

IN THE MATTER OF THE TRADE MARKS ACT 1994

**AND IN THE MATTER OF TRADE MARK APPLICATION NO 3127314
BY ROBERT MAGILL**

**AND IN THE MATTER OF OPPOSITION NO 405822
BY eHARMONY INC**

**ON APPEAL FROM THE DECISION OF
MR OLIVER MORRIS DATED 10 FEBRUARY 2017**

DECISION

1. This is an appeal from a decision of Mr Oliver Morris, the Hearing Officer for the Registrar, in which he upheld an opposition by eHarmony Inc ("the Opponent") to a trade mark application for a word mark MATCHEDHARMONY for services in Class 45, namely "online dating via a website, dating service." Mr Robert Magill, the applicant for the MATCHEDHARMONY mark, appeals against that decision.

Background

2. Mr Magill describes himself as the "project co-ordinator" of matchedharmony.com, a community dating project. He filed the trade mark application in issue on 16 September 2015, and it was published for opposition purposes on 9 October 2015.
3. The Opponent opposed the application pursuant to sub-sections 5(2)(b), 5(3) and 5(4)(a) of the 1994 Act. It relied upon two earlier EUTMs: No. 4118709 for EHARMONY, which is registered for "Personal services rendered by others to meet the needs of individuals" in Class 45 and No. 8165136 EHARMONY COMPATIBILITY MATCHING SYSTEM, which is registered for "introduction services: dating services; matchmaking services" also in Class 45. The objection under sub-section 5(4)(a) relied upon goodwill claimed in the sign EHARMONY in relation to "introduction services: dating services; matchmaking services" on the basis of its use of the mark since 2008.

4. Both parties filed evidence. Neither side requested a hearing before the Hearing Officer but both filed written submissions. Mr Magill acted in person throughout the proceedings.

5. The Hearing Officer decided the opposition on the basis of the objection under sub-section 5(4)(a). He found, in summary:
 - i. The relevant date for the establishment of the Opponent's goodwill was earlier than the date of Mr Magill's trade mark application, as use of that mark had commenced in about September 2013. The relevant date was therefore taken as September 2013.
 - ii. The Opponent had a particularly strong goodwill in relation to the provision of an online dating service under the EHARMONY name.
 - iii. Differences in the respective services provided to date by the parties were irrelevant, because Mr Magill's application had to be considered a notional basis in relation to the full specification for which registration was sought.
 - iv. There would be a misrepresentation because a substantial number of people believe that the services offered under Mr Magill's Mark were those of the Opponent.
 - v. This would lead to damage.
 - vi. As the objection under sub-section 5(4)(a) was made out, it was not necessary to deal with the objections under sub-sections 5(2)(b) or 5(3).

6. The Grounds of Appeal raised a number of points which I can summarise as follows:
 - a. The Hearing Officer disregarded evidence that the term "harmony" was used generically in the UK dating industry.
 - b. The Hearing Officer erred in failing to appreciate the differences between the parties' marks and in particular by finding that in the mark applied for the word "harmony" had more importance than "matched". He wrongly dissected the MATCHEDHARMONY mark.
 - c. The Hearing Officer failed to give due regard to the "ordinary prudence" which would be exercised by the average consumer of such services, their sophistication and intelligence.

- d. The Hearing Officer failed to appreciate the differences in the services actually offered by the parties.
 - e. The Hearing Officer was biased and his views were wrongly coloured by submissions made by the Opponent about copying of its logo.
7. The Opponent filed a Respondent's Notice, claiming that the Hearing Officer ought also to have found in its favour on the basis of sub-sections 5(2)(b) and 5(3).

Standard of review

8. This appeal is by way of review. The principles applicable on an appeal of this kind were recently considered in detail by Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (BL O/017/17) at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch).

“(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (REEF). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson* and others)."

9. Further comments on the nature of an appeal to the Appointed Person were made by Mr Iain Purvis QC in *Rochester* BL O/049/17, and he said at [33]:

"... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person.

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case."

10. I have borne these principles in mind on this appeal.

Merits of the appeal

The Hearing Officer disregarded evidence that the term "harmony" was used generically in the UK dating industry.

11. One of the exhibits to Mr Magill's witness statement consisted of webpages taken from a number of websites offering quite a variety of different sorts of dating services, all of which used the word harmony in one way or another, some as a part of their name or domain name. Mr Magill told me in a note that he sent to me after the hearing that all of the sites were in operation in the UK, although that contention was not made in his witness statement. Indeed, no evidence was given as to the extent or duration of those third party uses of the word HARMONY. I note that some of the sites appear to offer services internationally and at least one of the pages exhibited contained text in German.

12. The Hearing Officer noted at paragraph 20 of the decision Mr Magill's contention that the word harmony was used generically in the dating industry and referred to the websites mentioned above. He considered the impact of that evidence at paragraph 43 of the decision, where he said

"I am not persuaded by Mr Magill's accompanying claim that the word HARMONY is used generically in the UK dating industry and therefore the only part of its mark which is unique is the letter E (which in context means electronic harmony or online harmony). I do not consider that HARMONY is a descriptive term per se. I accept, though, that it has some inherent suggestive qualities. However, the use made by the opponent of the EHARMONY mark means, in my view, that members of the public would associate the HARMONY name with the opponent due to its prominent use as part of its name."

13. The Hearing Officer therefore clearly took into account Mr Magill's argument that HARMONY is a term used generically in the dating industry, and rejected that point on the basis of the evidence before him. The evidence was very limited and it seems to me that the conclusion reached by the Hearing Officer was one which was plainly open to him on the evidence which had been presented to him. It does not seem to me that there was any appealable error in the Hearing Officer's conclusion on this point.

The Hearing Officer erred in failing to appreciate the differences between the parties' marks and in finding that in the mark applied for the word "harmony" had more importance in relation to the mark/sign than "matched". He wrongly dissected the MATCHEDHARMONY mark.

14. Mr Magill criticised the Hearing Officer's analysis of the difference between the parties' respective marks. At paragraph 43 of the decision, the Hearing Officer said:

"In relation to the mark/sign matchedharmony v EHARMONY, it is clear that there are some differences, however, I consider it clear that members of the public will appreciate that both marks make use of the term HARMONY even when one takes into account that marks should not be artificially dissected (as Mr Magill points out)."

In the light of those comments, I am not persuaded that the Hearing Officer did fall into error by artificially dissecting Mr Magill's mark.

15. Moreover, whilst I appreciate that Mr Magill takes the view that the marks are different, it seems to me that the Hearing Officer was entitled to find that there was some similarity between them. I do not see any error in the Hearing Officer's reasoning on this point which would justify interference with his conclusion.

The Hearing Officer failed to give due regard to the "ordinary prudence" which would be exercised by the average consumer of such services, their sophistication and intelligence

16. This point was raised in two ways in the Grounds of Appeal. First, Mr Magill suggested that the Hearing Officer did not have due regard to the standards of ordinary prudence which would be exercised by the average consumer for both parties' services, and secondly he suggested that Mr Morris overlooked the sophistication and intelligence of customers, bearing in mind the amount of time they would have to spend on the parties' respective web portals in order to use their dating services.
17. The Hearing Officer dealt in paragraph 44 of his decision with the question of the level of care which would be used by the average consumer. He expressly rejected Mr Magill's submission that the service in question would be "highly considered" and found that just a normal level of care would generally be applied. Both of Mr Magill's points were largely based upon the differences between the parties' respective businesses to date. However, the Hearing Officer had to consider the possibility of a misrepresentation arising in relation to any kind of dating service, given the breadth of Mr Magill's trade mark specification. I do not consider that there was any error in his approach in this respect.

The Hearing Officer failed to appreciate the differences in the services actually offered by the parties

18. It seems to me that the Hearing Officer plainly did understand that the way in which the parties had provided their respective services differed. In paragraph 42 of the decision he said:

“A common field of activity is not a prerequisite to found a passing off claim ... However, a presence of a common field is clearly a highly important factor. In the case before me there is a clear overlap in the services to be provided. Although Mr Magill states that the services are different (due to the use of astrological as opposed to physiological algorithms being used and the different forms of marketing utilised) this in my view is not pertinent because Mr Magill's application must be considered on a notional basis which would include the exact same services that provided by the opponent.”

19. The Hearing Officer had therefore taken the differences between the parties' respective services into account, but rightly took the view that he had to consider the potential impact of the specification applied for rather than the past use of the MATCHEDHARMONY sign. There is no error in that part of his decision.

The Hearing Officer was biased and his views were wrongly coloured by submissions made by the Opponent about copying of its logo

20. In the Grounds of Appeal, Mr Magill contended that the Hearing Officer had approached the opposition with a "biased mind." He submitted that the Hearing Officer's view was "contaminated" by an argument raised by the Opponent only at a late stage in the proceedings, as to the inferences to be drawn by Mr Magill's use of a logo said to be similar to that used by the Opponent.

21. The point was first raised in the Opponent's written submissions dated 29 November 2016. At paragraph 67 of those submissions, the Opponent suggested that Mr Magill had adopted a virtually identical logo to one used on the Opponent's website and that it was implausible that the two images were independently created. The Opponent

contended that the image was adopted to suggest an association with its services and this cast doubt on Mr Magill's evidence about the manner in which he chose his mark. Rather similarly, in paragraph 68 of the submissions, the Opponent suggested that Mr Magill had deliberately chosen a colour scheme resembling that of the Opponent.

22. Mr Magill wrote to the IPO objecting to those submissions and pointing out that the logo complained of had been registered as a trade mark, whilst the point about the similarity of the logo had not been raised at an earlier stage in these proceedings. The IPO wrote to the parties on 13 December 2016 saying:

"The Hearing Officer ... observes that the opponent's earlier marks/rights relied upon are not logo marks and neither is the challenged mark, consequently, the use or registration of the parties' logo marks are not relevant to these proceedings. The opponent's submissions regarding any similarity of logos is irrelevant to its pleaded case, as are any submissions regarding the intentions of the applicant.

Parties are free to make submissions (as opposed to presenting evidence) that they believe support their case, consequently, the hearing officer will not direct that the opponent's submissions are partly struck out, as requested by Mr McGill, but he will give the appropriate weight to arguments made. Finally, in order to avoid further unnecessary costs and time, he encourages the parties not to make further submissions on the parties' various uses/registration of logo marks or regarding the applicant's intentions."

23. Mr Magill suggested that the Hearing Officer had not covered this point properly in his decision and must have been improperly influenced by the Opponent's submissions about the logo. However, the Hearing Officer did deal with the point at paragraph 45 of his decision. He said:

"I flag here that Mr Magill complained in a letter following the provision of written submissions that the Opponent had alleged that he intended to deceive. The main reasons why this was put forward were based on Mr Magill's mark being a combination of two words used by two of the leading players in the market with "matched" being taken from MATCH.COM and HARMONY

from EHARMONY, together with the fact that a logo initially used by Mr Magill was reminiscent of the logo used by the opponent. Whilst this is noted, it is not necessary to determine the matter of intent because i) deception may still be found even in innocent circumstances, ii) the opponent's argument is partly based on something (the logo) which is not included in the mark Mr Magill is seeking to register and iii) I am already persuaded that misrepresentation would occur."

24. In the circumstances, it does not seem to me that there is any force in Mr Magill's submission that the Hearing Officer was biased against him by reason of the point raised about the logos, but it is clear that Mr Morris understood that he should not take that point into account. I see no reason to conclude that the Hearing Officer was merely paying lip service to this point, given the conclusions which he had already set out as to the strength of the Opponent's goodwill and the likelihood that misrepresentation would arise.
25. For all these reasons, the appeal is dismissed and I do not need to consider the Respondent's Notice.
26. As is usual, costs should follow the event. I will order Mr Magill to make a contribution towards the Opponent's costs of the appeal in the sum of £750, which sum is to be paid together with the costs awarded by the Hearing Officer by 5 pm on Friday, 14 July 2017.

Amanda Michaels
The Appointed Person
29 June 2017

The Appellant appeared in person

Mr Ian Gill of A. A. Thornton & Co appeared for the Respondent