

O/0278/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003674434

BY FRIENDZ SOCIAL MEDIA LIMITED

TO REGISTER THE TRADE MARK:

FRIENDZR

IN CLASSES 9, 38, 42 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 429088 BY

VARIOUS, INC.

BACKGROUND AND PLEADINGS

1. On 28 July 2021, Friendz Social Media Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 10 September 2021, and registration is sought for the goods and services listed at paragraph **48** below.

2. On 10 December 2021, the application was opposed by Various, Inc. (“the opponent”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3) the opponent relies upon the following trade marks:

FRIEND FINDER¹

UKTM no. 906972822

Filing date 9 June 2008; registration date 9 August 2010

Priority date claimed: 5 May 2008

(“the First Earlier Mark”)

The logo for FriendFinder, featuring the word "Friend" in a bold, italicized sans-serif font, followed by "Finder" in a similar font. A small heart icon is positioned above the letter 'i' in "Finder".

UKTM no. 903693843

Filing date 3 March 2004; registration date 11 September 2007

(“the Second Earlier Mark”)

ADULT FRIEND FINDER

UKTM no. 906973218

Filing date 9 June 2008; registration date 9 August 2010

Priority date claimed: 5 May 2008

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having EUTMs being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

("the Third Earlier Mark")

AdultFriendFinder

UKTM no. 903693876

Filing date 3 March 2004; registration date 11 September 2007

("the Fourth Earlier Mark")

3. The opponent relies upon all of the services for which the earlier marks are registered, as set out in the Annex to this decision.

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are similar and the goods and services are identical or similar.

5. Under section 5(3), the opponent claims that it has a reputation for all of the services identified and that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

6. Under section 5(4)(a), the opponent relies upon signs identical to those listed in paragraph 2 above, which it claims to have used either since 2004 or 2008 throughout the UK. The services for which the opponent claims to have used the signs are the same as those covered by the corresponding trade mark registrations as set out in the Annex to this decision.

7. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

8. The applicant is represented by Boulton Wade Tennant LLP and the opponent is represented by D Young & Co.

9. Both parties filed evidence in chief. The opponent filed evidence in reply. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in chief in the form of the witness statement of Ezra Shashoua dated 13 July 2022. Mr Shashoua has been Chief Financial Officer for the opponent since September 2015. His statement is accompanied by 5 exhibits.

11. The applicant filed evidence in chief in the form of the witness statement of Ian Hewitt dated 16 September 2022. Mr Hewitt is a Director of the applicant. His statement is accompanied by 15 exhibits.

12. The opponent filed evidence in reply in the form of the witness statement of Bonnie Brooks dated October 2022. Ms Brooks is a Trade Marks and Designs Specialist acting on behalf of the opponent. Her statement is accompanied by 1 exhibit.

13. Both parties filed written submissions in lieu dated 22 December 2022.

14. I have taken the evidence and submissions into account in reaching this decision.

RELEVANCE OF EU LAW

15. 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 upon 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.

DECISION

Section 5(2)(b)

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

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

18. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had completed their registration process more than 5 years before the application date of the mark in issue, they are subject to proof of use pursuant to section 6A of the Act.

Proof of use

19. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant statutory provisions are as follows:

“(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

21. As the earlier marks are all comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

22. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the date of the application in issue i.e. 29 July 2016 to 28 July 2021. By virtue of the above provisions, use in the EU will be relevant from 29 July 2016 to 31 December 2020. Thereafter, only use in the UK will be relevant.

23. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

24. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

25. I note the following from the opponent’s evidence:

- a) The opponent has been using the earlier marks in the UK since at least 2000;
- b) The ‘hit count’ for FRIENDFINDER from 2015 to 2020 in the UK is as follows (Mr Shashoua states that these relate to unique visitors):

2015	678831
2016	442875
2017	254977
2018	226442
2019	248641
2020	154185

c) For the website adultfriendfinder.com, the following unique visitor information in the UK has been provided:

2015	44393863
2016	33981021
2017	22145558
2018	21158516
2019	25884673
2020	24482804

d) The marks appear in word form on the opponent's website during the relevant period, alongside the following:²



² Exhibits 2 and 3



Both websites have availability access specifically targeted at the UK market.

- e) I also note the following appeared on the opponent's Adult Friend Finder website during the relevant period:³



- f) In April 2017, there were over 8million UK users of the Adult Friend Finder website.⁴
- g) The following revenue for the ADULT FRIEND FINDER website in the UK has been provided:

2021	\$2.8million
2020	\$2.6million
2019	\$2.9million
2018	\$3.9million
2017	\$3.5million
2016	\$4.2million

³ Exhibit 2

⁴ Exhibit 4

- h) The opponent states that it spent over \$83million on advertising in 2019 and over \$94million on advertising in 2020. However, no breakdown is given as regards the different marks or the UK or EU markets specifically.
- i) ADULT FRIEND FINDER has won awards such as the 2016 AVN Award for Best Dating Website.⁵

26. The First and Third Earlier Marks have been used as registered. I am satisfied that use in different colours and fonts, as shown above, is use of the word only marks as registered. There is no evidence of use of the Second and Fourth Earlier Marks as registered. However, I consider that the distinctive character of the Second and Fourth Earlier Marks lies in the words FRIEND FINDER and ADULT FRIEND FINDER. I do not consider that the stylisation to the letter 'l's contributes significantly to that distinctive character. Consequently, I am satisfied that use of the words in the above forms is acceptable variant use of the Second and Fourth Earlier Marks.

27. I am satisfied that the earlier marks have been put to genuine use in relation to online dating platforms during the relevant period in the UK. Although there are no revenue figures provided for the FRIEND FINDER website, I note that the user numbers provided demonstrate a significant number of UK-based customers. Consequently, I am satisfied that there has been genuine use of all the earlier marks.

28. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

⁵ Exhibit 3

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

29. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not

constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

30. The opponent clearly provides users with the opportunity to post images, text and video content on its websites for the purposes of online dating. The opponent also clearly provides hosting of virtual communities for the purpose of online dating and dating services. However, I do not consider that this is sufficient to rely upon social networking services more broadly. There is insufficient evidence before me for the opponent to rely upon provision of information services. Taking all of this into account I consider the following to be a fair specification for the First and Third Earlier Marks:

Class 38 Providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information for the purposes of online dating; providing on-line chat rooms for users to transmit and receive messages and other information for the purposes of online dating; providing access to online dating websites featuring images, audio, video and audiovisual content, and other information.

Class 42 Hosting and maintaining virtual communities and facilities for them in the field of online dating.

Class 45 Dating services.

31. I consider the following to be a fair specification for the Second and Fourth Earlier Marks:

Class 45 Dating services; providing personal dating profiles via the internet.

Section 5(2)(b) – case law

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

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive

role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of trade marks

33. It is clear from *Sabel BV 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 marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

34. 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.

35. The respective trade marks are shown below:

Opponent’s trade marks	Applicant’s trade mark
<p data-bbox="336 857 655 947">FRIEND FINDER (the First Earlier Mark)</p> <p data-bbox="371 1037 643 1093"><i>FriendFinder</i></p> <p data-bbox="312 1176 679 1209">(the Second Earlier Mark)</p> <p data-bbox="312 1288 679 1377">ADULT FRIEND FINDER (the Third Earlier Mark)</p> <p data-bbox="260 1469 715 1541"><i>AdultFriendFinder</i></p> <p data-bbox="320 1615 671 1648">(the Fourth Earlier Mark)</p>	<p data-bbox="1018 857 1182 891">FRIENDZR</p>

Overall Impression

36. The overall impression of the applicant’s mark lies in the invented word FRIENDZR. There are no other elements to contribute to the overall impression, which lies in the word itself.

37. The First Earlier Mark consists of the words FRIEND FINDER. The overall impression lies in the combination of these words. The Second Earlier Mark consists of the same words, with the addition of two heart devices above the letter I in FRIEND and FINDER, and slightly stylised font. In my view, it is the words themselves that dominate the overall impression.

38. The Third Earlier Mark consists of the words ADULT FRIEND FINDER. The overall impression of the mark lies in the combination of these words. The Fourth Earlier Mark consists of the same words, with the addition of two heart devices above the letter I in FRIEND and FINDER, and slightly stylised font. In my view, it is the words themselves that dominate the overall impression.

Visual Comparison

39. The applicant's mark and the First Earlier Mark overlap to the extent that the first word of the First Earlier Mark is replicated at the beginning of the applicant's mark. However, the additional word FINDER in the First Earlier Mark and the letters ZR at the end of the applicant's mark act as points of visual difference. Consequently, I consider the marks to be visually similar to a medium degree.

40. The same applies to the Second Earlier Mark. However, the devices act as an additional point of difference. I do not consider that the stylisation contributes to the differences, as the applicant's mark could be used in any font. Consequently, I consider the marks to be visually similar to between a low and medium degree.

41. The applicant's mark and the Third Earlier Mark overlap to the extent that the second word in the Third Earlier Mark is replicated at the beginning of the applicant's mark. However, the additional words ADULT and FINDER in the Third Earlier Mark and the letters ZR at the end of the applicant's mark act as points of visual difference. Consequently, I consider the marks to be visually similar to a low degree.

42. The same applies to the Fourth Earlier Mark. However, the devices act as an additional point of difference. I do not consider that the stylisation contributes towards

the differences, as the applicant's mark could be used in any font. Consequently, I consider the marks to be visually similar to a very low degree.

Aural Comparison

43. The words FRIEND and FINDER in the First and Second Earlier Marks will be given their ordinary English pronunciation. The applicant's mark is likely to be pronounced FRIENDS-ARE or FRIEND-ZED-ARE. The point of aural overlap lies in the common articulation of the word FRIEND. However, the additional word in the First and Second Earlier Marks and the articulation of the letters ZR in the applicant's mark act as points of aural difference. Overall, I consider the marks to be aurally similar to no more than a medium degree.

44. The same applies to the Third and Fourth Earlier Marks. However, the additional word ADULT in the Third and Fourth Earlier Marks will act as a further point of aural difference. Consequently, I consider the marks to be aurally similar to between a low and medium degree.

Conceptual Comparison

45. The applicant submits that its mark is an invented word and, consequently, will have no clear meaning. I disagree. Whilst the mark is, as a whole, an invented word, I consider that the average consumer will recognise that the start of the invented word is the dictionary word FRIEND. Consequently, this meaning will be conveyed to the average consumer and will overlap with the same word in the First and Second Earlier Marks. The opponent submits that the letters ZR will be seen by some average consumers as a colloquialism for "FINDER". I have no evidence to suggest that this is the case and I can see no reason why it would be. I do not consider that the additional letters Z and R in the applicant's mark will contribute to the meaning conveyed (other than that the Z may be seen as a misspelling of the word FRIENDS). The word FRIEND in the First and Second Earlier Marks appears combined with the word FINDER. In combination, they convey the message of being something (a good or a service, presumably) that would assist in locating and making friends. I do not consider that any additional meaning is likely to be conveyed by the devices. Whilst there is

some conceptual overlap due to the common use of the word FRIEND, the overall meanings are not the same. Consequently, I consider the marks to be conceptually similar to a medium degree.

46. The same applies to the Third and Fourth Earlier Marks. However, the additional word ADULT provides further qualification to the word FRIEND. Consequently, I consider the marks to be conceptually similar to between a low and medium degree.

47. As the First and Third Earlier Marks have the broadest specifications, and the Second and Fourth Earlier Marks do not put the opponent in any stronger position in terms of similarity of the marks, I will continue the decision on the basis of the First and Third Earlier Marks only. If the opposition fails in relation to those marks, it follows that it will also fail in relation to the Second and Fourth Earlier Marks.

Comparison of goods and services

48. The competing goods and services are as follows:

Opponent's services	Applicant's goods and services
<p>First and Third Earlier Marks</p> <p><u>Class 38</u></p> <p>Providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information for the purposes of online dating; providing on-line chat rooms for users to transmit and receive messages and other information for the purposes of online dating; providing access to online dating websites featuring images, audio, video and audiovisual content, and other information.</p>	<p><u>Class 9</u></p> <p>Computer software; application software; social software; communications software; computer software for personal and social networking; application software for personal and social networking; downloadable software applications for smartphones, computers, tablets, mobile phones, television, wireless devices; computer software for accessing, browsing and searching online databases; application software for accessing, browsing and searching</p>

Class 42

Hosting and maintaining virtual communities and facilities for them in the field of online dating.

Class 45

Dating services.

online databases; geolocation software; computer software for providing information concerning current location of persons and assets; downloadable software in the nature of a mobile application for displaying and sharing a user's location and finding, locating, and interacting with other users and places; downloadable electronic publications; cases and covers for mobile phones.

Class 38

Telecommunications services; communications by computer, mobile phones, smart phones, tablets, wireless devices; internet communication services; internet based telecommunication services; electronic transmission of images, audio files, videos, messages, photographs, animations, information, digital files, documents, data files, multi-media content; peer to peer communication; providing access to databases in the field of personal and social networking; providing internet chatrooms; providing online forums; message sending; providing email and instant messaging services; messaging services, namely, sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; streaming of data;

	<p>video uploading services; photo uploading services; location-based transmission of information. information, advisory and consultancy services relating to all the aforesaid.</p> <p><u>Class 42</u></p> <p>Hosting services, software as a service, and rental of software; computer services, namely, creating communities for users to engage in personal and social networking; providing online, non-downloadable software in the field of personal and social networking; software as a service (SaaS) in the field of personal and social networking; platform as a service (PaaS) in the field of personal and social networking; application service provider (asp) in the field of personal and social networking; application service provider (asp) featuring digital mapping software for use in the fields of geographic information systems and location-based services, namely computer graphics software and computer software for providing information concerning location of persons; hosting computer sites [web sites] in the field of personal and social networking; information, advisory and consultancy services relating to all the aforesaid.</p>
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	<p><u>Class 45</u> Internet-based social networking, introduction, and dating services; online social networking services; online social networking services accessible by means of downloadable mobile applications; location-based personal and social introduction services; providing information about personal and social networking; information, advisory and consultancy services relating to all the aforesaid.</p>
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49. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

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

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

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

51. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

Class 9

Computer software; application software; social software; communications software; computer software for personal and social networking; application software for personal and social networking; downloadable software applications for smartphones, computers, tablets, mobile phones, television, wireless devices; computer software for accessing, browsing and searching online databases; application software for accessing, browsing and searching online databases;

52. These are all software goods that may be used in conjunction with the opponent’s “dating services” offering. It may be that the customer would access the opponent’s dating services through this type of software e.g. by downloading a ‘dating’ app.

Consequently, there may be an overlap in trade channels and user. The method of use and purpose of the goods and services will differ, as will the nature. I consider that there may be complementarity. Consequently, I consider the goods and services to be similar to a medium degree.

Geolocation software; computer software for providing information concerning current location of persons and assets; downloadable software in the nature of a mobile application for displaying and sharing a user's location and finding, locating, and interacting with other users and places;

53. Although these goods may be used for the purposes of interacting with others, their primary purpose is identifying someone's location. Consequently, I do not consider there to be the same complementarity with the opponent's services. I accept there may still be overlap in users and trade channels. The nature, method of use and purpose of the goods and services will differ. I do not consider there to be competition. Consequently, I consider the goods and services to be similar to a low degree. I can see no other point of overlap with the opponent's specification which would put it in a stronger position.

Downloadable electronic publications; cases and covers for mobile phones.

54. I can see no obvious point of overlap with the opponent's specification and I have no specific submissions from the opponent to assist me. Consequently, I consider these goods to be dissimilar to the opponent's services.

Class 38

Telecommunications services; internet based telecommunication services; Communications by computer, mobile phones, smart phones, tablets, wireless devices; internet communication services; electronic transmission of images, audio files, videos, messages, photographs, animations, information, digital files, documents, data files, multi-media content; peer to peer communication; providing internet chatrooms; providing online forums; message sending; providing email and instant messaging services; messaging services, namely, sending, receiving and

forwarding messages in the form of text, audio, graphic images or video or a combination of these formats;

55. In my view, all of these services are self-evidently identical or identical on the principle outlined in *Merix* to “providing on-line chat rooms for users to transmit and receive messages and other information for the purposes of online dating” in the specifications of the First and Third Earlier Marks.

Providing access to databases in the field of personal and social networking; streaming of data; video uploading services; photo uploading services;

56. In my view, these terms are identical on the principle outlined in *Merix* to “providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information for the purposes of online dating” in the specification of the First and Third Earlier Marks.

Location-based transmission of information.

57. Again, there may be a degree of overlap in trade channels and user. The nature, method of use and purpose differ. There is no competition or complementarity. Consequently, I consider the services to be similar to a low degree.

Information, advisory and consultancy services relating to all the aforesaid

58. These services will be similar to a medium degree to the opponent’s services where I have found the services to which they relate to be identical. This is because, although the trade channels and users would overlap, there would be no overlap in nature, purpose or method of use. There is no competition or complementarity.

59. Where I have found the services to which these relate to be similar to the opponent’s specification to only a low degree due to an overlap in user and trade channels, I consider these services will also be similar to a low degree. This is because the same overlap in user and trade channels will apply.

Class 42

Hosting services, software as a service, and rental of software; computer services, namely, creating communities for users to engage in personal and social networking; providing online, non-downloadable software in the field of personal and social networking; software as a service (SaaS) in the field of personal and social networking; platform as a service (PaaS) in the field of personal and social networking; application service provider (asp) in the field of personal and social networking; hosting computer sites [web sites] in the field of personal and social networking;

60. In my view, all of these services are self-evidently identical or identical on the principle outlined in *Meric* to “providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information for the purposes of online dating” in the specifications of the First and Third Earlier Marks.

Application service provider (asp) featuring digital mapping software for use in the fields of geographic information systems and location-based services, namely computer graphics software and computer software for providing information concerning location of persons;

61. I recognise that there may be some limited overlap in trade channels and user. Consequently, the services are similar to a low degree.

Information, advisory and consultancy services relating to all the aforesaid.

62. Where I have found the services to which these relate to be identical to the opponent’s services, I consider that these will be similar to a medium degree for the same reasons as set out above.

63. Where I have found the services to which these relate to be similar to a low degree due to an overlap in trade channels and user, these services will also be similar to a low degree, because the same overlap in trade channels and user will apply.

Class 45

Internet-based social networking, introduction, and dating services; online social networking services; online social networking services accessible by means of downloadable mobile applications; location-based personal and social introduction services;

64. These services are identical on the principle outlined in *Meric* to “dating services” in the opponent’s specifications.

Providing information about personal and social networking; information, advisory and consultancy services relating to all the aforesaid.

65. Although these services will clearly overlap in trade channels and user with the opponent’s “dating services”, I do not consider that they share the same purpose, method of use or nature. There is no competition, but there may be complementarity. Consequently, I consider the services to be similar to a medium degree.

The average consumer and the nature of the purchasing act

66. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

67. The average consumer for the parties’ goods and services is likely to be an adult member of the general public. The cost of the goods and services is likely to vary, as will the frequency of purchase. However, even where they are low (or no) cost and frequently purchased, various factors will still be taken into consideration by the purchaser such as suitability for particular requirements and ease of use. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process.

68. The goods and services are likely to be selected following perusal of physical signage or online equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that aural components may play a part as word-of-mouth recommendations may be made.

Distinctive character of the earlier trade marks

69. 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-2779, 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).”

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

71. I will begin by assessing the inherent distinctiveness of the earlier marks. The First Earlier Mark consists of the words FRIEND FINDER. I note that the applicant’s evidence contains screen shots of searches for the word “FRIEND” and the words “FRIEND FINDER” in relation to social networking software and other related searches. The opponent’s evidence in reply is focused upon undermining the value of these searches. In my view, these searches are of limited use as they are all dated after the relevant date and only the list of search results is provided – very little information is identifiable about the businesses that appear in the lists. Nonetheless, I agree with the applicant’s submission that in the context of the services covered by the opponent’s specification (i.e. services for the purposes of online dating) the word FRIEND is, clearly, low in distinctiveness. Further, the combined words FRIEND FINDER clearly identify the objective of the user. Consequently, I consider the First Earlier Mark to be distinctive to only a low degree. The Third Earlier Mark consists of the words ADULT FRIEND FINDER. The addition of the word ADULT simply specifies the type of friend the user is looking to meet through the opponent’s dating services. For the same reason, I consider the Third Earlier Mark to be distinctive to only a low degree.

72. I will now consider whether the distinctiveness of the earlier marks has been enhanced through use. The relevant market for assessing enhanced distinctiveness is the UK market. I have no revenue figures for the First Earlier Mark. There is also no

specific breakdown of advertising expenditure in relation to this mark and this market. Consequently, I am not prepared to find that the distinctiveness of the First Earlier Mark has been enhanced through use. With regard to the Third Earlier Mark, I accept that use in the UK has been reasonably longstanding. The number of “unique visitor information” appears high, although shows a decrease in visitor numbers in more recent years. The revenue figures provided are reasonable, although I have no way of knowing what percentage of the market this would represent. Although the opponent’s overall advertising expenditure is high, I have no way of knowing what proportion of that spend relates to the UK market and the Third Earlier Mark. As noted above, the opponent has won an award in relation to the website operated under the Third Earlier Mark. Taking all of this into account, I am satisfied that the distinctiveness of the Third Earlier Mark has been enhanced through use to no more than a medium degree.

Likelihood of confusion

73. 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 them 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.

74. I have found as follows:

- a) The First Earlier Mark and the applicant's mark are visually and conceptually similar to a medium degree and aurally similar to no more than a medium degree.
- b) The Third Earlier Mark and the applicant's mark are visually similar to a low degree and aurally and conceptually similar to between a low and medium degree.
- c) At least some of the services are identical. I will conduct my assessment on the basis of those services, as they represent the opponent's best case.
- d) The First Earlier Mark is inherently distinctive to a low degree.
- e) The Third Earlier is inherently distinctive to a low degree, which has been enhanced through use to no more than a medium degree.
- f) The average consumer is a member of the general public who is over the age of 18, and who will pay at least a medium degree of attention during the purchasing process.
- g) The purchasing process is likely to be predominantly visual, although I do not discount an aural component.

75. The only common element of the marks is the word FRIEND. The additional word FINDER in the First and Third Earlier Marks, the word ADULT in the Third Earlier Mark and the letters ZR in the application are all, in my view, not likely to be overlooked by the average consumer. Taking all of the above factors into account, the visual, aural and conceptual differences between the marks are, in my view, sufficient to avoid a likelihood of direct confusion, even when used on identical services.

76. I turn now to consider indirect confusion. In this regard, the applicant directed me to the comments of Mr James Mellor Q.C. sitting as the appointed person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which he stressed that a finding of

indirect confusion should not be made merely because two marks share a common element. The opponent submits:

“Even if the Office considers that direct confusion does not exist in this case (for the avoidance of doubt, the Opponent maintains that direct confusion would occur), it is clear that there is also a high risk of indirect confusion. There is a possibility that some consumers seeing the additional suffix “zr” will recognise that the Application bears a slight variation to the Opponent’s Registrations, but will notice the common elements between the marks and will conclude that FRIENDZR is another brand of the Opponent. Even if consumers realise that elements of the trade marks are not the same, they will infer any similarities between the trade marks and the goods and services are down to both parties being the same or related undertakings.”

77. I bear in mind that the word FRIEND for goods and services used in making personal connections (such as dating services) is not very distinctive and the distinctiveness of the common element is an important consideration. As noted above, the distinctiveness of the Third Earlier Mark has been enhanced through use to a medium degree. However, the distinctiveness of the mark lies in the combination of the elements ADULT FRIEND FINDER as a whole. In my view, it is unlikely that the average consumer would believe that only one undertaking could be using the word FRIEND in relation to these goods and services. The use of the word FRIEND in differing constructions (FRIEND FINDER in the earlier marks and FRIENDZR in the application) are more likely to be viewed as simply a coincidence than as identifying services originating from the same or economically linked undertakings. Taking all of this into account, I do not consider there to be a likelihood of indirect confusion, even where the marks are used on identical services.

78. As there is no likelihood of confusion in relation to the First and Third Earlier Marks, it follows that there will also be no likelihood of confusion in relation to the Second and Fourth Earlier Marks (as they are less similar to the application).

79. The opposition based upon section 5(2)(b) of the Act is dismissed.

Section 5(3)

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

“5(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 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.”

81. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

82. As the earlier trade marks are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(a) the United Kingdom include the European Union”.

83. 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*).

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

5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

85. 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.”

86. In determining whether the opponent has demonstrated a reputation for the services relied upon, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with those services. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it”.

87. I have already summarised the opponent's evidence of use above. For the same reasons explained previously, I am not satisfied that use of the First Earlier Mark is sufficient to justify a finding of reputation. The same will also apply to the Second Earlier Mark. I am prepared to find a moderate degree of reputation in relation to the Third Earlier Mark for dating services. The Fourth Earlier Mark is less similar to the application than the Third Earlier Mark and so, even if I were to find it had the necessary reputation, it would not improve the opponent's case. Consequently, I will carry out the assessment under section 5(3) on the basis of the opponent's Third Earlier Mark only. If it is unsuccessful in relation to that mark, it follows that it will also be unsuccessful in relation to the other three earlier marks.

Link

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

The degree of similarity between the conflicting marks

I have found the Third Earlier Mark and the application to be visually similar to a low degree and aurally and conceptually similar to between a low and medium degree.

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

At least some of the services covered by the application are identical to those for which the opponent has a reputation. I will carry out my assessment on the basis of those services.

The strength of the earlier mark's reputation

The Third Earlier Mark has a moderate reputation in relation to dating services.

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

I have found the Third Earlier Mark to be inherently distinctive to a low degree, which has been enhanced through use to no more than a medium degree.

Whether there is a likelihood of confusion

I have found there to be no likelihood of direct or indirect confusion.

89. Taking into account the distance between the marks, as well as the no more than medium (or average) level of distinctiveness (even after enhanced distinctiveness has been factored in), I am not satisfied that the relevant public would make a link between the marks. The only common element of the marks is the word FRIEND, which is low in distinctiveness for these goods and services. Any enhanced distinctiveness/reputation acquired by the Third Earlier Mark lies in the combination of the words ADULT FRIEND FINDER, not in the word FRIEND alone. Consequently, I see no reason why the applicant's mark would bring to mind the Third Earlier Mark, even when used in relation to identical services.

90. The opposition based upon section 5(3) is dismissed.

Section 5(4)(a)

91. Section 5(4)(a) of the Act states as follows:

"5(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”.

92. Subsection (4A) of section 5 of the Act 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.”

93. I can deal with this ground relatively swiftly. Whilst there are issues with the opponent’s evidence as noted above, I am satisfied that it is sufficient to establish a moderate (but protectable) goodwill. However, whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it has been acknowledged that they are unlikely to produce different outcomes in practice.⁶ Certainly, I believe that to be the case here. For the same reasons set out above, I consider that the common word FRIEND, which is very low in distinctiveness for these goods and services, is far more likely to be seen as a coincidence rather than indicating that the goods and services of the applicant originate from the opponent. Consequently, I do not consider that misrepresentation or damage will arise.

94. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

95. The opposition is unsuccessful and the application may proceed to registration.

⁶ *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

COSTS

96. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,800** calculated as follows:

Filing a counterstatement and considering the Notice of opposition	£400
Filing evidence and considering the opponent's evidence	£1000
Written submissions in lieu	£400
Total	£1,800

97. I therefore order Various, Inc. to pay Friendz Social Media Limited the sum of £1,800. 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 15th day of March 2023

S WILSON
For the Registrar

ANNEX

The First and Third Earlier Marks

- Class 38 Providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information; broadcasting services, namely, uploading, posting, showing, displaying, tagging and electronically transmitting images, audio, video and audiovisual content and other information; providing on-line chat rooms for users to transmit and receive messages and other information; providing on-line databases; providing access to websites featuring images, audio, video and audiovisual content, and other information.
- Class 42 Hosting and maintaining virtual communities and facilities for them; social networking services, namely, providing a means to foster, become part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them.
- Class 45 Social networking services, namely, providing a mean to foster, becoming part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them; dating services.

The Second and Fourth Earlier Marks

Class 41 Providing for personal use online electronic publications, journals and magazines; publication for personal use of books, journals and magazines online; provision for personal use of information relating to educational, entertainment, social, sporting and cultural activities; providing for personal use event listing via the Internet and electronic mail.

Class 45 Dating services; providing personal profiles via the Internet and electronic mail.