

O-055-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3127314

BY ROBERT MAGILL

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 45:

matchedharmony

AND

OPPOSITION THERETO (NO. 405822) BY EHARMONY INC.

Background and pleadings

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

matchedharmony

Class 45: Online dating via a website, dating service

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

3. eHarmony Inc. (“the opponent”) opposes registration on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on two earlier marks as follows:

- i) European Union trade mark (“EUTM”) registration 4118709 for the mark **EHARMONY** which was filed on 11 November 2004 and registered on 24 January 2006. Although registered for a wider range of services, the opponent relies on the following class 45 services: “Personal services rendered by others to meet the needs of individuals”.
- ii) EUTM registration 8165136 for the mark **EHARMONY COMPATIBILITY MATCHING SYSTEM** which was filed on 19 March 2009 and registered on 21 October 2009. Although registered for a wider range of services, the opponent relies on the following class 45 services: “introduction services; dating services; matchmaking services”.

4. Under section 5(4)(a) the opponent relies on the use of the sign **EHARMONY** since 2008 in respect of “introduction services; dating services; matchmaking services”. The essence of the opponent’s claims under the three grounds are that:

- Its marks are highly similar to the applied for mark which contains the whole of one of its earlier marks (save for the letter E).

- The word MATCHED is descriptive, so meaning that the focus of the mark will be on the word HARMONY.
- The consumer will likely associate the marks in the sense that they are part of the same family.
- The services are identical or highly similar.
- The earlier marks have a reputation and that unfair advantage will be taken of this and, further, that there will be detriment to their reputation and distinctive character.
- The opponent has goodwill associated with the name EHARMONY through its use since 2008. The use of the applied for mark will, it is claimed, lead to deception and damage.

5. It should be noted that both earlier marks have been registered for more than five years and are, therefore, subject to the proof of use provisions set out in section 6A of the Act.

6. Mr Magill filed a counterstatement denying the claims. He did not put the opponent to proof of use in respect of the earlier marks, so meaning that they may be taken into account in respect of the services relied upon without having to establish that genuine use has been made of them. A summary of the main points of Mr Magill's defence are that:

- The marks are not similar.
- The word HARMONY is a generic word synonymous with the dating industry. The letter E is not insignificant and that EHARMONY will be understood as ELECTRONIC HARMONY or ONLINE HARMONY.
- The applied for mark is very different to EHARMONY COMPATIBILITY MATCHING SYSTEM. Reference is made to the mark only being used in small print on the opponent's website and that it is not included in its URL.

- It is denied that the applicant's services are identical or similar to the services of either earlier mark.
- The services use different algorithms – the opponent uses a psychological one whereas Mr Magill uses an astrological one.
- The look and feel of the respective stylisations are different.
- It is denied that the average consumer will dissect the applied for mark and then link the dissected parts together [to the earlier mark].
- Although the respective marks operate in the same industry of online dating, the services are not similar.
- Mr Magill does not believe that “consumers who pass the intelligence test” would confuse the marks or believe that the services are from the same or an economically linked undertaking.
- There will be no passing-off.
- Any damage to the opponent's reputation, decreasing uniqueness etc of the EHARMONY brand, will depend on how the opponent treats its customers.
- It is accepted that the marks have been used internationally since 1999 and in the UK since 2008, but it is denied that the applied for mark will gain any advantage nor will it be detrimental to the reputation and distinctive character of the earlier marks.
- Mr Magill's mark has been used since 2013 with no confusion. The opponent has not threatened any litigation action.

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

8. It should be noted that Mr Magill's application has also been opposed by Match.com L.L.C. (opposition number 405810). A separate decision has been issued simultaneously by me in relation to that other opposition, based upon the facts and evidence presented in those proceedings.

The evidence

The opponent's evidence

9. This comes from Mr Ronald Sarian, the opponent's general counsel. He explains that the opponent is a significant player in the online dating arena. In the US, an average number of 438 people per day get married having met through eHarmony. This track record has, he states, led to the rapid and successful expansion into the UK market in 2008. Some of the facts that come from Mr Sarian's evidence are as follows:

- Since launching in the UK in 2008, the opponent's eHarmony service has attracted over 100k new subscription paying members per year. Total membership ranges between 450k and 800k.
- Fees generated from membership since 2010 are over £100 million.
- Advertising and promotion, since 2010, has been no less that £5 million per year and peaked at over £9 million in 2010.
- Examples of high profile television, radio, cinema and online advertising is provided.

10. Supporting exhibits can be summarised as follows:

- Exhibit 1 – consists of website prints from eharmony.co.uk showing the eHarmony trade mark (sometimes with a slight degree of stylisation) and which includes references to the Compatibility Matching System.
- Exhibits 2i to 2v – consists of promotional material for the eHarmony service.

- Exhibits 3 to 7v – contain prints from YouTube of videos for the eHarmony service that have appeared in the UK. They are said to be TV advertisements; the YouTube videos have views in the tens of thousands.
- Exhibits 8 to 9 – contain third party articles about eHarmony’s advertising campaigns in the UK in 2011.
- Exhibits 10 and 11 - contain articles about two other campaigns, but these are from after the relevant date.
- Exhibits 12i and 12ii – contain prints from the websites of Vouchercloud and Groupon relating to online vouchers for the opponent’s services. However, both are for offers that took place after the relevant date.
- Exhibit 13 - contains evidence showing eHarmony Google Adword advertising; the adword was purchased as early as 2008.
- Exhibit 14 - contains what appears to be articles from marketing publications which make reference to eHarmony from April and June 2015.
- Exhibit 15 - contains further articles about eHarmony from more general sources (Mail Online) and various travel publications.
- Exhibit 16 – contains details of a competition ran in the early part of 2015 called Love Captured. The eHarmony name is used in association with this.
- Exhibits 17i to 17xii – contains articles from a selection of publications (including national newspapers) from before the relevant date, all of which, in some way, make reference to eHarmony.
- Exhibits 18-32 – contain further articles and web extracts from a variety of sources which all refer to eHarmony and which often indicate that eHarmony is one of the leading online dating services.

11. Mr Sarian provides at Exhibit 33 a Wikipedia extract for match.com, a rival online dating service. Its business was clearly started in the US, but Mr Sarian states that it is active in other countries including the UK. There is, however, little evidence in this exhibit as to the extent of use in the UK.

Mr Magill's evidence

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

Differences between the marks

13. Mr Magill states that his mark is one word "derived from our imagination and creativity" which creates a different meaning to the earlier marks. In exhibit 15 he provides a definition for the word "match" (which focuses on combining well with something or, in the sense of a relationship, someone) and also a definition for "matched" when used as a suffix (which focuses on being suitable for something - as in well-matched). Additionally, a definition for HARMONY is provided which is based on a state of peacefulness and of things being suitable together. The definitions are taken from the Cambridge Dictionary Online.

14. Mr Magill states that his mark should not be dissected when deciding if confusion will exist. He states that HARMONY is a generic word and, further, that the E is not insignificant; he repeats the statements he made in his counterstatement to this effect. Exhibit 13 contains an extract from Wikipedia in relation to internet related prefixes such as E-.

15. Mr Magill states that the EHARMONY COMPATIBILITY MATCHING SYSTEM mark, just relates to computer code, that it is not used in the opponent's URL, and that it is used in small print on its website.

Difference between the services

16. For reasons that will become apparent, I do intend to provide a great deal of information in respect of this aspect of the evidence. For the record, though, some of Mr Magill's points are based upon the different domains the businesses use (Mr Magill started to use .date when that domain became available in 2015, whereas the opponent uses .com and .co.uk), the not for profit (and free) nature of his project, that his service uses an astrological algorithm, that his services use local advertising and are provided in the West country.

The widespread use of "match" and "harmony" in online dating

17. Mr Magill states that both the word "match" and "harmony" are often used in the context of internet dating, both in registered trade marks and more generally. He adds that the opponent's earlier marks are not for the word harmony per se.

18. Exhibits 6.1-6.3 contain details of three registered marks: mobile match, MUDDY MATCHES and URBAN MATCHES, all of which cover dating services. Exhibits 7.1 to 7.13 show dating websites which have the word match in their names as follows:

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

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

20. Mr Magill states that the word harmony is also generic in the dating industry as more and more algorithms are created to measure the harmony between people in a relationship. He states that it is only a matter of time before there will be a number of dating services which use harmony in their marks. Exhibit PDF9 consists of a Google.com search print for the term “dating harmony”. Only one page of results is provided, many of which relate to the opponent. Some are for dating comparison sites and there is even one for match.com. Exhibit 18 contains a print of a registered trade mark for HEALTH & HARMONY (and device) the services for which include dating services. Exhibits 17.1 to 17.6 show dating websites which use the word harmony in their names, as follows:

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

Absence of confusion

21. Mr Magill refers to the average consumer and the time they spend signing up to dating services and considering terms and conditions and subscription details etc. He states that the process is not an impulsive one. He states that to use the opponent’s service a member has to answer 258 questions (see the Wikipedia entry in Exhibit 14). He states that any prudent person would not confuse the marks.

22. He states that the opponent has not produced any evidence of confusion despite the fact that he has been operating his service for three years. He provides a print of three logos together, including the logo for eHarmony.co.uk, his own logo, and a logo used by match.com (consisting of the word MATCH and a heart device). Whilst this is noted, the logos actually used are not pertinent because it is the mark as filed/registered which must be considered.

23. Mr Magill comments on the claim that the opponent's goodwill will be damaged by the use of his mark. Mr Magill makes comments and provides supporting evidence that some of the opponent's customers were unhappy with its services which demonstrates, in his view, that eHarmony is not a high quality service.

24. Mr Magill provides what he considers to be examples showing how trade marks can share generic elements. The example he gives (in Exhibits PDF 5/6) is of FORD MOTOR COMPANY and GENERAL MOTORS, both using the word MOTOR/S. Another example is given of two registered marks for MATCH MOBILE and MOBILE MATCH.

The opponent's reply evidence

25. This comes from Mr Sarian. He provides a number of exhibits in response to the evidence of Mr Magill. Exhibit 34 contains a google.co.uk print for the word HARMONY per se which is said to show that the word is not synonymous with dating; only the opponent's website is found in relation to dating. I think it fair to flag at this point one of Mr Magill's submissions in reply which highlights, sensibly, that the word harmony has various other meanings (including relating to music) and, thus, the absence of other hits relating to dating is not in and of itself good evidence. Exhibit 35 is a print of the auto suggestion bar in google.co.uk which shows that when matchedharmony is entered, the suggestions are: match harmony, match eHarmony comparison, match eHarmony, OkCupid & PlentyofFish.

26. Exhibits 36 and 37 show firstly Mr Magill's more recent use, but also use in 2013 of matchedharmony.com as part of a crowd funding campaign. Exhibit 38 contains a print from Mr Magill's Facebook page and Exhibit 39 contains an image from that page

showing matched, harmony and.com on separate lines. Exhibit 40 is a separate image from the Facebook pages which show matched, harmony and .com written together but with each word in a different colour. Further examples of matched and harmony being used separately on Facebook are shown in Exhibit 41 and some images from Google images showing the same.

27. Exhibit 43 is similar to Exhibit 34 albeit the term now used in the search is MATCH, with only the match.com website being a dating based result. Various exhibits are provided in response to Mr Magill's evidence as to the services being different on account of, for example, the different marketing methods and geographical scope. I do not consider it necessary to summarise this evidence further. In response to Mr Magill's evidence about the absence of confusion, Mr Sarian provides Exhibit 49, an extract from a report by the UK Online Dating industry published in January 2015 by the Mintel Group. Beyond noting that eHarmony is listed as one of the leading players (as is match.com) it is not clear what Mr Sarian is asking the tribunal to take from this report.

28. I will begin my assessment with the ground under section 5(4)(a).

Section 5(4)(a)

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

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

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

(b)...

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

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

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

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

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

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

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

31. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

32. Whether there has been passing-off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, stated:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read

too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley*

Brewery Company Ltd. v. RBNB [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

33. The applicant must establish that it owned goodwill associated with the name EHARMONY at least by the date on which Mr Magill filed his trade mark, namely 16 September 2015. Mr Magill suggests that his mark has been used before it was filed, he states that it has been used for three years. However, there is little in the evidence to support such a claim. The best evidence in terms of attempting to date the first use is actually provided Mr Sarian. One of the Facebook pages contains a date in September 2013 and a Crowdfunding page from October 2013. I will, therefore, additionally consider whether the opponent had the requisite goodwill at the earlier date of September 2013.

Goodwill

34. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“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.”

35. In *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used ‘but had not acquired any significant reputation’ (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.”

36. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing-off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA)

37. In terms of what is required to establish goodwill, I note that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

38. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be

answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

39. The opponent's evidence is compelling in relation to the provision of an online dating service which has been up and running in the UK since 2008. The evidence shows that it is a significant business, one of the leading players in the UK market. The opponent clearly has the requisite goodwill to found a claim, indeed, I consider that the evidence demonstrates a particularly strong goodwill. It is also clear that the primary sign used in relation to that business is **EHARMONY**. This is so even at the earlier date in September 2013.

40. I have noted Mr Magill's points about the opponent's goodwill/reputation, however, this does not impact on my finding. I agree with the opponent that a business as large as it is bound to have some customers who are unhappy. Thus, I think Mr Magill's general point is unfounded. Furthermore, it is clear that, in any event, the opponent has a goodwill because it is still bringing in custom.

Misrepresentation

41. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

42. A common field of activity is not a prerequisite to found a passing-off claim (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). 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 service as that provided by the opponent.

43. 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). Mr Magill has provided evidence in relation to the use of the word HARMONY in the relevant trade (and also evidence in relation to the word MATCH). However, 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. The question, though, is not about association unless the association results in a substantial number of people likely believing that the services offered under the matchedharmony mark are actually those of the opponent. When considering this I agree with the opponent's submissions that in the context of Mr Magill's mark, the HARMONY part will take on more significance than matched due to the latter qualifying the former.

44. I come to the view that a substantial number of people will believe that the services offered under Mr Magill's mark are those of the opponent. The use that has been made by the opponent of the term HARMONY as part of its EHARMONY name will result in a substantial number of people believing that matchedharmony is some form of brand extension of EHARMONY. I accept that the word HARMONY may be used in some contexts in which its use would not signify the services of the opponent. However, the construction of Mr Magill's trade mark is not such a case, given that matchedharmony is a somewhat odd expression and it does not combine to create an obviously descriptive phrase where HARMONY is used purely in an obviously descriptive manner. Mr Magill's comments about the way in which he actually uses his mark are not pertinent because they do not appear in the mark he has sought to register. I also reject Mr Magill's submission that the services in question are highly considered due to the time spent on form filling etc. – an online dating service can be used in a much quicker fashion than that – just a normal level of care will generally be applied.

45. 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 a 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.

Damage

46. In *Harrods Limited V Harroddian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

47. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

48. Given my finding that a substantial number of members of the public would believe that the services offered by Mr Magill under his mark are those of the opponent, it is clear that there is a potential for damage in terms of diversion of trade. Further, the

types of damage resulting from the placing of one's reputation in the hands of another is also apparent. Damage is made out.

49. One final point I deal with is Mr Magill's submission regarding peaceful co-existence without any form of damage. This has the potential to inform the tribunal as to the capacity of signs to cause deception and, also, could give rise to a situation where, despite being the senior user, the opponent cannot restrain Mr Magill's use because it would be inequitable to do so. However, whilst acknowledging the potential for such arguments to be made, they do not apply here. The main reason for this is that very little has been said about the true extent of use made by Mr Magill. Therefore, it is not possible to accurately assess the degree to which the marks have been used alongside each other in the marketplace and, further, whether Mr Magill has established his own independent goodwill.

50. Given my findings, I do not consider it necessary to deal with the further grounds of opposition.

Conclusion

51. The opposition is successful and the application is to be refused registration

Costs

52. The opponent has been successful and it is entitled to a contribution towards its costs. My assessment is set out below.

Official Fee - £200

Preparing a statement of case and considering the counter-statement - £300

Filing and considering evidence - £600

Written submissions - £400

Total - £1500

53. I order Mr Robert Magill to pay eHarmony Inc. the sum of £1500 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of February 2017

A handwritten signature in black ink, appearing to be 'O. Morris', written in a cursive style.

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