

O/0488/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003581959
IN THE NAME OF ISOMOB LTD
FOR THE TRADE MARK**

FLIRTFINDER

IN CLASS 45

AND

**THE OPPOSITION THERETO UNDER NO. 424943
BY VARIOUS, INC.**

Background and pleadings

1. On 20 January 2021, Isomob Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK.

2. The application was accepted and published in the Trade Marks Journal on 12 March 2021 in respect of the following services:

Class 45: *Dating services; Computer dating services; Internet dating services; Internet based dating, matchmaking and personal introduction services.*

3. On 14 June 2021, VARIOUS, INC. (“the opponent”) opposed the application under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. Under Sections 5(2)(b) and 5(3), the opponent relies on the five trade marks and services set out below:

UK00906972822 (“the first earlier mark”)

FRIEND FINDER

Filing date: 09 June 2008; Registration date: 09 August 2010

Priority date: 05 May 2008

Class 38: *Providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information; broadcasting services, namely, uploading, posting, showing, displaying, tagging and electronically transmitting images, audio, video and audiovisual content and other information; providing on-line chat rooms for users to transmit and receive messages and other information; providing on-line databases; providing access to websites featuring images, audio, video and audiovisual content, and other information.*

Class 42: *Hosting and maintaining virtual communities and facilities for them; social networking services, namely, providing a means to foster, become part of,*

participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them.

Class 45: *Social networking services, namely, providing a mean to foster, becoming part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them; dating services.*

UK00801042402 ("the second earlier mark")

ADULTFINDER.COM

Filing date: 11 June 2010: Registration date: 29 May 2013

Class 45: *Online social networking services.*

UK00906973218 ("the third earlier mark")

ADULT FRIEND FINDER

Filing date: 09 June 2008: Registration date: 09 August 2010

Priority date: 05 May 2008

Class 38: *Providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information; broadcasting services, namely, uploading, posting, showing, displaying, tagging and electronically transmitting images, audio, video and audiovisual content and other information; providing on-line chat rooms for users to transmit and receive messages and other information; providing on-line databases; providing access to websites featuring images, audio, video and audiovisual content, and other information.*

Class 42: *Hosting and maintaining virtual communities and facilities for them; social networking services, namely, providing a means to foster, become part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal,*

educational or professional experiences, personal, educational or professional contacts, or other points of interest among them.

Class 45: *Social networking services, namely, providing a mean to foster, becoming part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them; dating services.*

UK00903693843 ("the fourth earlier mark")

FriendFinder

Filing date: 03 March 2004: Registration date: 11 September 2007

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

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

UK00903693876 ("the fifth earlier mark")

AdultFriendFinder

Filing date: 03 March 2004: Registration date: 11 September 2007

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

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

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

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the applicant's mark is similar to its own marks, and the respective services are identical or similar.

7. Under Section 5(3), the opponent claims a reputation in relation to the services for which the marks are registered and states that use of the applicant's mark would, without due cause, take unfair advantage of or be detrimental to the distinctive character or repute of the earlier marks.

8. Under Section 5(4)(a), the opponent relies on the signs 'FRIEND FINDER' and 'ADULT FRIEND FINDER' which it claims to have used throughout the UK since 2008 in relation to:

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

Social networking services, namely, providing a mean to foster, becoming part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them; dating services.

9. The opponent also relies on the following signs:

- The sign 'ADULTFINDER.COM' which it claims to have used throughout the UK since 2010 in relation to *Online social networking services*;
- Two signs identical to its fourth and fifth earlier marks respectively, which it claims to have used throughout the UK since 2004 in relation to *Providing for personal use online electronic publications, journals and magazines; publication for personal use of books, journals and magazines online; provision for personal use of information relating to educational, entertainment, social, sporting and cultural activities; providing for personal use event listing via the Internet and electronic mail; dating services; providing personal profiles via the Internet and electronic mail.*

10. The opponent claims that use of the applicant's mark would be contrary to the law of passing-off.

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

12. Both parties filed evidence during the evidence rounds, with the opponent also filing evidence in reply. In addition, the applicant filed written submissions dated 29 November 2022. I shall refer to the evidence and submissions to the extent that I consider necessary.

13. The opponent is represented by D Young & Co LLP and the applicant by Lewis Silkin LLP. Neither party asked to be heard but the opponent filed submissions in lieu. This decision is taken following a careful perusal of the papers.

EU Law

14. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

15. The opponent's evidence-in-chief consists of a witness statement by Ezra Shashoua, the chief financial officer at the opponent's company. Mr Shashoua's witness statement is dated 30 June 2022 and is accompanied by 5 exhibits (ES1 – ES5). In response to the applicant's evidence, Mr Shashoua filed a second witness statement dated 31 January 2013 with a further 10 exhibits (ES6-ES16).

16. The applicant's evidence-in-chief consists of a witness statement by Duncan Balloch, the applicant's legal representative in these proceedings. Mr Balloch's witness statement is dated 29 November 2022 and is accompanied by three exhibits (DB1-DB3).

DECISION

Proof of use

17. Section 6A states as follows:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

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

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

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

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

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

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

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

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

19. Section 100 of the Act is also relevant, which reads:

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

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

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

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29];

Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at

[22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

21. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the date of the application in issue, namely 21 January 2016 to 20 January 2021.

22. As all of the earlier marks relied upon by the opponent are comparable marks based upon an earlier EUTM or an earlier IR designating the EU, use of the marks in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment. This means that for the periods until 31 December 2020, the relevant jurisdiction for the proof of use assessment is the EU. However, for the period 1 January 2021 to 20 January 2021, the relevant territory for the proof of use assessment is the UK only. On the point of use in the EU, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same

time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

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

Proof of use assessment

24. In his evidence, Mr Shashoua states that:

- the opponent began using the earlier marks in the UK since at least as early as 2000 and the marks have been used continuously since this date;
- the opponent operates the following websites, all of which have members within the UK:

www.ffn.com;

www.adultfriendfinder.com

www.adultfriendfinder.co.uk

www.friendfinder.com

www.asianfriendfinder.com

www.seniorfriendfinder.com

www.jewishfriendfinder.com

www.adultfinder.com (which defaults to

https://blog.adultfriendfinder.com/adultfind/)

- UK revenue under the mark 'ADULT FRIEND FINDER' is said to be over \$25,000,000 between 2015 and 2021. Annual revenue figures under the brand 'ADULT FRIEND FINDER' and 'FRIENDFINDER' are as follows:

'ADULT FRIEND FINDER'

2021: \$2,803,059.77
 2020: \$2,635,105.15
 2019: \$2,934,035.40
 2018: \$3,923,545.70
 2017: \$3,531,024.70
 2016: \$4,241,163.13
 2015: \$5,427,587.55

FRIENDFINDER:

2021: \$1,579.69
 2020: \$3,649.36
 2019: \$5,227.62
 2018: \$6,950.16
 2017: \$3,430.15
 2016: \$6,451.07
 2015: \$9,933.46

However, no information has been provided to explain how the UK revenue is generated, i.e. whether from advertising or from the users of the websites paying a fee;

- Global advertising figures are provided for only two years, being \$83,393,000 in 2019 and \$94,132,000 in 2020, however, there are no specific figures for the UK or the EU;
- In April 2017, there were over 8.5 million users in the UK on ADULT FRIEND FINDER, however, it is not clear how this information has been gathered but the only supporting evidence are copies of webpages from www.adultfriendfinder.co.uk showing for each country the number of users in bracket, the UK number being 8,669,333;
- the opponent's primary website 'ADULTFRIENDFINDER' and its relating 'dating' services have been the subject of articles and profiles within the UK; two are mentioned, namely UK Review (2020) and UK Review (2022), however, there is no information about these articles or the circulation figures and there is no evidence supporting this statement;¹
- The ADULTFRIENDFINDER website has received several prestigious awards including as Dating Company of the Year in 2020 and 2022 and as Affiliate Program of the Year – Dating in 2015. No further information or evidence is provided about these awards but an image of a 2016 award shows that it is for the website adultfriendfinder.com, which suggests that it was a USA award² – a fact which is also confirmed by the applicant in its submissions;
- In his second witness statement, Mr Shashoua provides two tables attesting the number of unique visitors from the UK to the FRIEND FINDER (www.friendfinder.com) and ADULT FRIEND FINDER (www.adultfriendfinder.com) websites. He also points out that the figures are significant with over 245,000 unique UK visitors in 2019 alone:

¹ The opponent's provided some links, which are not admissible as evidence, but the applicant states that having clicked on the links they are endorsements paid by the Adultfriendfinder website.

² Exhibit 3

Friend Finder	
yr	uniques
2015	678831
2016	442875
2017	284977
2018	226442
2019	248641
2020	154185

Adult Friend Finder	
yr	uniques
2015	44393863
2016	33981021
2017	22145558
2018	21158516
2019	25884673
2020	24482804

However, Mr Shashoua seems to also recognise that the total number of user registrations on ADULT FRIEND FINDER and FRIEND FINDER include fraudulent users and provides a separate table showing that on 1 January 2019 ADULT FRIEND FINDER had over 22,000 registrations with no fraud detected and FRIEND FINDER had over 109 registrations with no fraud detected:

User Registration with and without fraudulent users at 01/19/2021:

Adult Friend Finder

regdate	FFadult_total_reg_no_fraud	FFadult_confirmed_reg_no_fraud	FFadult_total_reg_w_fraud	FFadult_confirmed_reg_w_fraud
2021-01-19	22955	8393	26763	10892

Friend Finder

regdate	FF_total_reg_no_fraud	FF_confirmed_reg_no_fraud	FF_total_reg_w_fraud	FF_confirmed_reg_w_fraud
2021-01-19	109	51	134	67

Mr Shashoua says that the table refers to the total number of registrations globally although and states that other exhibits corroborate the likelihood that a number of these registrations would have been within the UK;

- Articles from UK publications are produced including an article from The Mirror dated 5 February 2016 titled *“Hook-up website adultfriendfinder makes a very naughty promise to anyone looking for casual sex”*. The article states: *“adultfriendfinder boasts 63 million users worldwide including an estimated 7 million British members looking for casual sex”*.

25. The evidence shows that the opponent is a US company with a worldwide business consisting of offering a website which facilitates individuals meeting up for “casual sex”. Although the opponent has provided turnover figures for the UK, it is not clear how the revenue is generated and how the opponent can establish with any degree of certainty that users of its websites are UK-based. The opponent’s own witness, Mr Shashoua, admitted that there are a number of fraudulent registrations and says that it is likely that a number of genuine registrations would have been within the UK, however, this is far from providing clear evidence about the exact number of UK users which undermines the reliability of the turnover figures produced in evidence.

26. Nevertheless, there is evidence that:

- The opponent operates a working website www.adultfriendfinder.co.uk that directly targets the UK. Copies of pages from that website are produced from 2008, 2009, 2010, 2016, 2017, 2018, 2019, which show use of the mark ADULT FRIEND FINDER within the relevant period;
- There are not specific UK marketing figures, but there is evidence of the opponent advertising the UK website between 2016 and 2019 (within the relevant period) through a marketing strategy used to increase the visibility of the website in search engine results page;³
- Although the UK revenue figures are not 100% reliable, there are third party press articles confirming that there were an estimated 7 million users in the UK in 2016. Further, although there is nothing to say whether the turnover accrued from advertising or member’s fees, there is some indication that there is a subscription model (see below) meaning that it is reasonable to conclude that some turnover comes from members’ fees.

27. On balance, I find that the evidence is sufficient to show genuine use of the third earlier mark ADULT FRIEND FINDER within the relevant period in the UK.

³ Exhibit 11

28. Whilst the opponent might have used the words FRIEND FINDER within websites with a top-level domain ending in '.com' (which, I understand, target the USA), there is no evidence that the mark FRIEND FINDER has been used in relation to websites targeting the UK specifically. Further, the UK revenue figures for FRIEND FINDER are very low ranging from below \$2,000 (in 2021) to nearly \$7,000 (in 2018) and although the opponent has provided the number of users, these figures are not reliable, as they include fraudulent users, the only number of genuine users being provided being 109, which is very low indeed. Hence, I find that there is no genuine use of the first and fourth earlier mark.

29. Likewise, use of the mark ADULTFINDER.COM in relation to a website targeting the USA or countries other than the UK is not sufficient to show genuine use of the mark in the UK, in the absence of specific evidence about UK users (which has not been provided in this case).

30. As regard use of the fifth earlier mark, I consider that use of the word mark ADULT FRIEND FINDER counts toward use of the fifth earlier mark, as the impact of the stylisation and hearth devices is minimal.⁴

Fair specification

31. The final point of dispute relates to the terms in which, on the basis of the evidence filed, the services of the opponent may fairly be described.

32. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

⁴ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

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

33. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

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

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

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

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

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

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

34. The third and fifth earlier mark, for which I found that there has been genuine in the UK during the relevant period (use in the UK being sufficient for the purpose of establishing use in the EU prior to IP Completion Day), are registered for the following services:

Third earlier mark

Class 38: *Providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information; broadcasting services, namely, uploading, posting, showing, displaying, tagging and electronically transmitting images, audio, video and audiovisual content and other information; providing on-line chat rooms for users to transmit and receive messages and other information; providing on-line databases; providing access to websites featuring images, audio, video and audiovisual content, and other information.*

Class 42: *Hosting and maintaining virtual communities and facilities for them; social networking services, namely, providing a means to foster, become part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them.*

Class 45: *Social networking services, namely, providing a mean to foster, becoming part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal,*

educational or professional contacts, or other points of interest among them; dating services.

Fifth earlier mark

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

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

35. I shall start with the class 45 services, which, in my view, are the most controversial in this case.

Class 45

36. The registrations in class 45 covers social networking services, dating services and providing personal profiles on the Internet.

37. Cambridge online dictionary defines dating services as “*an organization that introduces people with similar interests to each other, especially people who want to start a romantic or sexual relationship with someone*”. Other online dictionaries provide similar definitions of dating services, namely “*Dating agencies or services are for people who are trying to find a girlfriend or boyfriend*” (Collins) and “*a service that arranges meetings between single people who want to begin a romantic relationship*”. There is no evidence of the opponent offering any introductory or matching services, but the evidence indicates that the opponent’s ADULT FRIEND FINDER website is free to join and that members who do not pay subscription fees can search for members, view profiles and communicate via live chat, whilst paying members enjoy other features, including sending and receiving emails. The evidence is very explicit in showing that the opponent’s website offers access to a database of personal profiles with a view of providing users with sex contacts (the term also used in the evidence is

“hook-up”). I am not convinced that the term dating, as it is understood in the UK – as a service aimed at bringing people together for meaningful relationship - is really appropriate to describe the services provided by the opponent which resolve to facilitating meetings for sex purposes only. Nevertheless, the evidence refers to ADULT FRIEND FINDER as an “adult” dating or “hook-up” site, which is probably how the ordinary consumer would describe the services in evidence. Hence, a fair specification would be *online adult dating services and providing personal profiles on the Internet*.

38. The registered services include *Social networking services, namely, providing a mean to foster, becoming part of, participate in, interact in, get feedback from and learn about communities of people who share interests, activities, goals, beliefs, values, passions, personal, educational or professional experiences, personal, educational or professional contacts, or other points of interest among them*. These services are clearly community centred, whilst the only facility offered by the opponent is access to a database of personal profiles. I find that there is no use in relation to these services.

Class 38

39. In its witness statement Mr Shashoua states that the opponent’s websites consist of *“online personals, social-networking, live video chat, recorded video, online chat rooms, webcams, instant messaging, photo and video sharing, and premium content”*. However, as Mr Balloch’s evidence revealed, there are a number of unrelated brands which are linked to the opponent’s website www.ffn.com which are not relevant to the opponent's earlier rights; a page from www.ffn.com, produced by Mr Balloch, claims that in 1999 Friendfinder merged with Cams.com, a live webcam model site and that since then, Cams.com has become one of the largest providers of model webcams in the world. Therefore, it is not clear whether the alleged live video chat, recorded video, online chat rooms, webcams, instant messaging, photo and video sharing services were provided through the UK website www.adultfriendfinder.co.uk or through other websites. Consequently, I find that there is no genuine use for the following services in class 38:

Providing on-line facilities for users to publish, access, share and exchange images, audio, video and audiovisual content, and other information; broadcasting services, namely, uploading, posting, showing, displaying, tagging and electronically transmitting images, audio, video and audiovisual content and other information.

40. Nevertheless, the copies of the webpages from www.adultfriendfinder.co.uk shows options like 'search our hot members', blogs, video, chats. Consequently, I find that the mark has been used in relation to the following services:

Class 38: *providing on-line chat rooms for users to transmit and receive messages and other information; providing on-line databases of personal profiles; providing access to websites featuring images, audio, video and audiovisual content, and other information, all of the aforementioned being provided in order to facilitate adult dating.*

Class 41 and 42

41. There is no evidence of the opponent providing any services in Class 41.

42. The WIPO website⁵ explains that class 42 covers services provided by persons in relation to the theoretical and practical aspects of complex fields of activities, for example, scientific laboratory services, engineering, computer programming, architectural services or interior design. It is clear that the registered social networking services in class 42 were applied for in the wrong class. As regards the registered *Hosting and maintaining virtual communities and facilities for them*, the services would include hosting websites or web portals for others, which is not what the opponent does.

43. Hence, in summary the services on which the opponent can rely are as follows:

⁵ <https://www.wipo.int/classifications/nice/en/>

Class 38: *providing on-line chat rooms for users to transmit and receive messages and other information; providing on-line databases of personal profiles; providing access to websites featuring images, audio, video and audiovisual content, and other information, all of the aforementioned being provided in order to facilitate adult dating.*

Class 45: *online adult dating services; providing personal profiles on the Internet.*

Section 5(2)(b)

44. Section 5(2)(b) of the Act is as follows:

“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”.

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

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

46. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

47. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, CJEU stated that:

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

48. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

49. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court (“GC”) clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

50. The GC confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods (though it equally applied to services) are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

51. The services to be compared are as follows:

The applicant's services	The opponent's services
<p>Class 45: <i>Dating services; Computer dating services; Internet dating services; Internet based dating, matchmaking and personal introduction services.</i></p>	<p>Class 38: <i>providing on-line chat rooms for users to transmit and receive messages and other information; providing on-line databases of personal profiles; providing access to websites featuring images, audio, video and audiovisual content, and other information, all of the aforementioned being provided in order to facilitate adult dating.</i></p> <p>Class 45: <i>online adult dating services; providing personal profiles on the Internet.</i></p>

52. The applicant's services *Dating services; Computer dating services; Internet dating services; Internet based dating, matchmaking and personal introduction services* either encompass or are encompassed by the opponent's online adult dating services. These services are identical on the principle outlined in *Meric*.

53. Although the opponent's services in class 38 and the contested dating services in class 45 are in different classes, they have a similar nature, purpose, and methods of use. The services are also in competition and might be provided through the same websites, so trade channels coincide. These services are similar to a high degree. The same goes for *providing personal profiles on the Internet*. These services are similar to a high degree.

Average consumer

54. 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. (as he then was) described the average consumer in these terms:

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


55. The average consumer for the services at issue is the general public over the age of 18. The opponent argues that because the services are inexpensive, a low degree of attention will be deployed when selecting them. I disagree. The average consumer is likely to take into consideration various factors when selecting the services at issue, including, for example, the size of the userbase signed up to the service and the success rate of the services, although it is unlikely that the degree of attention will be particularly high. On the whole, I find that a medium degree of attention is likely to be paid during the purchase for the services. The services are all likely to be sought out primarily by eye on websites and marketing material, so I would expect the purchase to be mainly visual. However, I bear in mind that the services may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind.

Comparison of marks

56. 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.”

57. 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. The respective marks are shown below:

The applicant's mark	The opponent's marks
FlirtFinder	ADULT FRIEND FINDER 

58. The contested mark consists of the combination “FlirtFinder”, presented in lower case with the two letters ‘F’ presented in capital letters. Given that the words ‘flirt’ and ‘finder’ are common words, the average consumer, in my view, will identify the

elements “Flirt” and “Finder” within the contested mark, though neither dominates the other and it will be seen as a unified whole.

59. The opponent’s earlier mark consists of the three words ‘ADULT’, ‘FRIEND’ and ‘FINDER’, presented in capital letters. The mark as a whole will naturally be taken as a reference to the services which resolve in providing users with a mean to find an adult friend. For reasons I will come to discuss later, I consider that ‘ADULT FRIEND’ plays a greater role in the overall impression of the mark.

60. Similar considerations apply to the fifth earlier mark, the only difference being that (a) the words ‘ADULT’, ‘FRIEND’ and ‘FINDER’ are conjoined, however, they will still be identified by the average consumer as separate words and (b) the stylisation and heart devices will be viewed as purely ornamental and do not add much to the overall impression of the mark.

Visual, aural and conceptual similarity

61. In its written submissions, the applicant states:

“It is denied that the marks are similar trade marks. The only element shared between the marks at issue is the word 'FINDER', which is defined in the Merriam-Webster dictionary as "one that finds". The applicant submits that the term 'FINDER' is entirely descriptive of the intended purpose of the opponent's services relied upon in the opposition, namely, that those services enable the average consumer to find a counterpart with whom to connect, socialise or communicate with. It follows that the term FINDER is devoid of distinctive character when applied to the services. Indeed, the verbal elements that comprise the opponent's trade marks (namely, ADULT, FRIEND and FINDER in various combinations) convey an immediate, direct and obvious marketing message and, therefore, are descriptive and devoid of distinctive character. The remaining elements of the opponent's trade marks are dissimilar in their visual, aural and conceptual characteristics. Analysing the marks at issue in their entirety (namely, FLIRTFINDER versus ADUL TFINDER.COM, FRIEND

FINDER and ADULT FRIEND FINDER), there can be no question that they are dissimilar”.

62. The opponent argues that the marks are highly similar. It states:

“The application is highly similar to [the fifth earlier mark] as the signs both start with the letter “F” and share an identical suffix. Due to the likenesses in the number and sequence of the letters, the position of the coinciding letters and the structure of the signs, the marks are similar to a high degree. [...]

With regards to the word mark ADULT FRIEND FINDER, due to the identical suffix, and the marks sharing dominant letters such as “Fs”, “Rs” “Ls” and “Ts”, the opponent contends that the signs should be found to be similar to a medium to high degree”

63. I agree with the applicant that the shared word element ‘FINDER’ is, at its highest, very low in distinctive character, both in the earlier marks and in the contested mark, because it will be readily understood by the average consumer as describing the purpose of the services, which is to provide users with a means to find an adult friend or someone to flirt with, respectively. Further, it must be noted that (i) the word ‘FINDER’ which is the coinciding component in the marks, is positioned at the end of the marks, and that beginning of the marks are generally more focused upon (although I appreciate that the principle is only a rule of thumb, it is applicable in this case); (ii) the non-coinciding components of the marks, namely the words ‘Flirt’ (in the contested mark) and ‘ADULT FRIEND/ADULTFRIEND’ (in the opponent’s marks) are visually, aurally and conceptually different and are placed at the beginning of the marks. Finally, it must also be noted that although the words ‘ADULT FRIEND’ are not particularly distinctive in the context of adult dating services, and the average consumer of the services will understand the words ‘adult friend’ in the opponent’s marks as a reference to a casual sex partner (no great feat of imagination being required), the phrase does not appear in any dictionary I have consulted, and it is a subtle way of referring to types of services which might certainly raise some eyebrows. Hence, I find that the words ‘ADULT FRIEND’ in the opponent’s marks are more distinctive and of significant visual impact in the overall impression than the common element ‘FINDER’. As

regards, the word 'Flirt' in the applicant's mark, whilst it may be of equally low distinctiveness than the word 'FINDER', it is the combination the two words which creates a distinctive whole. In my view, the contested mark and the opponent's first earlier mark are visually and aurally similar to a low degree.

64. Conceptually, the opponent's marks will convey the concept of services which assist users to find an adult friend/casual sex partner, whilst the applied for mark will convey the concept of services which assist users to find someone to flirt with, the definition of flirt being as follows:

"If you flirt with someone, you behave as if you are sexually attracted to them, in a playful or not very serious way.

Dad's flirting with all the ladies, or they're all flirting with him, as usual."

65. Overall, I consider the marks to be conceptually similar to a low to medium degree to the extent that they both contain the word FINDER and another word which refers to a partner. Whilst I accept that flirting is commonly intended to lead to sexual relations and there is a degree of conceptual overlap because at their core both marks will be understood as assisting the average consumer in finding sexual partners, it is also important to note that if the marks convey a similar concept, they do so in different ways, because (a) the words 'Flirt' and 'ADULT FRIEND' are visually and aurally different and (b) conceptually the words 'ADULT FRIEND' convey a more explicit concept than the word 'FLIRT'.

66. Turning to the fifth earlier mark, whilst the conjoining of the words creates an additional similarity, that is not particularly striking or original and it is counteracted by the additional stylisation, hence, I also find that the marks are visually and aurally similar to a low degree and conceptually similar to a low to medium degree.

Distinctive character of earlier mark

67. 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).”

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

69. The opponent’s first earlier mark consists of the word ‘ADULT FRIEND FINDER’. Although the mark is registered, and as such, cannot be said to lack distinctive character,⁶ it is highly allusive (if not descriptive) of the services for which it has been used, namely online adult dating services, providing personal profiles on the Internet (in class 45) and communication services aimed at facilitating adult dating (in class

⁶ Case C-196/11P *Formula One Licensing BV v. EUIPO*

38). The mark is inherently distinctive to a very low degree. The stylisation and hearth devices do not add much to the distinctiveness of the fifth earlier mark which is still very low.

70. The opponent has filed evidence of use. Although I have found genuine use, the evidence presented a number of flaws both as to the number of users, and the methods employed in determining the UK turnover. In particular, it is not clear how the revenue is generated. For example, it is not clear how many UK users are paying users, and it is not said whether any proportion of the revenue figures derives from advertising (rather than subscriptions) – and since advertising is not covered by the registered specifications revenue generated from advertising would not count towards enhancing the distinctiveness of the mark for the registered services. I also note that there is no indication of market share and no information about overall marketing spending in the UK, and that none of the awards the opponent claims to have received relate to its UK business. Hence, I am not prepared to find that the distinctiveness of the opponent's marks has been enhanced through use.

Likelihood of confusion

71. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

72. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

73. Earlier in this decision I found that:

- the competing services are identical or highly similar;

- the relevant consumers of the goods at issue are members of the general public who will select the services visually (although I do not discount aural considerations) paying a medium degree of attention;
- the earlier marks and the contested mark are visually and aurally similar to a low degree, and conceptually similar to a low to medium degree;
- the earlier mark is inherently distinctive to a very low degree and although there has been some use of the mark, it has not materially increased its distinctiveness.

74. The opponent's case is as follows:

"The opponent submits that the overall impression is that when considered in relation to the services in question, FlirtFinder immediately calls the opponent's registrations to the mind of the consumer. The average consumer is likely to see, focus on, and recall the prominent FINDER suffix of the application and the opponent's registrations, noting that the opponent's registrations are easily recognisable since they are so well-known.

According to the principle set down in Lloyd Schufabrik, the average consumer does not often have the opportunity to compare marks side by side but instead, must rely upon the imperfect recollection s/he has kept of the trade marks in her/his mind. When considering the trade marks in question, imperfect recollection is such that consumers could purchase the applicant's services in Class 45, either believing they are offered by the opponent or, at the very least, that there is some connection between the respective companies when there is not. It is therefore possible that consumers would easily assume that the contested services are provided by, or in connection with, the opponent. Even if the Office considers that direct confusion does not exist in this case, it is clear that there is a high risk of indirect confusion. There is a possibility that some consumers will recognise that the application bears a slight variation to the opponent's registrations, but will notice the common elements between the

marks, i.e., shared letters in the prefix and identical suffix, and will conclude that FlirtFinder is another brand of the opponent.

Further, it should be kept in mind that the necessary global assessment of the likelihood of confusion implies some interdependence between the relevant factors and in particular a similarity between the marks and the goods or services in question. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services and vice versa (*Canon v MGM* refers). With this in mind, seeing as how the contested services are identical to the services relied on under the opponent's registrations, the opponent submits that the minor differences between the respective trade marks are likely to go unnoticed by the relevant consumer. If, therefore, it is found that the trade marks are not as similar as the opponent believes, the principle of interdependence must be taken into account in reaching the conclusion that there is a risk of confusion.

On the basis of all the above, the opponent submits that there is a direct (as well as an indirect) likelihood of confusion such that the Application should be refused in its entirety, under the provisions of Section 5(2)(b) of the Act."

75. There are a number of issues with the way the opponent has put forward its case on the likelihood of confusion. First, when the case was originally pleaded the opponent claimed that there would be a likelihood of indirect confusion. It stated:

"It is conceivable that the applicant's trade mark could be mistaken as a new sub-brand of the opponent, or considered to identify services originating from the same undertaking. Overall, there is a likelihood of confusion and association on the part of the relevant consumer."

76. However, the opponent's primary case as set out in its submissions in lieu (which I have reproduced above) is that there is a likelihood of direct confusion. As the likelihood of direct confusion has not been pleaded, I would be justified in rejecting the claim without even considering it. Nevertheless, I will address it later for the sake of completeness.

77. Second, the opponent seems to refer to the wrong test, as it states that the contested mark will call to the mind of the opponent's mark. Aside from the fact that the argument of 'calling to mind' does not sit well with that of direct confusion through imperfect recollection, it is well established that it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

78. Third, the opponent's case is built on two arguments which I have already dismissed, namely (i) that the average consumer is likely to focus on the shared element FINDER and (ii) that the opponent's earlier marks are well-known (and so they would benefit from enhanced distinctiveness).

79. Normally, from my experience, when an opponent finds it difficult to pin down how confusion would occur, it is a good indication that confusion is unlikely. That is the case here.

80. Given the visual, aural and conceptual differences between the marks, and the fact that the coinciding element is placed at the end of the marks, it is unlikely that the average consumer paying an average degree of attention will directly confuse the marks. In this connection, even though similar endings of marks may be enough for confusion (*Bristol Global Co Ltd v EUIPO*, T-194/14), this does not apply here due to the low distinctiveness of the last (and common) elements of the marks, particularly given the services at issue. The best argument the opponent has made, in this connection, is that both marks will be understood as referring to locating people to engage in some form of relationship, e.g., a date or partner (in the applicant's mark), or relationship/friendship (in the opponent's mark) and that this semantic similarity would cause the average consumer to misremember one mark for the other. However, the term ADULT FRIEND has a very specific meaning in the context of the opponent's adult dating services (i.e. it means a sex contact), and so if there is any semantic similarity between the marks is very loose, and it is not sufficient to counteract the visual and aural differences between the marks.

81. Turning to indirect confusion, the case is even weaker as the common element FINDER is very low in distinctiveness in the context of the services at issue, and the

average consumer is unlikely to be surprised in seeing the term used in different trade marks indicating different origin, and is unlikely to assume a trade connection.

82. The opposition under Section 5(2)(b) fails.

Section 5(3)

83. Section 5(3) states:

“(3) A trade mark which-

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

84. Section 5(3A) states:

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

85. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs

particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

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

86. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 20 January 2021.

Reputation

87. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

88. Bearing in mind my earlier assessment of the evidence before me, I am not satisfied that the opponent had a qualifying reputation at the relevant date for the services claimed. Given that the conditions for establishing a claim under Section 5(3) are cumulative, without being able to establish a reputation the opposition under Section 5(3) fails at the first hurdle. But even if I were wrong, and a reputation did exist, there would be no link, due to the differences between the marks and the low distinctive character of the shared element. The opposition under Section 5(3) also fails.

Section 5(4)(a)

89. Section 5(4)(a) states:

"(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

(c)

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.”

90. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

91. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Goodwill

92. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a

business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

93. In this case, the applicant did not file any evidence of use, which means that the relevant date for the assessment under Section 5(4)(a) is the filing date of the application at issue, being 20 January 2021.⁷

94. The opponent relies upon the use of signs and services which are identical to those which I have already considered under Section 5(2)(b). I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires “a substantial number of members of the public are deceived” rather than considering whether the “average consumer is confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here. I accept that the opponent had the requisite goodwill in the UK at the relevant date in relation to a business offering adult online dating services and that the sign ADULT FRIEND FINDER was distinctive of that goodwill.⁸ Given my finding that there is no likelihood of confusion between the opponent’s mark ‘ADULT FRIEND FINDER’ and the contested mark ‘FlirtFinder’, I also find that it is unlikely that a substantial number of the opponent’s customers will be misled into purchasing the applicant’s services in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion under Section 5(2)(b). The opposition under Section 5(4)(a) fails.

OUTCOME

95. The opposition has failed. Subject to appeal, the applicant’s trade mark will proceed to registration.

⁷ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

⁸ Even if the opponent had goodwill in other less similar services such as those identified under the proof of use assessment it would not bring its case any further forward.

COSTS

96. As the applicant has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the applicant the sum of £1,700 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the opponent's statement:	£400
Filing evidence and considering the opponent's evidence:	£1,000
Written submissions:	£300
Total	£1,700

97. I therefore order VARIOUS, INC. to pay Isomob Ltd the sum of £1,700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 26th day of May 2023

**Teresa Perks
For the Registrar**