electronic communications networks; advisory and consultancy services relating to all the aforesaid services.*

*Class 45: Dating agency services; computer dating services; provision of dating agency services via the internet; dating services provided through social networking; marriage partner introduction or dating services; video dating services; social escort agency services; social escorting; social and personal introduction agencies; personality profiling services; psychological profiling; legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals; information and advice relating to dating and relationships; consultancy services relating to personal appearance; information and advisory services relating to the aforesaid services.*

**Mark details and relevant dates**

EU 10175073



Colours claimed: Black, red and orange

Filing date: 4 August 2011

Date of entry in register: 4 May 2014

### **Specification of services**

*Class 45: Dating agency services; computer dating services; provision of dating agency services via the internet; dating services provided through social networking; marriage partner introduction or dating services; video dating services; social escort agency services; social escorting; social and personal introduction agencies; personality profiling services; psychological profiling; legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals; information and advice relating to dating and relationships; consultancy services relating to personal appearance; information and advisory services relating to the aforesaid services.*

3. The opponent submits that there is likelihood that the applied for mark will be confused with each of the earlier marks. The applicant 'denies the claims made that any confusion between these terms could arise'.

4. For s.5(3) of the Act, the opponent relies upon its earlier '682, '971 and '685 marks. It claims to have a reputation for each of these earlier marks in connection with its Class 45 '*Dating agency services, online dating agency services, chatroom and social networking services*' and that the application would stand to benefit from the existing reputation that the opponent enjoys due to its longstanding use and marketing efforts.

5. Under s.5(4)(a) of the Act, the opponent claims that use of the applicant's mark is liable to be prevented under the law of passing off, owing to its goodwill attached to

the business operating under the signs 'naughty' and 'benaughty', which it claims to have used throughout the UK since 2009, in respect of '*Dating agency services, online dating agency services, chatroom and social networking services, telecommunications, providing internet platforms for social networking, design and development of software*'.

6. The applicant filed a counterstatement denying the claims made and requested that the opponent provides proof of use of its earlier trade mark no. 9951682 ('naughty').

7. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. No hearing was requested and so this decision is taken following a careful consideration of the papers.

8. For reasons of procedural economy, the opposition shall firstly be assessed in

relation to the opponent's EU no 8560971,  'NAUGHTY'. Whilst the aforementioned registration was older than five years at the date the application was published, the applicant did not request that the opponent proves use for all of the relied upon services. The opponent can, as a consequence, rely upon all of the services it has identified.

## **Evidence**

### **Opponent's evidence**

*Witness statement of Laura Edison with exhibits LE1 – LE19*

9. Ms Edison of Edison Legal Limited is a Scots law qualified solicitor, notary public and General Counsel for the opponent, a position held since 1 January 2015. Prior to this Ms Edison was the General Counsel at Cupid Plc, the previous owner of the 'NAUGHTY' trade marks.

10. Ms Edison begins by outlining the company structure and history. She states that the opponent operated the 'NAUGHTY' website under an exclusive licence from Cupid Plc from 2013 until a full assignment of rights and total transfer of ownership occurred on 18 December 2015. Ms Edison states that the opponent has continuously provided online dating services in the UK and EU under a family of trade marks which share the common theme NAUGHTY, i.e. BENAUGHTY, IAMNAUGHTY and NAUGHTYDATE. Further, a fourth website has continuously been operated by an associate company, Bulova Invest Ltd, under the trade mark GETNAUGHTY. Ms Edison stated that Bulova Invest Ltd and the opponent are sister companies since they have the same parent company, Grendall Investments Ltd.

11. Ms Edison states that BENAUGHTY has been one of the best-known adult dating websites in at least the UK since its launch in 2007.

12. She states that since the business is solely on-line, the majority of its marketing spend is also only carried out via the internet. For example, much of the spend is for 'pay per click' ('PPC') and internal affiliates ('INT') whereby the opponent operates an affiliate network and owners of third party websites can sign up to the affiliate network and, once accepted, can access its banners to advertise on their own websites. The third party then receives a fee. These third party websites are carefully directed at the opponent's key demographic, adults aged between 21 and 35.

13. Exhibit LE1 to the witness statement is a table detailing the marketing spend and number of new members registering ('registrations') for the 'NAUGHTY Trade Marks' for the period 2015 to 2016. The figures are broken down into BENAUGHTY ('BN'), GETNAUGHTY ('GN'), IAMNAUGHTY ('IAN') and NAUGHTYDATE ('ND').

14. Cost per action ('CPA') are online marketing companies who arrange for online adverts to be placed on third party websites. For the 'benaughty' brand, the marketing spend for CPA's was \$8,896 in 2015 (in the UK) and \$114,840 in 2016. The figures also include the number of new members registering on the benaughty website as a result of the CPA marketing method. In 2015, the number of new registrations was 5,409 and 70,616 in 2016.

15. Another marketing technique is 'pay per click' which is used to direct traffic to a website. In 2015, for the benaughty website the marketing spend was \$102,849 and \$274,809 in 2016. This led to 215,089 new members in 2015 and 163,488 in 2016. Finally, Ms Edison sets out the marketing spend on advertising through internal affiliates. This amounted to \$492,876 in 2015 and \$414,809 in 2016 resulting in 167,199 new members in 2015 and 131,001 in 2016.

16. To summarise, the total on-line advertising via the channels set out above was just over \$1m in 2015 and approximately \$910,000 for 2016 resulting in over 400,000 new members in 2015 and approximately 380,000 in 2016.

17. Ms Edison highlights that the BENAUGHTY website is particularly popular and since its launch in July 2007 it attracted 3,719,317 members by summer 2011. Further, by the same summer the total revenue generated in the UK from the benaughty.co.uk website was £16,713,981. This is broken down as follows:

<b>Year</b>	<b>Turnover</b>
2007 (since the launch in July)	£203,744
2008	£2,131,328
2009	£3,332,117
2010	£7,342,314
2011 (up to the summer)	£3,383,290

18. The marketing expenditure in the UK totalled £7,550,722. A breakdown has been provided as follows. It is not stated which marks these figures are aimed at promoting:

<b>Year</b>	<b>Marketing spend</b>
2007 (since the launch in July)	£226,491
2008	£1,103,278
2009	£2,103,855
2010	£3,199,895
2011 (up to the summer)	£917,199

19. Appendix LE4 to Ms Edison’s witness statement is a breakdown of the total number of new members registering on the four UK ‘NAUGHTY’ websites. They are as follows:

Year	Brand			
	BN	ND	GN	IAN
2014	612,966	235,548	545,342	161,512
2015	882,648	623,443	330,254	621,033
2016	556,932	334,434	356,242	421,934

20. UK revenue generated from the provision of online dating agency services for the four NAUGHTY websites in 2015 and 2016.

Year	Brand			
	BN	ND	GN	IAN
2014	\$2,233,274.40	\$698,552.09	\$509,594.56	\$119,726.67
2015	\$4,804,114	\$2,902,239	\$1,383,387	\$1,518,005
2016	\$3,420,476	\$2,199,906	\$1,346,257	\$1,686,120

21. In order for users to access the websites easily the opponent also provides users with a BENAUGHTY branded mobile application. This was launched in November 2010. Exhibit LE7 to the witness statement includes a table which shows that between 2015 and 2016 the NAUGHTYDATE, BENAUGHTY and IAMNAUGHTY applications have been downloaded thousands of times.

22. Exhibits LE8 and LE9 are YouTube screenshots of video clips which the opponent claims to have appeared on UK television shows aired on ITV, Dave and Comedy Central during the latter part of 2011, 2012 and 2014. They show use of

the  mark.

23. Exhibit LE10 to the witness statement is a screenshot of the 'BeNaughty – Online Dating App'. The print outs only include the date of printing, i.e. 10 April 2017. It is not clear when the app was launched.

24. Exhibit LE11 is a print out from 'SimilarWeb' which the opponent claims to demonstrate the global and local traffic ranking for its various 'NAUGHTY' websites between October 2015 and March 2017. The context of these figures is difficult to ascertain. They appear to be figures showing the worldwide ranking of the various websites, however, it is not clear how many of these visitors were from the UK or EU. Further, an example of the ambiguity of these figures are that Ms Edison states that they are for the period October 2015 to March 2017 and that iamnaughty.com's global ranking is #14.873. However, the screen print states 'Last month (December 16)' which indicates that the figures are for that particular month.

25. Exhibit LE12 to the witness statement comprises historic screenshots for the website [benaughty.com](http://benaughty.com), taken from the Wayback Machine. The screen prints

include the  mark and are dated July 2007, April, July 2008, January 2010, December 2011, April and December 2014, August 2015 and October 2016.

26. Exhibit LE13 consists of a print out from 'idateawards.com' for 2010. It indicates that the opponent came second in the Best Product Design, third in the Best Mobile Dating App categories and nominated for the Best Marketing Campaign award. A further print out states that 'BeNaughty.com' finished fourth in the 2011 #Winner of Best Dating Site'.

27. Exhibit LE14 consists of media articles which show evidence of use of the NAUGHTY brand. Some of the prints are taken from the independent website [OnLinePersonalsWatch.com](http://OnLinePersonalsWatch.com) and one (dated 1 February 2011) states that [benaughty.com](http://benaughty.com) has 3m members.

28. Exhibit LE15 is a review conducted by [leadingdatingsites.co.uk](http://leadingdatingsites.co.uk) of the opponent's 'benaughty' online dating services. It is dated 04/2017 and states that that the

opponent's benaughty.com website was launched in 2005 and has 3m members and '250,000 active weekly'. The extract provided from the 'benaughty' website shows

the  mark.

29. Exhibit LE16 consists of sales figures for the company Cupid Plc (the opponent's predecessor) for the UK which for 2010 amounts to £25.7m. The report also indicates that benaughty.com is one of the Group's most heavily visited sites, but does not provide any specific figures or information.

30. Exhibit LE17 consists of website print outs from cupidplc.com dated March and

April 2012 which show that the 'BENAUGHTY' and  trade marks were actively being used at this time.

31. Exhibit LE18 consists of a witness statement from a Mr Mark Brooks who is the CEO of Courtland Brooks Agency, which he states is a team of world class internet dating marketing professionals. This witness statement was made in relation to revocation proceedings launched before the EUIPO by Alamex Limited against EU trade mark registration no. 9951682 for the mark NAUGHTY (word) in the name of Together Networks Holdings Limited. It is dated 10 April 2016. In essence Mr Brooks states that he believes the 'BENAUGHTY' website was launched in 2007 and 'BENAUGHTY' is one of the hallmark adult dating and casual dating brands. In fact, I would go as far as to say that 'BENAUGHTY' was the UK *de facto* standard in the industry for many years, and certainly one of the top three players in adult dating websites in the UK'.

32. Exhibit LE19 is a witness statement from Marinos Gavriel on behalf of Marianthi Tanti for Multiserve Limited of Bulova Invest Limited based in the British Virgin Islands. The witness statement was prepared for the revocation proceedings outlined above and since it was made 'on behalf of' someone else is of very limited evidential value. In fact, the content contains no information which I consider assists my decision. It is disregarded.

## **Applicant's evidence**

*Witness statement of Mr Neil Jonathan Stanley*

33. Mr Stanley is a company director of the applicant. Mr Stanley claims that there is no confusion between the application and the opponent's 'benaughty'. To evidence this he attaches (as exhibit1) an extract 'taken from Google Search Console. It shows that the top 25 search on Google that users typed when looking for our brand. The opponent's brand does not appear at all proving that there is zero confusion amongst the public.' This is not the approach taken when assessing the likelihood of confusion in proceedings such as these. The test is not whether a consumer finds party A when it is searching for party B. The question is when they are already aware of brand A, but then encounter brand B, they will either be confused into believing that the latter is the former (and confusion therefore arises) or the consumer believes that they are commercially associated. Further, any Google search results to do not reflect the consumer's thinking. Therefore, this argument is dismissed.

34. Mr Stanley then submits that the opponent never uses its naughty mark in isolation. It is always in conjunction with another element.

## **DECISION**

### **Section 5(2)(b)**

35. Section 5(2)(b) of the Act is 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".

36. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*

*Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

*The principles*

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

37. When making a comparison of goods/services, all relevant factors relating to them should be taken into account. In the judgment of the Court of Justice of the European Union ('CJEU') in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. 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.

39. Goods and services may be considered identical if one term in a specification falls within the ambit of something in the competing specification, as per the guidance provided by the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ('*Meric*):

"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 für 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".

40. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the

way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

41. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

42. 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."

<b>Opponent's list of services (EU 8560971)</b>	<b>Applicant's list of services</b>
<p><i>Class 38: Telecommunications</i></p>	<p><i>Class 38: Telephone and mobile telephone services, cellular telephone communication, communications by telephone, facsimile transmission, paging services [radio, telephone or other means of electronic communication], teleconferencing services, telephone services, voice mail services. Computer communication and Internet access, communications by computer terminals, communications by fiber [fiber] optic networks, computer aided transmission of messages and images, electronic mail, electronic bulletin board services [telecommunications services], providing telecommunications connections to a global computer network, providing internet chatrooms, providing user access to global computer networks, providing online forums, rental of access time to</i></p>

	<i>global computer networks, transmission of greeting cards online, transmission of digital files, videoconferencing services. Access to content, websites and portals, providing access to databases. Telecommunication services, communications by telegrams, information about telecommunication, message sending, news agencies/wire service, satellite transmission, telecommunications routing and junction services, telegraph services, telex services, transmission of telegrams.</i>
<i>Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.</i>	<i>Class 42: IT services, computer system analysis, computer system design, monitoring of computer systems by remote access. Software development, programming and implementation, computer programming, computer software design, updating of computer software, computer software consultancy, creating and maintaining web sites for others, installation of computer software, maintenance of computer software. Hosting services and software as a service and rental of software, hosting computer sites [web sites], providing search engines for the internet, rental of computer software, rental of web servers, server hosting, software as a service [SaaS]. IT consultancy, advisory and information services, information technology [IT] consulting services.</i>
<i>Class 45: Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals, Dating agency services, Dating services, dating services provided through social networking.</i>	<i>Class 45: Dating services, dating services, marriage agencies, chaperoning/escorting in society [chaperoning], planning and arranging of wedding ceremonies.</i>

43. Neither party has offered submissions or evidence regarding the assessment of similarity between the respective services.

Class 38

44. The opponent’s telecommunication services are aimed at transmitting information such as words, images, videos, etc via various means. Therefore, applying the principles set out in *Meric*, most of the applicant’s services fall within the opponent’s ‘telecommunications’ and are, therefore, identical. These are:

*Class 38: Telephone and mobile telephone services, cellular telephone communication, communications by telephone, facsimile transmission, paging services [radio, telephone or other means of electronic communication],*

*teleconferencing services, telephone services, voice mail services. Computer communication and Internet access, communications by computer terminals, communications by fiber [fiber] optic networks, computer aided transmission of messages and images, electronic mail, electronic bulletin board services [telecommunications services], providing telecommunications connections to a global computer network, providing internet chatrooms, providing user access to global computer networks, providing online forums, transmission of greeting cards online, transmission of digital files, videoconferencing services. Telecommunication services, communications by telegrams, information about telecommunication, message sending, news agencies/wire service, satellite transmission, telecommunications routing and junction services, telegraph services, telex services, transmission of telegrams.*

45. With regard to the remaining '*rental of access time to global computer networks, Access to content, websites and portals, providing access to databases services*', these are services aimed at providing access to websites and portals rather than, strictly speaking, telecommunications. Therefore, they differ slightly in nature though there is a degree of competition since renting access to global networks may be for communicative purposes. Further, the rental or provision of access time to websites are likely to be provided by the same provider via the same trade channels and their users are likely to be the same. They are highly similar.

#### Class 42

46. Applying the principles set out in *Meric*, the following services either fall within the opponent's '*design and development of computer hardware and software*' or vice versa. Therefore, the following services are considered to be identical: *Class 42: IT services, computer system design, Software development, programming and implementation, computer programming, computer software design, updating of computer software.*

47. The contested '*computer system analysis, monitoring of computer systems by remote access. computer software consultancy, creating and maintaining web sites for others, installation of computer software, maintenance of computer software.*

*Hosting services and software as a service and rental of software, hosting computer sites [web sites], providing search engines for the internet, rental of computer software, rental of web servers, server hosting, software as a service [SaaS]. IT consultancy, advisory and information services, information technology [IT] consulting services'* and the opponent's 'design and development of computer hardware and software' appear to differ in nature since the former do not involve the design and development of computer hardware and software. However, the providers of the respective services are likely to be the same since they are all computer related services. It is highly conceivable that those that design and development services for software and hardware would also logically provide the contested services. They are also likely to target the same end user via the same trade channels. I consider them to be highly similar.

#### Class 45

48. The term '*dating services*' are identically contained in the applicant's (appearing twice) and opponent's list of services. Therefore, they are identical.

49. The applicant's '*marriage agencies*' includes a legal process whereby individuals enter a legally binding contract with one another that establishes rights and obligations between them. This is considered to be included in the opponent's broader term, '*legal services*'. Therefore, they are identical.

50. The applicant's '*chaperoning/escorting in society [chaperoning], planning and arranging of wedding ceremonies*' are all of a personal nature aimed at providing individually catered services to meet one's needs/requirements. Applying the principle set out in *Meric*, they are considered to be included in the opponent's broader category of, '*personal services rendered by others to meet the needs of individuals*'.

51. To summarise, all of the applicant's applied for services are considered to be identical to the opponents, except for the Class 38 '*rental of access time to global computer networks, Access to content, websites and portals, providing access to databases services*' and some of the Class 42 services.

## Average consumer and the purchasing act

52. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

53. In *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), Birss J. described the average consumer at paragraph 60 in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

54. The services in question range from, inter alia, dating services, telecommunications, IT services. They are services which I would expect at least a normal level of attention to be paid by the consumer when using such services. The purchasing act will be mainly visual following an inspection of websites, or the images and content generated by the user. However I do not discount that aural considerations such as word of mouth recommendations may also play a part in the purchasing process.

## Comparison of marks

55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

56. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

57. The respective trade marks are shown below:

	NAUGHTY DATING
Earlier trade mark	Contested trade mark

58. In terms of overall impression, the earlier mark consists of words and a device. All of these elements contribute to the overall impression of the mark. The word 'BE' within the heart device is slightly larger in size than 'NAUGHTY' but I do not consider it to be dominant. The combination of the words 'be' and 'naughty' are not descriptive of the services in question. They are two ordinary and natural meaning words which act as an active exhortation for someone to be naughty. Therefore, all of the elements (the device and words) all contribute to the overall impression of the mark with no one being more dominant than another.

59. The contested trade mark is a word mark. The word 'DATING' is descriptive for some of the services in question (e.g. dating services, the provision of dating sites) and is therefore negligible in the overall impression of the mark. For the remaining services the word 'DATING' it is not descriptive but does allude to the subject matter in which the services are being provided. For example, the telecommunication and IT services provide the suitable platform for the facilitation of dating via websites and apps. Therefore, whilst 'DATING' for such services is distinctive it plays only a subordinate role in the mark compared to 'NAUGHTY'. Whilst the word 'NAUGHTY' is not directly descriptive of the services provided it is allusive of the intended purpose of the services provided. For the services which 'DATING' is descriptive, 'NAUGHTY' is considered to be the distinctive and more memorable element of the contested mark.

60. Visually, the signs coincide with the distinctive element 'NAUGHTY' which is present in both marks. They differ insofar that the earlier mark includes the word 'BE' and device, and the contested mark includes the word 'DATING' (though this is considered to be descriptive for some of the services in question and allusive for the rest). Taking all of the aforementioned factors into consideration, I find that the signs are visually similar to a medium degree.

61. Aurally, the earlier mark will be pronounced as two words, namely 'BE-NAUGHTY'. The device element will not be enunciated. The contested mark will also be pronounced as two words, namely 'NAUGHTY-DATING'. Therefore, the marks are aurally similar to a high degree.

62. Conceptually, the earlier trade mark is likely to be perceived as an active exhortation to 'be naughty'. The applicant's mark is not encouraging the average consumer to be naughty but is allusive of dating which may be mildly rude, indecent or more liberal than more conventional dating services. The concept of the user of the services being, or actively encouraged to be, 'naughty' is clear. Therefore I find that the conceptual similarity is above average but not high.

### **Distinctive character of the earlier trade mark**

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

"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-0000, paragraph 49).

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)."

64. The level of distinctive character of a trade mark can vary, depending on the particular goods at issue: a mark may be more distinctive for some goods than it is

for others. Distinctiveness can also be enhanced through use of the mark. There has been no explicit claim of enhanced distinctiveness but evidence of use has been filed in support of its section 5(3) of the Act claim. The evidence has been summarised above.

65. The opponent's evidence shows strong use of the ' NAUGHTY' mark. The relevant date on which enhanced distinctiveness through use must be established is 20 October 2016. The evidence shows that the revenue generated by the 'benaughty' websites between 2008 and 2016 are consistently in the millions. In 2011 it is stated, via a third party report<sup>1</sup>, the amount of users of the 'benaughty' website is 3m with '250,000 active weekly' users. This number of users appears to be consistently maintained up to April 2017<sup>2</sup>. Whilst this is after the relevant date it does cast light backwards<sup>3</sup> on the position at the relevant date which confirms the membership as being consistent at the 3m.

66. These factors all lead me to conclude that the opponent, by virtue of the use made of the ' NAUGHTY' mark, enjoyed a reputation in respect of '*Dating agency services, online dating agency services, chatroom and social networking services*' at the relevant date.

67. With regard to the remaining services in relation to which the opponent has not established that the mark's distinctive character has been enhanced by virtue of the use made of the mark, I must assess the inherent distinctiveness.

68. As previously stated, the words 'be' and 'naughty' are not descriptive of the services in question and act as an active exhortation for someone to be naughty. Combined with the device of a heart with horns and a tail lead me to conclude that the mark is inherently distinctive for the remaining services to an average degree.

---

<sup>1</sup> Exhibit LE14

<sup>2</sup> Exhibit LE15

<sup>3</sup> Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

69. The factors considered above have a degree of interdependency (*Canon* at [17]), so that a higher degree of similarity between the goods may be offset by a lower degree of similarity between the marks, and vice versa. I must make a global assessment of the competing factors (*Sabel* at [22]), considering them 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]).

70. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting as the Appointed Person, explained these types of confusion as follows:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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”.

71. 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 simply 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.

72. In determining whether there is a likelihood of confusion, I shall first assess the applicant's strongest position, i.e. based on the services whereby the opponent does not have an enhanced degree of distinctive character and the word 'DATING' within the application is not descriptive or allusive of the services in question and therefore distinctive.

73. I have found that the majority of the services are identical and some terms in Classes 38 and 42 as being highly similar. With regard to the respective marks, they have been found to be visually similar to a medium degree. From an aural perspective they are similar to a high degree and conceptually similar to above average, but not high, degree. The similarity is by virtue of both marks sharing the inherently distinctive and dominant word 'NAUGHTY', with the only differences between the marks being 'BE' and a device for the opponent and 'DATING' for the applicant.

74. I have also found that the services will be purchased with an average degree of care and attention, which is most likely to follow a visual inspection (though I do not discount aural considerations). I consider that the similarity between the marks, both of which contain NAUGHTY, combined with the services being either identical or highly similar, lead to a conclusion that there is a likelihood of confusion. Therefore, I find that even if the average consumer does recall the differences between the marks they are likely to perceive the application as a variant brand originating from the opponent, leading to indirect confusion.

75. Since the above reflects the applicant's best position, it must follow that where the opponent may rely upon an enhanced degree of distinctive character and DATING is descriptive, the opposition must also succeed.

## **Conclusion**

76. The opposition has been successful and, subject to appeal, the application will be refused.

77. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade marks upon which the opposition is based. Further, there is no need to consider the remaining grounds.

## **COSTS**

78. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. In the circumstances I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fees	£200
Preparing the notice of opposition and considering the counterstatement	£200
Preparing evidence and considering the other side's evidence	£500
<b>Total</b>	<b>£900</b>

79. I therefore order Alamex Ltd to pay Together Networks Holdings Limited the sum of £900. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 8th day of May 2018**

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