

**O-1114-22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO 3468646**

**IN THE NAME OF MATCHU MEETCHU LTD**

**TO REGISTER**

**MATCHU MEETCHU**

**AS A TRADE MARK IN CLASS 09, 35, 38, 42 & 45**

**AND**

**OPPOSITION THERETO (UNDER NO. 420553)**

**BY**

**MATCH GROUP, LLC**

## BACKGROUND

1) On 20 February 2020, Matchu Meetchu Ltd ('the applicant') applied to register the trade mark MATCHU MEETCHU in respect of the following goods and services:

**09:** Communication, networking and social networking software.

**35:** Business networking.

**38:** Chatroom services for social networking.

**42:** Computer services.

**45:** Internet-based social networking services.

2) The application was published in the Trade Marks Journal on 06 March 2020 and notice of opposition was later filed by Match Group, LLC ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its grounds under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following two trade mark registrations:

- **UKTM 3415177 ('mark 1')**

The logo for Match.com, featuring the word "match" in a blue, lowercase, sans-serif font. A small blue heart is positioned above the letter "h".

**Filing date:** 19 July 2019

**Date of entry in register:** 11 October 2019

**Class 09:** 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.

- **EUTM 16246639 ('mark 2')**

## MATCH.COM

**Filing date:** 13 January 2017

**Date of entry in register:** 13 November 2019

**Class 09:** Downloadable software in the nature of a mobile application for internet-based dating and introduction; downloadable software in the nature of a mobile application in the field of social media, namely, for sending status updates to subscribers of web feeds, uploading and downloading electronic files to share with others.

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

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

4) It is claimed that the respective goods and services are identical or similar and that the respective marks are similar such that there exists a likelihood of confusion under Section 5(2)(b).

5) It is also claimed that the earlier marks enjoy a reputation in the UK in respect of all the goods and services covered by them and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier marks.

6) The trade marks relied upon by the opponent under sections 5(2)(b) and 5(3) of the Act are earlier marks, in accordance with section 6 of the Act. As both completed their registration procedure less than five years prior to the application date of the contested mark, they are not subject to the proof of use conditions, as per section 6A of the Act.

7) Under section 5(4)(a) of the Act, the opponent relies upon the use of 2 signs which are identical to marks 1 and 2, above. The sign which is identical to mark 1 is said to have been used throughout the UK since March 2015. The sign which is identical to mark 2 is said to have been used throughout the UK since January 1995. A third sign is also relied upon which is also identical to mark 1 but presented in black and white. All three signs are said to have been used in relation to 'Online dating and introduction services' and that the opponent's business, with which the earlier signs are associated, has consistently been recognised as being in the top 5 UK dating service providers. It is claimed that use of the applicant's mark, in respect of the goods and services applied for, will lead to misrepresentation and damage to the opponent's goodwill associated with its earlier signs.

8) The applicant filed a counterstatement. I note, in particular, the following statements made therein:

- The word MATCH is entirely non-distinctive of the services provided by the opponent.
- The marks are dissimilar when viewed overall. The allegation that they are similar due to the common inclusion of M-A-T-C-H is one which dissects the applicant's mark in an unnatural way. In the alternative, if there is any similarity between the marks is at the lowest level.

- The marks are not conceptually similar. To the extent that the user knows of the famous location MACHU PICCHU, the marks are conceptually dissimilar; to the extent that they do not, the marks are conceptually neutral because the applicant's mark will have no meaning.
- It is admitted that the respective goods in class 09 are identical, as per *Meric*<sup>1</sup> and that they are also similar to the opponent's services in classes 42 and 45.
- It is not admitted that the contested services in class 35 are similar to any of the opponent's goods and services.
- It is admitted that the contested services in class 38 are similar to the "social networking goods and services of the Opponent's registrations". It is not admitted that they are similar to the goods and services of the opponent insofar as they relate to dating and introductions.
- It is admitted that the respective services in class 42 are identical, as per *Meric*. Similarity or identity with any of the opponent's other goods and services is not admitted.
- It is admitted that the contested class 45 services are identical to the opponent's 'internet based social networking services' and similar to the other social networking goods and services of the opponent. Similarity or identity with the dating or introduction services of the opponent is not admitted.
- It is admitted that the opponent is the owner of goodwill in respect of the 'operation of a dating website' by reference to the domain name MATCH.COM and to the sign corresponding to mark 1 in blue and in black and white. It is denied that there would be misrepresentation or damage. It is submitted that, where the common element is entirely descriptive, the opponent must accept the existence of similar signs (if any similarity is found).
- In relation to the claim under Section 5(3) of the Act, the applicant states:

"It is not admitted that the mark MATCH.COM has acquired repute in the UK: the service of the business conducted by [the opponent] in the UK is one which has repute in relation to the operation of a dating site, but it is not

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<sup>1</sup> *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05)*

admitted that this attaches to the mark MATCH.COM as opposed to some other mark. Reputation is otherwise not admitted.

To avoid any suggestion from [the opponent] that this is a blanket non-admission of repute, we underline that it is not: it is accepted that there is a business in the UK which is the operation of a dating site and no evidence would need to be adduced to that fact or its success. The non-admission is that this attaches to the mark MATCH.COM.”

The same statement is made in respect of the claim based upon mark 1<sup>2</sup>. It is also denied, with explanation, that there would be any link made with, or damage caused to, marks 1 and 2.

9) The opponent is represented by Barker Brettell LLP; the applicant is represented by Brandsmiths S.L. Limited. The opponent’s evidence in chief consists of a witness statement in the name of Mr Julien Chouteau, dated 29 June 2021, with 12 exhibits. The applicant’s evidence consists of a witness statement in the name of Mr Aaron Ronald Wood, dated 20 August 2021, with 4 exhibits. The opponent’s evidence in reply consists of a second witness statement from Mr Chouteau, dated 01 October 2022, with 3 exhibits. I have read all the evidence and will refer to it when it is appropriate to do so. A hearing took place before me on 20 July 2022 at which the opponent was represented by Mr Jonathan Moss of Counsel, instructed by Barker Brettell LLP and the applicant was represented by Mr Aaron Wood.

## **DECISION**

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

10) This section of the Act states:

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

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<sup>2</sup> See paragraph 6 of the applicant’s skeleton argument.

(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.

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.”

11) The leading authorities which guide me are from the CJEU: *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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



12) Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

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

13) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

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

14) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

15) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

16) In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found 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 was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“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.”

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.”

17) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, where the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

18) The goods and services to be compared are:

Opponent's goods and services	Applicant's goods and services
<p><b>Class 09:</b> 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.</p> <p><b>Class 42:</b> 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.</p> <p><b>Class 45:</b> 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.</p>	<p><b>09:</b> Communication, networking and social networking software.</p> <p><b>35:</b> Business networking.</p> <p><b>38:</b> Chatroom services for social networking.</p> <p><b>42:</b> Computer services.</p> <p><b>45:</b> Internet-based social networking services.</p>

Class 09

19) The applicant concedes that its goods in class 09 are identical to the opponent's goods in class 09 as per *Meric* (which I understand is because the earlier mark includes the term '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') and similar to the opponent's services in classes 45 (which I understand is because the latter includes 'internet based social networking, ...services') and 42.

### Class 35

20) The applicant does not admit that its class 35 services are similar to any of the opponent's goods or services. Mr Moss contended that the applicant's 'business networking' is 'effectively identical' to the opponent's services in class 42. No reasoning was given in support of this contention. It is not obvious to me that there is any similarity, let alone identity, between those services. The respective nature, intended purpose and methods of use are different and there is no obvious competitive relationship in play. Neither does it appear to me that there would be any complementary relationship, in the sense described in the case law. I find no similarity between the aforementioned services.

21) It seems to me that the opponent's strongest case lies with its 'internet based social networking, introduction and dating services'. There is some similarity in nature between these services of the opponent and the applicant's 'business networking' because both are in the nature of bringing people together to form relationships, albeit that the applicant's services are aimed at facilitating the forming of business relationships and the opponent's services are for forming personal/romantic relationships and friendships. However, the precise purpose is not the same, the trade channels are unlikely to be the same or overlap to any significant extent and the contested services will be used by business/professionals whereas the earlier services will be used by the general public at large. There is also no competitive or complementary relationship in play between those services. I find a low degree of similarity between the opponent's 'internet based social networking, introduction and dating services' and the applicant's 'business networking' services in class 35.

### Class 38

22) The applicant concedes that its services in class 38 are similar to the “social networking goods and services of the Opponent’s registrations”. However, it makes no comments on the degree of that similarity. In my view, the degree of similarity is high between the contested services and the opponent’s ‘internet based social networking services’ in class 45, which represent its strongest case. This is because of the obvious overlap in nature, intended purpose, trade channels and that the contested class 38 services may be complementary and in competition with the opponent’s services.

23) I note that the applicant does not admit that its class 38 services are similar to ‘the goods and services of the opponent insofar as they relate to dating and introductions’. In my view, there is also a medium degree of similarity between the opponent’s ‘internet based...dating and introduction services’ with the contested class 38 services. This is because the users may be the same, the trade channels may overlap significantly and there may be an element of competition between the respective services with a consumer choosing to either find a romantic relationship through a chat room or through an online dating service. There may also be a degree of complementarity between the respective services.

#### Class 42

24) The applicant concedes that its services in class 42 are identical to the opponent’s services in class 42 as per *Meric*.

25) The applicant does not admit that its class 42 services are identical or similar to any of the opponent’s other goods and services. In my view, there is also a high degree of similarity between the contested class 42 services and the opponent’s ‘Downloadable software in the nature of a mobile application for internet-based dating’ in class 09. This is because there is a complementary relationship in play between those goods and services (the contested services are indispensable to the earlier goods because the former are necessary in order to develop the latter). Further, the contested ‘computer services’ is a broad term which would include the provision of non-downloadable equivalents of the kind of software covered by the

earlier marks and therefore the users, purpose and methods of use will be the same and the respective nature highly similar.

#### Class 45

26) The applicant concedes that its services in class 45 are identical to the opponent's 'internet based social networking services' in class 45. However, identity or similarity with the opponent's 'internet based introduction and dating services' is not admitted.

27) In my view, there is similarity between the opponent's 'internet based introduction and dating services' and the contested services. Both parties' services will be provided online and are intended to facilitate communication between like-minded individuals in order to form and/or maintain personal relationships. However, the opponent's services are specifically for the purpose of assisting in the forming of romantic relationships and the applicant's services are not for that specific purpose. The users may be the same, the trade channels may be the same, or at least overlap, and there may be an element of competition in play. I find a high degree of similarity between the opponent's 'internet based introduction and dating services' and the contested services in class 45.

#### **Average consumer and the purchasing process**

28) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer 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.”

29) The average consumer for the majority of the goods and services at issue is the general public, with the exception of the contested ‘business networking’ services in class 35 where the average consumer will be businesses or professional individuals. The average consumer is likely to take into consideration various factors when selecting the goods and services at issue but I would not expect the degree of attention to be particularly high. On the whole, I find that a medium degree of attention is likely to be paid during the purchase for all of the goods and services. They are all likely to be sought out primarily by eye on websites, for example, and so I would expect the purchase to be mainly visual. However, I bear in mind that the goods and services may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind.

### **Distinctive character of the earlier marks**

30) The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

31) I will first consider the inherent distinctiveness of mark 1. Mr Wood’s evidence provides a number of prints from various websites. The exhibits<sup>3</sup> show a mixture of descriptive and trade mark use of the word ‘match’ in the context of dating/introduction services. I accept that the average consumer will be well aware of the meaning of the everyday word MATCH which, in the context of the goods and services at issue, will be perceived as meaning a person who is well-suited to another. Inherently, the word MATCH is therefore, extremely low in distinctiveness in relation to the opponent’s services in class 45. It is also, to my mind, low in distinctiveness for the goods in class 09 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. The heart device, of itself, is not particularly distinctive for any of the earlier goods or services. This is particularly so in relation to those which are concerned with the forming of romantic relationships. Bearing all of this in mind, I find that mark 1, as a whole, is low in inherent distinctiveness for all of the earlier goods and services

32) Turning to mark 2, the .COM element of that mark merely indicates that the opponent’s goods/services are provided online and therefore more focus will be placed upon the word MATCH. Bearing in mind my findings above regarding the meaning of the word MATCH, I find that mark 2, as a whole, is also low in inherent distinctiveness for all of the earlier goods and services.

33) I must now consider the evidence of use before me which the opponent claims shows that its earlier marks enjoy an enhanced degree of distinctiveness consequent

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<sup>3</sup> ARW1 - ARW3

upon the use made of them. I have read all of the evidence and I set out below the most pertinent information therein.

34) 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.

35) By 2004, MATCH.COM online dating services had over 42 million registered users and secured an entry in the Guinness World Records.<sup>4</sup>

36) 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.<sup>5</sup>

37) 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.<sup>6</sup>

38) 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, every year from 2014 – 2020, for consumers in the UK. Similar information is provided for Sweden. That information shows that the Match brand held the top spot every year from 2014 -2018 and then the second spot in 2019 and 2020.

39) IPSOS also assesses the consideration of the brand for UK consumers. 'Consideration' means which brands have been tried at least once within 6 months or at least considered. This information shows that Match has consistently been in the top 2 since 2014 in the UK and in Sweden.

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

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<sup>4</sup> JC1

<sup>5</sup> JC2

<sup>6</sup> JC3

week. For the years 2014-2019, Match was in the top 4 brands used. In Sweden Match was a consistent top 5 used for the years 2014-2019.

40) In Sweden, Match has won the Evimetrix Brand award in 2015, 2016 and 2019 as the strongest brand within online dating in Sweden.

41) A number of press articles are provided, reviewing brands which provide online dating services and apps.<sup>7</sup> MATCH.COM is listed in the articles as being one of the best/top online dating service/app providers in the years 2015 – 2020.

42) The match + heart logo was introduced in 2015. Details of advertising/promotional campaigns are provided spanning the period of 2015 -2020 in which the match + heart logo is said to have been used. The logo is visible in a 'TV creative' dated 02 May 2015, 01 January 2019 and 01 January 2020. Further, a table of is provided, listing a large number of adverts that were said to have been shown in the UK from 2015 -2020, 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 and SKY ONE. A similar table is provided relating to adverts said to have been shown in Sweden over the same period of time.

43) The opponent spent between 9.3 million and 10.8 million Euros in online advertising campaigns in the years 2015 – 2019.

44) 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:<sup>8</sup>

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<sup>7</sup> JC6

<sup>8</sup> Paragraph 26 of the witness statement of Mr Chouteau



45) A table showing the number of times the opponent's Match app has been downloaded in the UK, Sweden and Denmark, is provided in the years 2015 – 2019. The figures for the UK are around 400,000 downloads every year; figures for Sweden range from 60,000 – 87,000 (roughly) downloads every year; figures for Denmark are less consistent, ranging from a high of 26,711 downloads in 2016 to 7,191 in 2019.

46) A table showing the Monthly Active Users of the opponent's online dating services is provided i.e. a unique user who has visited the domain the last 28 days, as follows:

Country	Domain	2016	2017	2018	2019
UK	uk.match.com	564,080	462,481	358,826	366,863
Denmark	dk.match.com	18,670	11,703	7,151	10,137
Sweden	Se.match.com	80,300	69,232	59,686	63,010

*Table 13: Monthly Active Users*

47) The following table is provided showing subscription revenue for the MATCH brand in the UK and the Nordics:

Year	Match UK		Match Nordics	
	Subscription (£)	Revenue	Subscription (£)	Revenue
2019	21 569 081		8 254 996	
2018	23 511 575		8 708 555	
2017	27 235 631		10 499 441	
2016	29 223 124		9 251 037	
2015	28 117 724		8 668 465	
2014	30 534 640		11 716 094	
2013	30 196 959		11 643 658	

Table 14: Match Subscription Revenue

48) Viewing the evidence in the round, I find that both of the earlier marks enjoyed an enhanced degree of distinctiveness in the UK, at the filing date of the contested mark, 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 09. In my view, the inherent distinctiveness of both marks had been elevated to a high degree at that date for those particular goods and services (only).

### Comparison of marks


49) 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.”

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

50) The marks to be compared are:

Opponent's marks	Applicant's mark
<p data-bbox="204 875 319 909"><u>Mark 1:</u></p>  <p data-bbox="204 1200 319 1234"><u>Mark 2:</u></p> <p data-bbox="304 1350 600 1395">MATCH.COM</p>	<p data-bbox="871 960 1331 1005">MATCHU MEETCHU</p>

Overall impression of each mark

51) Mark 1 consists of the word match, presented in blue, followed by the device element of a heart, also in blue. The match element is considerably larger than the heart device and the former also enjoys a more prominent position at the beginning of the mark. Although the heart element is not negligible, it is the match element that strongly dominates the overall impression of the mark as a whole.

52) Mark 2 consists of the words MATCH.COM. The .COM part of the mark is not negligible and contributes to the overall impression. That said, it is merely likely to indicate that the opponent's goods and services are provided online. The word MATCH, prominently positioned at the beginning of the mark, carries the greatest weight in the overall impression.

53) Turning to the applicant's mark, this consists of the words MATCHU MEETCHU. In my view, this mark does not naturally lend itself to deconstruction into separate elements which have differing weights in the overall impression. Neither word materially dominates the other.

#### Similarity between mark 1 and the contested mark

54) I will first consider the similarity between mark 1 and the applicant's mark. Mr Moss submitted that the marks are visually similar to a medium degree<sup>9</sup>. Both marks contain the letters m-a-t-c-h. I bear in mind that those are the only letters in the earlier mark and that they are positioned at the beginning of the contested mark and that it is usually the beginning of marks which tend to have the greater impact on the perception. However, that is no more than a general rule of thumb. The opponent's mark also contains the device element of a heart which is absent from the contested mark. There is also the additional letter 'u' at the end of those letters which is present in the applicant's mark together with the word MEETCHU which are both absent from the opponent's mark. Overall, I find there to be a low degree of visual similarity between mark 1 and the contested mark.

55) Aurally, Mr Moss contended that mark 1 is highly similar to the contested mark. I disagree. The applicant's mark is likely to be pronounced 'MAT-CHOO-MEET-CHOO'; the opponent's mark will be pronounced simply as 'MATCH' (the heart device will not be articulated). The sole point of aural similarity is that the first syllable of the applicant's mark is identical to the earlier mark. Again, I bear in mind that that point of coincidence occurs at the beginning of the contested mark, however, there are a further three syllables present in that mark which are entirely absent from the

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<sup>9</sup> Mr Moss' Skeleton argument, [22]

earlier mark. Overall, I find a low degree of aural similarity between mark 1 and the contested mark.

56) Turning to the conceptual position, the concept of the earlier mark is likely to stem mainly from the word 'match' which is likely to be perceived, in the context of the relevant goods and services, as meaning a person that is well-suited to another with the heart device merely indicating that that match is likely to be romantic one.

57) As for the MATCHU MEETCHU mark, Mr Wood submitted that that mark is likely to be perceived as a play on the words Machu Picchu, being, in his submission, a well-known place in Peru, South America and therefore the marks are conceptually different. Mr Moss did not accept that the contested mark would be perceived as a play on the name Machu Picchu. Instead, he submitted that the applicant's mark is likely to be recognised as the two well-known English words 'match' and 'meet' and that the 'u' and 'chu' at the end of those words will be seen as 'playful nonsense'. In his submission, the contested marks are therefore identical because they share the concept of introducing people to each other.

58) I am indeed aware of the place named Machu Picchu but I must be cautious not to assume that the average consumer in the UK will also be aware of it. In this connection, I am mindful of the comments of Ms Anna Carboni, sitting as the Appointed Person, in *CHORKEE* (BL O/048/08, [36]-[38]). In that case, the Hearing Officer was found to have been wrong to impute his own knowledge, that CHEROKEE was the name of a native American tribe, onto the average consumer, in the absence of any evidence to show that such a concept was also likely to be apparent to the latter.

59) I must therefore look at Mr Wood's evidence purporting to support his contention that the average UK consumer will be aware of the place named Machu Picchu. This is necessary because, if the evidence satisfies me that the average consumer is likely to be aware of that place name, this may affect my findings as to how the average consumer is likely to conceptualise the contested mark.



60) In his evidence, Mr Wood states that he understands that Machu Picchu is a place of some archaeological importance in relation to the Incas (a former civilisation in South America) and he is aware of it mainly by way of people reporting their hiking around South America or people talking about things they did when they visited South America. He provides some articles<sup>10</sup> which he found by conducting a search on Google for 'Machu Picchu' and highlights that they show the following: i) it is a UNESCO heritage site, ii) it is the most visited attraction in Peru, iii) it is one of the most popular tourist destinations in the world and iv) it is one of the seven modern wonders of the world.

61) Having considered Mr Wood's evidence, which indicates that Machu Picchu is one of the seven modern wonders of the world and one of the world's most popular holiday destinations, I come to the view that there is likely to be a significant proportion of UK average consumers who are aware that there is a historical place named Machu Picchu (even if they do not know precisely where it is). However, the evidence does not satisfy me that that fact is so well-known or notorious that it is likely to be known by everyone, or nearly everyone, in the UK general public. In my view, there is likely to be another, also significant, proportion of average consumers who are not aware of the place named Machu Picchu. With this conclusion in mind, I now turn to consider what concept, if any, the average consumer is likely to retain in their mind when faced with the contested mark, MATCHU MEETCHU.

62) MATCHU MEETCHU is likely, first and foremost, to be perceived as an invented phrase. However, that does not necessarily mean that it will evoke no concept at all. Even invented words/marks can evoke a concept if they resemble known words<sup>11</sup>. When faced with the contested mark in the context of the goods and services at issue, I find that there is likely to be a significant proportion of average consumers who perceive the mark as a play on the place name Machu Picchu (for those average consumers who are aware of that place) given the resemblance of the mark, as a whole, to that place name and I also find that those average consumers are likely, at the same time, to perceive the mark as alluding to the known English words

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<sup>10</sup> Exhibit ARW4

<sup>11</sup> *Usinor SA v OHIM* (Case T-189/05)

'match' and 'meet' owing to the resemblance of the two words in the mark to those known words. Further, I find that there is likely to be another, separate, significant proportion of average consumers who only perceive the mark as alluding to the words 'match' and 'meet' (those who are not aware of the place Machu Picchu). It follows that, for both groups of average consumer, there is some conceptual overlap with the earlier mark given the common 'match' concept that is likely to be perceived, whether or not they also perceive the play on the place name Machu Picchu. I find that, for the average consumer who perceives the play on the place name Machu Picchu and the allusion to the words 'match' and 'meet', the overall conceptual similarity between the marks is low. For the average consumer who only perceives the contested mark as being an allusion to the words 'match' and 'meet' I find that the overall conceptual similarity is medium.

#### Similarity between mark 2 and the contested mark

63) Both marks contain the letters m-a-t-c-h. The opponent's mark also contains '.COM' which is absent from the contested mark. The applicant's mark contains the additional letter 'u' at the end of the letters m-a-t-c-h together with the word MEETCHU which are absent from the opponent's mark. Overall, I find there to be a low degree of visual similarity between mark 2 and the contested mark.

64) Aurally, Mr Moss contended that mark 2 is highly similar to the contested mark. I disagree. The applicant's mark is likely to be pronounced MAT-CHOO-MEET-CHOO'; the opponent's mark will be pronounced as 'MATCH-DOT-COM'. Aside from the common 'MATCH' pronunciation at the beginning of the marks, the rest of the syllables in the marks are not similar. Overall, I find a low degree of aural similarity between mark 2 and the contested mark.

65) Conceptually, Mr Moss contended that mark 2 is conceptually identical to the contested mark for the same reasons given in respect of mark 1. I have already given my view as to how the contested mark is likely to be conceptualized. In mark 2, the .COM element will merely indicate that the services are provided online; as such, it does not introduce any significant conceptual difference between the marks. The main conceptual hook for the consumer will stem from the word

'MATCH', meaning a person or thing that is well-suited to another. I find that, for the average consumer who perceives the contested mark as being a play on the place name Machu Picchu and an allusion to the words 'match' and 'meet', the overall conceptual similarity between the marks is low. For the average consumer who only perceives the contested mark as being an allusion to the words 'match' and 'meet', the overall conceptual similarity is medium.

### **Likelihood of confusion**

66) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier marks are, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

67) I will first consider the likelihood of direct confusion between mark 1 and the applicant's mark. The respective goods and services are similar to varying degrees (low, medium and high) and others are identical. The earlier mark has a high degree of enhanced 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 09. For the other earlier goods and services, for which no use has been shown, the mark is inherently distinctive to a low degree. The respective marks are visually and aurally similar only to a low degree. The conceptual similarity between them is either of a low or medium degree, depending upon how the contested mark is perceived. Weighing these factors, I come to the firm view that the average consumer, paying at least a medium level of attention, is unlikely to mistake one mark for the other even allowing for imperfect recollection and even where the conceptual similarity is of a medium (rather than low) degree. There is no likelihood of direct confusion between mark 1 and the applicant's mark.

68) Turning to mark 2, the respective goods and services are, again, similar to varying degrees from (low, medium and high) and others are identical. The respective marks are also, again, visually and aurally similar only to a low degree and the conceptual similarity between them is either of a low or medium degree, depending upon how the contested mark is perceived. Weighing these factors, once again I come to the firm view that the average consumer, paying at least a medium level of attention, is unlikely to mistake one mark for the other even allowing for imperfect recollection. I find this even where the conceptual similarity is of a medium (rather than low) degree and even where the earlier mark enjoys a high degree of enhanced distinctiveness. There is no likelihood of direct confusion between mark 2 and the applicant's mark.

69) I now turn to consider whether there is a likelihood of indirect confusion between either of the earlier marks and the contested mark. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., 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)".

70) In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

71) Furthermore, 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.

72) Dealing first with mark 1, this is not a case which fits within any of the categories listed by Mr Purvis in the case law above. Although the contested mark contains the word element of the earlier mark, it is subsumed within the invented word 'matchu', which is itself subsumed within the distinctive phrase 'matchu meetchu', to form a mark which has only a low degree of visual and aural similarity and, at best, a medium degree of conceptual similarity with the earlier mark. It is highly improbable, in my view, that the contested mark will be perceived as being logical and consistent with a brand extension of the earlier mark or that there will be any other kind of mental process on the part of the average consumer that will lead them to conclude that the

respective goods and services coming from the same or linked undertaking(s). I make this finding despite the earlier mark being highly distinctive for certain of the earlier goods and services i.e. 'online dating services' and 'Downloadable software in the nature of a mobile application for internet-based dating' (there is even less likelihood of indirect confusion in relation to the earlier services for which the distinctiveness of the mark is lower). There is, to my mind, no "proper basis" for justifying a likelihood of indirect confusion between mark 1 and the contested mark.

73) I come to the same conclusion as regards mark 2, bearing in mind that it has the same degree of visual, aural and conceptual similarity to the contested mark as mark 1, that it covers the same goods and services as mark 1 and has the same degree of distinctiveness (inherent and enhanced) for the same goods and services as mark 1. Mark 2 therefore offers the opponent no stronger prospect of success.

**74) The opposition under section 5(2)(b) of the Act fails.**

75) I add here that I would have reached the same conclusion even if I had found that the respective 'internet-based social networking services' and 'internet-based introduction and dating services' are identical as opposed to highly similar (on the basis which appeared to be submitted by Mr Moss that the latter services would fall within the 'broader umbrella' of the former). Even then, when weighed against all other relevant factors there is no likelihood of confusion.

### **Section 5(3)**

76) Section 5(3) of the Act provides:

“(3) A trade mark which-

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

77) 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* and Case C-323/09, *Marks and Spencer v Interflora* and 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 Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a

change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

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

## **Reputation**

78) I am satisfied that both earlier marks had a qualifying reputation at the relevant date for 'online dating services' and 'Downloadable software in the nature of a mobile application for internet-based dating'. I find no reputation for any other goods and services relied upon.



## Link

79) Whether the public will make the required mental 'link' between the contested mark and each of the earlier marks must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

*i) The degree of similarity between the conflicting marks*

I have already assessed this under section 5(2)(b). Each earlier mark is visually and aurally similar to the contested mark to a low degree and each earlier mark shares either a low or medium degree of conceptual similarity with the contested mark, depending on how the latter is perceived.

*ii) 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*

I find that the contested class 09 goods are highly similar to the earlier class 09 goods for which the opponent has a reputation because the users will be the same, the trade channels may overlap significantly and the respective methods of use, nature and purpose overlap.

The contested class 38 services are similar to a medium degree to the class 45 services for which both earlier marks have a reputation

The contested class 42 services are highly similar to the class 09 goods for which both earlier marks have a reputation.

The contested class 45 services are highly similar to the class 45 services for which both earlier marks have a reputation.

The relevant public for the respective goods and services in classes 09, 38, 42 and 45 is the general public.

The contested class 35 services are similar to a low degree to the class 45 services for which both earlier marks have a reputation. The relevant public for the contested class 35 services is businesses/professionals whereas the relevant public for the earlier class 45 services is the general public at large. I add that I can see no similarity between the contested class 35 services and the opponent's 'Downloadable software in the nature of a mobile application for internet-based dating'. The respective nature, intended purpose and methods of use are different and neither is there any obvious complementary or competitive relationship in play.

*iii) The strength of the earlier mark's reputation*

I find that both earlier marks had a strong reputation at the relevant date.

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

Both earlier marks have a low degree of inherent distinctiveness in relation to the relevant earlier goods and services. However, their distinctiveness has been elevated to a high degree consequent upon the use made of them.

*v) Whether there is a likelihood of confusion*

There is no likelihood of confusion between the contested mark and either of the earlier marks.

Conclusions on link

80) Each of the earlier marks is visually and aurally similar to the contested mark to a low degree and conceptually similar to the same to either a low or medium degree. However, I find that the strong reputation and high degree of enhanced distinctiveness of both earlier marks is such that both are likely to be brought to mind by the relevant public when encountering the applicant's mark on the contested goods and services which have been found to be highly similar or similar to a

medium degree. For the avoidance of doubt, I make this finding regardless of whether the relevant public perceives the play on the place name Machu Picchu or not. The requisite link is therefore established in relation to the contested goods and services in classes 09, 38, 42 and 45.

81) I do not however consider that a link will be made when the contested mark is used on the services in class 35. Those services are similar only to a low degree to the services in which the opponent has a reputation and enhanced distinctiveness and are not similar at all to the earlier goods for which the opponent enjoys the same. This, together with the low degree of visual and aural similarity and, at best, medium degree of conceptual similarity between the respective marks is such that neither of the earlier marks is likely to be brought to mind when by the relevant public when encountering the contested mark in use in relation to the contested class 35 services. Without a link, there can be no damage. The grounds under section 5(3) of the Act against class 35 of the contested mark therefore fail.

## **Damage**

### Unfair advantage

82) In the Form TM7, the opponent's pleading on 'unfair advantage' under Q3 of the form for Section 5(3) is based upon the relevant public wrongly assuming that there is an economic connection between the applicant and the opponent. Mr Moss' submissions at the hearing were heavily focused upon this aspect of the pleaded case. He submitted that the relevant public is likely to believe that the opponent has either branched out to provide another service or have 'tweaked' their underlying brand. This is, effectively, a claim of indirect confusion. I have already found that there is no likelihood of confusion under section 5(2)(b) of the Act in respect of both earlier marks and therefore the 5(3) case, insofar as it is based upon there being a wrongly assumed economic connection, must also fail.

83) I now turn to the pleading provided in answer to Q4 of the Form TM7, which asks if 'there is any other basis for your claim of unfair advantage' (i.e. other than there

being an economic connection between the parties), the opponent stated the following:

“The use of MATCHU MEETCHU may bring to mind the opponent’s earlier [marks] and offering. The applicant would therefore be able to ride on the coat tails of the opponent’s reputation in the field, which means they would enjoy an enhanced recognition without having to have invested the same level of finances in their marketing activities.”

There is nothing in this pleading which suggests that it is based upon there being an economic connection between the parties. I therefore turn to consider whether there would be unfair advantage on the basis put forward in this pleading.

84) At the hearing, Mr Moss made much of the fact that the applicant had filed no evidence to explain why it had chosen the contested mark. In the light of this, he invited me to draw an adverse inference that the contested marks were therefore intended to take advantage of the reputation and highly distinctive character of the earlier marks. I drew Mr Moss’ attention to the above pleading in the Form TM7 and pointed out that it does not appear to make the direct allegation that the applicant ‘intended’ to take unfair advantage of the earlier marks. In response, Mr Moss pointed out that, although the opponent’s pleadings do not specifically refer to the applicant’s intentions, it was, in his submission, implicit in the allegation of ‘riding on the coat tails’ that the applicant intended to take advantage of the reputation of the earlier marks and therefore, in his submission, the pleading above constituted a direct allegation of an intention to take unfair advantage which the applicant has not responded to or denied. Mr Moss relied upon the case of *Jack Wills Ltd v House of Fraser (Stores) Ltd*<sup>12</sup> as support for this proposition, although he did not refer me to any specific part of that decision.

85) In the light of the above submission, I allowed Mr Wood a short period after the hearing to consider the *Jack Wills* case and to file written submissions in response to Mr Moss’ submission. Mr Wood’s submissions were duly filed shortly after the

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<sup>12</sup> EWHC 110 (Ch) (31 January 2014)

hearing<sup>13</sup>. Having considered the contents of paragraph 109 and 110 of the *Jack Wills* decision, Mr Wood states that:

‘An allegation of intention to take advantage or to knowingly mislead are of course serious and separate allegations and these should be properly alleged so that evidence can be directed to the allegation (if made).

As such, although Mr Moss was right to the more limited extent that the intent of how a sign is to be used is always relevant, it appears he misunderstood the case and was simply wrong as a matter of law to suggest that the case underlined that there is always an implied allegation of knowingly taking advantage.’

86) The opponent filed written submissions in reply<sup>14</sup> in which it states, inter alia, the following:

‘When an allegation of riding on the coat-tails (also known as free-riding – see paragraphs 75 to 79 of *Jack Wills* citing *L’Oreal, Whirlpool* and *L’Oreal* back in the Court of Appeal using both terms) is made, it is wholly intrinsic to that allegation that the person accused of riding on the coat tails has chosen to do so. It would be redundant to add that a party “intentionally” rode on the coat tails on another’s business. The element of intention is intrinsic in the very concept of free-riding/riding on the coat tails. Indeed, Jacob LJ commented in *L’Oreal* that there is no line between permissible and impermissible free-riding (see para 78 of *Jack Wills*).’

87) I note that Mr Moss made essentially the same argument in a recent case<sup>15</sup> before this tribunal involving different parties (and different marks). Coincidentally, Mr Wood also appeared as representative for the applicant in that case. The Hearing Officer in that case, Mr Allan James, said this in relation to Mr Moss’ invitation to draw an adverse inference:

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<sup>13</sup> Dated 20 July 2022

<sup>14</sup> Dated 21 July 2022

<sup>15</sup> BL O/921/22

“73. ...The important points are:

1. An allegation of ‘free-riding’ can mean different things, depending on the context in which the words are used;
2. The words ‘free-riding’ can be used to describe a party’s subjective intention or the objective effect of its use of a trade mark;<sup>16</sup>
3. An allegation that a party is attempting to deliberately confuse the customers of another business in order to ‘free-ride’ on the reputation embodied in its trade mark is essentially an allegation of deception;
4. An allegation that, although not attempting to actually confuse consumers, a party is intending to feed off the reputation and image of an earlier trade mark to give its own trade mark a commercial advantage, is essentially an allegation of intentional unfair competition;<sup>17</sup>
5. Although it is not necessary to show the user of the later mark intends to cause confusion or take advantage of an earlier reputed mark in order to make out a case under sections 5(2) and/or 5(3),<sup>18</sup> the courts have long taken into account evidence of an intention to deceive,<sup>19</sup> and the subjective intention of the applicant is relevant to the issue of whether any advantage gained is unfair;<sup>20</sup>
6. An allegation of an intention to deceive is a serious allegation, which should not be made lightly and must be clearly pleaded;
7. An allegation of intentional unfair competition must also be clearly pleaded, especially where the party alleging such an intent seeks to rely

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<sup>16</sup> See paragraph 33 of the judgment of Johnson J. in *Monster Energy Company v Red Bull GmbH*, [2022] EWHC 2155

<sup>17</sup> See *Whirlpool v Kenwood* [2009] EWCA Civ 753 at paragraphs 112 & 129, which make it clear that was said about unfair advantage in that case relates to non-confusion damage.

<sup>18</sup> *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) at paragraph 80 of the judgment

<sup>19</sup> See, for example, paragraph 115 of the judgment of the Court of Appeal in *Specsavers v Asda Stores* [2012] EWCA Civ 24, which also emphasises the difference between an intention to deceive and “*living dangerously*”, as Mr Moss suggested the applicant was doing in this case.

<sup>20</sup> See *Whirlpool v Kenwood* [2009] EWCA Civ 753 at paragraph 136

on that as a material factor in the assessment of whether what the applicant seeks to do is unfair;

8. The use of the words 'free-riding' as they appear in the opponent's unfair advantage pleading do not clearly allege a deliberate attempt to deceive, or a subjective intention to unfairly exploit the reputation and image of the earlier marks;

9. ...

10. ...;

11. ...

74. Therefore, although I agree that the applicant's failure to file evidence from someone with first-hand knowledge of why it has applied to register the contested marks for *energy drinks* is surprising, and understand why this has given rise to justifiable suspicions about the applicant's intentions, I would not have considered it appropriate to draw any adverse inferences from this omission, even if the applicant's subjective intention was relevant to the opponent's pleaded case.' (my emphasis)

88) I agree with the comments made by Mr James. I do not consider that it would be appropriate, in the absence of a clear and specific allegation in the opponent's pleaded case that the applicant intended to 'ride on the coat tails' of the reputation of the earlier marks, to draw any adverse inferences from the applicant's decision not to file any evidence about why it applied for the contested mark.

89) Nevertheless, I find that there is, objectively, a non-hypothetical risk that the link that is made between the contested mark and each of the earlier marks will result in the positive characteristics associated with each earlier marks, namely the marks' success and popularity, transferring to the applicant's mark. This association with each of the opponents' reputed marks would make the applicant's mark more attractive to the relevant public and give the applicant more custom than it otherwise would have enjoyed and make its job of marketing its goods and services easier. As this would come without paying any compensation to the opponent, and without the

applicant expending the money necessary to create a market for its own goods and services in the UK, I find that this constitutes unfair advantage. **The grounds under section 5(3) of the Act succeed against the contested mark in all classes except class 35.**

#### Other heads of damage

90) I do not consider that either of the other heads of damage are made out. As regards detriment to the distinctive character of the earlier marks, it is difficult to see why that would occur in the absence of a likelihood of confusion. Further, as regards the claim of detriment to the reputation of the earlier marks, this appears to be made on the basis that the applicant may provide 'substandard' goods and services, leading to detriment to the earlier marks reputation. This amounts to nothing more than conjecture. There is no evidence to suggest that the applicant already has a negative reputation for providing poor quality goods or services and there is nothing inherent in the applicant's goods and services that would cause any form of negative reaction.<sup>21</sup>

#### **Section 5(4)(a)**

91) Section 5(4)(a) states:

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

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

(b) [.....]

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<sup>21</sup> See *Cristalino* case [2015] EWCH 2760 (Ch) [89-90]; *Unite The Union v The Unite Group Plc* (BL O/219/13) [46-47]



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.”

92) 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).”

93) The opponent relies upon use of two signs which are identical to marks 1 and 2, which I have already considered under section 5(2)(b) of the Act. A third sign is also relied upon, being a black and white version of mark 1. I do not consider that the fact the third sign is in black and white renders it any more similar to the contested mark than the blue version of that sign. I find that that third sign is visually, aurally and conceptually similar to the contested mark to the same degree as mark 1 for the same reasons given in relation to the latter

94) I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires “*a substantial number of members of the public are deceived*” rather than considering whether the “*average consumer is confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here.

Bearing in mind my earlier comments regarding the use shown in the evidence before me, I accept that the opponent had a strong goodwill in its business providing 'Online dating services' at the filing date of the contested mark, and that the three signs relied upon were distinctive of that goodwill. However, I find it highly unlikely that a substantial number of the opponent's customers will be misled into purchasing the applicant's goods and services in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion.

95) This finding is not disturbed by Mr Moss' contention that I can take in to account an 'intention to deceive' under section 5(4)(a) which, of course, is not relevant under section 5(2)(b). There is nothing before me to indicate that there was any such intention on the part of the applicant.

**96) The opposition under section 5(4)(a) of the Act fails.**

## **OVERALL OUTCOME**

**97) The opposition succeeds against the goods and services in classes 09, 38, 42 and 45 and fails against the services in class 35.**

## **COSTS**

98) The opponent has had a greater degree of success than the applicant. I estimate the ratio of success to be roughly 80%:20% in the opponent's favour.

99) Mr Moss requested costs off the scale due to, in his submission, the following: i) unreasonable case management requests made by the applicant to suspend the proceedings pending related court proceedings and for disclosure and ii) improper language used by Mr Wood in correspondence to this tribunal alleging professional misconduct and/or incompetence on the part of the opponent's legal representative. I do not consider that either of these factors warrants a departure from the usual scale. As regards point i), the requests made by the applicant gave rise to a preliminary view of the tribunal to refuse those requests that was not challenged by

the applicant. On the contrary, the applicant expressly accepted the preliminary view, made no request to challenge it at a CMC and made no further comment about it. It is therefore not obvious to me that the opponent will have been put to any significant further cost or time in dealing with those requests. The requests, on the face of them, were also not obviously unreasonable ones to make. As regards point ii) I do not consider that it would be appropriate for me to take that matter into account in determining the costs in the matter before me. I will therefore base the award of costs upon the usual scale.

100) Using the guidance in Tribunal Practice Notice 2/2016, but allowing for the applicant's degree of success, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Preparing and filing evidence and considering the applicant's evidence	£1500
Preparing for, and attending, the hearing	£600
Total:	£2400 x 0.8
<b>Overall total:</b>	<b>£1,920</b>

101) I order Matchu Meetchu Ltd to pay Match Group, LLC the sum of **£1,920**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of December 2022**

**Beverley Hedley**  
**For the Registrar, the Comptroller-General**