

O/567/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003607175
BY THE PERFECT MATCH LTD
TO REGISTER:**



AS A TRADE MARK IN CLASS 45

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 426019 BY
MATCH GROUP, LLC.**

BACKGROUND AND PLEADINGS

1. On 9 March 2021, Bushra Anwar applied to register the trade mark shown on the cover of this decision in the UK for the following services:

Class 45: Dating services; Computer dating services; Video dating services; Internet dating services; Dating agency services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services.

2. On the same day the mark was applied for, Bushra Anwar assigned the mark to The Perfect Match Ltd (“the applicant”). This was confirmed to the Tribunal by way of a Form TM16 that was received on 17 November 2021.
3. The applicant’s mark was published for opposition purposes on 7 May 2021 and, on 6 August 2021, it was opposed by Match Group, LLC (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the section 5(2)(b) and 5(3) grounds, the opponent relies on the following marks:



UK registration no. 3415177

Filing date 19 July 2019; registration date 11 October 2019

Relying on all goods and services.

(“the opponent’s first mark”);

MATCH.COM

UK registration no. 916246639

Filing date 13 January 2017; registration date 13 November 2019

Relying on all goods and services.

(“the opponent’s second mark”).

4. The specifications of the opponent's marks are identical and are as follows:

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.

5. Under its 5(2)(b) ground, the opponent claims that the high similarity between the marks and the identity and/or similarity between the parties' goods and services will lead to a likelihood of confusion or a likelihood of association.

6. As for the opponent's 5(3) ground, the opponent claims that use of the applicant's mark may bring to mind the opponent's marks and that this would result in an unfair advantage for the applicant. Further, the opponent claims that the association between the marks would dilute and blur the distinctiveness of the opponent's mark and would be detrimental to the perceived quality and prestige of the opponent's offering. Finally, the opponent claims that use of the applicant's highly similar mark would dilute the inherent and acquired distinctiveness of the opponent's marks and that this would result in the relevant public being confused as to the origin of the opponent's goods and services which compromises the whole function of the marks, therefore, resulting in economic loss on behalf of the opponent.

7. Under its 5(4)(a) ground, the opponent relies on the earlier unregistered sign of 'MATCH.COM' ("the opponent's first sign") that it claims to have used since January 1995 throughout the UK. In addition, the opponent also relies on the following earlier unregistered sign:



("the opponent's second sign")

The opponent claims to have used its second sign since March 2015 throughout the UK. The opponent claims that both signs have been used for "dating services", "online dating and introduction services" and "internet based social networking". As a result of the claimed significant goodwill in these signs, the opponent claims that use of the applicant's highly similar mark results in a misrepresentation which could lead to damage or diversion of revenue, both of which being contrary to the law of passing off in the UK.

8. The applicant filed a counterstatement denying the claims made.
9. The opponent is represented by Barker Brettell LLP and the applicant is unrepresented. The opponent filed evidence in chief. While the applicant did not file any evidence, it did file written submissions during the evidence rounds. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
10. 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.

EVIDENCE

11. The opponent's evidence in chief came in the form of the witness statement of Mr Julien Chouteau dated 21 January 2022. Mr Chouteau is the Vice President of Finance and Analytics for Meetic SA, a position he has held since March 2019. Prior to this, Mr Chouteau was employed as a Director of Financial Planning and Analysis for Meetic SA since October 2011. Mr Chouteau sets out that Meetic SA and the opponent are wholly owned subsidiaries of 'Match Group, Inc' and, through intercompany agreements, Meetic SA is exclusively licensed by the opponent to use the opponent's marks in the UK. Mr Chouteau's statement is accompanied by 11 exhibits.

12. I do not intend to reproduce the evidence or submissions of the parties in full here, however, I will refer to them below where necessary.

DECISION

Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

14. Section 5A of the Act states as follows:

“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.”

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

16. The opponent’s marks qualify as earlier trade marks under the above provisions. As the opponent’s marks had not completed their registration process more than five years before the application date of the mark in issue, they are not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods and services for which its marks are registered.

17. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P 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 great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

18.As I have set out above, the opponent’s specifications are identical and I will, therefore, consider them together. The competing goods and services are as follows:

The opponent’s goods and services	The applicant’s services
<p><u>Class 9</u> 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><u>Class 42</u> 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><u>Class 45</u> Dating services; Computer dating services; Video dating services; Internet dating services; Dating agency services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services.</p>

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.

19. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically (although it equally applies to services), they can still be considered identical if one term falls within the scope of another or (vice versa):

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

20. I have submissions from both parties regarding the similarity of the goods and services. I do not intend to reproduce those here but will briefly address the submissions of the applicant that relate to the different ways in which the parties use their services. In its submissions, the applicant sets out that the method by which its users are matched is different from the method available through the opponent’s business. For example, the applicant submits that its user’s profiles are kept confidential and they will not be given access to message matched users but, should matched users wish to meet, the applicant will arrange this. While I appreciate that the parties may have different operating models for their services, the assessment I must make is a notional one and I am required to take into account all of the ways in which the marks could be used by reference to the goods and/or services for which they are applied for/registered. Therefore, the ways in

which the parties may use their goods/services is not relevant to the assessment I must make.

21. "Dating services" appears in both parties' specifications. They are self-evidently identical.
22. The remaining services in the applicant's specification, being "computer dating services", "video dating services", "internet dating services", "dating agency services", "dating services provided through social networking" and "internet based dating, matchmaking and personal introduction services" are all sub-categories of dating services and, given that the opponent's specifications consist of the broad term "dating services", it follows that the applicant's services all fall within it. Therefore, I find that these services are identical under the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

23. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. 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."

24. The opponent submits that the average consumer for the services at issue will be members of the general public. I have no submissions on this point from the applicant. I agree that the average consumer consists of members of the general public, although given the nature of the services, the average consumer will be over the age of 18.

25. The average consumer is likely to select the services after viewing them on a website or via advertising on search engines, television or in print. Therefore, the selection process will primarily be visual with the aural component also playing a role via word of mouth recommendations. While I am of the view that the services are likely to be mostly available online, I appreciate that there may also be instances wherein they are selected after visiting physical premises where the services will be offered. In this scenario, the services will likely be selected after seeing a list of services on signage or leaflets. I am of the view that the visual element will still dominate this method of selection but, again, I do not discount an aural component playing a role by way of in-person consultations. In respect of the level of attention paid, I am of the view that the average consumer will consider a range of factors such as 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. On the basis that the user of these services will be seeking them in the hopes that they result in a romantic relationship, I am of the view that the average consumer will pay at least a medium degree of attention (but not high) in selecting the services at issue.

Comparison of the marks



26. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

27. 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.”

28. 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.

29. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
 <p data-bbox="347 1361 743 1402">("the opponent's first mark")</p> <p data-bbox="443 1473 647 1507">MATCH.COM</p> <p data-bbox="323 1529 767 1570">("the opponent's second mark")</p>	

30. I have submissions from the opponent in respect of the comparison of the marks at issue. While I do not have submissions from the applicant in respect of the same, I do note that a letter from the applicant to the opponent was provided with the counterstatement that points to its position in respect of the similarity of the marks. I do not intend to reproduce these in full here but confirm that I have taken them into account in making the following comparison.

Overall Impression

The applicant's mark

31. The applicant's mark consists of both a figurative element and a word element. The figurative element is a stylised representation of the letter 'P' intertwined with a heart symbol that has been altered to appear as the letter 'M'. Both the 'P' and the M/heart symbol are presented in red and blue. Below this is the words 'Perfect Match' in a standard italicised red typeface. Given the prominent size of the 'PM'/heart element, I am of the view that it shares an equal role in the overall impression of the mark with the words 'Perfect Match'.

The opponent's first mark

32. The opponent's first mark consists of the word 'match' in a standard blue typeface followed by a blue heart device. Given the size and position of the word 'match', it will dominate the overall impression of the mark with the heart device playing a lesser role.

The opponent's second mark

33. The opponent's second mark is a word only mark that is comprised of the words 'MATCH.COM'. Given the fact that '.COM' will be understood as a reference to a website, it will play a lesser role. It, therefore, follows that the mark is dominated by the word 'MATCH'.

Visual Comparison

The applicant's mark and the opponent's first mark

34. While it is presented differently, the marks share the word 'MATCH' which is situated at the beginning of the opponent's mark and towards the end of the applicant's mark. The marks also share a visual representation of a heart device

which is placed at different points within each mark and is stylised to be read as an 'M' in the applicant's mark. Therefore, I consider that this only constitutes a very slight point of visual similarity. The marks differ with the presence of the word 'Perfect' and the letter 'P', both of which appear in the applicant's mark. Taking all of this into account and bearing in mind the dominance of 'match' in the opponent's first mark, I am of the view that the marks are visually similar to between a low and medium degree.

The applicant's mark and the opponent's second mark

35. Visually, these marks share the word 'MATCH'. As a word only mark, the opponent's second mark may be displayed in any standard typeface and colour, including the typeface and colour used in the word element of the applicant's mark. The marks differ in the presence of the words '.COM' in the opponent's mark, 'Perfect' and the 'PM'/heart device in the applicant's mark, none of which have any counterpart in the other parties' mark. While I have found that the '.COM' element plays a lesser role in the opponent's mark, it is still point of visual difference. Taking all of this into account, I am of the view that the marks are visually similar to a medium degree.

Aural Comparison

36. While the 'PM'/heart element in the applicant's mark is capable of being pronounced, I do not consider that it will be. This is particularly the case given that it will be readily understood as standing for 'Perfect Match'. In my view, it is highly unlikely that the average consumer would pronounce the applicant's mark as 'PM Perfect Match'. Instead, it will be simply pronounced as 'Perfect Match'.

The applicant's mark and the opponent's first mark

37. The only element in the opponent's first mark that will be pronounced is the word 'MATCH'. This will be pronounced in the ordinary way, being one syllable in length. As above, the applicant's mark consists of three syllables, being 'Perfect Match'.

This will be pronounced in the ordinary way. The first two syllables in the applicant's mark have no counterpart in the opponent's, however, the entirety of the opponent's mark is identical to the last syllable of the applicant's mark. While the additional syllables result in the applicant's mark being longer, it is not considerably so. Taking all of this into account, I am of the view that the marks are aurally similar to a medium degree.

The applicant's mark and the opponent's second mark

38. The 'MATCH' element of the opponent's second mark will, again, be pronounced in the ordinary way. However, the '.COM' element will be pronounced as two syllables, being 'DOT-COM'. As above, the applicant's mark will be pronounced as three syllables in the ordinary way. The opponent submits that as a result of both marks being three syllables in length, there is a shared rhythm. While these submissions are noted, I am not entirely sure what is meant by this. If a shared number of syllables resulted in aural similarity, it could be said that any three syllable word/phrase would be aurally similar to the opponent's second mark. This is not the case and the opponent's submissions on this point are, therefore, disregarded.

39. Overall, the aural similarities and differences set out at paragraph 37 above apply here. However, the marks differ further in that the '.COM' element in the opponent's mark will be pronounced and has no counterpart in the applicant's mark. It, therefore, serves as a further point of aural difference. Taking all of this into account, I am of the view that the marks are aurally similar to between a low and medium degree.

Conceptual Comparison

40. I note that the opponent's submissions argue that 'MATCH' is not descriptive of the services at issue in that people are not a 'match' for one another on the basis that "as complex human beings there are simply too many variables for a 'match' to really be possible." While I note these submissions, this does not prevent the

average consumer understanding the purpose of the services in that they aim to 'match' users with one another. I am of the view that in the context of the services at issue, 'MATCH' will be understood as a reference to dating services that seek to 'match' its users with one another i.e. matchmaking services.

The applicant's mark and the opponent's first mark

41. The concept of 'MATCH' in the opponent's first mark will be understood as set out above. As for the heart device, this will reinforce the concept conveyed by the word 'MATCH' in that the services aim to assist the user in finding love which feeds into the concept of matchmaking or dating services. Turning to the applicant's mark, the additional word before 'Match', being 'Perfect', will reinforce the concept discussed at paragraph 40 above in that the services will aim to find the user's 'perfect match'. As a result, I consider that 'Perfect Match' forms a unit. As for the 'PM'/heart device, I have found above that this will be understood as standing for the words 'Perfect Match' so will do little for the overall conceptual impact, aside from reinforcing the perception of 'Perfect Match' as a unit. However, the perception of the heart within that element will have the same impact as the heart in the opponent's mark in that it reinforces the overall concept of the mark.

42. Overall, I am of the view that both marks are dominated by the concept of matchmaking in that the services will aim to find the user a 'match'. While I accept that the reference to a 'perfect' match in the applicant's mark is a point of conceptual difference, I am of the view that it is very slight in that it does not take away from the concept of matchmaking, only reinforces it. Taking all of this into account, I am of the view that these marks are conceptually similar to a high degree.

The applicant's mark and the opponent's second mark

43. I do not consider that the removal of a heart device and the addition of '.COM' in the opponent's second mark will result in a different conceptual finding than that discussed above. This is because the concept of 'matchmaking' still remains with

the addition of '.COM' only indicating that the services are provided online via a '.com' website. Overall, I am of the view that these marks are conceptually similar to a high degree.

Distinctive character of the opponent's marks

44. 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).”

45. 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. In its submissions in respect of its 5(3) grounds, the opponent claims that its marks have a distinctive character, both inherent and enhanced through use. While the submissions were made in respect of the 5(3) grounds, I am content to accept this submissions as applying to the present grounds. Further, I note that evidence of use has been filed and it is ordinary in proceedings before the Tribunal that where evidence of use has been filed, enhanced distinctiveness is considered regardless of whether it is expressly pleaded or not.

46. Before considering the enhanced position through use, I will first consider the inherent position of the opponent's marks. The opponent's first mark consists of a word element, being 'MATCH', that is followed by a heart device. While I do not consider the word 'MATCH' to be directly descriptive of the services at issue, it is indirectly so. This is on the basis that it describes matchmaking services that aim to *match* its users to one another. The heart device does little to alter this in that it reinforces this understanding. As a result, I am of the view that the opponent's first mark is extremely weak in inherent distinctiveness. However, it is registered and must be accorded at least some distinctive character.¹ As a result, I am of the view that the opponent's first mark is only inherently distinctive to a very low degree. Turning to the opponent's second mark, I am of the view that the same finding applies in that the 'MATCH' element is indirectly descriptive. Further, the addition of '.COM' is likely to be perceived as no more than an indicator that the services are available online via a '.com' website.

47. While the opponent has filed a good deal of evidence to show use of its mark, the use is by Meetic SA. While that may be the case, I note that use of a mark by a third party with the consent of the owner is acceptable.² The evidence sets out that Meetic SA is exclusively licensed to use the opponent's marks in the UK. Further, the evidence sets out that the opponent and Meetic SA are part of the same group of companies and refers to intercompany agreements that allows for use of the opponent's marks by Meetic SA. While evidence of the agreement is not provided,

¹ *Formula One Licensing BV v OHIM*, Case C-196/11P

² *Einstein Trade Mark*, [2007] RPC 23

I am content to conclude that the use of the marks by Meetic SA is with the opponent's consent. Further, I note that the applicant hasn't taken issue with this point so I will proceed on the basis that use by Meetic SA of the opponent's marks is not challenged. Turning now to the evidence in respect of use, it sets out that the opponent launched as an online dating service provider in 1995. By 2004, 'Match.com' had over 42 million registered users. However, this appears to be a global figure and there is no indication of how much of this equates to UK use. Despite this, the evidence does go on to state that by 2008, 'MATCH.COM UK' celebrated two achievements in that, since 2001, more than 1 billion messages had been sent and also 1 billion winks (being described as a virtual signal within the messaging and chatroom services).³

48. A print-out from the website 'datingsitereviews.com' has been provided⁴ that confirms that the 'MATCH.COM' mobile app was available as early as 2008, with a dedicated app for iPhones and 'Palm Pre phones' in 2009 with apps for Android and Blackberry launching in 2010. While this website is noted, there is no indication as to its accuracy. For example, I note that some entries contain annotations seemingly from individuals or moderators of the website in respect of conflicting information and references to lack of evidence to back up the information.

49. The opponent has provided data that it obtained from 'ISPOS', being a brand tracking service that the opponent uses to evaluate its brand and market position. The opponent has provided a print-out from the about us page of the 'IPSOS' website and I note that the print-out claims that it consists of 'passionately curious experts' that use the 'best of science, technology and know-how'.⁵ The data shows a list of dating service providers between 2014 and 2020. I note that the evidence sets out that during these years, the opponent's brand was consistently ranked third or higher in the 'awareness list' for the 25 to 65 age bracket. While the opponent is confident that this evidence is applicable to the whole of the UK, it is unable to confirm as such. I will bear this in mind when assessing the evidence but

³ Exhibit JC2 of the witness statement of Julien Chouteau

⁴ Exhibit JC3 of *ibid*

⁵ Exhibit JC4 of *ibid*

note that the applicant has not sought to dispute this point either by filing its own evidence or in its written submissions.

50. In addition to the above 'awareness list', the opponent provides a similar list in respect of 'consideration' and 'usages'. According to the evidence, 'consideration' means which brands have been tried at least once within six months or at least been considered and 'usage' means that the brand has been used at least once within the last six months and at least once a week. In respect of 'consideration', I note that between 2014 and 2020, the opponent has ranked 2 or above for the 25-65 age bracket. As for the usage, the opponent appears as ranked fourth or higher between 2014 and 2019, with a ranking of eighth in 2020. While there is no indication as to the accuracy of the evidence from 'ISPOS' report, I note that it was open for the applicant to contest this point. However, they did not do so and I have no reason to disbelieve the evidence provided.

51. A number of press articles have been provided from various publications,⁶ some of which are regional UK publications such as Birmingham Mail, whereas others are from UK-wide publications such as Metro, hitched.co.uk and The Observer. Of this evidence, I note that the Birmingham Mail website shows that, as of the date of the article, being 18 July 2017, Match had 3 million UK members.⁷ While the press articles are noted, I must treat it with some caution as I note that some of them refer to dating sites outside of the UK in that there is a reference to Canadian dating sites or dating sites aimed at American users. Within this evidence is an article from the online statistics website, Statista, that details the percentage of UK users for leading providers and shows that 45% of respondents used Match in 2017, being the joint top response with Plenty of Fish.⁸

52. The opponent's evidence goes into detail in respect of various advertising campaigns it has undertaken. While I do not intend to reproduce the entirety of this evidence, I note that a range of outdoor advertising, press and internet campaigns are shown and these range from 6 January 2015 to 1 January 2020. This evidence

⁶ Exhibit JC5 of *ibid*

⁷ Page 4 of Exhibit JC5 of *ibid*

⁸ Page 13 of Exhibit JC5 of *ibid*

shows examples of the advertising used and I note that the opponent's first mark appears on the majority of these with reference to the opponent's mobile app. Further, I note that some of them cover London based outdoor advertising and advertising on itv.co.uk, being a popular UK television broadcaster. Further, I note that the evidence sets out detailed breakdowns of advertising campaigns between 2 May 2015 and 16 February 2020 that the opponent ran on UK TV channels such as ITV, E4, Channel 5, Channel 4, MTV, Sky One, 5Star and TLC. While I have no viewership figures in respect of these channels, I do not consider it to be a point of serious dispute that these channels are mainstream UK-wide channels.

53. In addition to the above advertising campaigns, the opponent has provided examples of advertising expenditure between 2015 and 2019. The figures cover costs for advertising on television, video on demand, video online, radio, press, out of home and cinema advertising and while no totals are provided, I note that during this time, the opponent incurred an expenditure in excess of 30 million euros. Despite being in euros, the evidence sets out that this is UK expenditure. In addition to the above, further expenditure for online advertising has been provided that show advertising expenditure in excess of 45 million euros between 2015 and 2019. Although in respect of this expenditure, I note that it is not limited to a specific territory. However, on balance of the UK advertising evidence discussed above, it is reasonable to infer that a significant proportion of this amount relates to the UK.

54. As above, the evidence confirms that the opponent provides its services via its own mobile app. Evidence has been provided from App Annie (a leading global provider of mobile data and analytics)⁹ that shows download figures between 2015 and 2019 for the UK. Of this I note that there were 392,008 downloads in 2015, 451,744 in 2016, 412,108 in 2017, 390,419 in 2018 and 410,177 in 2019. In respect of the opponent's app, I note that it appears on the Apple App Store as 'Match.com – Local Dating App' and its download screen shows the opponent's first mark also.

55. In addition to this, the services are provided via a website, being 'uk.match.com'. The evidence on this point is provided by way of figures relating to the opponent's

⁹ Exhibit JC6 of *ibid*

monthly active users. The data for each year was collated on 31 October meaning that the figures show the unique users for the 28 days prior to that date. Of these I note that there were 564,080 users in October 2016, 462,481 in October 2017, 358,826 in October 2018 and 366,863 in October 2019. While limited to monthly figures, it is clear that they reflect an ongoing and significant user base.

56. Lastly, I note that turnover figures have been provided for the years 2013 to 2019 for 'Match UK'. The opponent generates this via subscription revenue derived from the provision of its online dating and social introduction services. These figures show a subscription revenue of £30,196,959 in 2013, £30,534,640 in 2014, £28,117,724 in 2015, £29,223,124 in 2016, £27,235,631 in 2017, £23,511,575 in 2018 and £21,569,081 in 2019.

57. I note that no evidence of the market has been provided. However, even without this evidence I am content to conclude that the turnover figures provided are sufficient. This is on the basis that even against a large market, the turnover figures are sizable. This finding is further supported by the Statista rankings discussed at paragraph 51 above and the IPSOS evidence that shows the opponent as consistently being one of the top brands within the online dating market. In assessing the evidence as a whole, I have no hesitation in finding that the use shown is sufficient to enhance the distinctive character of both marks in respect of "dating services" (being the opponent's core business and the service that shares identity with the applicant's services). I make this finding on the basis that the evidence includes repeated reference to both the opponent's first mark and the opponent's website, being 'MATCH.COM'. That being said, I consider that the inherent level of distinctiveness is so low that the evidence, while significant, is only sufficient to enhance the distinctiveness of the marks to a medium degree.

Likelihood of confusion

58. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible

undertakings being the same or related. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

59. I have found the applicant's services to be identical with the opponent's services. I have found the average consumer for the goods and services to be members of the general public over the age of 18 who will select the services through primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will pay at least a medium degree of attention (but not high) when selecting the services at issue. I have found the opponent's marks to be inherently distinctive to a very low degree but this has been enhanced through use to a medium degree. I have found the applicant's mark to be visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to a high degree with the opponent's first mark and visually similar to a medium degree, aurally similar to between a low and medium degree and conceptually similar to a high degree with the opponent's second mark.

60. Taking all of the above factors and the principle of imperfect recollection into account, I do not consider that the average consumer would mistakenly recall or misremember the marks for one another. While the marks share the word 'MATCH', being the dominant and distinctive element of both of the opponent's marks, I am of the view that the 'PM'/heart device in the applicant's mark together with the additional word 'Perfect', prior to 'Match' are sufficient to enable the average consumer to differentiate between the parties' marks, particularly when paying a medium degree of attention during the selection process. While the marks

are conceptually similar to a high degree, I consider that the visual and aural differences between the parties' marks will mean that the average consumer will be able to accurately recall and remember which mark was which. Consequently, I do not consider there to be a likelihood of direct confusion between the marks, even on identical services. I will now consider whether there is a likelihood of indirect confusion.

61. 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)".

62. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (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.

63. I must now consider whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of their shared common elements. The opponent's submissions in respect of indirect confusion set out that "MATCH is the distinctive and dominant element in all marks." While I appreciate 'MATCH' is the distinctive and dominant element in the opponent's marks, I do not consider this to be the case for the applicant's mark. While I accept that the word 'Match' plays a pivotal role in the applicant's mark, it is not the dominant and distinctive element of the mark. Further, its role is shared with the word 'Perfect' on the basis that, together, they form a unit. Even if I were to apply the *Medion* principle (the correct approach of which is set out in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*¹⁰), this would not assist the opponent. In my view, the average consumer would not consider that the phrase 'Perfect Match' is a composite mark with each word having a distinctive significant independence of the significance of the whole.

¹⁰ [2015] EWHC 1271 (Ch)

64. In my view, upon recognising the differences between the parties' marks, I do not consider that the average consumer would assume that they come from the same or economically linked undertakings. Even though the distinctiveness of the opponent's marks have been increased through use, I do not consider that it has been enhanced to the extent where the average consumer would consider any and all use of the word 'MATCH' in relation to dating services as indicative of the marks being owned by the same or economically linked undertakings. This is particularly the case as 'Perfect Match' forms its own phrase that the average consumer would not consider a brand extension or sub-brand of the opponent's marks.

65. Further, I also bear in mind the case law cited above that states that a finding of indirect confusion in circumstances where there is no direct confusion is not a consolation prize and must be found on a proper basis. This is particularly the case given that the addition of 'Perfect' before 'Match' in the applicant's marks creates its own well-known phrase. While I accept the marks are conceptually similar to a high degree, the common concepts of a heart and that conveyed by the word 'match' are not very distinctive in the context of the services at issue. As a result, the conceptual similarity does not have a particularly striking impact on the issue of confusion. I see no reason as to why the consumer would consider that the opponent would re-brand itself as, or create a sub-brand of, 'Perfect Match'. I do not consider that the average consumer would believe this to be a logical rebranding and neither would they see it as indicative of a sub-brand. The consumer is more likely to view the addition of the different word of 'Perfect' to indicate different undertakings specialising in the same type of services that coincidentally use the word 'Match' rather than indicating that the marks originate from the same or linked undertakings. On this point, I remind myself of the case of *Duebros Limited v Heirler Cenovis GmbH*,¹¹ wherein Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because two marks share a common element and that it is not sufficient that a mark merely calls to mind another mark. He further stressed that this is mere association and not indirect confusion. Bearing this in mind, even if the applicant's mark was to call to mind the opponent's marks in the mind of the

¹¹ Case BL O/547/17

average consumer, this is not sufficient to find a likelihood of indirect confusion. Consequently, I do not consider there to be a likelihood of indirect confusion between the parties' marks, even on services that are identical.

66. As a result of my findings above, the opposition under section 5(2)(b) fails. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

67. 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.”

68. 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*).

69. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of its earlier marks being brought to mind by the applicant's later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the services are 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.

70. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 9 March 2021.

Reputation

71. 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.”

72. In its notice of opposition, the opponent claimed that its marks have a reputation in respect of the services listed at paragraph four above.

73. I have discussed the opponent's evidence in detail at paragraphs 47 to 56 above. While the evidence summary was made in respect of the enhanced distinctiveness of the opponent's marks through use, the opponent relies on the same marks and the same services under its 5(3) ground as it did in its 5(2)(b) ground. Further, the relevant date of assessments is the same. As a result, that same evidence will form the basis for the present assessment of reputation.

74. Assessing the evidence as a whole, I am satisfied that it shows significant levels of use for both of the opponent's marks in relation to “dating services” over a prolonged period of time and across the entirety of the UK. For the avoidance of doubt, I accept the use by Meetic SA in the evidence was with consent of the

opponent. I do not intend to repeat the evidence in full here save to say, briefly, that it shows use across the UK from 2008 at the latest (being when the opponent's app was launched), consistent high rankings amongst dating service providers by way of reports from a brand tracking service provider, a significant advertising expenditure of over 30 million euros with a number of promotional campaigns that ran on UK-wide television channels, a significant and consistent level of ongoing active users and a large turnover between 2013 and 2019 that stands in excess of £188 million. I am content to conclude that the evidence demonstrates that the opponent had, at the relevant date, obtained a strong reputation in its marks for "dating services". While I note that the opponent relies on a wider range of goods and services, I do not consider it necessary to consider these further at this stage. I will, however, return to consider them further, if necessary.

Link

75. As 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.

76. I have found the applicant's mark to be visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to a high degree with the opponent's first mark. I have found the applicant's mark to be visually similar to a medium degree, aurally similar to between a low and medium degree and conceptually similar to a high degree with the opponent's second mark.

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.

77. The services at issue are identical.

The strength of the earlier mark's reputation

78. The opponent's marks enjoy a strong reputation in the UK.

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

79. I have found above that the inherent distinctive character of the opponent's marks is very low. However, I have found this to be enhanced through use to a medium degree. In addition, I am of the view that the evidence shows that the opponent's marks strongly identify the services with a single undertaking.

Whether there is a likelihood of confusion

80. I have found there to be no likelihood of confusion between the marks.

81. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's marks to mind when confronted with the applicant's mark, thereby creating the necessary link. Even though I have found there to be no likelihood of confusion, this does not preclude me from finding the necessary link between the marks. I am of the view that, when all of the above is taken into account, particularly the strength of the opponent's reputation and the similarities between the marks (particularly the shared use of the word 'MATCH'), use of the applicant's mark on identical services is liable to bring the opponent's marks to mind, thereby creating the necessary link between them. I make this finding despite the fact that there is no likelihood of confusion and the only medium distinctiveness of the opponent's marks.

Damage

82. The opponent has pleaded that use of the applicant's mark would take unfair advantage of the reputation of its marks, that it would, without due cause, prove to

be detrimental to the reputation of the opponent and the distinctive character of the opponent's marks. I will deal with each head of damage in turn below.

Unfair Advantage

83. I bear in mind that unfair advantage has no effect on the consumers of the opponent's marks' goods and services. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

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

84. I have found above that the opponent has demonstrated that its marks have obtained a strong reputation for “dating services”. This is, in my view, the sort of reputation that would result in the applicant's mark benefiting from an enhanced level of recognition due to the link between the marks in the minds of the relevant public. In my view, the similarity of the parties' marks, when used on identical services, are sufficient to result in an unfair advantage being taken of the opponent's marks' reputation. The applicant, by using the word 'MATCH' on dating services would achieve instant familiarity in the eyes of average consumers,

thereby securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the strong reputation of the opponent's marks. Therefore, I find it likely that the applicant's mark is takes unfair advantage of the opponent's marks.

85. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. I will now move to consider the opponent's 5(4)(a) ground.

Section 5(4)(a)

86. Section 5(4)(a) of the Act reads as follows:

“(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.”

87. 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.”

88. 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).”

89. 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 reputation¹ 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 source² 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.”

Relevant Date

90. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s

assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

91. The applicant’s mark does not have a priority date and neither is there any evidence of use of the applicant’s mark prior to the application date at issue that is capable of being deemed as the start of the behavior complained about. This means that the relevant date for assessment of the opponent’s claim under section 5(4)(a) of the Act is the date of the application for registration, being 9 March 2021.

Goodwill

92. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in its signs at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“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.”

93. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

94. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

95. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

96. For passing off claims to succeed, there must be a protectable level of goodwill that exists in a business and the unregistered signs relied upon must be associated with or distinctive of that business. I have discussed above that the opponent's evidence sets out that Meetic SA is exclusively licensed to use the opponent's marks in the UK and that this is authorised by intercompany agreements. I have accepted that this use is with the consent of the opponent. In respect of goodwill, I do not consider it controversial to infer that due to the relationship between the companies, the agreements set out that any goodwill that arises as a result of the use of the opponent's marks in the UK by Meetic SA remains vested in the opponent, being the owner of the marks. I am, therefore, satisfied that any goodwill resulting from the use of the marks vests in the opponent's business. Further, I

note that the applicant hasn't taken issue with this point so I will proceed on the basis that the ownership of the goodwill isn't challenged.

97. Goodwill arises as a result of trading activities. I am satisfied that the evidence that I have summarised in detail at paragraphs 47 to 56 above is sufficient to prove that, as at the relevant date, the opponent had a strong level of goodwill in its business providing "dating services". It is my view that both of the signs relied upon were distinctive of that business.

Misrepresentation and damage

98. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

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

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

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

99. And later in the same judgment:

".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of*

London (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

100. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*,¹² it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that this is the case here and find that there is no misrepresentation under the 5(4)(a) ground as I do not consider that a substantial number of members of the public will be deceived into selecting the services offered under the applicant’s mark on the mistaken belief that they are the services of the opponent. While the assessment I have made in respect of a likelihood of confusion at paragraphs 60 to 65 above was based on an assessment of the opponent’s marks and not the opponent’s signs, my reasons here echo those given above on the basis that the opponent’s signs and services for which goodwill has been found are identical to those upon which my likelihood of confusion assessment was made. This ground, therefore, fails.

CONCLUSION

101. While the opposition reliant upon the 5(2)(b) and 5(4)(a) grounds has been unsuccessful, the opposition succeeds in full under the 5(3) ground. As a result, the application is refused in its entirety.

¹² [2012] EWCA (Civ) 1501

COSTS

102. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While the opposition failed in respect of two grounds upon which it was based, it did not affect the overall success of the opposition. Therefore, I do not consider it appropriate to make a reduced costs award to reflect the fact that the applicant succeeded in defending two grounds. In the circumstances, I award the opponent the sum of **£1,200** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the applicant's counter statement:	£200
Preparing evidence:	£500
Preparing submissions in lieu of a hearing:	£300
Official Fees:	£200
Total	£1,200

103. I therefore order The Perfect Match Ltd to pay Match Group, LLC the sum of £1,200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of July 2022

A COOPER
For the Registrar