

How potent is "honest concurrent use" as a defence in light of the decision in *Match v Muzmatch*, and how do you gain an edge for your clients?

Tom St Quintin  
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# *Match Group LLC v Muzmatch Limited* [2023] EWCA Civ 454, [2023] FSR 18

- Both parties operated dating sites, or “matchmaking” services
- Match started first, trading in UK from 2001 via website, then mobile app.
- Its trade marks were MATCH.COM and *match*<sup>♥</sup>
- It was very much the market leader: it had a dominant presence in 2011.

# Match Group LLC v Muzmatch Limited [2023] EWCA Civ 454, [2023] FSR 18

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# *Match Group LLC v Muzmatch Limited*

## [2023] EWCA Civ 454, [2023] FSR 18

- Muzmatch started in 2011. Initially it was scale, via a website (muzmatch.com).
- In 2015 it launched a mobile app, and traded on a much larger scale.
- Match learned about it in 2016.
- Match successfully resists the application to register Muzmatch as a TM.
- But Match does not commence proceedings until 2020.

# Match Group LLC v Muzmatch Limited [2023] EWCA Civ 454, [2023] FSR 18

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# First instance decision - [2022] EWHC 941 (IPEC)

Nicholas Caddick K.C. (sitting as Deputy High Court Judge) found:

- Infringement under ss.10(2) and 10(3) TMA 1994, and passing off
- S. 10(2) was found on an “indirect confusion” basis: i.e. that consumers would believe it was a business extension.
- S. 10(3) on unfair advantage of reputation basis.
- Muzmatch does not have a defence of honest concurrent use

# “Match” – is it a descriptive word?

- The similarity in marks is in the word “match”; but “match” can be descriptive of the parties’ services
- Of course, a descriptive mark can become distinctive (e.g. British Airways)
- Match produced evidence of its reputation:
  - Surveys
  - Advertising
  - Number of users, amount of revenue
- Evidence shows that people referred to Match interchangeably as “match” or “match.com”
- In short: “MATCH” had become distinctive of one source, i.e. the Claimant.

# Evidence of actual confusion – First Instance

- There was no evidence of actual confusion.
- Despite co-existence of 10 years by the time of trial, and searches of around 53m records
- However, that did not assist Muzmatch: the judge held that the confusion was not of the type likely to come to light
- Lack of evidence of confusion was not inconsistent with a likelihood of confusion.

# Evidence of actual confusion – on appeal

- Lack of evidence more significant if long period of co-existence (Arnold LJ [39])
- Lack of evidence is also significant in era of social media (Arnold LJ [46])
- However “indirect confusion is inherently less likely to come to light than direct confusion” (Arnold LJ [49])
- The assessment of evidence is a matter for the trial judge. He was entitled to place little significance on the lack of evidence because the nature of searches carried out and whether they were directed at the issue of confusion was not known (Arnold LJ [47] and [53])

# Honest Concurrent Use – First Instance

- Muzmatch argues that even without acquiescence or estoppel, 10 years of co-existence meant the use had become HCU.
- It said this provided a defence to an infringement claim.
- This HCU “defence” was rejected at trial at [136]-[142]: “it is difficult to see how use that starts as infringing use can be turned into honest use by the fact that it has continued.”
- “The very reason why use infringes is because, if left unchecked, its effect would be to educate the public that the mark does not indicate the services of the trade mark proprietor.”

# Honest Concurrent Use – on Appeal

- HCU - *“the most important issue raised by this appeal”* (Arnold LJ [62])
- Not a separate defence, but a factor in the infringement analysis (Arnold LJ [115])
- The test: If a D’s use of the mark does not have an adverse effect on the functions of the Mark, then HCU (Arnold LJ [87], [91])
- If C establishes a prima facie case of likelihood of confusion, the burden shifts to the defendant to establish that test is met

# Honest Concurrent Use – on Appeal

- In exceptional cases, honest concurrent use may lead to the conclusion that there has been no infringement, even though there is a level of actual confusion between the trade mark and the sign,
- That is the position if “most of the relevant class of consumers have come to understand that the trade mark and the sign denote different trade origins”
- (That was the case in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch* [2012] EWCA Civ 880 and *IPC Media v Media 10* [2013] EWCA Civ 143 – cited by Arnold LJ at [97]-[102])

## *EasyGroup Ltd v Nuclei Ltd* [2024] FSR 9 (CA)

- Here HCU succeeded: [78], [87], [98]-[103]
- The competing marks were “easyOffice” vs “EASYOFFICES”
- There had been 5 years concurrent use
- D was the senior user, but not the senior registered mark owner.

## *EasyGroup Ltd v Nuclei Ltd* [2024] FSR 9 (CA)

- When easyGroup first complained, D agreed not to use an orange and white livery: it took steps to avoid confusion.
- There was no evidence of actual confusion, and if there was any confusion it was to be tolerated because of HCU.
- On appeal, Arnold LJ expressed “sympathy” with the conclusion that there was HCU after only 5 years concurrent use, but it was nevertheless not able to interfere with the finding of no likelihood of confusion.

# Learning Points

- Unsurprisingly, these cases are fact sensitive. The first instance decision is of paramount importance.
- The relevance of HCU reduces if underlying case is strong.
- Cs: be vigilant, act quickly, and don't give HCU a chance.
- Ds: "stay in lane". Encroaching further may defeat HCU.
- If there has been some delay, then actual confusion is more important – if there is confusion, D has a high hurdle to cross.

# The Long Delay

*“Like gardens trade mark cases always get worse with neglect – even if rights are not actually lost, delay is apt to turn what would be over in a few weeks by a quick application into a mini State Trial”*

Arnold LJ at *Match* [123] (quoting from Jacob LJ in *Phones 4U v Phone 4u.co.uk* [2006] EWCA Civ 244 at [8])