

O/122/18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO 3 003 117 FOR THE
TRADE MARK: BLINK FOR GOODS IN CLASS 09 IN THE NAME OF NUANTI
LIMITED**

AND

IN THE MATTER OF AN APPLICATION FOR INVALIDATION BY GOOGLE INC

Background and pleadings

1. Nuanti Limited is the Registered Proprietor (RP) of UK trade mark No 3 003 117 BLINK. The trade mark was applied for on 23rd April 2013 and registered on 13th September 2013 in respect of the following goods in Class 09:

Browsers, namely, software, software components, operating systems or electronic devices for interacting with online and offline computing environments, the internet and the world wide web, but not including search engines or search engine software.

2. Google Inc is the applicant for invalidation in these proceedings (the applicant). It makes this application on the basis of Section 5(4) (a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its alleged earlier rights in BLINK. It claims to have been providing services under this sign since 3rd April 2013 and has acquired goodwill under the sign. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.
3. The applicant also makes a claim under Section 3(6) of the Act. It argues that the RP applied for BLINK in bad faith. Specifically, it argues that the Director of the RP, Mr Alp Toker, knew about Google’s use of BLINK (and intention to use BLINK in the UK) due to Mr Toker’s previous role in contributing source code to the WebKit project (BLINK’s predecessor).
4. The RP filed a counterstatement denying the claims made, save for admitting that it had previously enjoyed a close relationship with the applicant.
5. Both sides filed evidence. This will be summarised to the extent that it is considered appropriate.
6. A Hearing took place on 26th September 2017, with the applicant represented by Mr Leighton Cassidy of Fieldfisher. Mr Alp Toker, the sole Director and shareholder of the Registered Proprietor, appeared in person.

Legislation

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

“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.”

8. Section 47 states:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.

Evidence

Applicant's evidence

9. This is a witness statement, dated 2nd December 2016, from Ms Emily Burns, Senior Trademark Counsel of Google Inc (the applicant). She explains that the applicant is a United States headquartered Multinational Corporation which specialises in Internet-related services and products, including online advertising technologies, search, cloud computing, software and hardware. It is noted that the applicant owns current US, Canadian and International trade mark registrations in BLINK in Class 09.
10. By way of background, Ms Burns explains that the applicant uses the BLINK trade mark within an open source software project known as "The Chromium Projects", for which the applicant is, according to Ms Burns, the organiser and creative force. These projects were founded by the applicant in September 2008. The main product is an open source web browser called CHROMIUM, the source code of which is used in the applicant's web browser and distributed under the trade mark CHROME. The projects are international and have users and contributors from all over the world including the UK.
11. The applicant uses the BLINK trade mark in relation to an open source web rendering engine within these projects. Exhibit EB3 contains extracts from the BLINK specific pages of the projects website.
12. The applicant launched the BLINK trade mark on 3 April 2013. At launch, the BLINK branded web rendering engine was based on a version of the Webkit rendering engine which many browsers used at the time. The launch of BLINK meant that the applicant would no longer use Webkit. The initial announcement of the BLINK branded rendering engine was made on the applicant's Chromium blog. Exhibit EB5 is an extract from this blog, dated 3rd April 2013. On 4th April, the applicant promoted the launch via a video on YouTube entitled "Blink Questions Answered". Exhibit EB6 is a screen shot

from this clip which according to Ms Burns, has been viewed over 33,000 times. It clearly shows the source as being “Google developers”. There is no information as to the locations of those who have viewed this information.

13. According to Ms Burns, the announcement was also distributed in the UK through various mailing lists connected to the projects, including mailing lists for WebKit developers. Exhibit EB7 is a post on the Webkit Mailing List, dated 3rd April 2013. Details of who this was sent to are not provided, but it is clearly aimed at those who have previously worked on the Chromium project.
14. The announcement was also reported in the technology and mainstream media, including the UK. Exhibit EB8 are extracts from articles published in media outlets. It is noted that one of the articles regarding the launch was UK focussed (other content on the page includes £ sterling). Exhibit EB9 is a representative sample of the coverage since launch and includes an extract from an in depth article from the Guardian.com website on 5th April 2013 regarding the launch itself.
15. As regards market share, Ms Burns explains that at April 2013, the applicant enjoyed a 35.69% share in respect of web browsers. This has since grown to 46.88%. While the context is slightly tricky as it does not specifically relate to the use solely of BLINK, it is useful in building a picture of the success of the applicant in the particular industry and at the relevant date, namely the filing date in these proceedings which is 22nd April 2013.
16. Ms Burns’s witness statement also provides information regarding the Director of the Registered Proprietor, Mr Alp Toker. She explains that prior to the launch of the BLINK trade mark on 3rd April 2013, Mr Toker was involved with and contributed to source code on the WebKit project (i.e. the predecessor of BLINK). Exhibits EB13, 14, 15 and 16 are extracts from both the Registered Proprietors own website and those of WebKit, seemingly in support. It is noted that in its counterstatement, the Registered Proprietor accepts that prior to the relevant date, it worked closely with the applicant providing mentoring and

assistance to the applicant's employees in respect of browser software design and development.

17. Ms Burns goes on to explain that Mr Toker is also a current subscriber to the WebKit mailing list, as evidenced by the excerpt of the list at Exhibit EB17. Exhibit EB18 is a further extract from the list, evidencing, according to Ms Burns, that Mr Toker was actively posting on the list around the time of the announcement of the BLINK project (this is actually dated October 2013). Further the launch was announced on this list. According to Ms Burns, Mr Toker would have seen this launch announcement and would therefore have had knowledge of the applicant's rights in the BLINK trade mark and intention to use the mark including in the UK.

Registered Proprietor's Evidence

18. This is a witness statement, dated 16th February 2017, from Mr Alp Toker, the Director and sole shareholder of the Registered Proprietor. Though the entirety of the witness statement has been perused and considered, it will not all be summarised. Rather, this summary will focus upon the information considered to be directly relevant to the issues in hand in these proceedings.

19. Mr Toker explains that Nuanti Blink is the RP's brand which has been used in the industry from 2011 onwards, predating any use by the applicant. Mr Toker includes an extract from the RP's website showing such use. It is noted that this is dated October 2013, which is after the relevant date in these proceedings.

20. Mr Toker claims that the applicant has asserted that BLINK is not a product of the applicant. He refers to a post by a Mr Alex Russell, dated 11th April 2013 in which Mr Russell explains that BLINK is not a product but a project. And that products may be downloaded which uses or embeds BLINK but which has a different name, such as CHROME. There is also a further post from Mr Russell, claiming that Chrome is the product, not BLINK.

21. Mr Toker makes much of the apparent distancing from BLINK by the applicant. He asserts that a code name, such as BLINK is not capable of being used as a trade mark. I will return to this point further below.
22. Mr Toker attempts to demonstrate how, from 2008 onwards, the RP ranked first following internet searches of particular terms. For example: blink web browser solutions. Upon perusal of the screenshots, it is noted that there is nothing to place any of the information into context. It is wholly unclear as to what products the RP was providing and from what date, if even it was providing anything at all.
23. In respect of the choice of BLINK as a trade mark by the RP, Mr Toker explains its origins are in respect of work he carried out for WebKit on blinking (flashing of text). This was, according to Mr Toker in 2007. Mr Toker also considers that this in effect, shows the RP's first use of BLINK. I will return to this point later and note that BLINK in the context reported here is clearly used as a descriptor (blinking, i.e. flashing) in respect of the behaviour of a caret (or cursor).
24. Mr Toker relies upon an extract from Wikipedia in support of the assertion that the RP is the "rightful" owner of the BLINK name. I will return to this point further below.
25. In respect of the launch of BLINK by the applicant, Mr Toker argues that it does not explicitly mention Google in respect of BLINK. Further, that the applicant has not in fact switched from WebKit to Blink.
26. Mr Toker provides an invoice, dated 2012 (so, prior to the relevant date). There is no mention of BLINK at all. Further, details of accounts are provided. Again, there is no context in respect of use of BLINK, so I am unable to gauge its relevance to the issues in hand here.

Applicant's evidence in reply

27. This is a further two witness statements. One from Emily Burns and one from Alex Russell. I will summarise Alex Russell's first. This is dated 7th June 2017. Mr Russell explains that he is a Software Engineer for the applicant. In response to his blog comments (relied upon by the RP), Mr Russell explains that he is neither the public face of the applicant, nor its spokesman. In respect of his comments in the blog, Mr Russell explains that these were in respect of a query from a third party in respect of BLINK and that Mr Russell was explaining the differences between the end user product supplied by the third party and the open source component of a larger project of the applicant's. Mr Russell explains that it is this distinction that is being referred to and should not be taken as an admission that any trade mark rights in BLINK are disclaimed.

28. The second statement from Ms Emily Burns is also dated 7th June 2017 and will not be summarised in its entirety. This is because some of the content is in respect of Mr Russell's blog comments, for which a witness statement from Mr Russell himself has already been summarised above. In respect of the remainder of the witness statement and in response to the use by Nuanti of BLINK, Ms Burns makes the following comments:

- The only dated website print showing use by Nuanti on its website of BLINK is dated October 2013. This is after the relevant date.
- The other evidence in respect of the origin of BLINK and its choice by the RP refers only to the technical feature blink and not as trade mark use by the RP.
- Ms Burns emphasises all the evidence of goodwill provided in respect of the applicant and its use of BLINK.
- In respect of turnover figures and the invoice filed by the RP, Ms Burns notes that BLINK is not included anywhere. As such, they are without context.
- In respect of the Wikipedia entry, Ms Burns argues that the original (and current) entry was dated on 3rd April 2013 and described BLINK as a browser engine developed by Google (the applicant). Ms Burns suggests that Mr

Toker, at the time of filing his evidence, filed a non-current version of the website.

29. This concludes my review of the evidence.

Passing Off - Principles

30. 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 stated that:

“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).”

31. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 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.”

Goodwill

32. *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.”

33. It considering whether or not the applicant had acquired a protectable goodwill at the relevant date, I bear in mind the following:

- The evidence demonstrates numerous media announcing the launch of BLINK as Google's new browser engine. This includes a UK focussed entry.
- The evidence contains other publicity articles and analysis of the launch, including one from the Guardian.com, two days following the official launch.
- Ms Burns's witness statement makes clear that the launch would also have been publicised on subscriber lists. These were inevitably made up of technical personnel. Indeed, in the main, it is noted the technical community that would have been the most interested in this launch. This is because browser engines are used as part of a web browser. The user of the browser engines is therefore the technical community as they will develop complete browser products for end users.
- In the circumstances in these proceedings, the applicant launched BLINK as its new browser engine a mere 20 days prior to the relevant date, namely the filing date of the application by the RP. However, the applicant (Google) was, at that point, already a well - established company in the web browser industry and who had amassed a significant market share – 35.69%.

34. In respect of the final point above, I bear in mind that it is currently not clear whether an advertising campaign featuring a mark can create a protectable goodwill without any actual sales to UK customers. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 66 of the judgment) that:

“Finally, a point which I would leave open is that discussed in the judgment of Sundaresh Menon CJ in *Staywell* (see para 46 above), namely whether a passing off claim can be brought by a claimant who has not yet attracted goodwill in the UK, but has launched a substantial advertising campaign within the UK making it clear that it will imminently be marketing its goods or services in the UK under the mark in question. It may be that such a conclusion would not so much be an exception, as an extension, to the “hard line”, in that public advertising with an actual and publicised imminent intention to market, coupled with a reputation thereby established may be sufficient to generate a protectable goodwill. On any view, the conclusion would involve overruling *Maxwell v Hogg*, and, if it would be an exception rather than an extension to the “hard line”, it would have to be justified by commercial fairness rather than principle. However, it is unnecessary to rule on the point, which, as explained in para 46, has some limited support in this jurisdiction and clear support in Singapore. Modern developments might seem to argue against such an exception (see para 63 above), but it may be said that it would be cheap and easy, particularly for a large competitor, to “spike” a pre-marketing advertising campaign in the age of the internet. It would, I think, be better to decide the point in a case where it arises. Assuming that such an exception exists, I do not consider that the existence of such a limited, pragmatic exception to the “hard line” could begin to justify the major and fundamental departure from the clear, well-established and realistic principles which PCCM's case would involve. In this case, PCCM's plans for extending its service into the UK under the NOW TV mark were apparently pretty well advanced when Sky launched their NOW TV service, but the plans were still not in the public domain, and therefore, even if the exception to the “hard line” is accepted, it would not assist PCCM.

35. It appears to be clear that advertising under a mark is not sufficient to create an actionable goodwill where there was no imminent prospect of trade commencing at the time: *Bernadin (Alain) et Cie v Pavilion Properties Ltd* [1967] RPC 581. Pre-launch publicity appears to have been accepted as sufficient to create an actionable goodwill in the cases of *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228, but as explained in paragraph 3-070 of Wadlow's 'The Law of Passing Off 4th Ed', the plaintiffs in these cases had long established businesses with goodwill in the UK. The real issue was whether their new marks had become distinctive of those businesses to their UK customers through advertising alone. In considering this issue, it is clear, both from the evidence and from my own knowledge, that Google is not just an established business, it is a household name. It also enjoyed a significant market share prior to the launch of BLINK. I also note that these proceedings are subject to the same standard of proof as civil proceedings more generally; namely, that I must be satisfied on the balance of probabilities. Bearing this in mind, I conclude that it is more probable than not, that by 22nd April 2013, i.e. the filing date of the application, at the very least, those in the technical community would have been fully aware that BLINK was the name of Google's new browser engine as a component of its web browser and so was distinctive of it. I consider therefore that goodwill, at the date of application of the contested trade mark, has been established by Google and that BLINK was distinctive of Google's business.

36. It is noted that the RP claims that it has superior rights in BLINK and had been using it since 2011 (having first worked with blinking as a technical feature in 2007/2008). There is no persuasive evidence to corroborate this claim. It is therefore set aside.

Misrepresentation

37. 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.”

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

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

39. It is noted that the attacked trade mark is identical to that of the applicant. Further, the field of activity is also identical. It is considered that misrepresentation is inevitable.

Damage

40. In *Harrods Limited V Harrodian 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.

41. The parties in these proceedings are potentially in direct competition with one another, namely the provision of browsers. Further, in respect of identical

signs. There is clearly scope for Google to lose customers to the RP or otherwise lose control of its own reputation. Bearing all of the aforesaid in mind, damage is foreseeable and considered to be highly likely.

42. The result is that the applicant succeeds in respect of its invalidation under Section 5(4)(a).

43. The applicant's success under Section 5(4)(a) means that I do not, strictly speaking, need to go on to consider the remaining ground of invalidation, namely the allegation of bad faith, based upon Section 3(6) of the Act. However, for the sake of completeness I will do so.

Section 3(6) – BAD FAITH

Legislation

44. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

45. Section 47 of the Act states:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Summary of the law

46. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral*

Property Pty Ltd (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

47. It is noted that in its counterstatement, the RP admits that it has enjoyed a close working relationship with the applicant. The RP also claims in its evidence that it has made use of BLINK from 2011 onwards (and that it is in fact the senior user), but fails to provide any corroborating evidence on the point. Further, the applicant's evidence demonstrates that the controlling mind

of the RP, Mr Alp Toker, was a contributor to its development activities. Further, that he was a subscriber in respect of the applicant's publications, within which the launch of BLINK was announced. It is also considered highly relevant that, despite claiming use since 2011 (unproven), it only applied for BLINK twenty days after the launch by the applicant. An identical sign in respect of identical goods. Taking all of these matters in the round, it is considered that, the RP acted in bad faith in applying for BLINK. The application for invalidation also therefore succeeds under this ground.

48. The application for invalidation succeeds in its entirety.

COSTS

49. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £2350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Application and accompanying statement plus official fee - £500

Preparing and filing evidence - £750

Considering evidence - £350

Preparation for and attendance at Hearing - £750

TOTAL - £2350

50. I therefore order Nuanti Limited to pay Google Inc the sum of £2350. The above sum should be paid 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 22nd day of February 2018

Louise White

For the Registrar