

O-054-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3127314

BY ROBERT MAGILL

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 45:

matchedharmony

AND

OPPOSITION THERETO (NO. 405810) BY MATCH.COM, L.L.C.

Background and pleadings


1. This dispute concerns whether the following trade mark should be registered:

matchedharmony

Class 45: Online dating via a website, dating service

2. The mark was filed on 16 September 2015 by Mr Robert Magill and it was published for opposition purposes on 9 October 2015.

3. Match.com L.L.C. (“the opponent”) opposes the registration of the mark on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on three earlier marks under section 5(2)(b), as set out below; only one of these marks (mark i)) is relied upon under section 5(3):

- i) European Union trade mark (“EUTM”) registration 182253 for the mark **MATCH.COM** which was filed on 1 April 1996 and registered on 9 March 2004. The mark stands registered in class 42 in respect of “[i]nformation and consultancy services in the nature and field of on-line dating and introduction services”.
- ii) UK registration 3097217 for the mark  which was filed on 3 March 2015 and registered on 30 October 2015. The mark stands registered in class 45 in respect of:

Providing social introduction and date-arranging services; administering personality and physical attractiveness testing and creating personality and physical attractiveness profiles of others; dating agency services; match-making services; computer dating services; provision of dating agency services via the Internet; provision of dating agency services via television, radio and telephone; agency services which arrange personal introductions; social escorting services; information and advisory services

relating to the aforesaid services; providing information regarding on-line dating and introduction services.

- iii) UK Registration 2622977 for the mark **match.co.uk** which was filed of 29 May 2012 and registered on 7 September 2012. The mark stands registered in respect of the same services as per mark ii).

4. Under section 5(4)(a) the opponent relies on the use of the sign MATCH.COM since 1995 in respect of online dating and introduction services. The essence of the opponent's claims under the three grounds are that i) the average consumer would understand the services offered under the respective marks to come from the same or a related undertaking, ii) that use of the applied for mark would blur/dilute the distinctiveness of the opponent's mark and that the applicant would gain an unfair advantage and, iii) that the use of the applied for mark constitutes a misrepresentation to the public which would damage the opponent's goodwill and which, it is claimed, is preventable under the law of passing-off.

5. In relation to the earlier marks, marks ii) and iii) had been registered for less than five years when Mr Magill's mark was published, so meaning that there is no requirement for them to have been genuinely used in order for them to be relied upon. However, mark i) had been registered for more than five years, and is, therefore, subject to the proof of use requirements set out in section 6A of the Act.

6. Mr Magill filed a counterstatement denying the claims. He did not put the opponent to proof of use in respect of mark i) so meaning that the earlier mark may be taken into account with the opponent not having to establish that genuine use has been made of it. In its written submissions the opponent states that the decision of Mr Magill to not put it to proof of use is a "direct acknowledgement that the Applicant is aware of the market presence of the Opponent under the MATCH.COM brand". I do not accept that such an acknowledgement can be taken solely from a decision not to request proof of use. A summary of the main points of Mr Magill's defence are that:

- The marks are not visually and phonetically similar to the earlier marks. Mr Magill’s mark is one word which he says has a different meaning to the earlier marks.
- The word MATCH is a generic word used in most internet dating services to describe relationship compatibility and “is a descriptive mark synonymous with the services offered in dating services. Many dating services have the word match as part of their name and registered trade mark”.
- Although the respective marks operate in the same industry of online dating, the services are not similar.
- Mr Magill does not believe that “consumers who pass the intelligence test” would confuse the marks or believe that the services are from the same or an economically linked undertaking.
- That the applied for mark does not ride on the coat tails of the earlier mark in view of the generic nature of the word MATCH.
- That there will be no passing-off.
- The consumer will spend a considerable time filling in forms, readings terms and conditions and subscription rates, so the purchasing process is not an impulse one. Any prudent person of average intelligence would not be confused.
- Any damage to the opponent’s reputation, decreasing uniqueness or power of attraction, will stem from how the opponent treats its customers.
- Mr Magill’s mark has been used since 2013 with no confusion and the opponent has not threatened any litigation action.

7. Mr Magill has represented himself throughout the proceedings. The opponent is represented by Barker Brettell LLP. Both sides filed evidence. Neither side requested a hearing, both opting to file written submissions in lieu of attendance.

8. It should be noted that Mr Magill's application has also been opposed by eHarmony Inc. (opposition number 405822). A separate decision has been simultaneously issued by me in relation to that other opposition, based upon the facts and evidence presented in those proceedings.

The evidence



The opponent's evidence

9. A witness statement was filed by Ms Evdokia Moustaka, Legal Affairs Manager of Match.com International Limited, part of the same group as the opponent. Ostensibly, her evidence details the use made of the earlier marks and their reputation. It is explained that the Match.com group belongs to IAC which includes a number of online dating platforms including match.com, OkCupid, Tinder and PlentyofFish. Revenue cannot be split to show revenue in the UK for match.com or other EU member states. I highlight below some of the keys facts that are presented in terms of the use of the marks:

- Over 42 million singles have registered with match.com since 1995. This is a global figure. There are currently 15 million members actively using the service.
- The match.com mark has featured in media articles. One example from the Telegraph identifies match.com and refers to a claim (by its owners) that the service has led to more dates, marriages and relationships than any other service.
- The business has corporate offices in Europe, including the UK.
- On the basis of visits to www.uk.match.com the opponent has a 13% share of the market in 2016. This was measured at 6% in 2012 and 8.5% in 2013.
- No data on registrations and subscriptions is provided because this is considered by the opponent to be highly confidential.

- Data for monthly active users of the UK website is provided which stands at around half a million in the last three years prior to Mr Magill's application being made. Similar data is provided for other EU member states, albeit at much lower levels.
- A figure for daily active users (a unique user who has been active on a specific day – here the first day of every month in 2012) is provided. This stands as 1.1 million.
- Marketing campaigns have been run on various social network platforms.
- Television advertising has taken place with the number of “opportunities to see” between 2012 and 2015 being over 707 million.
- Advertising in various publications is also referred to with “opportunities to see” (in the same period set out above) being 949 million.

Exhibit EMI consists of a witness statement filed in an earlier opposition case dated January 2012. It shows similar information to that already summarised. It contains a number of press articles from UK publications which mention match.com. Various other exhibits are provided. Those that are worth noting are:

- Exhibit EM III – This contains the raw data used in relation to the website statistics and claimed market share.
- Exhibit EM IV – This contains press articles in which match.com is mentioned. Two are from before the relevant date, the others after.
- Exhibit EM IX – This contains the Facebook profile for three Nordic versions of match.com. The  earlier mark is detailed on the profile picture, although the date is after the relevant date.
- Exhibit EM XI – This contains prints from the YouTube channels of various country specific match.com sites, including the UK, which contains the words match.com and the  mark; there is an entry saying that the user joined

You Tube in 2009. It has 799 subscribers with over 8 million views (presumably of its video content). There is nothing to show that the profile, as it looks in the print, was how it looked before the relevant date.

- Exhibit EM XII – This contains Instagram profiles for various match.com sites, including the UK. which is headed ukmatch and contains the web address uk.match.com. The page has 703 followers, but is not dated.
- Exhibit EM XIII – This contains various Twitter profiles, including one for the UK, which is headed with the *match* mark. Reference is made to Match UK & IE. It has 12.1k followers and it joined Twitter in 2011. There is nothing to show that the profile, as it looks in the print, was how it looked before the relevant date.
- Exhibit EM XIV – This contains information on affiliate marketing, including information showing that the cashback sites Quidco and Topcashback have a listing for match.com, both of which also show the *match* mark. There is nothing to show that the profile, as it looks in the print, was how it looked before the relevant date.
- Exhibit EM XV – This contains website prints of a comparative nature. One is from a website headed “UK Dating Site Price” which has a link to an article dated after the relevant date relating to the prices for match.com in 2016. Two other prints relate to the Top 10/Best dating sites of 2016. The top 4 in each is the same: Zoosk, Elite Singles, eHarmony and MATCH.COM.
- Exhibit EM XVII – This contains a print from a website named freedating.co.uk on which, according to Ms Moustaka, match.com is featured. There is also a print from the opponent’s (UK) website which shows that it is possible to register for free and browse potential matches.

10. A witness statement was also provided by Ms Rosalyn Newsome, a trade mark attorney at Barker Brettell. Much of the evidence given by Ms Newsome relates not to

match.com, but, instead, to one of its rivals, eHarmony Inc, which operates a dating service under the name eHarmony. The exhibits she provides are as follows:

- Exhibit RJN1 – This consists of a Wikipedia entry for eHarmony which shows that the dating service was launched in 2000 and now operates in 150 countries including the UK.
- Exhibit RJN2 – This consists of a screen shot for eHarmony’s website. It is clearly a US based business but its operation in the UK is mentioned. It provides a “Compatibility Matching System” which allows its members to be matched to compatible persons.
- Exhibit RJN3 – This consists of a screenshot of a website identifying the best online dating websites which include both match.com and eHarmony.
- Exhibit RJN4 – This consists of a print from the website Money which lists the Top 10 online dating websites. The list includes both match.com and eHarmony. The print is from 2016, after the relevant date.
- Exhibit RJN5 – This consists of an article from askmen which compares the services of match.com and eHarmony. The article is undated. Given that one of the factors compared is the price, which is listed in \$s, this appears to be a US website.
- Exhibit RJN6 – This consists of another website article comparing match.com and eHarmony. This is dated in 2013 but, again, the use of \$s in the article suggests that this is a US website.
- Exhibit RJN7 – This contains another article comparing the two services this time from onlinedatinghelp.co.uk. It refers to match.com and eHarmony being the two biggest subscription based providers. The writer of the article sometimes refers to match.com as match. The article is not dated.

- Exhibit RJN8 – This consists of another article comparing the two services. Again, it is not dated. Reference is made to them being two of the biggest dating service providers.

11. I note that Ms Newsome refers to the services of the opponent being referred to as match, but beyond the references in RJN7, the references are all to match.com.

Mr Magill's evidence

12. Mr Magill is the project co-ordinator of what he describes as the organisation matchedharmony.date, a community dating project. His evidence deals with four issues: the differences between the marks, the differences between the services, the widespread use of the words MATCH and HARMONY in the dating industry, and, the absence of confusion. I will summarise Mr Magill's evidence accordingly.

Differences between the marks

13. Mr Magill states that his mark is one word with a different meaning to match. In Exhibit 15 he provides a definition for the word "match" (which focuses on combining well with something or, in the sense of a relationship, with someone). A definition for "matched" is also provided when used as a suffix (which focuses on being similar or suitable for each other (as in well-matched)). The definitions are taken from the Cambridge Dictionary Online. Mr Magill states that his mark should not be dissected when deciding if confusion exists.

Differences between the services

14. For reasons that will become apparent, I do not intend to provide a great deal of information in respect of this aspect of the evidence. For the record, though, some of Mr Magill's points are based upon the not for profit (and free) nature of his project, that his service uses an astrological algorithm, that his services do not provide dating events (which match.com apparently does), that he uses local advertising whereas match.com uses television, affiliate and Google adword advertising.

The widespread use of “match” and “harmony” in online dating

15. Mr Magill states that the word match is often used in the context of internet dating, both in registered trade marks and more generally. He adds that the opponent’s earlier marks are not for the word match per se. Exhibits 6.1-6.3 contain details of three registered marks: mobile match, MUDDY MATCHES and URBAN MATCHES, all of which cover dating services. Exhibits 7.1 to 7.13 show dating websites which have the word match in their names as follows:

- matchmehappy.co.uk
- matchmakercafe.com
- matchmaker.com
- matchmecanada.ca
- matchingsouls.nl
- matchcompany.co.nz
- matchmadeabroad.com
- matchwereld.nl
- disabilitymatch.co.uk
- divinematch.co.uk
- thefreematchmaker.com
- halifaxmatch.ca
- veggiematchmakers.com

16. Mr Magill states that every dating service uses the word match or matches to describe suitable potential dates. He gives an example in Exhibit PD2 which is an email to him (from 2016) from what appears to be a dating service called Plenty Of Fish which alerts him to new matches.

17. Mr Magill states that the word harmony is also generic in the dating industry as more and more algorithms are created to measure the harmony between people in relationships. He states that it is only a matter of time before there will be a number of dating services which use harmony in their marks. Exhibit 18 contains a print of a registered trade mark for HEALTH & HARMONY (and device) the services for which

include dating services. Exhibits 17.1 to 17.6 show dating websites which use the word harmony in their names, as follows:

- harmoniouspartners.com
- harmonylove.com
- paganharmony.com
- conjugalharmony.com
- harmony-dates.com (a Facebook page with a link to the preceding web address)
- Serious Dating live with Harmony (a Facebook page)

Absence of confusion

18. Mr Magill refers to the average consumer and the time they spend signing up to dating services and considering terms and conditions and subscription details etc. He states that the process is not an impulsive decision or purchase. He states that any prudent person would not confuse the marks. He states that the opponent has not produced any evidence of confusion despite the fact that he has been operating his service for three years. He provides a print of the three logos together, including the match[♥] mark, the logo which Mr Magill uses, and the logo for eHarmony.co.uk. Whilst this is noted, the logos actually used are not pertinent because it is the mark as filed/registered which must be considered.

19. M Magill comments on the claim that the opponent's goodwill will be damaged by the use of his mark. Mr Magill then comments and provides supporting material showing that some of the opponent's customers were unhappy with its service which demonstrates, in Mr Magill's view, that match.com is not a high quality service.

20. Mr Magill provides what he considers to be another example of how trade marks can share generic elements. The example he gives (in Exhibits PDF 5/6) is of FORD MOTOR COMPANY and GENERAL MOTORS, both using the word MOTOR/S.

The opponent's reply evidence

21. This comes from Ms Moustaka. She highlights that, as opposed to being matchedharmony.date, Mr Magill's service was originally called matchedharmony.com. Archive prints showing this are provided in Exhibit EM-A.

22. In terms of the difference in definitions between match and matched, Ms Moustaka considers them to have a connection and some similarity. She then goes on to consider the claimed differences between the services. One of the key points made, which I will return to, is that the opponent's services are not limited in any way. I do not consider it necessary to summarise the evidence further on this point.

23. In terms of the third party marks which include the word MATCH, she states that, if filed today, they would be challenged by the opponent due to the more robust enforcement policies it now adopts. She additionally states that a business decision (of an unspecified nature) was taken when deciding not to challenge the "mobile match" mark. She states that since 2012 no UK marks have been registered containing the word MATCH in relation to dating services. Ms Moustaka considers that the examples of other dating websites which have the word match in them is not pertinent because this dispute is not about domain name registrations. She further notes that some of these websites are not UK based.

24. In relation to the use of the word matches in the phrase "view your matches", Ms Moustaka states that this is just one example and such use is not in a trade mark context. She states that Mr Magill has applied to register the mark as a trade mark because he wants it as a brand.

25. Ms Moustaka does not accept that the word HARMONY is generic in the industry. She sees Mr Magill's mark as an attempt to combine the branding elements of two industry leaders.

26. In relation to the negative reviews highlighted by Mr Magill, Ms Moustaka states that match.com has millions of members so the negative comments were from a tiny

proportion of its customers. She does not consider this to be persuasive evidence that the opponent's services are not high quality ones.

Section 5(2)(b)

27. Section 5(2)(b) of the Act states that:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

29. Before making any comparisons, I should deal with Mr Magill's point that the services are not similar despite both being in the online dating industry. I stated earlier that I did not need to summarise Mr Magill's evidence about the difference between the services. This is because the test before the tribunal is a notional one based upon the specifications that have been applied for, or registered. The specifications of the earlier marks are not limited to any form or subset of dating and, therefore, notionally speaking, cover all forms of dating service. Therefore, even if the services are actually marketed in different ways in trade, this is not pertinent.

30. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade"¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

"..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

31. Services can be considered identical if one term falls within the ambit of the other, as per the decision in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (*Merica*):

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

32. Mr Magill seeks to register his mark for the following services:

Class 45: Online dating via a website, dating service.

33. The match.com mark covers:

“Information and consultancy services in the nature and field of on-line dating and introduction services”.

34. Despite the fact that the specification of the earlier mark begins with “information and consultancy”, the specification goes on to identify that this is in the nature and field of online dating and introduction services. Being in the nature of online dating means that its very nature is of an online dating service. Therefore, I consider this to be identical to the services of the applied for mark which cover online dating services per se. The second applied for term (dating service) includes online dating so is identical on the same basis. If I am wrong on my interpretation, the services must nevertheless be similar to a very high degree given the clear overlap between an online dating service per se, and information and consultancy relating to online dating.

35. The other two earlier marks cover:

“Providing social introduction and date-arranging services; administering personality and physical attractiveness testing and creating personality and physical attractiveness profiles of others; dating agency services; match-making services; computer dating services; provision of dating agency services via the Internet; provision of dating agency services via television, radio and telephone; agency services which arrange personal introductions; social escorting services; information and advisory services relating to the aforesaid services; providing information regarding on-line dating and introduction services.”

36. Given the breadth of the above specification, the services are likewise identical.

Average consumer and the purchasing act

37. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

38. Mr Magill has referred to the consumer as being those who have passed “the intelligence test”. The average consumer is not, however, required to have a particular

level of intellect. They are, however, deemed to be reasonably well-informed and reasonably circumspect. The point Mr Magill is attempting to make is that the services are not casual or impulse selections, and, instead, are more considered selections driven, for example, by the reading of terms and conditions etc. The opponent submits that the selection process is a casual one due to the average consumer using apps on mobile phones etc to use the services, that multiple dating services will be used at the same time and that the apps will be used whilst doing other things such as watching television or commuting on the train. Whilst I do not necessarily agree with Mr Magill that the potential reading of terms and conditions is overly significant, I nevertheless agree that the selection (as opposed to the subsequent use of something which has already been selected) of an online (or other type of) dating service is not a casual process. The average consumer will need to consider issues such as cost, how the service works, will it find suitable dates for him/her? This is not a casual approach. However, having said that, I do not consider that this equates to the services being highly considered. The selection process is, in my view, a normal reasonably considered one, not materially higher or lower than the norm.

39. It seems to me that the marks will most likely be encountered via visual media, by way of the average consumer perusing website, brochures, advertisements etc. However, the aural impact of the marks should not be ignored completely as the services could be subject to word of mouth recommendations etc.

Comparison of marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

42. Mr Magill comments in his submissions that the actual logos and forms of presentation that are actually used in trade differ. This, as alluded to earlier, is not pertinent. I must consider the notional and fair use of the marks which have been applied for/registered. The marks to be compared are:

matchedharmony v MATCH.COM


matchedharmony v 

matchedharmony v MATCH.CO.UK

43. In terms of the overall impressions, Mr Magill’s mark is comprised of two ordinary English words “matched” and “harmony” combined. Mr Magill highlights that the mark comprises one word which should not be artificially dissected. Whilst this point is borne in mind, I consider it clear that that the average consumer will easily see the two words in question and appreciate that they have merely been conjoined. That said, neither visually or aurally does either word materially dominate the other. In terms of concept, the word “matched” qualifies the word “harmony”, so meaning that harmony is the element which will have greater conceptual focus. I bear in mind the point submitted by the opponent that the beginnings of marks tend to have greater importance, however, this is, of course, just a rule of thumb.

44. The overall impression of all the earlier marks will be dominated by the word MATCH (given that the rest of the marks comprise either top level domain indicators or a small device of a heart), although the other elements are not to be ignored from the comparison because they still play a role, albeit a lesser one.

45. Visually, the fact that all of the marks begin with the letters/word match-/MATCH creates a degree of visual similarity. However, there are a number of differences: the additional “ed” at the end of “match” in the applied for mark, the additional word “harmony”, the longer visual impression as a whole. I consider there to be only a low degree of visual similarity.

46. Aurally, the fact that all the marks begin with the same “match-“ sound creates some similarity, but the additional three syllable word creates a difference, and a further difference is created in the first and third earlier marks on account of the additional articulations of .com and .co.uk. It is also noted that the beginning sound is longer in the applied for mark because of the further sound created by the letters “ed” at the end of match, although I accept that this difference is not as significant as the other differences. I consider there to be a low degree of aural similarity with  and a very low degree of aural similarity with the other earlier marks.

47. Conceptually, the meaning of the earlier marks falls primarily on the word MATCH; a word which indicates a good combination of something. Whilst I accept that the word matched is not a million miles from such a meaning, it is the whole phrase “matchedharmony” that much be borne in mind. From that perspective, the word matched qualifies the word harmony, indicating harmony that has in some way been matched. Thus, the concepts overall are not the same, nor are they particularly similar. Any similarity based solely on the concept of matching is, in my view, weak.

Distinctive character of the earlier mark

48. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma*

AG, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

49. From an inherent perspective, the word MATCH per se is extremely weak in distinctiveness. I accept that Mr Magill’s evidence is not the strongest because the websites he mentions are not all UK based and because they do not establish the position before the relevant date, nor is the one example he provides of the word match being used (in the sense of “see your new matches”) very persuasive as it is just one example. Nor do two marks on the register tell the tribunal much of anything. In his submissions Mr Magill states that the opponent has not shown that the word MATCH is not used, however, the onus is not on the opponent. Nevertheless, the dictionary meaning of the word is clear and I think one can accept on judicial notice that the word match, in the context of matchmaking, is a well-known expression. The inherent distinctiveness is added to due to the addition of a heart and domain names, but then

to only a low degree. That said, it is the distinctiveness of the point of similarity that is key.

50. That then leads to the use that has been made of the marks. It is clear from the evidence that the opponent is one of the leading players in the online dating world. The opponent's earlier MATCH.COM mark will be very well-known. Whilst the use is of the mark as a whole, it is, I think, fair to assume that the distinctiveness of the word MATCH per se will have increased also which, in turn, will rub off on the other earlier marks. I cannot say that the other two marks as a whole are likewise well-known. There is no use of the mark ending with .co.uk. There is use of *match*[♥] but it is not clear when this mark was introduced or how much of the use was made before the relevant date.

Likelihood of confusion

51. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

52. It is highly improbable that the differences between the marks will go unnoticed notwithstanding the concept of imperfect recollection. Therefore, even though the services are identical, there is no likelihood that the marks will be directly confused.

53. In terms of indirect confusion, had the opponent's marks (or at least its MATCH.COM mark) not been the subject of extensive use, the answer to this question would have been straightforward. The average consumer would not put the common presence of match- at the beginning of these marks down to the economic providers being the same or being related. They would instead put the commonality down to the

co-incidental use of a common English word(s) which has a particular descriptive resonance for the services at issue. However, the added factor here is the extensive use of MATCH.COM and that, in my view, it could be said that MATCH per se may be seen as a reference to the opponent. In its submissions, the opponent refers to the fact that the applicant is seeking to register its mark as a brand and that this is not, therefore, simple descriptive use. I have carefully considered these points, however, my finding is that there is still no likelihood of (in)direct confusion. This is because the use of match in the applied for mark, or more accurately “matched”, is a form of qualifying use, qualifying the word harmony. The impact of this is that the average consumer will not see the matched aspect of the mark as indicating trade origin. The fact that it may be in a trade mark (or brand) is not enough when the whole mark is considered. They will still see it as some form of descriptive use of the word, albeit it within a trade mark, with some resonance in the particular field. **The opposition under section 5(2)(b) fails.**

54. I should stress that the points Mr Magill made in his written submissions as to the absence of any legal challenge by the opponent as to, for example, the infringement of its marks is not pertinent. I must simply decide, based on the facts before me, whether the grounds of opposition are applicable. I was also not taken with Mr Magill’s point about the absence of confusion because the extent of his use is not clear, which means that is not clear what opportunity for confusion has arisen. Further, the mark as used is not exactly the same as the mark applied for.

Section 5(4)(a) – passing off

55. Section 5(4)(a) of the Act reads:

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

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

(b)...

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

56. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

57. It is clear that the opponent has the necessary goodwill to overcome the first hurdle set out above. However, in terms of misrepresentation, it is logical to conclude that if there is a no likelihood of confusion then, similarly, there will be no misrepresentation for similar reasons as I have already given. In its written submissions the opponent refers to the use of other match based marks such as MATCH AFFINITY. This is akin to a family of marks argument. However, there is no mention of such a claim in the opponent's statement of case, and no mention of any other signs relied upon under section 5(4)(a). This is reason enough to say that the family of marks argument should fail. In any event, the structure of the applied for mark and the qualifying nature of the word matched still means, in my view, that there would be no misrepresentation even if the additional use as part of the claimed family of marks was to be considered. **The ground under section 5(4)(a) fails.**

Section 5(3) of the Act

58. Section 5(3) of the Act reads:

“5-(3) A trade mark which-

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

59. The leading cases are the following CJEU judgments: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the later mark would cause an average consumer to bring the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

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

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

Reputation

60. In *General Motors* the CJEU stated:

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

61. Given what I have said earlier, I accept that the MATCH.COM mark has the requisite reputation in respect of, essentially, online dating services. It is a particularly strong reputation.

The required link

62. In addition to having a reputation, a link must be made between the subject trade mark and the earlier marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

63. In *Intel* the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

– the existence of the likelihood of confusion on the part of the public”.

64. Whether there is link is another multifactorial assessment. Most of the factors have already been assessed under section 5(2)(b). There is no reason why the assessment of those individual factors should be any different under section 5(3). I come to the view that the fairly low level of similarity between the marks overall, despite the services being identical, and despite the earlier mark enjoying a strong reputation, no link will be made. The way in which the “matched” element blends with, and qualifies, the word harmony (on which more focus will be placed), together with the inherently descriptive nature of that word, means that in the context of dating services, the relevant consumer will not bring MATCH.COM to mind. As part of its argument under section 5(3), the opponent highlights that another major player in the online dating world is E-HARMONY and that, therefore, Mr Magill has deliberately combined an element of the opponent’s mark with an element of the E-HAMRONY mark in order to gain an unfair advantage. Whilst the submission is noted, this gets the opponent nowhere if a link with its mark is not established. Further, there is nothing in the evidence that suggests the deliberate intention that the opponent claims.

Conclusion

65. The opposition fails.

Costs

66. The applicant has been successful in these proceedings and is entitled to a contribution towards his costs. Mr Magill gave an indication of the time he spent on dealing with certain matters. These were:

- i) 3 hours for the Notice of opposition
- ii) 20 hours for the Notice of Defence
- iii) 2 hours for considering the forms of the other side
- iv) 20 hours for preparing and considering evidence
- v) 20 hours for preparing written submissions.

67. The hours claimed for the Notice of Opposition must have been in error because Ms Magill did not complete such a notice. He no doubt considered the opponent's Notice of Opposition, but this is dealt with in the third of his claims, a claim which is reasonable. In terms of item ii), the counterstatement provided is short, running to less than two pages, with Mr Magill setting out the basis of his defence. 20 hours seems excessive for what was produced. I will make the assessment based on 5 hours. In terms of item iv), 20 hours seems reasonable. Finally, item 5 is for the preparation of written submissions. I doubt that they would have taken the same length of time to produce as Mr Magill spent considering and compiling evidence. I will make the assessment based on 10 hours. In view of this, my assessment on costs is to be based on the following, what I consider reasonable and proportionate amounts of time:

Considering the statement of case and filing a counter-statement – 7 hours (2 hours for considering the form, 5 hours for preparing/filing counterstatement)

Filing and considering evidence – 20 hours

Preparing written submissions – 10 hours

Total – 37 hours

68. Mr Magill did not indicate any hourly rate at which he thought he should be compensated. The minimum rate given in The Litigants in Person (Costs and Expenses) Act 1975 is £18 per hour. I consider it appropriate to apply such a rate here. This means that I award the following costs.

Considering the statement of case and filing a counter-statement – £90

Filing and considering evidence (including submissions) – £360

Preparing written submissions – £180

Total – £666

69. I order Match.com, L.L.C. to pay Mr Robert Magill the sum of £666 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of February 2017

**Oliver Morris
For the Registrar,
The Comptroller-General**