

O/0691/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003905341
BY WEBMIX YAZILIM HIZMETLERI LIMITED SIRKETI
TO REGISTER:**



AS A TRADE MARK IN CLASSES 9, 38, 41, 42 AND 45

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 442526
BY MATCH GROUP, LLC**

BACKGROUND AND PLEADINGS

1. On 26 April 2023, WEBMIX YAZILIM HIZMETLERI LIMITED SIRKETI (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 12 May 2023 in respect of the following goods and services in classes 9, 38, 41, 42 and 45:

Class 9: *Magnetic and optic data carriers and computer software and programmes recorded thereto; downloadable computer software for social media, dating and matchmaking; downloadable and recordable electronic publications; Downloadable software applications; Downloadable software for dating and matchmaking; downloadable software applications for dating and matchmaking to be used on wireless devices and mobile devices; Communication, networking and social networking software.*

Class 38: *Telecommunications services; video-on-demand transmission; providing internet chatrooms and online forums; teleconferencing and videoconferencing services; message sending; streaming of data; videoconferencing services; chatroom services; communication on social media platforms for social networking; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission, broadcasting and reception of audio, video, still and moving images, text and data; providing access to a video sharing portal; providing internet application services for communications; SMS/application message sending services; electronic delivery of images and photographs via a global computer network; telecommunications services for providing access to data/sound or images.*

Class 41: *Education and training; Arranging and conducting of conferences, congresses and seminars; Sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; Publication and editing of printed matter, including*

magazines, books, newspapers, other than publicity texts; electronic publication services; photographic reporting services; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; entertainment and amusement information via internet online; educational services; training services; organization and presentation of shows, competitions, games, concerts, education and entertainment events; arranging, organizing, conducting, and hosting social entertainment and education events; conducting educational conferences; production and distribution of streaming audio and video; production and distribution of broadcast programs; information, advisory and consultancy relating to the aforementioned services.

Class 42: *Computer services, namely, computer programming, computer system design, creating, maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for the internet, hosting websites; Industrial design services, other than engineering, computer and architectural design; graphic arts designing; Hosting, design and development of software in the field of mobile applications; Development of application software solutions; development of application software solutions for delivery of multimedia content; Providing online non-downloadable software for use in communication; Providing temporary use of online non-downloadable software for use in dating and matchmaking.*

Class 45: *Marriage agencies; Social networking services; Internet based dating, matchmaking and personal introduction services.*

2. On 14 August 2023, the application was opposed by Match Group, LLC (“the opponent”) based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purpose of its Section 5(2)(b) ground, the opponent relies on the following four trade marks and the goods and services covered by the same, as shown below:

UK00916246639 (“the first earlier mark”)

MATCH.COM

Filing date: 13 January 2017

Registration date: 13 November 2019

The opponent relies upon all of the goods and services for which the mark is registered, namely:

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

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

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

UK00003097217 (“the second earlier mark”)

match

Filing date: 03 March 2015

Registration date: 30 October 2015

The opponent relies upon some of the services for which the mark is registered, namely:

Class 45: *Providing social introduction and date-arranging services; administering personality and physical attractiveness testing and creating personality and physical attractiveness profiles of others; dating agency services; match-making services; computer dating services; information and advisory services relating to the aforesaid services; providing information regarding on-line dating and introduction services.*

UK00003415177 (“the third earlier mark”)

match

Filing date: 19 July 2019

Registration date: 11 October 2019

The opponent relies upon all of the goods and services for which the mark is registered, namely:

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

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

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

UK00003638131 (“the fourth earlier mark”)



MatchGroup

Mark Description/Limitation: The mark consists of the stylized letters "M" and "G" with shaded ovoids appearing over the "M" to resemble the shape of two human figures facing each other along with the word "MATCHGROUP" below the stylized letters

Filing date: 07 May 2021

Registration date: 26 November 2021

Priority date: 04 May 2021

Priority country: United States of America

TM from which priority claimed: 90690202

The opponent relies upon all of the goods and services for which the mark is registered, namely:

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 relationships 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; video conferencing 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, mobile phone 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 information and recommendations about social entertainment events by means of electronic communications; Entertainment services, namely, providing an online interactive database of videos and user generated content containing digital images, photos, text, 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 includes 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. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the marks are similar, and the goods and services are identical or similar.

5. For the purpose its Section 5(3) ground, the opponent relies on the first, second and third earlier mark which are set out in the table above (but not on the fourth earlier mark) claiming reputation for the same goods and services which are relied upon under Section 5(2)(b). In addition, under this ground, the opponent relies on two additional marks the details of which are set out below:

UK00003671573 (“the fifth earlier mark/flame device mark”)



Mark Description/Limitation: The colours shown in the mark are white (Pantone 11-0601 TCX), orange (Pantone PMS Orange 021) and pink (Pantone Pink C).

Filing date: 21 July 2021

Registration date: 07 January 2022

The opponent claims that this mark has a reputation for some of the services for which it is registered, namely:

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 via a website; 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 via a website.*

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 includes 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.*

WO0000001374703 ("the sixth earlier mark/flame device 2 mark")



Mark Description: The mark consists of a flame on an orange and pink background.
Colours claimed: The colour(s) orange and pink is/are claimed as a feature of the mark.

Colour indication: The mark consists of a flame on an orange and pink background.

International registration date: 25 September 2017

Designation date: 25 September 2017

Date of protection of the international registration in UK: 09 February 2018

Priority date: 23 August 2017

Priority country: United States of America

TM from which priority claimed: 87580368

The opponent claims that this mark has a reputation for all of the goods and services for which it is registered, namely:

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.*

Class 45: *Dating services provided via mobile applications; internet-based social networking, introduction and dating services.*

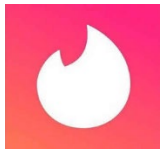
6. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks.

7. For the purpose of its Section 5(4)(a) ground, the opponent relies upon the following four unregistered signs which it claims to have use throughout the UK since the dates and for the services shown below:

match

Dated used: March 2015

Provision of dating, social introduction and social networking services; mobile app for dating, social introduction and associated social networking; website for dating, social introduction and associated social networking; organising events for entertainment purposes; entertainment services in the nature of arranging social entertainment events.



Dated used: 2012

Provision of dating, social introduction and social networking services; mobile app for dating, social introduction and associated social networking; website for dating, social introduction and associated social networking.

match

Dated used: March 2015

Dating services; online dating and introduction services; internet based social networking; downloadable software in the nature of a mobile application for internet-based dating and introduction.

match

Dated used: March 2015

Dating services; online dating and introduction services; internet based social networking; downloadable software in the nature of a mobile application for internet-based dating and introduction.

8. The opponent's claim under Section 5(4)(a) is as follows:

“The applicant has deliberately taken three brands of the opponent, being the word ‘match’, the composite match and heart device branding and a ‘flame device’ and incorporated these elements in the opposed mark. The word ‘match’, the device of a heart and the device of a flame are all present in the opposed application. Moreover, as is clearly shown by the designated goods and services, the applicant intends to target the opponent’s industry. This is a clear misrepresentation of the opponent’s goodwill which will invariably lead to damage to the opponent’s business.”

9. The applicant filed a counterstatement, denying the claims made and putting the opponent to proof of use of the second earlier mark (i.e. UK00003097217). In particular, the applicant argues that (a) the parties' goods and services are dissimilar; (b) the parties' signs are dissimilar because the only common elements between them are descriptive or generic words and figurative elements used in dating applications; (c) there is no likelihood of confusion; (d) the applied-for mark will not cause detriment to, or take unfair advantage of, the distinctive character of or reputation of the earlier marks.

10. The applicant also adds that it is a Turkish company, which was established in 2020 in Türkiye. It launched the "Matchpub" dating application in 2021, and the app

become one of the leading online dating applications with more than 600K downloads. The applicant further explains that MatchPub's aim is to bring the *"pub experience into the digital world to offer users a trustworthy chat environment"*, that *"users can register for free on MatchPub and have video conversations with other verified users, which makes it distinctive from other dating applications"* and that this is *"a reflection of traditional pub greetings in digital world"*.

11. The applicant further argues that the word 'MATCH' is descriptive and common for dating apps claiming that even the opponent uses it in a descriptive manner on their 'TINDER' application with the opponent's app being described as "MATCH, MEET & DATE NEW PEOPLE". In support of this claim, the applicant provides screenshots of dating apps taken from AppleStore. Lastly, the applicant argues that the figurative elements of the respective marks have nothing in common *"except [from] both being a flame which is used as "a powerful feeling" in love affairs"* and that the applicant's *"logo is an entirely original interpretation of the universal flame and heart icons, adapted by [the applicant's] own designer"*.

12. The opponent is represented by Barker Brettell LLP. The applicant is represented by RightPro IP & Legal Consultancy Ltd.

13. Both parties filed evidence. Neither party requested a hearing, and only the opponent filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

THE EVIDENCE

14. The opponent filed evidence in chief in the form of two witness statements, one from Céline Boudière (with exhibits CB1-11) and the other from Stuart Gurr (with exhibits SG1-4), both dated 8 January 2024.

15. Ms Boudière is the Chief Marketing Officer for Meetic and gives evidence about the opponent's use of its earlier marks. She explains that Match Group, LLC (i.e. the opponent) and Meetic are wholly owned indirect subsidiaries of Match Group, Inc. and

that Meetic is licensed by the opponent to use its MATCH trade marks in Europe and the UK.

16. Mr Gurr is the Vice President of Communications for Tinder. He gives evidence about Tinder's use of the flame device and explains that Match Group LLC (i.e. the opponent) is the parent company for Tinder.

17. In addition to its evidence in chief, the opponent also filed evidence in reply to the applicant's evidence in the form of a further witness statement from Céline Boudière dated 25 April 2024 (with exhibits CB12-14)

18. The applicant filed evidence in the form of the witness statement of Ismail Hakki Dilmec dated 6 March 2024 (with exhibits 1-4). Mr Dilmec is the founder and executive manager of the applicant company and gives evidence about the applicant's use of the applied-for mark and the opponent's position within the online dating business.

RELEVANCE OF EU LAW

19. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PROOF OF USE

20. The six trade marks relied upon by the opponent qualify as earlier marks under Section 6(1)(a) of the Act by virtue of their earlier filing dates. Only the second and sixth earlier mark have completed their registration procedures more than five years before the filing date of the applicant's mark and are subject to the use conditions, as per Section 6A of the Act. However, the applicant has requested proof of use only in relation to the second earlier mark (which is relied upon under both Section 5(2)(b) and 5(3)), but not the sixth earlier mark (which is relied upon under Section 5(3) only).

21. Though the opponent relies upon the second earlier mark for the purpose of both Section 5(2)(b) and 5(3), I do not think it adds anything to the opponent's case because the third earlier mark is nearly identical to the second earlier mark (the only difference being that it is presented in blue) and has a broader specification, covering, essentially, the same services in class 45 as those covered by the second earlier mark, as well as additional goods in class 9 and services in class 42. Accordingly, for reasons of procedural economy, I will proceed on the basis that the opposition based upon the second earlier mark cannot be more successful than that based upon the third earlier mark, and I will disregard the former for present purposes, only returning to it if it becomes necessary to do so.

DECISION

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because –

(a) ...

(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”.

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

23. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

24. 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:

(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 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 to mind the earlier mark, 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

25. When making the comparison, all relevant factors relating to the goods and services in the specifications 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 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.”

26. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

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

27. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

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

28. In *Sanco SA v OHIM*, Case T-249/11, the General Court (“GC”) indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

29. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

30. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

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

31. The competing goods and are as follows:

The applicant's goods and services	The opponent's goods and services
<p>Class 9: <i>Magnetic and optic data carriers and computer software and programmes recorded thereto; downloadable computer software for social media, dating and matchmaking; downloadable and recordable electronic publications; Downloadable software applications; Downloadable software for dating and matchmaking; downloadable software applications for dating and matchmaking to be used on wireless devices and mobile devices; Communication, networking and social networking software.</i></p>	<p>FIRST EARLIER MARK</p> <p>Class 9: <i>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.</i></p> <p>THIRD EARLIER MARK</p> <p>Class 9: <i>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.</i></p> <p>FOURTH EARLIER MARK</p> <p>Class 9: <i>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</i></p>

	<p><i>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.</i></p>
<p>Class 38: <i>Telecommunications services; video-on-demand transmission; providing internet chatrooms and online forums; teleconferencing and videoconferencing services; message sending; streaming of data; videoconferencing services; chatroom services; communication on social media platforms for social networking; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission, broadcasting and</i></p>	<p>FOURTH EARLIER MARK Class 38: <i>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</i></p>

<p>reception of audio, video, still and moving images, text and data; providing access to a video sharing portal; providing internet application services for communications; SMS/application message sending services; electronic delivery of images and photographs via a global computer network; telecommunications services for providing access to data/sound or images.</p>	<p>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 relationships 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; video conferencing 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.</p>
<p>Class 41: Education and training; Arranging and conducting of conferences, congresses and seminars; Sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment,</p>	<p>FOURTH EARLIER MARK Class 41: Provision of non-downloadable publications in the nature of articles in the fields of mobile application dating, internet-based dating, matchmaking, interpersonal</p>

sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; Publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; photographic reporting services; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; entertainment and amusement information via internet online; educational services; training services; organization and presentation of shows, competitions, games, concerts, education and entertainment events; arranging, organizing, conducting, and hosting social entertainment and education events; conducting educational conferences; production and distribution of streaming audio and video; production and distribution of broadcast programs; information, advisory and consultancy relating to the aforementioned services.

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, mobile phone 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 information and recommendations about

	<p><i>social entertainment events by means of electronic communications; Entertainment services, namely, providing an online interactive database of videos and user generated content containing digital images, photos, text, 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.</i></p>
<p>Class 42: <i>Computer services, namely, computer programming, computer system design, creating, maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for the internet, hosting websites; Industrial design services, other than engineering, computer and architectural design; graphic arts designing; Hosting, design and development of software in the field of mobile applications; Development of application software solutions; development of application software solutions for delivery of multimedia content; Providing online non-</i></p>	<p>FIRST EARLIER MARK</p> <p>Class 42: <i>Providing a website featuring technology in the field of social media, namely, a website that enables users to send status updates to subscribers of web feeds, upload and download electronic files to share with others.</i></p> <p>THIRD EARLIER MARK</p> <p>Class 42: <i>Providing a website featuring technology in the field of social media, namely, a website that enables users to send status updates to subscribers of web feeds, upload and download electronic files to share with others.</i></p> <p>FOURTH EARLIER MARK</p>

downloadable software for use in communication; Providing temporary use of online non-downloadable software for use in dating and matchmaking.

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 includes blog posts, new media content, other on-line

	<p><i>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.</i></p>
<p>Class 45: <i>Marriage agencies; Social networking services; Internet based dating, matchmaking and personal introduction services.</i></p>	<p>THE FIRST EARLIER MARK</p> <p>Class 45: <i>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.</i></p> <p>THE THIRD EARLIER MARK</p> <p>Class 45: <i>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.</i></p> <p>THE FOURTH EARLIER MARK</p> <p>Class 45: <i>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</i></p>

	<i>dating services; Online social networking services.</i>
--	--

32. Before I turn to the comparison of the goods and services, I should briefly say something about the opponent’s argument that the respective goods and services are identical or similar.

33. Aside from claiming that the applicant’s goods and services “*should be considered identical*” to the opponent’s goods and services based on the principle outlined in *Meric*, the opponent appears to confuse identity with similarity as it claims that if the goods and services are not considered to be identical, they must nonetheless considered to be similar to the extent that the opposed goods and services are not defined and could encapsulate the earlier goods and services as “*the broad drafting leads to an overlap in the industries*”. That is exactly what identity means applying the *Meric* principle, and it is not an argument that would lead to a secondary finding of similarity (as opposed to identity). In addition, in relation to other goods and services, the opponent claims that they are identical, but then states that the end purposes and channels of trade are identical – this suggests that only some of the relevant *Canon* criteria coincide. In my view, those submissions add nothing to the opponent’s case. Accordingly, unless I find that the overlap between the respective goods and services is obvious, I am not prepared to conclude that they are identical or similar based on lines of reasoning that have not been argued or advanced by the opponent.¹

Class 9

Magnetic and optic data carriers and computer software and programmes recorded thereto; downloadable computer software for social media, dating and matchmaking; downloadable and recordable electronic publications; Downloadable software applications; Downloadable software for dating and matchmaking; downloadable software applications for dating and matchmaking to be used on wireless devices and mobile devices; Communication, networking and social networking software.

¹ SmartX Trade Mark, BL O/0911/24

34. The opponent's specification covers various types of downloadable software all restricted to the following: for internet-based dating; for instant messaging; for enabling social networking; in the field of social media; for accessing, sending, receiving, posting, and sharing images, audio, video, text, links, data, and information via the internet; for use in communications between speakers of different languages by means of language translation and subtitling; 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.

35. The applicant's downloadable computer software for social media, dating and matchmaking; downloadable software applications; downloadable software for dating and matchmaking; downloadable software applications for dating and matchmaking to be used on wireless devices and mobile devices; communication, networking and social networking software are either self-evidently identical to the opponent's software goods, or are identical on the principle outlined in *Meric*, because they encompass, or are encompassed by, the opponent's goods. These goods are **identical**.

36. The applicant's Magnetic and optic data carriers and computer software and programmes recorded thereto are essentially non-downloadable computer software recorded on magnetic and optic data carriers and can include recorded (non-downloadable) computer software identical to the downloadable software covered by the earlier specifications, e.g. downloadable software for accessing, sending, receiving, posting, and sharing images, audio, video, text, links, data, and information via the internet. The nature, purpose and use of the respective goods is the same, all being the same type of software, the only difference being in the method of use insofar as the applicant's software is recorded, whereas the opponent's software is downloadable from the Internet. The goods target the same users and are in competition, although they are not complementary and are unlikely to share trade channels. These goods are similar to a **high degree**.

37. Lastly in this class, whilst the opponent's specification does not contain any term which is identical to the applicant's downloadable and recordable electronic

publications in class 9, the specification of the fourth earlier mark includes *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* (in class 41). Hence, the applicant's *downloadable and recordable electronic publications* (in class 9) might be in the same form and relate to the same field as those provided through the opponent's services (in class 41), namely in the form of articles in the fields of mobile application dating, internet-based dating, matchmaking, interpersonal relationships, social introduction and social networking. Although the nature of the respective goods and services is not the same, the applicant's goods being downloadable and recordable electronic publications, the opponent's services consisting of the provision of non-downloadable publications (and the method of use might differ accordingly), the purpose of the goods and services is the same insofar as they both provide the end-user with access to the same sort of publications. The goods and services are not complementary but can certainly be in competition, and might share trade channels, and producers as the same publisher might make its publications available through the provision of non-downloadable publications as well as in the form of downloadable and recordable electronic publications. These goods and services are similar to a high degree. Alternatively, the fourth earlier mark includes *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* (in class 9) which could be used to download the applicant's *downloadable and recordable electronic publications*; this would result in the goods targeting the same users, sharing distribution channels and being highly complementary and similar to also a medium degree.

Class 38

Telecommunications services; video-on-demand transmission; providing internet chatrooms and online forums; teleconferencing and videoconferencing services; message sending; streaming of data; videoconferencing services; chatroom services; communication on social media platforms for social networking; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission,

broadcasting and reception of audio, video, still and moving images, text and data; providing access to a video sharing portal; providing internet application services for communications; SMS/application message sending services; electronic delivery of images and photographs via a global computer network; telecommunications services for providing access to data/sound or images.

38. The fourth earlier mark covers a range of services in class 38, which are identical to the applied-for services in the same class.

39. The applicant's Telecommunications services is sufficiently broad to cover the opponent's *telecommunications services, namely, personal communication services*. These services are identical (*Meric*).

40. The applicant's video-on-demand transmission is a distribution method by which customers pay for each piece of video-on-demand content. These services are encompassed by the opponent's *telecommunication services, namely, electronic transmission and delivery of images, audio, video, text, links, data, and information via the internet and Transmission of sound, video and information from web cams, video cameras or mobile phones, all featuring live or recorded materials* which include transmission of video-on-demand. These services are identical (*Meric*).

41. The applicant's providing internet chatrooms and online forums; chatroom services; are sufficiently broad to encompass the opponent's providing on-line chat rooms for social networking. These services are identical (*Meric*).

42. The applicant's communication on social media platforms for social networking if not identical, is highly similar to the opponent's *providing text messaging services; on-line chat rooms for social networking; video conferencing services for social networking* which are all communication services that can be delivered in the context of social media platforms for social networking. These services are identical (*Meric*) or highly similar. I extend the same finding to telecommunications services for providing access to data/sound or images and providing internet application services for communications both of which encompass the opponent's video conferencing services.

43. The applicant's teleconferencing and videoconferencing services; videoconferencing services encompass the opponent's *video conferencing services for social networking* and so are identical (*Meric*).

44. The applicant's message sending; SMS/application message sending services; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission, broadcasting and reception of audio, video, still and moving images, text and data; electronic delivery of images and photographs via a global computer network either encompass or are encompassed by the opponent's broad term *telecommunication services, namely, electronic transmission and delivery of images, audio, video, text, links, data, and information via the internet*. These services are identical (*Meric*).

45. The applicant's streaming of data is the continuous transfer of data from one or more sources at a steady, high speed for processing into specific outputs. In my view, this term falls within the opponent's *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*, transmission of information and transfer of data meaning, is in my view, the same thing. These services are identical (*Meric*).

46. Lastly, in this class, the applicant's providing access to a video sharing portal are at least similar to the opponent's term *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*, the opponent's services being indispensable for the provision of the applicant's services in a way that consumer believes that the responsibility for the services lies with the same undertakings. In addition to being complementary, the services target the same users and might share trade channels. These services are similar to at least a medium degree.

47. If I am wrong, and some of the applied-for services are not identical, they are, nonetheless similar to a medium degree, as they are all telecommunication services sharing the same nature and having the same purpose of enabling the end-users to

communicate and/or access and share data, sounds or images. Further, the services target the same users and are normally distributed through the same trade channels.

Class 41

Education and training; Arranging and conducting of conferences, congresses and seminars; Sporting and cultural activities; entertainment; ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; Publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; photographic reporting services; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; entertainment and amusement information via internet online; educational services; training services; organization and presentation of shows, competitions, games, concerts, education and entertainment events; arranging, organizing, conducting, and hosting social entertainment and education events; conducting educational conferences; production and distribution of streaming audio and video; production and distribution of broadcast programs; information, advisory and consultancy relating to the aforementioned services.

48. The applicant's education and training; entertainment; educational services; training services; organization and presentation of shows, competitions, games, concerts, education and entertainment events; arranging, organizing, conducting, and hosting social entertainment and education events; entertainment and amusement information via internet online are either encompassed by, or encompass, the opponent's *Organizing and arranging social entertainment events; Entertainment services, namely, providing on-line non-downloadable interactive game software; Educational and entertainment services, namely, continuing programs about dating and relationships accessible by means of Internet streaming, video on demand, web-based applications, mobile phone 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. These services are identical (*Meric*). The same goes for the applicant's Sporting and cultural activities which fall within the opponent's *Organizing and arranging social entertainment events*, social entertainment covering sporting and cultural events.

49. The applicant's Publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line are either identical (*Meric*) or similar to, at least, a medium degree the opponent's *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; 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; Entertainment services, namely, providing an online interactive database of videos and user generated content containing digital images, photos, text, graphics, music, audio, video clips, multimedia content, and visual and audio performances; Providing non-downloadable music videos over the Internet or other communications network*, as they might cover the publication of the same multimedia content and overlap in trade channels.

50. The applicant's production and distribution of streaming audio and video; production and distribution of broadcast programs are identical (*Meric*) to the opponent's *Educational and entertainment services, namely, continuing programs about dating and relationships accessible by means of Internet streaming, video on demand, web-based applications, mobile phone applications, computer networks, and other forms of transmission media, namely, radio, television, satellite, audio and video.*

51. The applicant's ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts have no counterpart in the opponent's specification and the opponent has not provided any specific reasons why I should find that these

services are similar to its goods and services. In this connection, I note that in its submissions in lieu, the opponent provided a colour-coded table showing where the similarity between the respective services in class 41 lies; although the opponent presented the applied-for “*organization and presentation of shows, competitions, games, concerts, education and entertainment events; arranging, organizing, conducting, and hosting social entertainment*” in the same purple colour as the earlier “*entertainment, namely, live music concerts, arranging and conducting of concerts*” (I take this to mean that these services are identical or similar), it left the applied-for “*ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts*” uncoloured. I take this to mean that no identity or similarity between these services and the earlier services was identified. In any event, in the absence of a clear indication on the opponent’s part as to which goods or services of its own registrations are alleged to be similar to these services, I decline to find that they are identical or similar to any of the opponent’s goods and services.² The services have a different nature, purpose, method of use and use, they are neither complementary nor in competition, and there is no evidence that the channels through which the services are distributed coincide (for example, there is no evidence that those who arrange and conduct concerts and social events also provide ticket reservation and booking services), the targeting of the same average consumer, who is a member of the general public, not being sufficient for a finding of similarity. These services are **dissimilar**.

52. The same goes for the applicant’s *arranging and conducting of conferences, congresses and seminars* (which were left uncoloured) and *conducting educational conference*. Admittedly, the opponent’s specification covers some educational services, however, they are in the form of “*continuing programs about dating and relationships accessible by means of Internet streaming, video on demand, web-based applications, mobile phone applications, computer networks, and other forms of transmission media, namely, radio, television, satellite, audio and video*”. Educational services provided through conferences, congresses and seminars are very different in nature from programs about dating and relationships provided online (or through radio

² SMARTX, BL-O-911/24, paragraphs 27 and 28

and television), as conferences are “events, sometimes lasting a few days, at which there is a group of talks on a particular subject, or a meeting in which especially business matters are discussed formally”;³ likewise a congress is defined as “a large formal meeting of representatives from countries or societies at which ideas are discussed and information is exchanged”⁴ whereas a seminar is defined as “an occasion when a teacher or expert and a group of people meet to study and discuss something”.⁵ It appears to me, therefore, that online, radio and TV programs about dating and relationship are unlikely to be the subject of conferences, congresses and seminars, the latter involving a formal provision of educational services or expert discussions about academic subjects or international matters. These services have no counterpart in the opponent’s specification and the opponent has not provided any specific reasons why I should find these services to be similar. These services are **dissimilar**.

53. I extend the same conclusion to Photographic reporting services which I understand to cover a service akin to photographic journalism which is distinguished from other branches of photography services for being part of news media. These services have no counterpart in the opponent’s specification and the opponent has not provided any specific reasons why I should find these services to be similar. The services have different natures, purposes, uses, users, methods of use, they do not share trade channels and are neither complementary nor in competition. These services are **dissimilar**.

54. Furthermore, to the extent that I found some of the above services to be dissimilar, the same finding of dissimilarity applies to the corresponding information, advisory and consultancy relating to the aforementioned services.

Class 42

Computer services, namely, computer programming, computer system design, creating, maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for

³ Cambridge online dictionary

⁴ Cambridge online dictionary

⁵ Cambridge online dictionary

the internet, hosting websites; Industrial design services, other than engineering, computer and architectural design; graphic arts designing; Hosting, design and development of software in the field of mobile applications; Development of application software solutions; development of application software solutions for delivery of multimedia content; Providing online non-downloadable software for use in communication; Providing temporary use of online non-downloadable software for use in dating and matchmaking.

55. The opponent states that the opposed services in class 42 should be considered identical to the earlier services in the same class because “*there is a commonality in the end user, end purpose and delivery method in that both facilitate online interactions through the provision of access to online software and websites*”. The opponent also states that these services are highly similar to the earlier goods in class 9 because they are complementary - though it does not explain how – “*as they are the delivery method of the software itself in class 9*”. As I have said above, these claims do not really explain where the identity or similarity lies.

56. The applicant’s *providing temporary use of online non-downloadable software for use in dating and matchmaking* are identical to the opponent’s *providing temporary use of non-downloadable software for online introduction, dating and social networking services*. The same goes for the applicant’s *providing online non-downloadable software for use in communication* as the opponent’s services cover access to software for use in social networking whose main purpose is to allow communication between individuals. These services are **identical**.

57. However, I find that all the remaining services in the opposed specification in class 42 are dissimilar to the opponent’s services in the same class. This is because the opponent’s services in class 42 consist merely in providing temporary use of non-downloadable software for online dating, communicating, social networking, and location sharing/tracking as well as providing on-line web pages featuring user-defined information and a social network platform. Whilst these are services that can be accessed online by member of the general public, they are not highly specialised computer and IT services of the same kind of those listed in the applicant’s specification (namely *computer programming, computer system design, creating,*

maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for the internet, hosting websites; industrial design services, other than engineering, computer and architectural design; graphic arts designing; hosting, design and development of software in the field of mobile applications; development of application software solutions; development of application software solutions for delivery of multimedia content) which are business to business services and have nothing in common with the opponent's services. The services have different natures, purposes, uses, users, methods of use, they do not share trade channels and are neither complementary nor in competition. In particular, I consider that in the context of the words of the specification (which relate to highly specialised computer services) the terms *updating and rental of computer software, providing search engines for the internet*, refer to business to business services and would not cover the rental of dating software, and the provision of search engines for dating as services targeting members of the general public who seek dating services. These services are **dissimilar**.

Class 45

Marriage agencies; Social networking services; Internet based dating, matchmaking and personal introduction services.

58. The applicant's social networking services; Internet based dating, matchmaking and personal introduction services are identical to the opponent's dating services. Marriage agencies are, if not identical, highly similar to the opponent's dating services, as they have the same nature and purpose of meeting a partner for the purpose of dating or marriage, target the same users and are in competition, as users can choose between the parties' services to achieve the same result. These services are identical or highly similar.

59. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by

holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

60. Some similarity of goods and services is therefore essential for a likelihood of confusion to be established. Since I have concluded that there is no meaningful similarity between the following services, the opposition based on Section 5(2)(b) fails in relation to them:

Class 41: *ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; arranging and conducting of conferences, congresses and seminars; conducting educational conferences; photographic reporting services.*

Class 42: *Computer services, namely, computer programming, computer system design, creating, maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for the internet, hosting websites; Industrial design services, other than engineering, computer and architectural design; graphic arts designing; Hosting, design and development of software in the field of mobile applications; Development of application software solutions; development of application software solutions for delivery of multimedia content.*

Average consumer

61. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The 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.”

62. The average consumer of the parties’ goods and services is a member of the general public, although given that most of the goods and services at issue relate to online dating, the average consumer will be over the age of 18.

63. The purchasing process for the goods is likely to be predominantly visual, with the goods being downloaded from websites or purchased from retailers (in shops or online). However, as word-of-mouth recommendations may also play a part, I do not discount that there will also be an aural component to the purchase. Turning to the services, they are likely to be selected primarily visually following consideration of websites and promotional material. However, the aural component might also play a role via word-of-mouth recommendations.

64. In respect of the level of attention paid, I am of the view that it will be medium, neither higher nor lower than the norm, even in relation to goods and services that relate to dating. This is because whilst the average consumer is likely to consider a range of factors (such as, for example, the size of the userbase already signed up to the service, any potential match-making methods or algorithms used by the service provider, any promotional materials that points to the success rate of the services and testimonials from past users who found partners via that service), the goods and services are neither highly specialised nor particularly expensive.

Comparison of marks

65. 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 CJEU 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.”

66. 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. The respective marks are shown below:

The application	The earlier marks
	<p data-bbox="810 309 1007 338">MATCH.COM</p>   <p data-bbox="810 891 1214 958">MatchGroup</p>

Overall impression

The application

67. The application consists of a figurative element representing a pink flame incorporating a white heart shape followed by the words 'match' and 'pub' presented in lower case letters in a slightly stylised font. Although the two words 'match' and 'pub' are conjoined, the average consumer will perceive them separately because they are well-known English words and are clearly separated by the difference in the thickness of the fonts.

68. Although the figurative element is placed before the words 'matchpub', the principle that beginnings of marks tend to be more focused upon is, in this case, overridden by the rule of thumb that words speak louder than devices. This is because although, admittedly, the word 'match' is very low in distinctiveness (or descriptive) in the context of some of the goods and services concerned, which relate to online dating and matchmaking, as it is a reference to the nature of the services (i.e. to find a match): (i) the figurative element is even less distinctive than the word 'match' since the

images of a flame and a heart are banal, are not heavily stylised and symbolise passion and love and (ii) the word 'PUB' is averagely distinctive and forms a unit with the word 'match', the two words having the greater weight in the overall impression.

The first earlier mark

69. The opponent's first earlier mark consists of the word 'MATCH' followed by the internet domain name suffix '.COM', all presented in capital letters. The overall impression of this mark will be dominated by the word 'MATCH' given that the element '.COM' merely indicates a domain name and will therefore have much less impact in the overall impression.

The third earlier mark

70. The opponent's third earlier mark consists of the word 'match' presented in blue, in a slightly stylised lower-case font with a heart device positioned at the top right of the letter 'h'.

71. As I have mentioned above, it is a general rule of thumb that words speak louder than devices. I consider that rule to be applicable here. The heart device plays a subordinate role as it is relatively smaller in size compared to the word 'match' and it is placed at the end of the word. Further, even if the word 'match' is very low in distinctiveness (or descriptive) in the context of some of the goods and services at issue (i.e. those relating to dating and matchmaking), the heart device is even less distinctive as it is a symbol of love and romantic relationships. Overall, I find that although the heart device has a visual impact, it is the word 'match' which is more dominant and by which the mark is likely to be referred to and which carries the greater weight in the overall impression of the mark.

The fourth earlier mark

72. The opponent's fourth earlier mark consists of the words 'MatchGroup' conjoined and presented in title case, in a grey slightly stylised font. This element is placed underneath a figurative element which appears as the initial letters 'M' and 'G'

presented in a handwritten script with the addition of two dots above the letter 'M' that are stylised to look like two connected individuals.

73. Whilst the figurative element has a visual impact, it will be perceived as being a stylised version of the initialism 'MG' which stands for 'MatchGroup'. Consequently, whilst both elements contribute to the overall impression, it is 'MatchGroup' that carries more weight.

Visual similarity

74. Visually, the application and the first earlier mark coincide in the word 'match/MATCH'; this is the dominant element of the earlier mark and the first co-dominant element of the application. Further, as the earlier mark is a word-only mark, it can be presented in the same stylised font as that used in the application. Although the figurative element in the application and the suffix '.COM' in the earlier mark create some visual differences between the marks, they have very little impact due to their reduced weight in the overall impression. Moreover, whilst the word 'pub' creates a more distinctive difference, it is placed after the word 'match' and it is shorter. Overall, I consider these marks to be similar to a medium degree.

75. Turning to the third earlier mark, the marks coincide in the word 'match', which is the dominant element of the earlier mark and the first co-dominant element of the application. Although the figurative elements of the marks are not identical and are placed before and after the dominant words 'matchpub' and 'match' respectively, they are both very small in size, are weakly distinctive and have very little impact due to their reduced weight in the overall impression; second, they both represent a heart (though this is incorporated in a flame in the application). Lastly, whilst the word 'pub' creates a more distinctive difference, it is placed after the word 'match' and it is shorter. Overall, I consider these marks to be similar to a medium degree.

76. Finally, the fourth earlier mark. This mark and the application coincide in the word 'match/Match' which is a co-dominant element in both marks. Although the figurative element of the application creates some visual differences between the marks, it has very little impact due to its reduced weight in the overall impression. Moreover, whilst

the word 'pub' and 'Group' create more distinctive differences, they are placed after the words 'match/Match' and are shorter and/or subordinated to it. Lastly, the figurative element of the earlier mark is likely to be perceived as a stylised version of the initialism 'MG' reinforcing the identification of 'MatchGroup' as the element having the greater weight in the overall impression. Overall, I consider these marks to be similar to a medium degree.

Aural similarity

77. From an aural point of view, the figurative elements of the marks will not be verbalised. I consider that (i) 'MATCH - PUB' and 'MATCH -DOT-COM' (in the first earlier mark) are similar to a medium degree, (ii) 'MATCH-PUB' and 'MATCH' (in the third earlier mark) are similar to a medium to high degree and (ii) 'MATCH-PUB' and 'MATCH -GROOP' (in the fourth earlier mark) are similar to medium degree.

Conceptual similarity

78. Conceptually, the main concept conveyed by the marks is provided by the word 'match' which will be the same in all marks. The word 'match' has different meanings, including the following:⁶

- *“A sports competition or event in which two people or teams compete against each other – e.g. a tennis match”.*
- *“A person or thing that is equal to another person or thing in strength, speed, or quality – e.g. be no match for something/someone”.*
- *“Something that is similar to or combines well with something else – e.g. The curtains look great - they're a perfect match for the sofa”.*

⁶ Cambridge online dictionary

- *“If two people who are having a relationship are a good match, they are very suitable for each other – e.g. Theirs is a match made in heaven (= a very good relationship)”.*

79. As it can be seen, the meaning of the word ‘match’ alone is not the same as that of the word ‘matchmaking’, which means *“the activity of arranging marriages or romantic relationships between people – e.g. a matchmaking service/website/app”*. Nevertheless, when used in relation to dating software and dating/introduction services, the word ‘match’ is likely to be seen as a reference to the nature of the goods and services (to find a match).

80. Admittedly, whilst the word ‘match’ is very low in distinctiveness (or descriptive) for goods and services aimed at finding a partner or a match, the other concepts conveyed by the marks, namely the words ‘.com’ and ‘group’ and the heart/flame devices are even less distinctive and do not introduce any distinctive conceptual difference between the marks. The average consumer is likely in fact to take the element ‘.com’ as a reference to the fact that the goods and services are provided online and the element ‘group’ as a reference to the nature of company providing the goods and services, whilst the heart/flame devices are banal and given the nature of the goods and services (which are aimed at finding a partner), are descriptive as they symbolise the concept of love, passion and relationships.

81. The word ‘pub’ in the application is, in itself, more distinctive than the word ‘match’, but will be read in conjunction with the word ‘match’ and I accept the applicant’s argument that the average consumer will perceive ‘matchpub’ as a reference to the fact that the users of the applicant’s goods and services will *“match and meet”* with other users in a virtual setting that tries to reproduce the experience of a more traditional pub setting. Consequently, the combination somewhat downgrades the conceptual significance of the word ‘pub’ because it is the matching (and meeting) experience of the pub that is more relevant. Hence, I find that the marks are conceptually similar to a medium degree.

Distinctive character of earlier mark

82. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

83. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

84. As it will be recalled, the applicant states that the word ‘MATCH’ is descriptive and common for dating applications. This was addressed by the opponent in its

submissions in lieu where he states that the claim is denied. In addition, the opponent states:

“At page 9 of the Counterstatement, the Applicant included 5 screenshots from dating service providers being Vibing, Live, Zoosk, eHarmony and Boo to presumably support this statement. It is not denied that the word "match" may be used generically to describe a possible characteristic of a dating service provider but that is completely different to the claim that "MATCH is common for dating applications". None of the examples provided are for Apps themselves which contain MATCH as part of the brand name. Moreover, no other leading dating service provider has a brand which uses MATCH (Table 1, First Witness Statement of Céline Boudière dated 08 January 2024 and Second Witness Statement of Céline Boudière dated 25 April 2024 at paragraph 5).

Even should the Office conclude that the inherent distinctiveness of the Earlier MATCH Registrations is low, the evidence filed by the Opponent, and indeed past decisions of the UK IPO, confirms that the Opponent enjoys an enhanced degree of distinctiveness consequent of the use of the Earlier Registrations. Indeed in the decision 0-1114-22, the view is that the "inherent distinctiveness of both marks [MATCH.COM [and the third earlier mark] had been elevated to a high degree at that date for those particularly goods and services". The relevant goods being "downloadable software in the nature of a mobile application for internet-based dating" and "online dating services" in class 45. This decision was issued 16 December 2022.”

85. I have read decision of the Hearing Officer in *MATCHU MEETCHU* (BL-O-1114-22). The starting point in her assessment was that the average consumer would be well aware of the meaning of the everyday word ‘MATCH’ which, in the context of the opponent’s services in class 45 would be perceived as meaning a person who is well-suited to another. She then concluded that inherently, the word ‘MATCH’ is “*extremely low in distinctiveness*” in relation to the registered services in class 45 and also in relation to the goods in class 9 which enable the user to engage in such services and for the earlier services in class 42 which may be closely aligned/integral to the opponent’s (online) services in class 45. She further concluded that the heart device

“is not particularly distinctive for any of the earlier goods or services”. Having found that the present first and third earlier mark (which were relied upon in that opposition) were low in distinctiveness, the Hearing Officer went on to assess the evidence of use and concluded that the distinctiveness of these marks had been enhanced to a high degree at the relevant date of 20 February 2020 for *online dating services* in class 45 and *downloadable software in the nature of a mobile application for internet-based dating* in class 9.

86. The marks relied upon in this opposition are the same as those relied upon in *MATCHU MEETCHU*. However, the relevant date here is 26 April 2023 which is over 3 years after the relevant date in *MATCHU MEETCHU*. Nevertheless, from the summary of the evidence in *MATCHU MEETCHU* it also looks like the evidence filed in that case overlaps significantly with that filed in the present case. I set out below the most pertinent information therein:

- Mr Chouteau states that MATCH.COM has been used by the opponent (and its predecessors in title) since 1995. The match + heart logo mark has been used by the opponent in the UK since 2015.
- By 2004, MATCH.COM online dating services had over 42 million registered users and secured an entry in the Guinness World Records.⁷
- By October 2008, MATCH.COM UK celebrated 2 key achievements: since 2001 more than 1 billion messages had been sent and 1 billion winks (being a virtual signal within the messaging service or chatroom service) had been sent.⁸
- MATCH.COM had a mobile app as early as 2008 and had a dedicated app for iPhones and Palm Pre phones in 2009, with dating apps for Android and Blackberry launched in 2010.⁹

⁷ Exhibit CB1

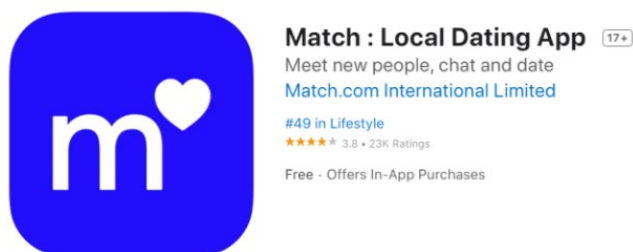
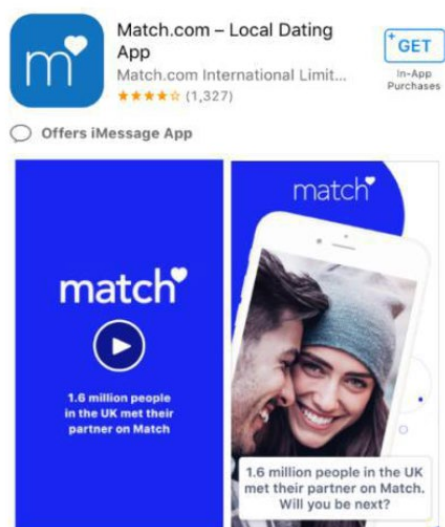
⁸ Exhibit CB2

⁹ Exhibit CB3

- Data provided by IPSOS Brand Tracking, which assesses brand awareness, shows that ‘the Match brand’ has been in the top 3 of awareness of online dating service providers, and in the top 2 of consideration (this means that the brand has been tried at least once with 6 months or at least considered) every year from 2014 – 2022, for consumers in the UK. The ‘MATCH’ brand has also hit the number one for three years in awareness (2014, 2015 and 2018) and six years in consideration (2014, 2015, 2018, 2019, 2020 and 2022).
- IPSOS also assesses the usage of the brand for UK consumers. ‘Usage’ means that the brand has been used at least once within the last 6 months and at least once a week. For the years 2014-2019, Match was in the top 4 brands used. However, its rating went down to 9th place in 2020, 7th place in 2021, and 6th place in 2022.
- A number of press articles are provided, reviewing brands which provide online dating services and apps.¹⁰ MATCH.COM is listed in the articles as being one of the best/top online dating service/app providers in the years 2015 – 2020. Notably, an article from Statista details the percentage of UK users for leading providers and shows that 45% of respondents used Match.com in 2017; an article dated 2019 from the UK website www.hitched.co.uk lists MATCH.COM at number 5 in a list of the best online dating sites, and an article from ww.scribbler.com shows that MATCH.COM was the 3rd most popular UK dating app in 2021 with over half million average monthly searches.
- Further, a table is provided, listing a large number of adverts that were said to have been shown in the UK from 2015 -2022, their duration and the date on which they were shown. All are said to have shown MATCH, www.match.com and the match + heart logo. The channels said to have shown these adverts include ITV, E4, Channel 5, Channel 4, MTV, SKY ONE, 5Star and TLC.
- The opponent spent between 9.3 million and 10.8 million Euros in online advertising campaigns in the years 2015 – 2022.

¹⁰ Exhibit CB5

- The opponent has provided the MATCH app since 2010. The app enables the opponent’s customers to sign up to the online dating service, review potential partners, manage payment and subscriptions, manage and update their profile, conduct searches and contact other members. An image of the app is provided showing the match + heart logo and MATCH.COM, as shown below:



- A table showing the number of times the opponent’s Match app has been downloaded in the UK during the years 2015 – 2022 shows figures of approximately 400,000 downloads every year.
- A table showing the UK Monthly Active Users of the opponent’s online dating services is provided i.e. a unique user who has visited the domain in the last 28 days, as follows:

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

Table 8:UK Monthly Active Users

- The following table is provided showing subscription revenue for the MATCH brand in the UK:

Year	Match UK Subscription Revenue (£) in excess of (million)
2022	19
2021	21
2020	21
2019	21
2018	23
2017	27
2016	29
2015	28
2014	30
2013	30

This equates to over £250million over a period of 10 years. The evidence explains that the subscription revenue is generated through the subscription payments derived from the provision of online dating and social introduction services whether via these services are accessed via the Match app or via the domain.

87. Looking at the evidence in the round, I am also of the view that even if the word 'MATCH' in the earlier marks had no or very little distinctiveness as a starting point, by reason of the opponent's activities, by the relevant date, the word 'Match' (which formed the dominant part of all the earlier marks) had become a word which the average consumer would have associated with the business of the opponent and had become distinctive to a high degree (or to a degree between medium and high if the initial position is one of descriptiveness rather than very low distinctiveness) in relation

to 'online dating services' in class 45 and 'Downloadable software in the nature of a mobile application for internet-based dating' in class 9.

88. For the other goods and services, which are not related to online dating and for which the word 'MATCH' is not descriptive (or very low in distinctiveness) , the earlier marks are inherently distinctive to a medium degree.

Likelihood of confusion

89. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

90. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

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

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

91. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.

92. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must

be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

93. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

94. Earlier in this decision I found that:

- Most of the goods and services are identical or similar to a high degree with a few being similar to a medium degree.
- The average consumer for the goods and services is a member of the general public who will select the goods and services visually with a medium degree of attention.
- The application and the first earlier mark are visually, aurally and conceptually similar to a medium degree. The same goes for the fourth earlier mark, whereas the application and the third earlier mark are visually and conceptually similar to a medium degree and aurally similar to a medium to high degree.
- Regardless of the starting position, the distinctiveness of the shared element ‘MATCH’ in the earlier marks has been enhanced to a high degree (or at least medium to high) as a result of the use made in relation to ‘online dating services’ in class 45 and ‘Downloadable software in the nature of a mobile application for internet-based dating’ in class 9. For the other goods and services, which are not related to online dating, the earlier marks are distinctive to a medium degree.

95. In theory, the fact that the competing marks share a common element that is descriptive or very low in distinctiveness may make it harder to conclude that there is a likelihood of confusion, but it does not make it impossible.¹¹ However, in this case, the opponent has overcome this initial difficulty, having demonstrated that as a result

¹¹ *Peninsula Face2Face*, BL-O-0368/23

of the use made, the earlier marks had acquired a very substantial degree of distinctiveness and reputation as a brand and a badge of origin for Match's online dating services by the relevant date. In other words, whilst the average consumer will be aware of the descriptive connotation of the word 'MATCH' in the context of goods and services relating to online dating, it will also be aware that it is the opponent's brand, identifies the opponent's business, and is being used by the opponent both descriptively and distinctively. This is clear from the IPSOS brand reports.

96. In my view, whilst the differences between the marks, in particular the presence of the word 'PUB' in the application is sufficient to avoid direct confusion, it is not sufficient to avoid indirect confusion. Although the word 'PUB' is distinctive of itself, the applicant has argued (an argument which I have accepted) that the average consumer will perceive 'matchpub' as a reference to the fact that users of the goods and services will "match and meet" with other users virtually similarly to what people do in a traditional pub setting - this implicitly downgrades the significance of the word 'PUB' insofar as it becomes descriptive of the nature of the goods and services (i.e. to denote the experience of finding a partner or match in a pub). In particular, Mr Dilmec provided evidence that the applicant has "*aimed to create a virtual pub experience for a trustworthy chat environment*" whereby users of the 'MatchPub' app have video conversations with other verified users, which makes it distinctive from other dating applications, because it is similar to meeting someone in a pub physically (rather than virtually). It is therefore likely that the average consumer who is familiar with the opponent's use of the distinctive brand 'MATCH' (and the earlier marks) for online dating, would believe that 'matchpub' is another mark used by the opponent in relation to a specific line of goods and services which try to replicate in a virtual setting the experience of meeting a prospective partner and finding a match in a pub.

97. There is a likelihood of indirect confusion.

98. For the sake of completeness, I should make two observations.

99. First, although the evidence does not show use of the fourth earlier mark as such, the enhanced distinctiveness acquired by the word 'MATCH' is also a strength to the fourth earlier mark which will be seen as a 'MATCH' mark used by the MATCH group

of companies. The fact that this mark covers services other than the ones in relation to which the element 'MATCH' has acquired enhanced distinctiveness, is not fatal, as the relevant services in classes 38 and 41 are identical or similar to the opponent's registered services and are sufficiently aligned to the opponent's online dating business to cause confusion.

100. Second, I have not overlooked Mr Dilmec's evidence that the applicant's main target is Turkey where the opponent's brand MATCH.COM is not known, and that the applicant's UK downloads only consists of 0,6% of total downloads. This is irrelevant as the likelihood of confusion must be assessed from the point of view of the UK consumer (not the consumer residing in Turkey). Likewise, the applicant made an allegation that the opponent owns almost all dating applications to prevent any competitors, and is attempting to monopolise the online dating market by using and registering descriptive words as trade marks. This is not something that fall within the assessment I am required to undertake under Section 5(2)(b), and shall say no more about it.

101. Lastly, in his witness statement, Mr Dilmec mentions the existence of other two trade marks containing the word 'MATCH', namely 'MUDDY MATCH' in the UK and 'CATHOLIC MATCH' in the US which he claims are used for conflicting services and provides copies of these mark registrations.¹² Suffices to say that state of the register evidence has very little or no weight in opposition proceedings as it tells one very little, and does not tell one what is happening in the market place.¹³

102. The opposition under Section 5(2)(b) succeeds in relation to the following goods and services:

Class 9: *Magnetic and optic data carriers and computer software and programmes recorded thereto; downloadable computer software for social media, dating and matchmaking; downloadable and recordable electronic publications; Downloadable software applications; Downloadable software for*

¹² Exhibit IV

¹³ *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01 and *Zero Industry Srl v OHIM*, Case T-400/06

dating and matchmaking; downloadable software applications for dating and matchmaking to be used on wireless devices and mobile devices; Communication, networking and social networking software.

Class 38: *Telecommunications services; video-on-demand transmission; providing internet chatrooms and online forums; teleconferencing and videoconferencing services; message sending; streaming of data; videoconferencing services; chatroom services; communication on social media platforms for social networking; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission, broadcasting and reception of audio, video, still and moving images, text and data; providing access to a video sharing portal; providing internet application services for communications; SMS/application message sending services; electronic delivery of images and photographs via a global computer network; telecommunications services for providing access to data/sound or images.*

Class 41: *Education and training; Sporting and cultural activities; entertainment; Publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; entertainment and amusement information via internet online; educational services; training services; organization and presentation of shows, competitions, games, concerts, education and entertainment events; arranging, organizing, conducting, and hosting social entertainment and education events; production and distribution of streaming audio and video; production and distribution of broadcast programs; information, advisory and consultancy relating to the aforementioned services.*

Class 42: *Providing online non-downloadable software for use in communication; Providing temporary use of online non-downloadable software for use in dating and matchmaking.*

Class 45: *Marriage agencies; Social networking services; Internet based dating, matchmaking and personal introduction services.*

But fails in relation to the following services:

Class 41: *ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; arranging and conducting of conferences, congresses and seminars; conducting educational conferences; photographic reporting services.*

Class 42: *Computer services, namely, computer programming, computer system design, creating, maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for the internet, hosting websites; Industrial design services, other than engineering, computer and architectural design; graphic arts designing; Hosting, design and development of software in the field of mobile applications; Development of application software solutions; development of application software solutions for delivery of multimedia content.*

Section 5(3)

103. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

104. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and the court's answer to question 1 in *L'Oreal v Bellure*).

105. The conditions of Section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the 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 later mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of

Section 5(3) that the goods and 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.

106. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, that being 26 April 2023.

Reputation

107. In *General Motors*, Case C-375/97, the CJEU held that:

“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.


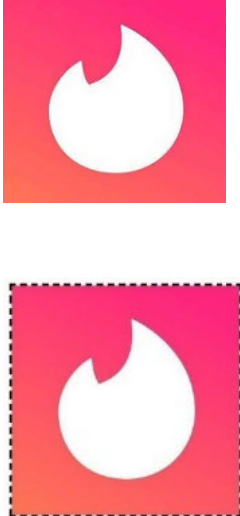
26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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.”

108. Under this ground the opponent relies on the first and the third earlier mark (as it will be recalled, I have taken the approach of disregarding the second earlier mark).

109. I have discussed the evidence of use above when dealing with the question of enhanced distinctiveness. For the same reasons I have outlined above, I find that at the relevant date, the first and third earlier marks had a reputation in the UK in relation to *‘online dating services’* in class 45 and *‘downloadable software in the nature of a mobile application for internet-based dating’* in class 9. This is sufficient for me to consider the question of a link. However, before I turn to consider that question, I would need to decide whether the opponent has also a reputation in the two additional figurative marks (i.e. the fifth and sixth earlier mark) that I reproduce below:

The application	The earlier marks
	

110. One of the requirements for the ground under Section 5(3) to succeed is that the competing marks are similar, or sufficiently similar to cause a link. In this case, there is no similarity in my view between the opponent’s flame devices and the applicant’s mark which includes a flame device. This, in turn, makes the question of whether the opponent’s flame devices had a reputation redundant. Aside from the fact that the devices in the respective marks represent the same concept of a flame, they **do not** do so graphically in a distinctively similar manner. The flame device in the application is light pink and has a symmetric shape with three high points (the central one being higher than the lateral ones) and incorporates a white heart shape in the middle; the opponent’s flame devices are white against a bright pink/orange rectangular background and have only two high points (rather than three), the right one being higher than the left one. In addition, the application contains the dominant verbal element ‘matchpub’ which have no counterpart in the earlier flame devices. The overall

impression of these marks is strikingly different. The sharing of a concept (i) which is descriptive for the services in relation to which reputation is claimed and (ii) without a similar graphic representation of the same, does not make the competing marks similar. Accordingly, in the absence of any similarity between the competing marks, the opposition under Section 5(3) based on these flame devices fail at the first hurdle.

111. I will therefore limit my consideration of the link to the first and third earlier mark.

LINK

112. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

113. I adopt the same finding as above.

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.

114. I adopt the same finding as above in relation to the goods and services in classes 9, 42 and 45. However, the opponent does not rely on the fourth earlier mark under this ground (the fourth earlier mark being the only earlier mark which cover services in class 38 and 41). Nevertheless, I find that the applied-for services in class 38 and 41 are similar to a low degree to the opponent's goods and services in classes 9, 42 and 45 insofar as they can all relate (or be aligned) to the provision of online dating. The average consumer is a member of the general public.

The strength of the earlier mark's reputation

115. The reputation of the earlier marks is a strong one.

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

116. The earlier marks are inherently very low in distinctiveness, however the use made by the opponent has increased their distinctiveness to a high degree (or medium to high degree).

Whether there is a likelihood of confusion

117. Under Section 5(2)(b) I found that there is a likelihood of confusion in relation to the applied-for goods in class 9, the services in class 45 and some of the services in class 42. I extend the same finding here to the services in class 38 and 41, though the level of similarity now is lower (as the services in class 38 and 41 are no longer relied upon under this ground).

118. Whilst I find that the applied-for mark would create a link in the mind of the average consumer (and cause damage) in relation to similar goods and services, in my view, the reputation of the earlier marks is not sufficient to bridge the gap between the opponent's goods and services and the applicant's services which I found to be dissimilar and have survived the objection based on Section 5(2)(b). Any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation will without doubt diminish as one moves away from the core online dating services in relation to which the earlier marks have been used.¹⁴ This is all the more so since the shared word 'MATCH' is an ordinary English word: it is not, therefore, a highly distinctive fanciful or invented word. Further, the word 'MATCH' has an inherent descriptive connotation in relation to the goods and services for which it has built a reputation. Consequently, when encountering the word 'MATCH' used in another mark for services for which that word is neither descriptive nor has it acquired enhanced distinctiveness (as opposed to the use made by the opponent which is both descriptive and distinctive) the average consumer will not make a link with the opponent's 'MATCH' brand. If a link is made it will be so fleeting not to cause any damage.

¹⁴ ROJA DOVE, BL-O- 016/10

119. Consequently, the opposition under Section 5(3) cannot succeed to a greater extent than that under Section 5(2)(b).

Section 5(4)(a)

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

121. Subsection (4A) of Section 5 states:

“(4A) 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.”

122. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely

goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

123. 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 is 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.”

124. Under this ground the opponent relies on the word ‘MATCH’ as well as on two signs corresponding to the second and third earlier mark and on a figurative sign corresponding to the flame device with the services for which goodwill is claimed all being relating to online dating.

125. The relevant date for the assessment under this ground is the filing date of the application at issue, being it 26 April 2023. The first hurdle for the opponents is to show that it had the required goodwill at the relevant date.

126. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage 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.”

127. Goodwill arises as a result of trading activities and accrues to the business that the public thinks is responsible for the goods and services. The relevant market for assessing goodwill is the UK. I reviewed the opponent’s evidence above and I found that at the relevant date the opponent had a very successful business in the UK providing goods and services for online dating and was one of the top three performers in the relevant UK market between 2015 and 2022. Taking all this into account, I find that the opponent has been able to evidence sufficient goodwill for online dating services.

128. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

129. Although this was an infringement case, the principles apply equally under Section 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

130. In my view, this is the case here. Whilst I find that the relevant public faced with the applicant's mark will believe that there is a connection with the earlier marks in relation to identical services in class 45, and similar goods and services in classes 9, 38, 41 and 42 (which are closely aligned/integral, or at least similar to a low degree, to the opponent's online dating services in class 45), I find that the differences between the remaining services (those which have survived the Section 5(2)(b) attack) are too significant to give rise to misrepresentation. As such the opposition based on Section 5(4)(a) cannot succeed to a larger extent as that under Section 5(2)(b).

OUTCOME

131. The opposition is successful in relation to the following goods and services which will be refused registration:

Class 9: *Magnetic and optic data carriers and computer software and programmes recorded thereto; downloadable computer software for social media, dating and matchmaking; downloadable and recordable electronic publications; Downloadable software applications; Downloadable software for dating and matchmaking; downloadable software applications for dating and matchmaking to be used on wireless devices and mobile devices; Communication, networking and social networking software.*

Class 38: *Telecommunications services; video-on-demand transmission; providing internet chatrooms and online forums; teleconferencing and videoconferencing services; message sending; streaming of data; videoconferencing services; chatroom services; communication on social media platforms for social networking; transmission of text/photo/video via the smart phone application; transmission of information via applications for smart phones; transmission, broadcasting and reception of audio, video, still and moving images, text and data; providing access to a video sharing portal; providing internet application services for communications; SMS/application message sending services; electronic delivery of images and photographs via a global computer network; telecommunications services for providing access to data/sound or images.*

Class 41: *Education and training; Sporting and cultural activities; entertainment; Publication and editing of printed matter, including magazines, books, newspapers, other than publicity texts; electronic publication services; multimedia publishing of printed matter, books, magazines, journals, newspapers, newsletters, tutorials, maps, graphics, photographs, videos, music and electronic publications; electronic publication of information on a wide range of topics on-line; entertainment and amusement information via internet online; educational services; training services; organization and presentation of shows, competitions, games, concerts, education and entertainment events; arranging, organizing, conducting, and hosting social entertainment and education events; production and distribution of streaming audio and video; production and distribution of broadcast programs; information, advisory and consultancy relating to the aforementioned services.*

Class 42: *Providing online non-downloadable software for use in communication; Providing temporary use of online non-downloadable software for use in dating and matchmaking.*

Class 45: *Marriage agencies; Social networking services; Internet based dating, matchmaking and personal introduction services.*

132. The opposition fails in relation to the following services which will proceed to registration:

Class 41: *ticket reservation and booking services for entertainment, sporting and cultural events, including ticket reservation and booking services for theatres, cinemas, museums and concerts; arranging and conducting of conferences, congresses and seminars; conducting educational conferences; photographic reporting services.*

Class 42: *Computer services, namely, computer programming, computer system design, creating, maintaining and updating websites for others, computer software design, updating and rental of computer software, providing search engines for the internet, hosting websites; Industrial design services,*

other than engineering, computer and architectural design; graphic arts designing; Hosting, design and development of software in the field of mobile applications; Development of application software solutions; development of application software solutions for delivery of multimedia content.

COSTS

133. Both parties have achieved a measure of success. Accordingly, I order that each party bear their own costs.

Dated this 24th day of July 2025

TERESA PINTO
For the Registrar