



Neutral Citation Number: [2022] EWHC 941 (IPEC)

CLAIM NO. IP-2020-000080

**IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND & WALES
INTELLECTUAL PROPERTY LIST (CHD)
INTELLECTUAL PROPERTY ENTERPRISE COURT
EUROPEAN UNION TRADE MARK COURT**

Judgment handed down by email
Date: Wednesday 20 April 2022

Before:
NICHOLAS CADDICK Q.C.
(sitting as a Deputy High Court Judge)

BETWEEN:

**(1) MATCH GROUP, LLC
(2) MEETIC SAS
(3) MATCH.COM INTERNATIONAL LIMITED**

Claimants

-and-

**(1) MUZMATCH LIMITED
(2) SHAHZAD YOUNAS**

Defendants

TIM AUSTEN (instructed by Browne Jacobson LLP) for the Claimants

JESSIE BOWHILL (instructed by Bristows LLP) for the Defendants

Hearing dates: 17th and 18th January 2022

JUDGMENT

Nicholas Caddick Q.C. (sitting as a Deputy High Court Judge):



Introduction

1. This is an action by the Claimants for trade mark infringement and passing off in relation to the use of the word “match” for online introduction and dating services.
2. Both sides assert that the case is simple or straightforward. Despite this and despite this being heard as a two-day trial in the Intellectual Property Enterprise Court (“IPEC”), there were 21 lever arch files of documents, 4 lever arch files of authorities and each side’s opening submissions ran to more than 70 pages.
3. The Claimants are members of the Match group and are involved in the operation of a number of online dating sites worldwide, including the UK. As no point is taken as regards their precise roles or involvement in that business, I will not seek to distinguish between them and will refer to them collectively as “Match”.
4. Match is the proprietor of a number of registered trade marks in the words or devices and for the goods and services set out in the table below:

Trade Mark	Filing date	Number	Services relied on
MATCH.COM	1 April 1996	EUTM 000182253 ¹	Class 42: “information and consultancy services in the nature and field of on-line dating and introduction services”
MATCH.COM	13 January 2017	EUTM 016246639 ²	Class 9: <i>inter alia</i> “downloadable software in the nature of a mobile application for internet-based dating and introduction” Class 42: a social media website Class 45: <i>inter alia</i> “dating services; internet based social networking, introduction and dating services”

¹ Since the UK’s withdrawal from the EU, this mark is now protected in the UK as a comparable trade mark (EU), No.UK00900182253

² Now protected in the UK as a comparable trade mark (EU), No.UK00916246639

Trade Mark	Filing date	Number	Services relied on
	3 March 2015	UKTM 3097217	Class 45: <i>inter alia</i> “providing social introduction and date-arranging services, dating agency services, match-making services; computer dating services; provision of dating agency services via the Internet”
TINDER	5 November 2013	EUTM 012278396	<i>Inter alia</i> Class 45: dating services
	7 October 2016	UKTM 3190024	<i>Inter alia</i> Class 45: dating services

5. I will refer to the first mark listed above as “the 1996 Match.com Mark”, to the second as “the 2017 Match.com Mark” and to the third as “the Match Device Mark”. I will refer to the first two of them as “the Match.com Marks” and to the first three of them collectively as “the Match Marks”. I will refer to the final two marks listed above as “the Tinder Marks”.
6. In around April 2011, the Second Defendant (Mr Younas) set up a business under the name Muzmatch with the aim of providing online or internet based matchmaking services to the Muslim community. Mr Younas did this in his spare time away from his main job as a Vice President of the Institutional Equities Division of Morgan Stanley. Initially, he operated Muzmatch as a sole trader but, at the end of 2014, he left Morgan Stanley and, on 7 January 2015, founded the First Defendant (Muzmatch Limited) to take over the Muzmatch business. As Mr Younas is the CEO and the moving force of Muzmatch Limited, I will refer to the Defendants collectively as “Muzmatch” save where it is necessary to distinguish between them.
7. By a Claim Form issued on 30 July 2020, Match claimed that Muzmatch has infringed each of the above trade marks and has committed acts of passing off. The claim concerned Muzmatch’s use of the word “match” as part of its name and also its use of the words “match” and “tinder” as part of a search engine optimisation (“SEO”) strategy designed to increase the number of customers visiting the Muzmatch website.
8. By an Order dated 18 June 2021, Muzmatch submitted to judgment in respect of the uses it had made of the word “tinder” and it gave undertakings not to use that word in relation to dating services and websites and mobile applications for internet dating and matchmaking. However, it continued to deny liability with regard to the claims relating to its use of the word “match”. It does not seek to invalidate the Match Marks but argues that its activities do not infringe. In particular, it argues that the word “match” used by itself is not distinctive and that Match is wrongly seeking to monopolise a word (“match”), which is an ordinary descriptive word when used in relation to dating and introduction services.

The witnesses

9. Match relied on the evidence of Alexandre Lubot and of Jérôme Riviere. Mr Lubot joined the Match group in 2011 and is the CEO of EMEA and APAC division of Match Group Inc. of

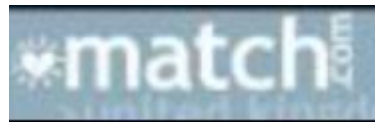
which the present Claimants are indirectly subsidiaries. His evidence concerned the nature of Match's business and its brand positioning. He also dealt with Muzmatch's business and its SEO strategies and with certain negotiations between Match and Muzmatch. Mr Riviere is the Brand and Consumer Vice President of the Second Claimant, having joined the Match group in 2012. His evidence dealt with how Match had used and built its brand, with its reputation and with its customers, including its Muslim customers.

10. Both Mr Lubot and Mr Riviere were cross examined and, in closing, Ms Bowhill commented that they had "*stuck to the party line that their brand was 'match'*". If this was a criticism of them, then I do not accept it. In my judgment, their evidence reflected their genuine belief regarding Match's brand and I find that they were both straightforward and honest witnesses doing their best to assist the court.
11. There were occasions when the evidence of Mr Lubot and Mr Riviere related to events occurring or to reports produced before they joined Match. This is to some extent unavoidable given the restrictions on the number of witnesses under the IPEC procedure. However, I am satisfied that they were able to assist the court based on their knowledge of Match's records.
12. The Defendants relied on the evidence of Mr Younas and of Mr Geoffrey Craig. Mr Younas gave extensive evidence regarding his foundation of Muzmatch and of its activities and also, supported by Mr Craig, about how the name "Muzmatch" came to be chosen in 2011. Mr Craig was another senior employee of Morgan Stanley and, save for his involvement in the choice of the Muzmatch name, has no interest or role in the Muzmatch business. Both Mr Younas and Mr Craig were cross examined and, in closing, Mr Austen (whilst not agreeing with aspects of their evidence) did not criticise them as witnesses. He was right not to do so. I find that they too were straightforward and honest witnesses doing their best to assist the court.
13. Based on that evidence and the documentary evidence, I will now deal with my findings of fact with regard to the parties' branding, reputation and activities.

Match's business and branding

14. Match provides online dating services. As Mr Riviere's evidence made clear, its services are principally aimed at people who are looking to find another person with whom they can build a long term relationship (including marriage). This was also apparent from research done for Match by the Isurus Agency in 2011 as well as from the more recent 2018 International Wave research. In this regard, Match differs from other service providers such as Plenty of Fish or, more recently, Tinder, which are more focussed on people who are seeking more casual relationships.
15. Because the aim is to connect people who do not know each other, users of dating services have to provide sensitive personal information about themselves and about what they are looking for in a partner. As a result, it is important that users feel that they can trust the platform that they are using (or platforms, because the evidence is that some users use more than one).
16. Match started providing its services in the United States in around 1995, trading via a website at www.match.com. On 1 April 1996, an application was filed to register "match.com" as a trade mark in the UK but Match did not, in fact, launch its website in the UK until 2001. I have been shown a copy of a page from that website from 2001. At the top of this page is the

logo shown below, featuring a beating heart image, the “Match” name in large, bold, lower case text, and the characters “.com” printed vertically in much smaller lower case text.



Below this logo, the website page has four circles labelled “My Home”, “Search”, “Match” and “Subscribe” which describe the nature of the on-line dating process. The page, therefore, shows how the word “Match” can be used distinctively (as part of the above logo identifying the provider of the services) and also descriptively (to describe a part of those services, the finding of a match or partner).

17. In 2003, Match’s UK logo was changed. The beating heart device was dropped. The “match” element retained its large, bold, lower case text but the “.com” element was brought onto the same horizontal plane in a lower case font of the same size but which (unlike the “match” element) was not emboldened.
18. In 2006, the logo was changed again to the form shown below with the “match.com” element being retained as in the 2003 version but with a figurative element added to the right, featuring a caricature of a male and a female (known as “Jack and Jill”) with a small pink love heart above.



19. In 2009, Match’s European operations, including those in the UK, were acquired by Meetic SAS. Shortly before this, in January 2009, Match created a Twitter handle at <https://twitter.com/matchuk>. This was followed, in December 2009, by a YouTube channel at <https://www.youtube.com/user/UKmatch> and, in March 2010, by a Facebook page at <https://www.facebook.com/matchuk/>. In March 2011, a further twitter handle was created at <https://twitter.com/matchUK>. In each of these addresses, the word “match” was used without the “.com” element. Consistently with this, I have seen a Facebook page for Match with a logo (shown below) which also omitted the “.com” element:



20. In 2010, Match started providing an alternative service in the UK, known as Match Affinity. Mr Austen asserted that this was, in effect, a sub-brand of Match although, as Ms Bowhill stated in closing, that was not part of Match’s pleaded case. However, I note, that Match Affinity used a logo similar to that depicted at paragraph 18 above but with the word “affinity” inserted between the word “match” and the word “.com” in a different colour, as shown below:



21. In July 2011, Match launched an app allowing customers to download software for internet-based dating to a mobile phone or device. In the US, from April 2014, the mobile app used the logo set out below and, in 2015, that logo was adopted for Match’s services provided via the app in the UK.



22. Finally, on 3 March 2015, Match applied to register the Match Device Mark (shown below) as a trade mark and in that same year adopted that mark as the logo for its website.



I have seen pages from Match’s UK website after it adopted the Match Device Mark and, in addition to using the above logo, they use the word “Match” as a brand (i.e. distinctively and by itself).³

23. The logos shown above are not, for the most part, the same as the Match Marks as registered and are not, therefore, the marks on which Match’s trade mark claims are based. Further, Match’s passing off claim as pleaded does not rely on any alleged misrepresentation made by Muzmatch with regard to these logos per se. However, what this history does show is that, throughout Match’s trading in the UK (including before April or May 2011 when Muzmatch started trading), the branding of Match’s services has generally involved some level of emphasis on the “match” element of the Match Marks. This emphasis has been by way of placement, size, colour, or emboldening of the word “match” or by its being the sole word used to identify Match as the source of the services.

Match’s reputation and goodwill

24. In considering the evidence in relation to Match’s reputation and goodwill, I will concentrate on the material relating to the period up to April or May 2011 as that was the date when, according to Match, Muzmatch’s infringing activities commenced.

The brand awareness and tracking reports

25. Shortly before Meetic SAS acquired Match’s European operations in 2009, it commissioned a company called TNS to carry out a Brand Monitoring Survey in relation to the Match brand in the UK. Thereafter, brand awareness or brand tracking reports were obtained annually, from TNS until July 2012 and thereafter from a company called IPSOS.
26. These reports evidence the “top of mind” awareness, spontaneous awareness and aided awareness of the Match brand at the relevant time on the basis of the responses provided by a

³ e.g. “1.6 million people in the UK met their partner on Match” or “Hi, I’m your Match coach. How can I help you”

sample group of some 1000-2000 people split on the bases of gender, race, age, revenue, profession and other demographics. As Mr Riviere explained:

- a. Top of mind (“TOM”) awareness is where a brand is the first brand mentioned by members of the sample group when they are asked to name a brand spontaneously and without being given a list of brands as a prompt. This, Mr Riviere explained, is an important metric as consumers tend to act on the basis of their TOM awareness when deciding where to look for goods or services;
- b. Spontaneous awareness is where a brand is one of those mentioned when members of the sample group are asked to name a brand spontaneously and without any list; and
- c. Aided awareness is where a brand is recognised by members of the sample group from a list of brands which they are shown.

27. TNS report 2009 – in this report, TNS stated that Match.com had a TOM awareness score of 28%, a spontaneous awareness score of 37% and a prompted awareness score of 65%. The report noted that the equivalent scores for Match’s nearest competitor were 8%, 15% and 35% and, on this basis, concluded that “*The leading position of Match.com is confirmed by its awareness score (know (sic) by 2/3 of singles) far ahead of its competitors...*”.
28. TNS report 2010 – in a more detailed (61 page) report in 2010, TNS stated that “*Match.com/Match*” had scores of 37% for TOM awareness, 48% for spontaneous awareness and 74% for aided awareness. Even without the figures for Match Affinity (a sub-brand set up by Match in 2010, which itself scored 15% for aided awareness), Match’s figures were substantially higher than those of its nearest competitor, eHarmony, which had scores of, respectively, 10%, 24% and 48%. On this basis, TNS concluded that “*Match is, by far, leading the market in terms of awareness...*” and it paid tribute (at p.38) to the effectiveness of “*Match’s campaigns*”, noting that the campaign media recalled by customers was “*overwhelmingly TV*”.
29. In contrast to the 2009 report, in the commentary to its 2010 report, TNS generally referred to “Match” as the name of the business. For example, the “Objectives” listed on p.5 were to (1) “*Follow the development of the Match’s brands and of its competitors*”; (2) “*Evaluate the performance of Match’s latest advertising campaigns*” and (3) “*measure the impact of Match’s recent Match Making brand launches...*”. Then, at pp.10-12, the 2010 report stated that its “Main Findings” were: “*Awareness: Match is the clear leader*”; “*Match has a large leadership in terms of awareness...*”; “*Match has one of the market’s strongest image...*”; “*Match users’ satisfaction is only at an average level*”; and “*Match is the brand with the strongest growth potential*”. Similarly, in its “Recommendations” (p.13), the 2010 report noted that: “*Match now has the market’s strongest level of awareness and needs to nourish this brand with content*”, and that “*As market leader, Match will be the first brand to benefit from this market growth*”. Whilst the report makes some use of the name “match.com”, this was confined to the various tables and to the footer of the title pages for the report’s sections, where it used the match.com logo (as shown in paragraph 18 above).
30. This tendency in some people to refer to the business as “Match” (as opposed to “match.com”) is also apparent from the fact that the customer awareness figures mentioned above were stated to be in relation to “*Match.com/Match*”. This was consistent with the evidence of Mr Riviere that the figure for TOM awareness which appears in the various

reports included consumers whose spontaneous response was simply “Match” as well as those whose response was “Match.com”.

31. TNS report 2011 - in its 2011 report, TNS reverted to referring to the business as “match.com”. It reported that “*Match.com is still leading the market*” (p.7) based on scores of 28% for TOM awareness, 43% for spontaneous awareness and 69% for aided awareness (again, not including the separate figures for Match Affinity) as against scores for eHarmony (Match’s closest competitor) of 7%, 18% and 53% respectively. At p.8, the 2011 report noted that “*Match.com’s awareness most comes from its TV ads*” and that the awareness of Match Affinity was also “*driven above all by TV*”, although internet ads also played a part.
32. TNS report 2012 – in contrast to the 2011 report, the much more extensive commentary of TNS’ report of July 2012 contained many references to “Match” as the business name. For example, it concluded (at p.10) that “*Match clearly leads the singles market in terms of awareness*” and (at p.19) that “*Match is still dominating the market, with the highest (and increasing) top of mind*”. These conclusions were based on scores for match.com of 31% for TOM awareness, 44% for spontaneous awareness and 70% for aided awareness (not including Match Affinity’s scores), with eHarmony scoring 8%, 22% and 58%.
33. Later IPSOS reports - given that Muzmatch started operating in around April to May 2011, the later reports (produced by IPSOS) are of less significance to the issues in this case although they continued to show that there was a very high level of brand awareness and TOM awareness of the Match brand which, after 2015, also included the Match Device Mark.
34. As in most of the earlier reports, IPSOS’ July 2013 report used “Match.com” and “Match” almost interchangeably when referring to the business, (see especially at p.86) as did IPSOS’ January 2015 report. By contrast, its 2014 report tended to refer simply to “Match”. In its 2016 and subsequent Reports, IPSOS displayed the Match Device Mark or the device with an “M” and a heart (as shown in paragraph 21 above) but in its commentary referred to the business simply as “Match”.
35. Summaries of the brand awareness figures - in his evidence, Mr Riviere provided the following summaries of the brand awareness figures provided by these reports in respect of the Match brand. These figures, and particularly the TOM awareness figures, serve to emphasise how well known the Match brand was in the market at the relevant times and, in my judgment, justify Mr Riviere’s comment that, in 2012, Match dominated the market.

Match.com/Match

	2009	2010	2011	2012	2013	2014	2015	2016	2017	2018
Aided awareness (%)	65	74	69	70	85 ⁴	87	83	77	89	89
Top of mind awareness (%)	28	27	28	31	42	47	38	36	41	33

⁴ Mr Riviere explained (and I accept) that the jump in the awareness figures between 2012 and 2013 was due to the different methodology used by IPSOS whereby respondents who indicated that they were certain that they would not use on-line dating were removed from the sample.

Spontaneous awareness (%)	37	48	43	44	65	71	60	64	67	61
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How this level of awareness was achieved

36. Mr Riviere gave evidence as to how Match had achieved this level of awareness with the public. He referred to its investment in TV advertising, outdoor posters, radio advertisements, inserts for print magazines, PR, social media and digital advertising. Insofar as he referred to events or matters from the time before he joined Match in April 2012, he asserted (and I accept) that what he says is consistent with his knowledge of the Match business and its documents and, given the evidential constraints inherent in this being a 2 day IPEC trial, I can see no reason to doubt the accuracy of his evidence in this regard.
37. Mr Riviere’s evidence, which I accept, was that in 2010, spending on TV advertising for Match in the UK was an estimated £4,936,000 (28% of the total spend in the whole dating category and not including the further £4,779,000 spent on Match Affinity). In 2011, the TV advertising spend for Match.com alone was £6,759,000 (31%) (again, not including the £2,844,000 spent in respect of Match Affinity). In 2012 it was £8,551,000 (52%). The sums, whilst estimates, suggest that Match funded extensive advertising and I do not accept Ms Bowhill’s comment that such evidence was meaningless. Indeed, as mentioned above, the TNS reports from 2010 and 2011 both paid tribute to the success of Match’s advertising, and in particular to its TV advertising, in creating awareness of the Match brand.
38. Mr Riviere listed 58 different television advertisements run by Match between 2009 and 2020, including 10 that were aired before the launch of Muzmatch in April or May 2011. These advertisements would have had multiple views as they were aired on 240 or so digital and analogue television channels (including many that were accessible in the UK). They were also uploaded onto Match’s YouTube channel. I have been provided with copies of 26 of these advertisements. In 9 of them (including one called “Laces” from 2010 and others from 2012 to 2014) the voiceover (including those of purported customers) refers to “Match” as the source of the relevant dating services.⁵ The advertisements also used on-screen text to direct viewers to the “match.com” or “matchaffinity.com” websites for more details. Ms Bowhill commented that there was no evidence from those whose voices were used in the advertisements nor as to the circumstances in which these words came to be used. However, I see no reason to doubt that the words were those of actual users and, even if this were not the case, these advertisements still show how Match was choosing to project its brand to the public (as “Match” as well as “match.com”). Nor do I accept Ms Bowhill’s criticism that this is akin to survey/witness evidence for which no permission was given. None of this material was produced for the purposes of litigation. Instead, it was produced precisely in order to promote Match’s brand to the public and, accordingly, seems to me to be of significance.
39. Match also promoted its business via social media. As I have mentioned above, between January 2009 and March 2011, it created two Twitter handles. I do not have figures for

⁵ The 2010 advertisement was for Match Affinity and included the words “If you’re looking to start a lasting relationship, our free affinity test can help you find someone on your wave length. So take your first step now at Matchaffinity.com a different kind of relationship service from Match”. The other 8 (post 2011) advertisements were part of the so-called “Real Members” TV campaign and featured real users of Match telling their own dating story in their own words and referring to the Claimants as “Match”.

Match's followers on Twitter as at 2011 (although Mr Riviere's evidence is that they had 103,000 and 14,000 followers respectively as at October 2021). However, Match's YouTube channel which was created in December 2009 had had over 500,000 views as at 30 January 2012 (and over 6 million views by October 2021) whilst Match's Facebook page at www.facebook.com/matchuk/ created in March 2010 had had over 6,000 page likes as at November 2011 (and 203,000 by October 2021). I note that the internet addresses for these forms of social media used the word "match" or "matchuk" or "UKmatch" rather than "match.com".

40. Finally, as set out in Match's Amended Particulars of Claim, there were a significant number of advertisements in printed and online media which used the Match Marks. These included advertisements in the Metro on 27 June 2010 and in the Daily Mail and the Mail Online on 6 October 2010, each generating a very significant number of "opportunities to see" for the public.
41. The success of this advertising is apparent not only from the brand awareness figures referred to above but also from the fact that there were 342,086 UK visitors to the Match website in May 2011 alone and from the fact that, in the UK, Match had around 119,000 subscribers and sales in excess of €25m in 2010 and around 129,00 subscribers and sales of more than €29m in 2011. Finally, Mr Riviere's evidence was that, according to YouGov research from 2011, Match was the dating brand that was the source of most relationships and marriages.

The activities of Muzmatch

A dating service targeted at Muslims

42. As mentioned above, Muzmatch was founded by Mr Younas in around April or May 2011. Mr Younas' evidence was (and I accept) that he was a practising Muslim and wanted to provide a service that would allow Muslims to find a marriage partner in a way that was compatible with Islamic values. His concern was that for many Muslims, the only way to meet a marriage partner was through family contacts or intermediaries, a process which many Muslims found awkward and outdated. Whilst websites were being used by and were becoming more popular with some Muslims, many other Muslims disapproved of them, and in particular, of the more "mainstream Western" websites because they were perceived to allow or promote casual relationships rather than focussing on finding a marriage partner. Meanwhile, the only website then specifically targeted at the Muslim market was, in Mr Younas' view, of very poor quality.
43. As a result of this, Mr Younas decided to set up Muzmatch to provide Muslims with the opportunity to find marriage partners using the more modern means of a website but one which specifically sought to be compatible with Islamic values. To this end, he created a pay as you go⁶ website with features designed to weed out users who were not serious in their search for a Muslim marriage partner. This was reflected in that website's homepage from 2011 which stated that the Muzmatch website:

"... is the UK's leading website helping you to find your perfect Muslim marriage partner! Giving you unique privacy and openness with no monthly membership fees, we

⁶ The website was free to access but users had to pay a small fee to unblur the photographs of potential partners or to be able to contact a potential partner.

are the only place to go to find other serious like-minded single Muslims looking for marriage”.

44. Similarly, the registration page for the website in 2011 referred to Muzmatch as the “*Muslim Marriage Site for Single Muslims*” and stated that:

“...we aim to do things differently – with a big emphasis on the quality of Muslim singles, rather than quantity. We want to make it simply and easy for you to search for your ideal Muslim Marriage Partner Inshallah, whilst ensuring that our site deters those Muslims who are not serious and genuine in seeking Islamic marriage...”.

45. In about March 2015, having realised that most traffic on Muzmatch’s website was via mobile devices, Mr Younas launched the Muzmatch app. Thereafter the website was retained to promote Muzmatch’s services but visitors to it were directed to the app. Until around March 2017, the app was free to use but gradually paid-for features were introduced including, in May 2017, Muzmatch Gold, a premium monthly subscription service. However, Muzmatch’s focus continued to be to provide a service, targeted at Muslims, to find a marriage partner and its app is described on the Apple App Store as “*Muzmatch: Single Muslim dating; Halal, Arab & Muslim marriage*” and on the Google App Store as “*Muzmatch: Muslim & Arab Singles, Marriage & Dating*”. Similarly, upon opening the Muzmatch App, users encounter a screen stating: “*Where single Muslims meet*”.

46. In cross examining Mr Younas, Mr Austen suggested that Muzmatch might seek or might already be seeking to attract non-Muslim customers and so broadening its target audience. In view of what I have said above, I cannot see any basis for this suggestion. Moreover, in order to ensure that Muzmatch’s services are consistent with Islamic values, the Muzmatch app has the following features:

- a. All users are required to confirm their ethnicity, sect, religiosity, frequency of praying,⁷ marital status and marital plans. Such user profiles have to be approved, making it difficult for a non-Muslim to use Muzmatch without submitting false information. Users can set their own preferences and filters regarding the profiles they are sent of potential partners. Only where there is a mutual like between users, can those users proceed to “chat” via the app.
- b. A person cannot use Muzmatch without agreeing to abide by an Islamic Oath of etiquette. This includes an agreement to abide by Muzmatch’s Behaviour Guidelines, supported by its Safety Guidance. This was designed to “*keep things halal*” (i.e. in compliance with Islamic law).
- c. Technical measures are used to filter out inappropriate content and conversations are monitored to ensure they are consistent with the Behaviour Guidelines. Users are also encouraged to report unacceptable content either through the in-app reporting function or by contacting Muzmatch’s Customer Support Team by email. Such reports are investigated and Mr Younas’ evidence was that, in September 2021 alone, some 3,915 reports had been filed, resulting in 570 accounts being blocked.

⁷ Users have to state whether they are “very practising”, “moderately practising”, “practising” or “non-practising” Muslims and whether they “never”, “sometimes”, “usually” or “always” pray.

- d. A user can opt to be completely anonymous and private, using a nickname and/or to have private or blurred photos. A user can also opt to involve a chaperone (wali) or a family member in their search. Where a chaperone is used, the user's profile is marked accordingly and the chaperone can monitor the user's conversations and interactions with other users.











47. Notwithstanding these features, it is clear from documents included in Muzmatch's disclosure that there is still a fairly substantial number of Muslims to whom Muzmatch's services are not halal, but are rather "haram" (forbidden).

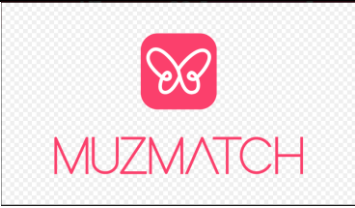
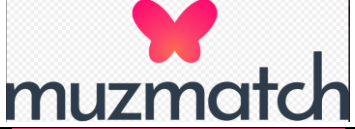

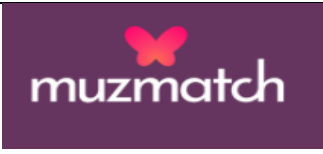




The choice of the "muzmatch" name

48. Mr Younas and Mr Craig gave evidence as to how the name Muzmatch came to be chosen. They explained that, in the course of office banter between a group of colleagues at Morgan Stanley, various names had been suggested for dating services for different faith communities (including names such as IdoHindu, iJew, SeekSikh). In the course of this, someone (probably Mr Craig, but possibly Mr Younas himself) suggested "muzmatch" would be an appropriate name for the matchmaking services that Mr Younas was thinking of providing to the Muslim community.
49. Mr Craig stated that he didn't recall knowing at the time of Match as he was recently married and dating services were "*not on my radar*". Mr Craig was stated that the group from Morgan Stanley had not discussed other existing dating sites on the market and had not carried out any research into names. In cross examination, Mr Austen sought to suggest that Mr Craig must have been aware of Match. However, I see no reason to doubt Mr Craig's evidence. Mr Younas' evidence was that he had heard of Match (as well as various other dating websites such as eHarmony, JDate, Shaadi, Jeevansathi, Bharat Matrimony and Single Muslim) and he was aware of it as a mainstream dating website. He said, however, that he was not thinking about Match when he chose "muzmatch" because, in his mind, the word "match" in this context described the service being provided (matchmaking) and linking it to the letters "muz" showed that those services were being directed at Muslims. Mr Younas liked the name because it carried a clear and simple message (a service that helped users find a Muslim match). In effect, the name "*says on the tin what the service is for*" and was catchy and memorable.
50. Despite that evidence, the pages that I have seen from Muzmatch's website (certainly those from 2011), do not use the word "match" (or even variants such as "matchmaking") descriptively but instead refer to the service as being the means to find "*your perfect Muslim partner*". The business card used by Muzmatch to promote its services in that period had that same statement on its front whilst, on its reverse, were the words "*Halal alternative to find your spouse*". That continued to be how Muzmatch described its services throughout, although I note that Muzmatch's app, launched in March 2015, does feature a page which states "*it's a muzmatch*" when notifying a user that its search has found a potential partner.
51. Mr Younas also gave evidence that he had no intention of suggesting any connection between Muzmatch and Match and, indeed, that any such suggestion would have been damaging given the taboo in the Muslim community surrounding the use of mainstream dating websites. I will return to this later in this judgment

How the name “muzmatch” was used

52. Having chosen the name Muzmatch, Mr Younas registered “muzmatch.com” as a domain in April 2011. This was followed in May 2011 by the launch of Muzmatch’s website followed, as mentioned above, by the launch of its app in March 2015.
53. In his evidence, Mr Younas dealt in detail with the evolution of the Muzmatch branding, tracing through the various signs it had used and the creative processes and thinking involved in them. Based on his evidence, Ms Bowhill’s Skeleton provided the following list of the logos used by Muzmatch and their dates of use:

Logo No.	Sign used by the Defendants	Date of use
1		April 2011 to February 2015
2		April 2011 to January 2015
3		April 2011 to February 2016
4		Limited use on social media and as part of testing the Muzmatch App from 9 February 2015 to 5 March 2015
5		March 2015 to February 2016
6		March 2015 to February 2016
7		2016 – January 2020
8		
9		February 2016 to August 2016
10		2016-January 2020

11		August 2016 to January 2020
12		January 2020 to present
13		
14		
15		
16		January 2020 to present
17		
18		January 2020 to present

54. I should make two points about this list;

- a. First, it omits some variants of the logo used by Muzmatch, such as the variants that appeared on the front and the back of the business cards mentioned above. These were the same as logo 2 above but without the letters “BETA” and, on the front, with the letters “.com” added in white text.
- b. Secondly, Match does not make any claim as regards the logos which do not include the word “muzmatch”. There is, therefore, no claim as regards logos 4, 5, 9, 15 and 16 shown above.

55. The evidence shows that whilst operating from its website, Muzmatch’s business grew such that, by February 2015, it had 8,122 users in the UK and there had been some 1.5m page views of pages from its website. During this period, the Muzmatch name or logo was used not only on Muzmatch’s website but also in its marketing and promotional materials – being predominantly organic social media content, word of mouth, leaflets and, in particular, on the business card mentioned above which Mr Younas says was handed out at mosques and at Muslim events.

56. After the switch to the app in March 2015, Muzmatch appears to have grown more rapidly. Whilst it had had 7,824 signups in the UK in March 2016, generating some 25.8m online swipes, by September 2021, those figures had grown to 666,069 signups and an average of 71m swipes a month. In this period, the name was used not only on the app itself but also in organic and (largely after 2017) in paid-for social media content promoting the app. These included two advertisements featuring a play on the words from well-known songs by Lionel Richie “*Halal! Is it me you’re looking for*” (which reached over 100,000 people in the UK in February 2018) and Adele “*Halal from the other side!*”. The same advertisements also appeared on the London Underground and on public buses in London and Manchester. Mr Younas also gave evidence of television advertisements since 2018 on the Islam Channel and Sky TV and, from there, on Muzmatch’s YouTube page.

Muzmatch’s Search Engine Optimisation (SEO) activities

57. An important part of the case related to Muzmatch’s SEO activities in the period from January 2012 to January 2020. Mr Younas’ evidence was that, in around January 2012, he put in place an SEO strategy copied from that used by the SingleMuslim.com dating website. He explained that the strategy involved making a list of some 5000 words or word combinations (referred to as “keywords”) that related in some way to Muslim marriage or Muslim matchmaking. A page, known as a landing page, was then created on the Muzmatch website for each of these keywords. These landing pages would be indexed by search engines, such as Google, so that a user who carried out a search using one of those keywords would be presented with search results which included a link which, if clicked on, took the user to the relevant landing page on Muzmatch’s website. Muzmatch accepts that the aim of its SEO strategy was to promote and increase visits to its website.
58. Mr Younas’ evidence was that the list of keywords that he adopted in January 2012 was copied from the SingleMuslim.com list (albeit that he scanned through it to ensure that there was nothing that was offensive or an obvious outlier). Although the word “match” was not of itself a keyword, there were some 132 keywords that contained that word, including, for example, “match-muslim”, “muslimmatch”, “muslim-match” and “UK-muslim-match” with, sometimes, a country reference (e.g. Afghanistan or Albania, etc.). However, Mr Younas’ evidence (which I accept) was that in creating his list of keywords, he did not think about Match.com or the Match Group. He pointed out that if he had wished to mislead people or to suggest that Muzmatch was a Muslim version of the Match brand, he would have included “match.com” in the list, but he had not done that. I will return to this point later, but it is noteworthy that the list of keywords does include keywords such as Singlemuslim, Shaadi, SimplyMarry, Salaam Love and Asian Flames, which are the names of other dating or introduction websites.
59. In around March 2015, Mr Younas revisited the list of keywords to include keywords more related to mobile apps such as “muslim-app” and “muslim-mobile”. It does not appear that Mr Younas added any more keywords containing the word “match”. However, he did add “muslim-tinder”, “tinder” and “halal-tinder” as keywords. The word “tinder” was clearly not a word relating to or describing Muslim marriage or Muslim matchmaking. Indeed, as set out above, Muzmatch now accepts the use of such keywords infringed Match’s trade marks in the Tinder Marks.

60. The following is an example of a landing page for a search using the keyword “UK Muslim Match”. As can be seen, that search term is set out prominently at the top of the landing page and is then repeated three times in the subsequent text. Although this particular page was dated 4 October 2018, it is probable that it would have been in substantially the same form in 2012. Certainly, Mr Younas does not suggest that he had altered the wording of the landing pages.



61. It is not clear exactly how many users, having carried out a search on the keywords in issue, would have clicked through to these landing pages. As Mr Austen pointed out, this data was available to Muzmatch (but not to Match) using the Google Analytics tool but it was not produced. In the absence of Google Analytics data, Match relied on a report from its own SEO agency (Clustaar) for the period starting in January 2017 and ending 25 September 2021. This report contained data obtained by use of the SEMRUSH tool. It shows the actual position (or ranking) that various links to Muzmatch’s website achieved when a search was carried out using the keywords in issue. Then, on the basis of that ranking, the report provided estimates of the volume of searches that would have been carried out in order to achieve that ranking and of how many of those searches would have resulted in the searcher clicking through to the relevant landing page on Muzmatch’s website.
62. The report concluded that there had been some 32,770 searches carried out in respect of the URLs “muzmatch.com/”, “muzmatch.com/single-muslim-marriage-uk-muslim-match” and “muzmatch.com/single-muslim-marriage-muslim-match-making” and that these led to a total of 11,725 click throughs to the relevant landing pages on Muzmatch’s website.
63. Whilst these figures are estimates, they are based on the actual ranking of the links to the Muzmatch website as they appeared in the search results. In my judgment, they show that there were a substantial number of searches on keywords that included the word “match” and that a reasonably substantial number of users clicked through from that link to the landing pages on the Muzmatch website. Given that achieving such click throughs was the entire purpose of the SEO strategy that Muzmatch operated for almost 10 years and given the absence of any evidence from Muzmatch on this issue, I see no reason not to accept these figures.

Settlement discussions and Match’s acquisition of Harmonica

64. It appears that Match learned of Muzmatch’s activities in around January 2016. On 26 January 2016, its representatives wrote to Muzmatch asserting that those activities infringed the 1996 Match.com Mark and the Match Device Mark (amongst other marks) and amounted

to passing off. This led to without prejudice settlement discussions where the parties sought to agree terms on which, subject to an agreement on branding style, Muzmatch could continue to use the Muzmatch name. However, these discussions broke down in late 2016. Subsequently, from September 2017, the parties were involved in negotiations as to whether Match could buy Muzmatch. In the course of these negotiations, Match made four separate offers, all of which were rejected by Mr Younas and these negotiations ended in January 2019.

65. As I understand it, Muzmatch's case is not that these events gave rise to any estoppel but rather that they showed a degree of tolerance of its activities and that this is relevant to explaining its state of mind in continuing to use the Muzmatch name. I will return to this later. However, whatever the position during those discussions, by 2018, Match's objection to Muzmatch's use of the Muzmatch name was clear from its oppositions to applications made by Muzmatch to register that name as an EU and a UK trade mark. Those oppositions, based on the grounds that use of that name would give rise to a likelihood of confusion and would take unfair advantage of the reputation of the Match Marks, succeeded in the EU Intellectual Property Office's Opposition Division on 19 January 2018 and in its Board of Appeal on 25 September 2018 and also in the UK Intellectual Property Office on 12 February 2020.

66. On 7 August 2019, Match made a public announcement that it had:

"... made an acquisition of Cairo-based Harmonica, an app which approaches mobile matchmaking with respect for local traditions and cultures. In total, a team of 12 full-time employees is joining Match Group to help it serve the Muslim demographic globally"

67. The announcement went on to refer to Match's hopes for "*international growth and expansion ... mostly across Asia and the Middle East*" which included "*many countries that are predominantly Muslim*" and noted that Harmonica would remain headquartered in Cairo. Mr Younas argues that the fact that Match sought to buy Muzmatch and then acquired Harmonica shows that Match did not cater for the Muslim community. He also points out that when Match re-branded the Harmonica business, it chose not to use the "Match" name, but instead called it "Hawaya". I will return to these points later in this judgment. In April 2020 the Hawaya app was launched in the UK and is described in the Apple App Store as a "*Muslim Marriage App*". The action against Muzmatch was commenced by Claim Form issued on 30 July 2020.

The trade mark claims

68. Match's claim is that Muzmatch has used signs ("the Muzmatch Signs") which infringe the Match Marks under s.10(2)(b) and/or s.10(3) of the Trade Marks Act 1994 and also, in the case of the two European trade marks (the 1996 Match.com Mark and the 2017 Match.com Mark) for the period before the UK's withdrawal from the EU, infringe those Marks under Articles 9(2)(b) and/or 9(2)(c) of the EU Trade Mark Regulation.

69. The Muzmatch Signs for these purposes are those of the logos shown in paragraph 53 above that include "match" (as part of the word Muzmatch) and the keywords featuring the word "match" that were used by Muzmatch as part of its SEO activities as set out in paragraph 58 above.

70. Regarding the Match Marks, only one of these predated the time in April or May 2011 when Muzmatch started trading. Notwithstanding this, there was no counterclaim for invalidity of the two later Match Marks based on Muzmatch's earlier use.

Sections 10(2) and 10(3)/Article 9(2)(b) and 9(2)(c)

71. Section 10(2) and (3) of the Trade Marks Act 1994 and arts.9(2)(b) and (c) of the EU Trade Mark Regulation are in substantially the same form. So far as material, s.10(2) and (3) provide that:

10 Infringement of registered trade mark.

...

- (2) *A person infringes a registered trade mark if he uses in the course of trade a sign where because—*

...

- (b) *the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,*

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

- (3) *A person infringes a registered trade mark if he uses in the course of trade, in relation to goods ... a sign which—*

- (a) *is identical with or similar to the trade mark ...*

...

where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

The average consumer

72. The test for infringement under both s.10(2) and s.10(3) is conducted through the eyes of a hypothetical person referred to as the average consumer.
73. The average consumer is a consumer of the goods or services in question. In this case, because the Match Marks are registered for on-line dating and introductions services generally (or information or consultancy services in relation thereto), the average consumer would be a member of the general public who is or may be interested in looking for a partner by means of an on-line dating or introduction service.
74. Where the parties differ is as regards the significance of Ms Bowhill's argument that "*practising Muslims are not the 'typical user' of dating services*". It was not entirely clear to me whether the suggestion here was that the average consumer of Match's services could not be a practising Muslim or whether that was simply a factor to bear in mind when assessing issues such as that of the likelihood of confusion. Either way, for the reasons set out below, I do not accept this argument. Nor do I accept Ms Bowhill's submission in closing that "*the*

market for Muslim dating is a discrete and distinct one”, if by that she meant that no Muslim would use Match’s services.

75. In the first place, I do not think that it is possible to put all practising Muslims into a single category and to say that they are “*not the typical user of dating services*”. To do so assumes a uniformity of views that does not exist. Mr Younas himself gave evidence regarding the huge diversity of views within Islam and this is reflected in the fact that Muzmatch itself asks users whether they are “very practising”, “moderately practising”, “practising” or “non-practising” Muslims and whether they “never”, “sometimes”, “usually” or “always” pray. Whilst it may be that some practising Muslims will not use dating services (indeed, as mentioned above, there seems to be a reasonably substantial number of Muslims who object even to Muzmatch’s Islamic-focused dating services on the basis that it is “haram”), other practising Muslims (as well as some non-practising Muslims) will use them. Further, whilst it is correct that (before its 2020 launch of Hawaya) Match had not specifically targeted the Muslim community, Mr Riviere’s evidence (which I accept) was that, in 2018 and 2019, Match had a reasonably large number of new registrants who identified themselves as Muslims when registering for its services. Although Match did not have records for the earlier years, I can see no reason why the position would have been any different then. Secondly, whilst it is true that Match’s services were not specifically targeted at Muslims, the fact is that they were not specifically targeted at *any* particular class or type of person (other than someone who is looking for a partner). The targeting of its services could reach (and in Mr Younas’ case clearly did reach) Muslims as well as non-Muslims. Accordingly, I find that the average consumer might be of any race, creed, age, sex or background.
76. As to the characteristics of the average consumer, it was common ground that the average consumer is someone who is reasonably well informed, reasonably circumspect and observant, albeit someone who rarely has the chance to make a direct comparison between the marks in issue and so has to run the risk of imperfect recollection. Ms Bowhill submitted (and I accept) that the level of attention paid by the average consumer of dating services is likely to be higher than for normal consumer items, not least because users of dating services have to provide a significant amount of personal (even highly personal) information and, as Mr Lubot accepted, need to trust the platform to which they are providing that information.

The relevant date

77. The relevant date for assessing whether there has been an infringement under s.10(2)(b) or s.10(3) is the date when the use of the sign complained of commenced – unless the mark was registered after that use began, in which case the relevant date would be the date of filing of the application for registration.
78. It appeared to be common ground that the relevant dates here were:
- a. March or April 2011 for alleged infringements of the 1996 Match.com Mark by the use of the “muzmatch” name. This is because that was the date when use of that name started and, although Muzmatch has since used a variety of different logos featuring that name, Match did not suggest that any of them was so different as to justify a different (and later) relevant date;

- b. 13 January 2017 for alleged infringements of the 2017 Match.com Mark (that being the date on which the application to register that mark was filed);
- c. 3 March 2015 for alleged infringements of the Match Device Mark (that being the date on which the application to register that mark was filed); and
- d. January 2012 for alleged infringements of the 1996 Match.com Mark by Muzmatch's uses of the word "match" in its SEO keywords.

The law relating to infringements under s.10(2)

79. The conditions for infringement under s.10(2) were summarised by Kitchin LJ in *Comic Enterprises v Twentieth Century Fox Film Corp* [2016] EWCA Civ 41 at [28] where he said in relation to Article 5(1)(b) of the Directive (the provision implemented in the UK by s.10(2)):

“A proprietor of a registered trade mark alleging infringement under Article 5(1)(b) of the Directive must satisfy six conditions, namely (i) there must be use of a sign by a third party within the relevant territory; (ii) the use must be in the course of trade; (iii) it must be without the consent of the proprietor; (iv) it must be of a sign which is identical with or similar to the trade mark; (v) it must be in relation to goods or services which are identical with or similar to those for which the trade mark is registered; and (vi) it must give rise to a likelihood of confusion.”

80. Further guidance with regard to the approach to assessing infringement under s.10(2) was provided by Kitchin LJ in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24 at [52] as follows:

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Was there an infringement under s.10(2)

81. With regard to Match’s claim under s.10(2), there are no issues as regards conditions (i), (ii), and (iii) referred to in paragraph 79 above. The Muzmatch Signs were clearly used within the relevant territory, in the course of trade and without Match’s consent.

Condition (v) – identical or similar goods/services

82. As regards condition (v), as I understand Muzmatch’s pleaded case, it admits (at paragraph 44 of its Defence) that its services were identical to those for which the Match Marks were registered.⁸ However, in its submissions at trial, it asserted that there is only a low degree of similarity between its services and the class 42 services for which the 1996 Match.com Mark is registered. This was not explored or explained in any detail at trial and given Muzmatch’s pleading, I do not think that it is an argument that is open to Muzmatch. But, in any event, I do not think that it would assist Muzmatch greatly. The class 42 services in question were “*information and consultancy services in the nature and field of on-line dating and introduction services*”. Even if Muzmatch does not provide such services, the on-line dating and introduction services that it does provide seem to me to be clearly complementary in nature and, in my judgment, there is a reasonably high level of similarity in these services.

Condition (iv) –similarity of the marks/signs

83. Condition (iv) requires a comparison to be made between Muzmatch’s Signs (i.e. the 13 or so logos that include the word “muzmatch” and the various SEO keywords used by Muzmatch that include the word “match”⁹) and the Match Marks as registered (as set out below).

MATCH.COM
match

⁸ The Defence does not refer to the class 9 goods for which the 2017 Match.com Mark is registered, but as these relate to the app software, I assume that it is accepted that these are identical goods.

⁹ i.e. the keywords such as “match-muslim”, “UK-muslim-match” etc.

84. At paragraph 44(e) of its Defence, Muzmatch denies that there is any similarity between the Muzmatch Signs and the Match Marks. In my judgment, that is clearly not correct. These Signs and these Marks all include the word “match” and so there is clearly *some* similarity and, to that extent, condition (iv) is satisfied.
85. On this basis, the real issue (and this is how I understood Ms Bowhill to put her case) was not that there was no similarity but, rather, as to the extent of that similarity and the impact that that might have on the likelihood of confusion (i.e. condition (vi)). To this end, Ms Bowhill referred to various differences between the Match Marks and the Muzmatch Signs based on one or more of the following factors - (a) the inclusion of “muz” or “Muslim” or “UK” or “United Kingdom” in the Signs, (b) the presence of “.com” in two of the Match Marks, (c) differences in the font or case (upper or lower) used, (d) the heart device used in Muzmatch’s signs until 2016 and (e) the butterfly device added by Muzmatch to its logos in 2016.
86. In dealing with condition (iv), neither party provided a detailed comparison of each of the many Muzmatch Signs in issue as against each of the Match Marks. Instead, they dealt with the issue in general terms. I will do the same and will comment in particular on the five factors referred to in paragraph 85 above.
- a. “*Muz*”/“*Muslim*”/UK – in my judgment, notwithstanding the addition of “muz” to Muzmatch’s logos or the addition of “muslim”, “UK” or “United Kingdom” to its keywords, the “match” element remains a clear and important area of visual similarity between the Signs and the Marks. Further, there is a clear oral similarity in that the average consumer is likely to emphasise the “match” part when enunciating the Match Marks and is likely to give the muz/muslim/UK element and the “match” element equal emphasis when enunciating the Muzmatch Signs (in effect reading them almost as separate words - “Muz Match” or “UK Muslim Match”). I also find that there is a clear conceptual similarity. The average consumer would perceive that the word “match” was being used as a brand, but would also see that it was a reference to the nature of the services (to find a match). Conceptually, the addition of “muz” or “muslim” or “UK” would be seen as merely restricting that same concept somewhat (to find a Muslim match in the UK).
 - b. “.com” – this was a feature of Match’s two Match.com Marks but not of Muzmatch’s Signs (with the exception of logo 1 and of the sign on the business card to which I have referred). However, this does not prevent a clear visual and aural similarity arising from the common use of the word “match”. Further, I do not think that any great conceptual difference arises from the presence or absence of the “.com” element. The average consumer, whilst taking note of this element, is likely to take it to be a reference to the fact that the services are provided online and, therefore, to focus more on the “match” element of the mark.
 - c. *Font/case* – there are some differences between the font and case used for Muzmatch’s Signs and those used for the Match Marks. However, none of the Signs or Marks is particularly heavily stylised and, bearing in mind the imperfect picture of the marks and signs that the average consumer has in his head, it seems to me that the average consumer is likely to focus more on the similarity in the word used than on the particular font or style in which it is written.

- d. *Heart device* – Match’s registered marks did not include the heart device until 2015 (when the Match Device mark was registered). By contrast, a simple heart device was a feature of Muzmatch’s logos from as early as 2011 but was dropped in 2016 and was replaced by the butterfly device. Such devices would have no effect at all when the marks are being referred to orally. Visually and conceptually, the average consumer would notice the presence of the heart. However, given the nature of the services (to find a partner), the very simple way in which the heart was depicted, and the role of imperfect recollection, I do not think that the presence of the heart (or its absence) would significantly affect the assessment of similarity that the average consumer would make based on the common use of the word “match”.
- e. *Butterfly device* – as mentioned above, the butterfly device was added to Muzmatch’s Signs in 2016. What I said above in relation to the heart device, seems to me to apply equally to this device.

87. For these reasons, I find that there is a medium level of similarity between the Match Marks and the Muzmatch Signs – albeit a similarity that is slightly greater in some cases than in others. For example, there is a slightly higher degree of similarity in the case of logo 2 (because the word “match” is emphasised by being in a different colour to that used for the “muz” element) and logos 7 and 8 (because they do not feature the heart or the butterfly device). It also seems to me that the Muzmatch Signs have a slightly higher level of similarity when compared with the Match Device Mark than with the two Match.com Marks.

Condition (vi) - the likelihood of confusion

88. Condition (vi) is the likelihood of confusion. Match’s case here is that Muzmatch’s Signs give rise to a likelihood of confusion because the use of the word “match” as part of the Muzmatch name and as part of some of its SEO keywords is likely to cause some members of the public to be confused into believing that Muzmatch’s services come from Match (as a sort of sub-brand of Match) or from an entity that was economically linked to Match.

Further guidance from the cases

89. In dealing with this issue in *Specsavers*, in addition to the guidance quoted at paragraph 80 above, Kitchin LJ noted, at [52(d)] and [87] respectively, that:
- a. The issue of the likelihood of confusion 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 a comparison solely on the basis of the dominant elements”; and
 - b. “In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer's mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.”

90. Given Ms Bowhill’s argument that “match” is descriptive rather than distinctive, it is also worth noting the comments of Mr Daniel Alexander Q.C., sitting as a Deputy High Court Judge, in *Planetart LLC v Photobox Ltd* [2020] EWHC 713 at [26]-[29]. *Planetart* concerned a claim that the claimant’s registered trade mark for “FreePrints” was infringed by the defendant’s use of the sign “PHOTOBOX FREE PRINTS”. Under the heading “The significance of commonality of descriptive signs”, Mr Alexander said:

“26 One aspect of the approach to determining whether there is a likelihood of confusion which is important to this case is the significance of the adoption of common descriptive elements. In *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159 at [83]–[84] the Court of Appeal said:

“...where you have something largely descriptive the average consumer will recognize that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another.”

See also *Elliott v LRC Products* (O/255/13 at [57]) where the Appointed Person, Daniel Alexander QC, observed that consumers are less likely to think that two descriptive marks denote businesses that are connected with one another because a credible and dominant alternative explanation exists for the similarity in marks which has nothing to do with their denotation of a common trade source, namely that the similarity is attributable to their descriptiveness.

27 The case law does not suggest that there are general rules as to how descriptiveness should be taken into account but it is clear that it should be done. The fact sensitivity of such is illustrated in a number of cases. For, example, one concerning registration of a figurative mark incorporating “VAPE & Co” for e-cigarettes which was opposed by the proprietor of a prior registration for a figurative mark including the words “The Vape Co” (*Nicoventures Holdings Ltd v The London Vape Company Ltd* [2017] EWHC 3393 (Ch)). Birss J said (see [31]–[36]):

“The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive ... it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.”

28 That approach drew on the analysis by Arnold J of the case law of the European courts in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) where he said at [44]:

“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion”.

29 These cases show that there is no hard rule that use of a descriptive term cannot lead to a finding that there is confusion but they also show that such a case is harder to establish. It also has the impact of somewhat downgrading the significance of conceptual similarity in the evaluation of the likelihood of confusion at least in so far as the mark is descriptive of the goods and services in question.”

91. As is clear from these comments, the fact that a claimant’s mark and a defendant’s sign share a common element that is descriptive may make it more difficult to conclude that there is a likelihood of confusion, but it does not make it impossible. Moreover, it seems to me that a finding of a likelihood of confusion may well be appropriate where the average consumer recognises that that common element, whilst capable of being used descriptively, is in fact being used distinctively as a badge of origin. The issue is highly fact sensitive and has to be assessed globally, taking into account all relevant factors, including the context in which the signs have been used.

The present case

92. In support of her argument that there was no likelihood of confusion, Ms Bowhill argued that the only similarity between Muzmatch’s signs and the Match Marks lies in the use of what she said was the “wholly descriptive” word “match” and she relied on the following three points of difference arising from the context of its use in this case, namely:

- a. That the Match Marks included additional elements not included in the Muzmatch Signs – i.e. the “.COM” element that was part of the Match.com Marks and the heart device that was part of the Match Device Mark;
- b. Conversely, that the Muzmatch Signs had additional elements that were not included in the Match Marks – i.e. “MUZ”, “muslim”, “UK”, “United Kingdom” and the butterfly device; and
- c. That there were “distinct differences between the services provided by the parties as a result of the targeting of either the Muslim community or the general public”.

93. I have already rejected point (c) above (see paragraphs 74-75 above) and, for the following reasons, I have concluded that notwithstanding the other differences, there is a likelihood of confusion arising in respect of the use of the word “match” in the Muzmatch Signs:

- a. I am fully satisfied on the basis of the evidence summarised in paragraphs 24-41 above that, by 2011, the 1996 Match.com Mark had acquired a very substantial degree of distinctiveness and reputation as a brand, a badge of origin for Match’s online dating services. This is clear from the various branding and tracking reports. In my judgment, that distinctiveness and reputation also attached to the 2017 Match.com Mark from its filing date.

- b. The average consumer would have seen the word “match” as the dominant element in each of the Match Marks in the sense referred to by Kitchin LJ in *Specsavers* (see paragraph 80(e) and (f) above) and, whilst the average consumer would be aware of the “.com” element and, later, of the heart device as part of those Marks, they would not be particularly influenced by either of them (see paragraphs 86(b) and (d) above). Consistently with this, the evidence shows that, by April or May 2011, many people were referring to the business simply as “Match”, as can be seen from the branding and tracking reports, the responses of some people to the TOM awareness question posed for those reports and some of Match’s advertisements to which I have referred. Indeed, by 2011 Match was itself emphasising the “Match” element of its Mark (see paragraph 23 above). Another example of this can be seen on the page from the Match.com website dated 26 May 2010 which stated: “*Are you looking for matchaffinity.com? A different kind of relationship service from match*”. Whilst this is referring to Match Affinity, it is a page from the main Match.com website referring to another service available from Match and, more importantly for present purposes, referring to itself simply as “match”.
- c. In these circumstances, the average consumer, certainly by early 2011, would have been well aware that the word “match” in the context of on line dating services was capable of being used and was being used both descriptively and distinctively (the example I put to Mr Austen in argument being “*I met my perfect match on Match*”). The average consumer would be perfectly able to distinguish between such uses and would have been in no doubt that, in the context of the Match.com Marks, it was being used in a distinctive sense rather than descriptively.
- d. Muzmatch produced evidence of third parties using the word “match” in relation to dating services. In many of these instances, the word was plainly being used descriptively. In others, it was part of the name of the service provider but, with two exceptions, there is no evidence that these service providers were trading in 2011. The exceptions were “Senior Match” and “Millionaire Match”. The 2021 Google Play descriptions of the apps for these entities quote prices in pounds sterling and state that they started trading before 2011. However, this is all that I know about them. I know nothing about the scale of their operations and, in particular, whether they were operating in the UK under those names as at 2011 (I note that the “developer” was, in both cases, said to be in California). Mr Lubot’s evidence was that Match had been active in opposing or obtaining limitations of around 180 third party applications for trade marks that included the word “match” but none pre-dated 2011 and only 7 were from 2011 (Match being successful in each of these cases in preventing registration of the word “match” for dating services). It appears, therefore, that use of “match” in a distinctive sense was not widespread in around April 2011, save by Match.
- e. On this basis, I am satisfied that by early 2011 the average consumer would have associated distinctive uses of the word “match” in the context of on-line dating services with the services of Match, the Claimants. In my judgment, this would have been the case when the average consumer looked at the 1996 Match.com Mark and also, from its 13 January 2017 filing date, at the 2017 Match.com Mark, and also at the Match Device Mark when it started to be used in 2015.

- f. In relation to the Muzmatch logos, it is again clear that the word “match” was being used as part of the business name – i.e. in a distinctive rather than descriptive sense. Indeed, there is no evidence (as at 2011) of Muzmatch using the word descriptively in relation to its services (see paragraph 50 above).
- g. Although, in Muzmatch’s logos and its SEO keywords, the word “match” was accompanied by one or more of the additional elements of “muz”, “muslim”, “UK” “United Kingdom” or the butterfly device, for the reasons set out in paragraph 86(a) and (e) above, I do not see that this would significantly reduce the likelihood of confusion with the Match Marks.
- h. In the case of the SEO keywords, the use of the word “match” is less obviously distinctive and I can see that some users might have used the keywords containing the word “match” descriptively. For example, a search on “UK Muslim Match” may have been intended to find a match who was a Muslim in the UK. However, that same search may also have been made if the keyword was used being distinctively – by someone looking for a Muslim partner on Match. Indeed, the fact that such use could be distinctive is implicit in Muzmatch’s admission of liability with regard to its use of Tinder as an SEO keyword.
- i. On this basis, an average consumer carrying out a search using a keyword that included the word “match”, may well have been looking for Match and its services. However, as Ms Bowhill submits, the mere fact that Muzmatch used the word “match” as part of a keyword is not, of itself, actionable. Rather, as appears from *Interflora Inc. v Marks & Spencer plc* [2014] EWCA Civ 1403 at [155], the issue is whether what was produced as a result of a search carried out using that keyword was such that an average user could not have ascertained (or could only have ascertained with difficulty) whether what was produced originated from Match (or an undertaking economically connected with Match) or from a third party.
- j. In this regard, as Ms Bowhill points out, there is no evidence of what the search results themselves (i.e. the link) would have looked like when a user carried out a search using one of the relevant keywords. On this basis, she argues that the court is unable to determine whether those search results satisfied the *Interflora* test. In my judgment, it is likely that the results would have shown a link to the Muzmatch website and, therefore, to have featured the “muzmatch” name. If so, the average consumer would not have been able to ascertain (and certainly not without difficulty) that that link did not originate from Match (or an undertaking economically connected with Match) but, rather, from a third party.
- k. Even if I am wrong as regards the link, it is common ground that a user who clicked on that link would have been taken to the relevant landing page on the Muzmatch website. In such event, as appears from paragraph 60 above, a user who had searched on “UK Muslim Match” would have been taken to a landing page that used that search term in its title and in a further three places, including in the phrase “*if you are looking for Uk Muslim Match then you have come to the right place. ...*”. The absence of the letter “a” before “Uk Muslim Match”, the capitalisation used in the above phrase, and the wording of this landing page as a whole, is more consistent with

distinctive use than with descriptive use. In my judgment, it was liable to lead a user to believe that the landing page was connected with Match. Whilst the website itself was the Muzmatch website, I am satisfied for the reasons set out above that would not have dispelled the confusion and would not have made it clear to the user that the services on that website were actually being offered by a third party with no connection to Match.

1. Finally, by reason of the matters set out in paragraphs 61-63 above, I find that a relatively substantial numbers of users would have seen the link and the relevant landing pages on the Muzmatch website (respectively, 32,770 and 11,725) and are likely to have been confused as a result.
94. Taking the evidence as a whole and, in particular, the evidence of Match's dominant presence in the market as at 2011 (and continuing thereafter), I find that the use of the Muzmatch Signs was likely to lead the average consumer in this case to conclude that Muzmatch was connected in some material way with the business that used the Match.com Marks and, after 3 March 2015, with the business that used the Match Device Mark. In particular, I find that the average consumer would have thought that Muzmatch was a sub-brand of that business specifically targeted at Muslim users and particularly at those Muslim users who felt that the services of a mainstream on-line dating service provider were not in accordance with Islamic values.
95. In reaching this conclusion, I have taken into account the point made by Ms Bowhill that Muzmatch has been trading since 2011 and that, despite hugely extensive searches by the parties for the purposes of disclosure,¹⁰ Match has only been able to find three instances of what it says (but Muzmatch denies) was confusion. Ms Bowhill argues that, if there was a *likelihood* of confusion, then there would by now have been some credible evidence of *actual* confusion.
96. In *Jack Wills v House of Fraser* [2014] ETMR 28 at [99], Arnold J said that:
- “... As I have said in a number of judgments, absence of evidence of actual confusion is not necessarily fatal to a claim under art.5(1)(b). The longer the use complained of has gone on in parallel with use of the trade mark without such evidence emerging, however, the more significant it is. Other relevant factors are the scale of the use complained of and the likelihood of actual confusion being detected.”
97. Further guidance was provided in *Fine & Country Ltd v Okotoks Ltd* [2012] EWHC 2230 (Ch), (a passing off case) where, after stressing (at [83]) that the issue is one for the judge, Hildyard J stated that:
- “84 The courts recognise, however, that finding and producing actual evidence of confusion is difficult. Members of the public are reluctant to attend court. Moreover, people who are confused and deceived may remain confused and deceived, and there is no reason why this should come to the attention of the parties. Furthermore, members of the public who were once deceived, but then appreciate that they were misled, will frequently have no reason to draw this to

¹⁰ Ms Bowhill's Skeleton referred to Match and Muzmatch having between them searched more than 53.7 million records, using 17 keywords.

the attention of the parties, especially if the realisation comes some time after any relevant dealing with the parties. Finally, persons may be deceived, and decide not to do business with the claimant as a result. They have therefore no reason to contact the parties and inform them of the confusion. For these reasons, evidence of actual confusion and deception is often decisive, but its absence is not.

85 Thus, in *Phones 4U* at [45] Jacob LJ observed:

“It should also be remembered here that it is seldom the case that all instances of deception come to light — the more perfect the deception the less likely that will be so.”

86 More recently in *Specsavers v. Asda Stores* [2010] EWHC 2035 at first instance, Mann J said in relation to a defence based on absence of confusion:

“First, Mr Purvis relied on a complete absence of complaints about confusion from Asda customers despite the 6 months that the logo had been present in the stores to the date of the trial. There was unchallenged evidence as to complaints procedures and handling, and none were recorded. I give this little weight. For this route to have yielded any relevant complaints there would have to have been customers who were confused, who then had their confusion removed, and who then felt sufficiently strongly about it to complain to Asda formally about it. This does not seem to me to be a likely scenario. I have difficulty in imagining how this can arise in practice.”

87 In *Harrods v. Harrodian School* Millett LJ said:

“Evidence of actual confusion is always relevant and may be decisive. Absence of such evidence may often be readily explained and is rarely decisive. Its weight is a matter for the judge.”

Kerr LJ (dissenting, but not on the approach to evidence of confusion) put the point this way:

“Even if there is no evidence of confusion whatever, the court must decide for itself, and may conclude that passing-off has been established: see e.g. per Sir Raymond Evershed M.R. in *Electrolux Ltd v. Electrix Ltd* (1953) 71 R.P.C. 23 (CA) at p. 31. Thus, it has often been said that the availability of such evidence is important, but not its absence, because it is notoriously difficult to obtain such evidence.”

98. It is, therefore, possible to conclude that there is a likelihood of confusion even in the absence of evidence of actual confusion. Indeed, as the passages quoted above show, the absence of evidence of confusion is “rarely decisive”. It is, as Hildyard J said in *Fine & Country* at [83], a matter for the trial judge to determine on the facts.

99. In the present case, notwithstanding that Muzmatch has been trading since April 2011 (albeit not on a particularly large scale until after 2016), I find that the absence of evidence of actual confusion is not because there was no relevant confusion but rather reflects the fact that Match’s and Muzmatch’s services have been provided via their websites and, more recently, their apps. Where services are provided to a customer in that manner, then any other dealings with that customer are likely to be conducted via that same website or app and are likely to

relate to the services that that customer had received via that website or app. On this basis, as Hildyard J noted in *Fine & Country* at [84]-[86] (see above), it is hard to see how or why any confusion that there might be in the customer's mind would come to light. It would rarely be relevant to the customer's issues – and that this is so even for those customers who use (as Ms Bowhill submitted was possible) two or three different on-line dating platforms. Given this, it seems to me that, despite the longer period of trading involved, this case falls squarely within the scope of what Mann J said in *Specsavers* as set out above.

100. In arguing that confusion would have come to light, Ms Bowhill pointed to Mr Younas's evidence that Muzmatch had been contacted by customers of Minder (another provider of dating services) in relation to matters concerning Minder's services. The difficulty with this is that I know nothing about Minder and its services, save that Mr Younas has said that it had copied a number of app features and it looked similar to the Muzmatch app. Otherwise, I have no evidence as to how Minder operated and I do not think that this evidence helps me in considering the likelihood of confusion arising from two businesses like Match and Muzmatch that are using similar names.

The evidence of actual confusion

101. As mentioned above, Match seeks to rely on three instances of what it says is relevant confusion. As no witnesses were called to give evidence with regard to these instances, I do not place any great reliance on them. The most that can be said is that two of them provide some (albeit limited) support for Match's argument that there is a likelihood of confusion.
102. The first instance is based on an email received by Match on 9 May 2021 from a person regarding "*an account on muz match*" which, that person said, was not his account but which had used his pictures. As Ms Bowhill points out, on its face, this may not be evidence of relevant confusion given that the person concerned claimed not to be a user of any dating websites. However, the fact that someone had contacted Match with a complaint regarding Muzmatch is evidence of some sort of a likelihood of confusion arising from the similarity in the names, although in the absence of more details, it is difficult to place too much reliance on this particular instance.
103. The second instance is in a website chat in July 2018. This involved a person in the USA who appears to have been a customer of both Match and Muzmatch and who complained to Match about a \$20 charge levied by Muzmatch. Ms Bowhill points out that it is not evidence of actual confusion in the UK. However, the fact that a customer made that mistake in the US shows that there is a likelihood of such confusion arising in similar circumstances in the UK. Again, in the absence of more details, it is difficult to place too much reliance on this.
104. The final instance relied on by Match was in an email dated 3 January 2016 referring to a user having "met on a different match app previous to this". In my judgment, this email is of little or no value given that it is wholly unclear from the context whether the reference to a "different match app" was being used distinctively or descriptively.

Conclusion on s.10(2)

105. For these reasons, I find that there is a likelihood of confusion as between the Muzmatch Signs and the Match Marks and, therefore, an infringement pursuant to s.10(2).

Was there an infringement under s.10(3)

106. I will now deal with Match's claims under s.10(3). In doing so, I will assume (contrary to my conclusion above) that use of the Muzmatch Signs did not give rise to any likelihood of confusion with the Match Marks within the meaning of s.10(2).

The law relating to infringement under s.10(3)

107. As regards the test for infringement under s.10(3), in *Comic Enterprises Kitchen LJ* stated, at [111], that:

“In *Interflora* this court explained (at [69]) that a proprietor of a registered trade mark alleging infringement under Article 5(2) must therefore show that the following requirements are satisfied: (i) the registered trade mark must have a reputation in the relevant territory; (ii) there must be use of a sign by a third party in the relevant territory; (iii) the use must be in the course of trade; (iv) it must be without the consent of the proprietor; (v) it must be of a sign which is identical with or similar to the trade mark; (vi) it must be in relation to goods or services; (vii) it must give rise to a link between the sign and the trade mark in the mind of the average consumer; (viii) it must give rise to one of three types of injury, that is to say, (a) detriment to the distinctive character of the trade mark, (b) detriment to the repute of the trade mark, or (c) unfair advantage being taken of the distinctive character or repute of the trade mark; and (ix) it must be without due cause.”

108. In this case, there is no issue as regards requirements (ii), (iii), (iv) and (vi) referred to above. Muzmatch's use of its Signs was clearly use within the relevant territory, in the course of trade, without Match's consent and in relation to goods or services. The issues, therefore, are whether requirements (i), (v), (vii), (viii) and (ix) are satisfied.

Requirement (i) - reputation

109. In its Amended Defence, Muzmatch admits that the Match.com Marks (but not the word “match” by itself) have a reputation amongst members of the general public but not amongst members of the Muslim community. It also admits that the Match Device Mark has a minimal reputation but, again, not within the Muslim community.
110. The task of showing that a mark has a reputation in the UK is not intended to be particularly onerous (see *Red Bull v Sun Mark* [2012 EWHC 1929 (Ch) at [90]) and, in my judgment, the evidence summarised in paragraphs 24-41 above, clearly establishes that by at 2011, the 1996 Match.com Mark had a very significant reputation in that it was clearly known by a very substantial part of the public concerned with such services and was, in fact, the dominant force in the market. Moreover, given that the evidence clearly shows that Match had Muslim customers, and that Mr Younas himself was well aware of the Match brand (despite not being a customer), I find that that reputation extended to people within the Muslim community. I am also satisfied that this reputation would also have attached to the later 2017 Match.com Mark upon it being registered.
111. The position is different as regards the Match Device Mark. This had a filing date of 3 March 2015 and Ms Bowhill argued that as at that date it could have no acquired distinctiveness, but only its minimal inherent distinctiveness. I accept that I have to take this mark as it was as at

its relevant date of 3 March 2015. However, as I have already found, by 2011 (and therefore as at 3 March 2015) the average consumer would have been aware that where the word “match” was used in a distinctive sense, it designated the services of Match, the Claimants (see paragraph 93(e) above). Of course, given Match’s dominant position in the market reflected in the levels of awareness summarised, its advertising and its social media following (see paragraphs 35-38 above), the Match Device Mark would rapidly have acquired its own distinctiveness and reputation in any event (including in the Muslim community) after 3 March 2015.

Requirement (v) - similarity of sign/mark

112. I have dealt with the level of similarity between the Match Marks and the Muzmatch Signs when dealing with Match’s s.10(2) claim. As set out there, I find that there is a medium degree of similarity.

Requirement (vii) – a link

113. There is an issue as to whether, in the mind of the average consumer, use of the Muzmatch Signs would give rise to a link between those Signs and any of the Match Marks.
114. As regards what constitutes a link for these purposes, it is clear from *Specsavers* ([2012] EWCA Civ 24) at [120]-[121] that what is required is a certain degree of similarity between the Marks and the Signs such that the average consumer would make a connection between them. It is not necessary that the average consumer would be confused. It is simply that, taken in context, the sign would call the registered mark to that person’s mind.
115. Although I am considering the application of s.10(3) on the assumption that I was wrong to conclude that there was a likelihood of confusion, the factors that led me to reach that conclusion would, in my judgment, establish a link in the mind of the average consumer as between the Muzmatch Signs and the Match Marks. In summary, by 2011 the 1996 Match.com Mark had established a very significant reputation in the market (which was also enjoyed by the 2017 Match.com Mark from its filing date), there is medium level of similarity between the Match.com Marks and the Muzmatch Signs, and there is either an identity or a reasonably high level of similarity between the parties’ goods/services. As the use made of the Muzmatch Signs was clearly use intended to be distinctive (as a brand) rather than descriptive, I am satisfied that the average consumer would have made a link between those Signs and the Match.com Marks. I am aware that the evidence of Mr Younas and Mr Craig was that the Signs did not create any link in their minds. However, in this respect, I do not think that their views are representative of those of the average consumer.
116. The position as regards the Match Device Mark is, again, slightly different given that it had no acquired distinctiveness in itself as at its relevant date of 3 March 2015. Nevertheless, for the reasons set out above, I find that the average consumer (being aware of the extensive use made by the Claimants of the name “Match”) would have made a link between the Muzmatch Signs and this Mark as well.
117. I also note that the likelihood that users would make a link between Muzmatch’s keywords and the Match Marks is clear from the fact that Muzmatch’s SEO strategy involved the use of the names of other dating service providers including, as from 2015, of the name Tinder (see

paragraphs 58 and 59 above). The SEO strategy of using such keywords relied on the fact that users would make a link between those keywords and those service providers.

Requirement (viii) – the three types of injury

118. Under s.10(3) liability can arise in respect of any of three types of injury - (a) detriment to the distinctive character of the mark (often called “dilution”), (b) detriment to the repute of the mark (“tarnishment”) and (c) unfair advantage being taken of the distinctive character or repute of the mark (“free-riding”).
119. Match’s claim in this regard was focussed primarily on injury within (a) and (c) above. Whilst type (b) injury (damage to repute or tarnishment) was relied on in Match’s Particulars of Claim, it was barely mentioned by Mr Austen in his submissions and, in my judgment, rightly so. I have been shown no evidence that Muzmatch’s use of its Signs is liable to tarnish the image of the Match Marks in the way envisaged by cases such as *L’Oreal v Bellure NV* Case C-487/07 at [40].

Requirement (viii) – unfair advantage

120. Turning then to Match’s claim based on type (c) injury (namely that Muzmatch Signs took unfair advantage of the distinctive character or repute of the Match Marks), the following principles appear from the authorities:
- a. The more immediately and strongly the protected mark is brought to mind by the sign complained of, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark— see *L’Oreal* at [44]. In this sense, the stronger the reputation of the protected mark, the more likely it is that to create a link to it would be unfair.
 - b. There is no need to show a likelihood of confusion or a likelihood of detriment to the distinctive character or repute of the mark or, more generally, to its proprietor. Instead, unfair advantage is taken where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark – see *L’Oreal* at [49]-[50] and *Specsavers* at [127].
 - c. Whilst a defendant is most likely to be found to have taken unfair advantage of the reputation of a trade mark where that defendant intended to take such advantage, such an intention is not a necessary element for liability under s.10(3). Liability may arise where the court is satisfied that the objective effect of the use which has been made of a sign is to enable the defendant to benefit from the reputation of the protected mark – see *Sky Plc v SkyKick UK Ltd* [2018] EWHC 155 (Ch) per Arnold J at [315] and *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 per Arnold J at [80].

121. In my judgment, applying these principles, I am satisfied that even in the absence of a likelihood of confusion, the Muzmatch Signs take unfair advantage of the distinctive character or repute of the Match.com Marks. As set out above, even by 2011, the 1996 Match.com Mark had a very strong reputation (which was also enjoyed by the 2017 Match.com mark from its filing date), including amongst members of the Muslim community. Match had invested very substantial sums in order to build that reputation and, as Mr Lubot stated, to build trust in its platform and to reduce any stigma that might attach to the use of online dating services. By using the name “muzmatch” in a way that created a link to the Match.com Marks (and particularly to do so in relation to identical or, at least, highly similar goods or services), Muzmatch was, in effect, taking some of the benefit of that reputation and of that investment and was doing so without paying for it.
122. The case is less clear as regards the Match Device Mark given that that Mark in itself had no enhanced distinctiveness as at its relevant date of 3 March 2015. Nevertheless, I find that by reason of Match’s activities, the word “Match” (which formed the dominant part of this Mark) was a word which the average consumer would have associated with the business of the Claimants (see paragraph 93(a)-(e) above) and, therefore, that the use of the word Muzmatch also took unfair advantage of the distinctive character or repute of this Mark.
123. In reaching these conclusions, I have taken into account Mr Younas’ evidence that in 2011, when he chose the name Muzmatch, it was not his intention to make a link to or take any benefit from the 1996 Match.com Mark. Indeed, I note that (as mentioned above) he did not use the word “match” by itself or “Match.com” as SEO keywords. However, I do not see that this assists Muzmatch. As I understand it, Mr Younas’ state of mind was based on his belief that the word “match” was descriptive. In my judgment, for the reasons I have already set out, whatever Mr Younas’ subjective intention or belief, the average consumer (including some who were Muslims) would not have seen the relevant use of the word “match” by either Match or Muzmatch as being descriptive and would instead have made a link between the Muzmatch Signs and the Match Marks. The objective effect, therefore, of the use of the Muzmatch Signs was that Muzmatch benefitted from the reputation of the Match Marks.
124. Moreover, objectively viewed, the intention to benefit from the reputation of the Match Marks is clear from Muzmatch’s SEO strategy. If there was no benefit to Muzmatch, it is hard to see why it would have used keywords including the word Match in a way that could be distinctive (see paragraph 93(k) above) along with the names of other dating service providers including, from 2015, the name Tinder (see, again, paragraphs 58 and 59 above). In my judgment, that was taking unfair advantage.
125. I should also note that, given that Mr Younas was prepared to use the name Tinder as part of Muzmatch’s SEO strategy, it is hard to accept his claim that the creation of a link with Match would have been detrimental to Muzmatch. Tinder’s services, being more clearly focussed on forming casual relationships, are likely to be more objectionable to traditional Islamic values than Match’s services. Yet Muzmatch was perfectly prepared to use the Tinder name. Indeed, in addition to its use as part of an SEO keyword, I have seen marketing material from Muzmatch describing itself as “*Way more than just a ‘Muslim tinder’*” and interviews given by Mr Younas in which he said “*I took what was good from Tinder*”.

126. In arguing that it had not intended to take unfair advantage, Muzmatch also placed some reliance on the fact that, after 2016, there had been discussions between Match and Muzmatch (see paragraph 64 above). I cannot see how this assists Muzmatch. The negotiations started with Match's letter alleging that Muzmatch's actions infringed the Match Marks and that was still Match's position in 2018 when it successfully opposed Muzmatch's applications to register the Muzmatch name as a trade mark (see paragraph 65 above). Muzmatch may have hoped that the negotiations would lead to a favourable result that would allow it to continue using the Muzmatch name, but I cannot see how this could convert the unfair advantage that Muzmatch had taken of the Match Marks into a fair advantage.
127. For these reasons, I also reject Ms Bowhill's argument that Match's decision to rebrand Harmonica as Hawaya (rather than as a sub-brand of Match) shows that there could be no benefit to Muzmatch in creating a link in people's minds with Match.
128. An argument raised by Mr Austen was that the conclusion that Muzmatch had taken unfair advantage of the distinctive character or repute of the Match Marks was supported by the style and colours which Muzmatch used for its branding. These, he said, were initially very close to and, thereafter, tended to follow Match's branding. As set out above, Mr Younas admits that he was aware of Match and I can see that it is likely that he kept Match's branding in mind. However, I am not convinced that this provides Match with much real assistance. As appears from *Planetart* at [38], the concept of unfair advantage under s.10(3) does not seek to prevent a business learning from its competitors, even to the extent of (to use the words of Mr Alexander Q.C. in *Planetart*) "adopting similarities in approach and presentation". On the facts, I do not think that the evidence shows a general tendency by Muzmatch to follow or to ape Match's branding beyond its use of the Match name. Mr Younas gave detailed evidence of how Muzmatch's branding was chosen and evolved and, in the context of on-line dating services, I do not regard it as particularly significant that there are similarities in the use of lower case lettering, or of a heart device, or that Muzmatch (for a very short time in respect of an app to be used on smaller mobile devices) used the single letter "M" with a heart device. In other respects, Muzmatch did not follow Match's branding.

Requirement (viii) – detriment to distinctive character

129. The other type of injury relied on by Match was detriment to the distinctive character of the Match Marks.
130. In *L'Oreal* at [39] the CJEU provided the following guidance as regards this aspect of s.10(3):
- “39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark's ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, para.29).
131. In determining whether there has been such dilution, the stronger the link that the sign makes to the protected mark, and the stronger the reputation enjoyed by that mark, the more likely it

is that a court will conclude that there has been detriment to it. However, in order to show such detriment, a claimant must prove (by evidence) actual injury to its mark – in the sense that there has been a change in the economic behaviour of the average consumer or at least a likelihood that there will be such a change (see *Comic Enterprises* per Kitchin LJ at [114] and [116]-[118]) and *Skykick* per Arnold J at [310].

132. On the assumption on which I am currently proceeding (i.e. that there is no likelihood of confusion) and in the absence of any evidence to establish any other form of damage to the distinctive character or reputation of the Match Marks, I have concluded that Match’s claim in this regard must fail. On this assumption, there is no evidence that use of the Muzmatch Signs has led (or is likely to lead) to any change in the economic behaviour of the average consumer.

Requirement (ix) – without due cause

133. The final condition in relation to a potential liability under s.10(3) is whether Muzmatch’s use of its Signs was without due cause.
134. In *Planetart*, Mr Alexander Q.C. noted (at [40]) that the onus of proof is on the defendant to show that it did have due cause. He then went on at [42]-[45] to make the following points regarding the issue of due cause:

“42 First, having regard to the general principles of trade mark law, which require consideration of marks as a whole, the question of whether (for example) there are interests of other economic operators having signs capable of denoting their products and services justifying the use of the sign must be evaluated by reference to the mark and sign taken as a whole. In the case of a mark composed of a number of elements, the court should consider whether those interests should reasonably permit the use of all of those elements in combination, not merely some of them.

43 Second, the approach should not be so strict that it is only where a defendant proves that there is no practical alternative at all to the use of the sign in question that a defendant's sign would be regarded as being used with due cause. There has to be some degree of latitude, which will depend on the circumstances of the trade. However, it must be borne in mind that this provision only comes into play after it has been found that there is not only a link between the registered trade mark and the sign but also that it has taken unfair advantage or is detrimental to the distinctive character of the trade mark in the sense that the case law has required. That does raise the bar for a defendant to show that the use of the sign is nonetheless with due cause.

44 Thirdly, where the registered mark includes descriptive elements (or other elements which are less likely to have trade mark significance—such as a colour or design) and the case for application of s.10(3) is largely based on the common use of such elements, the easier will it be for a defendant to show that the use of those elements is with due cause. That approach gives effect to the purpose of the law articulated in *Leidesplein* and *Argos*.

45 Fourthly, cases are highly fact dependent but the court should seek a proportionate response. The greater the intrusion into the trade mark proprietor's legitimate interests in the ways that the law seeks to protect against, the stronger will need to be the defendant's justification for nonetheless using the sign in question."

135. It seems to me that, in a case such as the present, the factors to be considered in relation to the issues of unfair advantage and of due cause are much the same. On this basis, given my finding that Muzmatch had taken unfair advantage of the distinctive character or reputation of the Match Marks and given that Match is not seeking to prevent descriptive uses of the word "match", then Muzmatch has not established that its conduct was with due cause.

Honest concurrent user

136. I turn now to deal with Ms Bowhill's argument that this is a case of honest concurrent use by Muzmatch of the marks in question.

137. The concept of honest concurrent user has its roots in s.12(2) of the Trade Marks Act 1938 and was carried into s.7 of the Trade Marks Act 1994. These provided that a trader who could establish honest concurrent use of a mark might be entitled to register that mark notwithstanding the existence of another trader with earlier rights in that mark. Save for this, the concept is not something that is, expressly at least, recognised in any UK or European trade mark legislation.

138. Despite this, as explained in cases such as *Budějovický Budvar, národní podnik v Anheuser-Busch, Inc* C- 482/09, [2009] EWCA Civ 1022 and [2012] EWCA Civ 880 and *IPC v Media 10* [2014] EWCA Civ 1439, the concept reflects the fact that where two parties have been trading for a sufficiently long period using the same mark, that mark may have come to indicate the goods or services of either of those parties. In effect, the mark may no longer fulfil (as least as between those parties) the essential function of a trade mark: namely acting as a badge of origin for the goods or services of just one of them. In such a case, a party may be entitled to register the mark notwithstanding that the other party had also used the mark (as in *Budweiser*) or it may be able to defend an infringement claim brought by that other party (as in *IPC v Media 10*). Further, it is clear from cases such as *Victoria Plumb Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 that the concept can apply not just where the marks used by the parties were identical but also where they were similar and, therefore, can apply to infringement cases brought under s.10(2) and 10(3) of the Trade Marks Act 1994 as well as to those brought under s.10(1). In such infringement cases, it is not that honest concurrent user is a specific defence; rather, it is that where there has been honest concurrent use, the conditions for infringement are unlikely to be satisfied (see the suggestion made by Arnold J, in relation to s.10(2), in *W3 Ltd v Easygroup Ltd* [2018] EWHC 7 at [287]).

139. As explained by Jacob LJ in *Budweiser*, where the concept operates, its effect is that the parties must live with such confusion as is inevitable given their long period of concurrent use although, as explained by Henry Carr J in *Victoria Plumb* at [74] and [79], neither party should do anything to exacerbate the confusion beyond that which is inevitable.

140. Ms Bowhill argues that the present case is a strong case of honest concurrent use. She points to the fact that Match and Muzmatch have coexisted for over ten years in the same field and

that, as a result, the public has been educated that the marks do not indicate the services of just one of them. The guarantee given by the marks is, she submits, different. I do not accept this argument.

141. In cases like *Budweiser* and the other honest concurrent user cases relied on by Ms Bowhill, the use relied on as being honest concurrent use seems not to have been infringing use when it started. Indeed, in each of them, the claimant's mark sued on was registered after (usually well after) the honest concurrent user had started. In contrast, in the present case, Muzmatch's use started as infringing use of Match's prior registered Mark; that use had interfered with the essential function of that Mark, had given rise to a likelihood of confusion and/or had taken unfair advantage of the reputation of that Mark. Moreover, given the 26th January 2016 letter and Match's (successful) opposition to the registration of the Muzmatch name as an EU and a UK trade mark (see paragraphs 64-65 above), Muzmatch was well aware that Match regarded the Muzmatch Signs as infringing. In the absence of, say, estoppel or statutory acquiescence, it is difficult to see how use that starts as infringing use can be turned into honest use by the fact that it has continued. The very reason why use infringes is because, if left unchecked, its effect would be to educate the public that the mark does not indicate the services of the trade mark proprietor. It must be a very unusual case where (again, in the absence of estoppel or statutory acquiescence) a defendant can argue that continuing to infringe gives rise to a defence to an infringement claim. I do not think that this is such a case and, in my judgment, Muzmatch's use cannot be regarded as honest concurrent use. Whilst I accept that Mr Younas did not intend to create a link or confusion with the Match Marks (because he wrongly saw use of the word "match" as descriptive in this context and because he was serving only the Muslim community), I do not see that this can give rise to a defence when, objectively viewed, his actions infringed Match's rights for the reasons set out above.
142. It seems to me that Ms Bowhill's argument is really seeking to take the concept of honest concurrent user into the sphere of acquiescence or estoppel or even of limitation (none of which features in the list of issues for this case). There is an element of this in Ms Bowhill's submission that Mr Younas relied on representations made by Match during the settlement discussions to the effect that their concern was not use of the name Muzmatch per se, but rather, the format and style used. Ms Bowhill (rightly, in view of the matters mentioned in the previous paragraph) does not argue that this gives rise to any estoppel but simply relies on it to support her claim that Muzmatch was acting honestly. However, I cannot see that this assists Muzmatch. As I have already found, Muzmatch's mistaken views as to the legal basis of its actions cannot transform what were infringing acts into non-infringing acts.

Passing off

143. I turn, finally, to the issue of passing off. The basic principles of law are well established. To succeed, Match must establish that it has relevant goodwill and that there has been a misrepresentation by Muzmatch which has caused damage to Match's goodwill.
144. Dealing first with the issue of goodwill, Mr Austen's argument is that by 2011 Match had acquired goodwill not only in Match.com but also in the word "Match" when used distinctively. For the reasons set out in paragraphs 24-41, in paragraph 93(a)-(e) and in paragraphs 110-111 above, I accept this argument. I find that by 2011, the 1996 Match.com Mark had acquired a substantial goodwill and that that goodwill also attached to the 2017 Match.com Mark as from its filing date of 13 January 2017. I also find that significant

goodwill would have attached to the Match Device Mark soon after its filing date of 3 March 2015 given the use that was then made of it (as evidenced in, for example, the March 2016 branding report). I am also satisfied that, by 2011, Match had also acquired significant goodwill in the word “match” by itself, when used distinctively (i.e. as part of a brand) in relation to online dating services in that, by that time, such use would have been seen as indicating that the relevant goods or services emanated from the Claimants, Match. Finally, I am also satisfied that, whilst Match’s services were not specifically targeted at people in the Muslim community, its goodwill in the Match Marks and in the word Match extended into that community (see paragraphs 75 and 110 above).

145. As to misrepresentation, for the reasons set out above in relation to the issue of a likelihood of confusion (see paragraphs 93–104 above), I am satisfied that the use of the Muzmatch Signs did constitute misrepresentations in that they would have led some consumers to assume that the goods and services offered by Muzmatch were somehow connected with or derived from Match. In my judgment, given the likelihood of confusion, damage would be caused to Match’s goodwill.
146. For the reasons I have already given, it does not seem to me that Muzmatch can raise a defence based on the concept of honest concurrent use. Accordingly, in my judgment, Match’s passing off claim succeeds.

Conclusion

147. For these reasons, I find that Muzmatch, by its use of the Muzmatch Signs, has infringed Match’s Marks and/or that such use amounts to passing off.

Post script – suitability of IPEC

148. As is apparent from the length of this judgment and from the volume of evidence and other material before the court, this case was not the simple or straightforward case that the parties suggested. I do not mean this as a criticism of the quality of the parties’ advocacy or trial preparation (which were very high). However, I do not think that the case was not suitable to be heard as a two day trial in the IPEC. In particular, with counsel being limited to a half day each for their oral submissions, I have been very reliant on their written submissions and did not have the benefit of hearing full oral submissions on various matters of factual or legal difficulty. This inevitably made writing this judgment a far lengthier and more difficult task.
149. In my view, if the parties wished this case to be heard as a two day trial in the IPEC, they should have attempted to narrow the issues in the lead up to the CMC and, if that was not possible or if the scale of the issues only later became apparent, one or both of them should have sought to have the case transferred into the main High Court list to allow for it to have a longer trial. In this regard, from the evidence before me, it does not seem that this was the sort of case where either party needed the special IPEC procedures and, in particular, its cost capping rules, to help them obtain access to justice. Both appear to have fought this case as if it was normal High Court litigation.