O-606-18

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK NO 3,003,117 IN THE NAME OF NUANTI LIMITED

IN THE MATTER OF AN APPLICATION FOR INVALIDATION BY GOOGLE INC

AND IN THE MATTER OF AN APPEAL FROM THE DECISIONS OF LOUISE WHITE DATED 22 FEBRUARY 2018 (O/122/18)

DECISION

Introduction

1. This is an appeal from the decision of Louise White, for the Registrar, dated 22 February 2018 in which she declared Nuanti Limited's trade mark number 3,003,117 invalid on the basis of an application made by Google Inc under sections 5(4) and 3(6) of the Trade Marks Act 1994. Nuanti appeals that decision.

2. The registered trade mark (No 3,003,117) is for the word mark BLINK for the following goods in class 9:

   > 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.

3. This trade mark was filed on 23 April 2013 (the relevant date) and was registered on 13 September 2013. Google allege that they had been using the mark BLINK since 3 April 2013 and that by the relevant date it had acquired sufficient goodwill to prevent the registration by Nuanti. They also allege that the director of Nuanti, Alp Toker, knew about Google's use of BLINK and applied to register the mark in bad faith.

Background

4. Internet Browsers, such as Google Chrome, Microsoft Edge, and Firefox, include a wide range of different software components. One of these components is a browser engine, which transforms HTML and other resources on a webpage into the visual representation which is seen by users of the browser.

5. WebKit was (and is) a leading browser engine. Before 4 April 2013, it was used by Google Chrome (the Opponent's browser). Accordingly, when an end user downloaded Google Chrome before April 2013 this download would include WebKit (and numerous other software components).

6. WebKit became (and remains) an open source project. There are various forms of open source development, but in summary the relevant type used for WebKit (and later for Blink) involves the source code of the component being made available. Software developers, some of whom are entirely independent of the organisation "leading" the

project ("Project Leader"), can decide to make improvements to the code or try to address known problems (debug). The new code or revised code is sent by the developer to the Project Leader (usually by uploading it through a particular designated website). The Project Leader then assesses the code (either internally or through other independent developers). The code is then either rejected or accepted. If the code is accepted it might be made available by way of an update or simply incorporated into the next "build" released of the software component. These builds have different names depending on how stable they are (meaning how likely there are to crash or otherwise malfunction). Google, along with some other developers, call the first build the canary build, which is followed by the developer, beta and then stable build.

7. Open source projects rely on numerous standard term copyright licences, the purpose of these licences is to ensure that the source code, as it is updated from time to time, is available to developers to further improve the software. The licences also enable the code to be used wholesale by a third party in its own software (provided any improvements they make to the software are made available under the same open source licence terms).

8. Accordingly, open source projects usually (although not always) involve independent developers who spend time (and possibly money) to improve the software. Where such a developer's work is accepted by the Project Leader, that developer will usually get some form of recognition (such as non-executable comments in the source code acknowledging the contribution). Such independent developers are not paid for the coding by the Project Leader (but they may receive indirect benefits from others, such as job offers, speaking engagements and so forth). These developers are free to start and stop any coding project whenever they like. While particular problems might be identified by the Project Leader as needing to be solved, there is no obligation on any developer to step forward to try and improve the software.

9. WebKit had been developed along these lines. However, on 4 April 2013, Google decided that it wanted a "fork". A fork is where existing source code (in this case for WebKit) is used to start a new open source project (in this case Blink). This means, for example, that those open source developers who worked on Webkit before the fork can make improvements to the code which he or she can submit to WebKit or Blink or both. It may be that the improvement is accepted by one project and not the other or the improvement is only submitted to one project (or in time only works with one project). This means that as time passes, the code of the two projects, which on the date of the fork was identical, gradually diverges (it is a "fork" in the road).

Standard of appeal

10. The principles applicable on appeal from the registrar were considered in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person. These principles have now been approved and applied by the High Court; see for instance: *Royal Mint Ltd v The Commonwealth Mint and Philatelic Bureau Ltd* [2017] EWHC 417 (Ch) at paragraph 18 and *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) at paragraph 11.

11. Mr Alexander summarised the position at paragraph 52 of his Decision (I made a few minor updates to this summary in *Grill'O Express* (O/140/17), paragraph 6, which I have incorporated in square brackets):

> 52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.
>
> (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR [52.21]). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong ([…][CPR 52.21]).
>
> (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF*, *DuPont*).
>
> (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).
>
> (iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country and others*).
>
> (v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).
>
> (vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).
>
> Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.

12. In addition, it is worth highlighting certain comments made by Mr Alexander in relation to the assessment of goodwill in *Advanced Perimeter Systems v Keycorp Ltd* [2012] RPC 14, paragraph 34:

> In short, determining whether there is sufficient goodwill and a likelihood of substantial misrepresentation involves a critical, but not mechanical, approach to the evaluation of the evidence as a whole. So long as the principles outlined above are borne in mind, it will be difficult to fault a hearing officer's assessment. In particular a hearing officer is not bound to

> accept what is said about goodwill, without question, even if it is not answered or the subject of cross-examination.

13. I will apply these principles.

The relevant public and the generation of goodwill

14. It was accepted by the parties that the relevant public would be software developers. This is because the average user of a web browser would not know the names of the software components, such as a browser engine, which make up the browser.

15. The first issue is how, and in what way, is goodwill generated in an open source project or software.

16. In terms of the end user there is no real difference between open source and proprietary software. The software provides the end user tangible benefits which can be enjoyed and so can attract goodwill. The fact that money is not charged to use the browser, but some other benefit from users is obtained (such as the giving of information) makes no difference: see *Marcus Publishing Plc v Hutton-Wild Communications* [1990] RPC 576 at 584, Dillon LJ.

17. However, in the instant case, the relevant public is developers (and not end users). Open source projects rely on the desire of software developers to be involved. They rely on the contribution by developers of their time (that is money's worth) without any payment in return. However, critically, software developers (particularly those who are highly skilled) will have a number of open source projects to choose from when they are deciding whether and in which project to invest their time.

18. I see no problem with the attractive force drawing in developers to projects to be akin to the attractive force (that is goodwill) that brings in customers into a more conventional business arrangement. Surprisingly, considering the number and economic value of open source development, there is no direct authority on point. However, in my judgment, a close analogy can be drawn with the goodwill which the courts will attribute to a charity (although, for the avoidance of doubt, I am not saying that open source developers are acting charitably or that the projects are conducted for charitable purposes).

19. In *British Diabetic Association v The Diabetic Society* [1996] FSR 1 at 10-11 Walker J explained how charities compete in the marketplace for donations and legacies:

> I conclude, therefore, that the scope of a passing off action is wide enough to include deception of the public by one fund-raising charity in a way that tends to appropriate and so damage another fund-raising charity's goodwill—that is, the other charity's "attractive force" (see Lord Macnaghten in *Inland Revenue Commissioners v. Muller & Co.'s Margarine Ltd* [1901] AC. 217, 223) in obtaining financial support from the public. That conclusion raises a number of questions which may have to be explored at some future time (though litigation of this sort will, I sincerely hope, be extremely rare). I will make some tentative comments on points which were raised, but not fully examined, in counsel's submissions.
>
> The wider the scope of passing off, the freer has to be the interpretation of some of Lord Diplock's requirements, especially the reference to "prospective customers of [a trader] or

ultimate consumers of goods or services supplied by him" . It is obvious that in the case of many charities, their benefactors are likely to be a class of the public quite different from that of their beneficiaries. In the case of—for instance—the NSPCC or the RNLI the "prospective customers . . . or ultimate consumers" of the charity's services will, with rare exceptions, be different from those whose generosity funds the services.

By contrast the Association (like the average church congregation) seems to be a charity which for its financial needs depends to a high degree on self-help: the evidence suggests that diabetics and their families and friends are a major source (though not, of course, the only source) of subscriptions, legacies, in memoriam gifts (in lieu of flowers) and fund-raising activities. That reinforces my conclusion that (whatever may be the position with charities of a different character) passing off can provide a remedy in a situation such as the present, if misrepresentation is established. The Association's self-help character may also be material to the assessment of the evidence as to reputation and likely deception.…

20. As a charity needs to protect its goodwill to maximise its support (financial and otherwise), an open source project must do likewise to keep software developers giving up their time without any direct payment. And like charities, the class of developers who give up their time to code in an open source project will be different from the class of prospective end users (i.e. the beneficiaries of the free labour).

21. Accordingly, open source projects can generate goodwill in relation to attracting the provision of software developer services to undertake coding.

22. This presents an ancillary question, namely whether the provision of canary, developer, beta, and other early builds of the software to developers attract goodwill in the software product. The build, or code, being made available to developers seems to me to be the same as selling raw materials, such as clay or cement. Importantly, subject to the terms of the open source licence, there is nothing stopping the developer taking the code and using it for things totally unrelated to the open source project for which it was supplied. It must therefore be the case that, in principle, goodwill can attach to the supply of a build, or software product.

23. There may be some additional questions in the open source environment as to the generation of goodwill. It may be that, in strict legal terms, independent open source developers (particularly where they can approve updates or new builds) may be responsible for generating goodwill in the project (rather than the Project Leader). While the point is not necessary to determine in this case (as the Appellant did not develop for Blink), it is at least arguable that there is some form of shared goodwill between the Project Leader and the developers. However, I should also point out that while this may make sense legally, it appears to be contrary to some basic customs in relation to open source. In this regard, I note a statement by Eric Raymond in his seminal texts on open source, *The Cathedral and the Bazaar: Musings on Linux and Open Source by an Accidental Revolutionary* (2001), p 73-76:

…the owner of a software project is the person who has the exclusive right, recognized by the community at large, to distribute modified versions … There are, in general, three ways to acquire ownership of an open-source project. One, the most obvious, is to found the project. When a project has had only one maintainer since its inception and the maintainer is still active, custom does not even permit a question as to who owns the project…

The Fork

24. Having concluded that it is possible for goodwill to attach to the distribution of a new build, the issue arises whether a new build had been provided to developers by Google before 23 April 2013.

25. Google accepts that it provided no evidence demonstrating that before 23 April 2013 anyone had downloaded a product called Blink from any website Google controlled. However, Google's case is that once a new fork is announced the new product comes into being automatically. Therefore, the source code in the Chrome browser ceased to be called Webkit and became known as Blink immediately upon the announcement.

26. I do not accept that this is right. This is not a simple case of repacking. To take an example, if Mr Slugworth buys Wonker chocolate bars, takes off the packaging, and then resells them to the public as Slugworth chocolate bars, he can start generating goodwill connected to the mark Slugworth (providing he avoids inverse passing off). But if Mr Slugworth simply hands over Wonka bars in their original packaging saying these are Slugworth chocolate bars no goodwill can be generated for him. This is because the consumer knows that the chocolate bar is not Slugworth's but Wonka's. In other words, because consumers do not associate the chocolate bar with Slugworth no "attractive force" is created to bring in customers.

27. As with chocolate bars, Google, in starting to call the Webkit web engine product Blink, will generate goodwill for Google only once the relevant public sees what is being provided as Blink is not Webkit. In other words, it has been repackaged and not simply sold on in its original wrapping. The relevant public for Blink is the very developers who had been writing code for WebKit. They would literally know what Webkit looks like on the inside and would recognise it from its code. Unless, and until, the code behind Blink was different from that for Webkit I cannot see how developers would treat it as a new Google product. It would still be seen by the relevant consumer as Webkit.

28. The Hearing Officer, however, appeared to treat the announcement of the fork as the creation of the new product, as is clear from the following comment at paragraph 35 of her Decision:

> …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….

29. For the reasons I have explained, I think this is a material error because the mere announcement of the fork does not "create" a product without some form of "repackaging".

30. This brings me to the question of whether a new build or update was made to create a distinct Blink product in the period on or before 23 April 2013. Unfortunately, the evidence is very poor in this regard.

31. The Respondent directed me to an article an on C:Net entitled “Blink, Google’s new Chrome browser engine, comes to life”, dated 4 April 2013 (which was included as Exhibit EB9); this includes the following:

> Yesterday, Google announced the project, which splits its browser work from Apple's in the open-source WebKit project. Today, Blink is up and running.
>
> The first updates -- including a new list of 36 Blink ‘owners’ who have authority to approve changes -- are arriving.
>
> ‘Chrome 28 will be the first blinking release,’ Chrome programmer Mike West said in a Hacker News comment. The current stable version of Chrome is version 26; new versions arrive about every six weeks.
>
> ‘The repository seems to be mostly up and working and commits are coming in,’..

32. This suggests that the first version of Chrome to include Blink would be Chrome 28. This would be somewhere between 6-12 weeks after the date of the article (based on the six-week cycle). However, in either case the first release to include the Blink product would be after 23 April 2013.

33. I was also referred to an article in Ars Technica entitled “Google going its own way, forking WebKit rendering engine”, dated 3 April 2013 (Exhibit EB3):

> For Web users and Web developers, there won't be any immediate differences. As of right now, Blink is essentially identical to WebCore, and the first pieces of work that Google does will be to clean the architecture up to remove extraneous pieces that it doesn't need. The first Canary builds will be built tonight or tomorrow, and these will trickle into developer, beta, and eventually stable releases at six-week intervals.

34. This is somewhat contradictory in that it suggests that developers will not notice anything different initially (ie no new product), but at the same time says Canary builds will be released. As there is no evidence as to the circulation of the nightly Canary builds, and what they actually contained, it would be impossible to use such a statement to determine whether goodwill could be generated in Blink based on the accessibility of such builds, particular where there is contradictory evidence of the six-week build cycle.

35. Accordingly, in the absence of direct evidence from Google as to when builds of a distinct Blick product were first released, and to whom, and whether those persons were located in United Kingdom. I must conclude that Google has failed to establish that a Blink product was distributed during the three-week period.

Is advertising enough?

36. The Hearing Officer concluded at paragraph 35:

> 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.

37. Nothing put forward by either party really contradicted this finding as to the existence of reputation. This presents the question whether the Hearing Officer was entitled to conclude that advertising is enough to establish a case for passing off.

38. The starting point is *Maxwell v Hogg* (1866-7) LR 2 Ch 307, a case of the Court of Appeal in Chancery. The judgment of Sir George Turner LJ (at page 311) starts as follows:

> "This case being, as it is admitted, altogether new, must be considered upon principle. The first principle which applies, not only to this case, but to every case in this Court is, that the Plaintiff must shew some property, right, or interest, in the subject matter of his complaint. The question, then, in that point of view is, whether the expenditure made by Mr. Maxwell upon his intended work of 'Belgravia ,' and the advertisements issued by him from July to October, have created any such right of property in him as to entitle him to an injunction restraining another person from using the same title.
>
> I will consider this question, first, with reference to the expenditure, and then with reference to the advertisements. That expenditure upon a work not given to the world can create, as against the world, an exclusive right to carry on a work of this nature, seems to me a proposition quite incapable of being maintained. It never, so far as I am aware, has been thought that any such equity exists. Then, if the expenditure alone will not confer such a right, will the advertisements do so? Such an advertisement is nothing more than an announcement of an intention on the part of the Plaintiff to publish in the month of October following a work under a given title. Can that be considered as constituting in him an equitable title, or any title, to the name under which that work is to be published? If it is to be considered as doing so, the consequence will be that, without having made any new publication at all, he might come to this Court saying: 'I have advertised my intention to publish in October a given work under a given title, and nobody else shall publish a work under that title until I have had an opportunity of bringing my work before the public.' He does not by his advertisements come under any obligation to the public to publish the work, and therefore the effect of holding the advertisements to give him a title, would be that, without having given any undertaking or done anything in favour of the public, he would be acquiring a right against every member of the public to prevent their doing that which he himself is under no obligation to do, and may never do.

Sir Hugh Cairns, from page 313, said:

> I think, also, that this case cannot be decided on the ground of the loss which may be sustained by the Plaintiff in consequence of his being anticipated in his design of publishing under this name. It is very probable that such a loss may be sustained, but the first question to be determined is, is there a right, or is there property, on the part of the Plaintiff to be protected? for if there is only loss sustained, without there being a right of property to be protected, this Court cannot interfere;…..
> It is admitted that the case is a new one, and that there is no authority precisely in point, but it must be admitted that the dicta in equity are opposed to the view that such a bill as this can be maintained; and the case of Lawson v. Bank of London , and all the definitions which have been given in this Court of the nature of the right to protection in the case of trade marks, seem to me to be opposed to the idea that protection can be given where there has been no sale, or offering for sale, of the articles to which the name is to be attached.

39. Subsequently, in *Chivers v Chivers* (1900) 17 RPC 420, Farwell J held something similar at page 431:

> It has also been put by Mr. Hughes -and I must advert to it, although perhaps it is not necessary for the purpose of my judgment-he has pressed upon me the large amount spent by the Plaintiff on advertisement. He says that by advertising the world gets to know of *Chivers*. The logical result of that would be that if a London tradesman, dealing only in London before he got any

> trade in the country at all, chooses to disfigure the fairest landscape in the kingdom by the atrocious act of advertising, he would obtain for himself, having by that means forced it upon public attention, a monopoly of the use of the name which he has thrust upon the eyes of all passengers by railway. Advertisement, distinguished from trade, is nothing. No doubt if you have the trade the advertisement assists the trade, but to say that a man can by advertising alone make his name known in connection with particular goods so as to assist him in obtaining a monopoly of the goods seems to be untenable as a proposition

40. While the issue about the geographical extent of goodwill has moved on significantly, the basic point about advertising not being sufficient is in accord with *Maxwell v Hogg*. The traditional position is, therefore, that advertising alone does not create goodwill. The authorities cited by the Hearing Officer in favour of advertising, in the absence of trade, being sufficient to found a case of passing were *Allen v Brown Watson* [1965] RPC 191 and *British Broadcasting Corporation v Talbot* [1981] FSR 228.

41. Turning first to *Allen*, this case related to the publication of a book. The book, *My Life and Loves* by Frank Harris, had been the subject of extensive pre-publication publicity. However, on the relevant date (that is, when the writ was issued), it appears that the book had been published. *Allen* cannot, therefore, be taken to be authority that advertising alone is sufficient, rather it is support for the proposition that with substantial advertising goodwill can attract quickly: see Slade LJ to this effect in *My Kinda Bones v Dr. Pepper's Stove* [1984] FSR 289 at 301.

42. In the *Talbot* case, the BBC was seeking an injunction based on the wide-scale promotion of the mark *Carfax*. Sir Robert Megarry VC stated as follows:

> I begin with the goodwill claimed by the BBC to have been built up in CARFAX as applied to their scheme. Although that scheme has not yet been launched, that does not prevent the BBC from having built up goodwill in it which is entitled to protection: see *W. H. Allen & Co. v. Brown Watson Ltd*. [1965] R.P.C. 191, where the title of an unpublished book was held to have become distinctive of that book, so that it could be protected against publication of a rival book under the same name. Here, there is ample evidence that a significant part of the public knew about the name CARFAX as distinctive of the BBC's system. ….

43. In *Kinda Bones v Dr. Pepper's Stove* [1984] FSR 289 at 302-3 it was argued by Counsel that *Talbot* was wrongly decided as *Allen* was not support for the proposition made. However, a different approach to *Talbot* was stated by HHJ Birss QC in *Plentyoffish Media Inc. v Plenty More LLP* [2011] EWHC 2568 (Ch), [2012] RPC 5 at paragraph 33:

> As regards *BBC v Talbot*, in my judgment Ms Clark is correct. One can see the parallel between that case, in which publicity generated before the actual service starts can be said to have given rise to a goodwill even though there are no customers, and a case like this one, in which the Appellant argues that publicity has given rise to goodwill even though there are no customers in the UK. However the cases are not the same. The BBC already had a business in the UK at all material times. No question of location arose. The public who heard the publicity about CARFAX knew the name to be distinctive of the BBC's service. The goodwill attached to a business situated in the UK. The line of cases ending in *Hotel Cipriani* involve a different problem — no business in the UK at all. In my judgment *BBC v Talbot* does not assist the Appellant and is not in conflict with Hotel Cipriani

44. A similar point is made by Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresention* (5th Ed, Sweet and Maxell 2016) at paragraph 3-71 (which was cited by Google). On the *Plentyoffish* approach, Google has a very established business in the United Kingdom, including, among other things, open source development projects. The extensive advertising between 4 April 2013 and 23 April 2013 led software developers to associate Blink (a new product) with Google's existing business in the United Kingdom. Accordingly, it would not matter that Google as yet had no customers for the particular product (Blink). In other words, under *Plentyoffish*, there is one rule for an existing business expanding its product range and another for a foreign business entering the United Kingdom for the first time (whether with a new product or one it has already sold overseas). This was the reasoning adopted by the Hearing Officer at paragraph 35 of her Decision.

45. However, this approach does not appear to me to be consistent with *Starbucks (HK) Ltd v British Sky Broadcasting Group* [2015] UKSC 31, [2015] 1 WLR 2628 where at paragraph 47 Lord Neuberger stated:

> … I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question...

Later at paragraph 62 he stated:

> If it was enough for a claimant merely to establish reputation within the jurisdiction to maintain a passing off action, it appears to me that it would tip the balance too much in favour of protection. It would mean that, without having any business or any consumers for its product or service in this jurisdiction, a claimant could prevent another person using a mark, such as an ordinary English word, "now", for a potentially indefinite period in relation to a similar product or service. In my view, a claimant who has simply obtained a reputation for its mark in this jurisdiction in respect of his products or services outside this jurisdiction has not done enough to justify granting him an effective monopoly in respect of that mark within the jurisdiction.

46. The key requirement is that the customers must be in the jurisdiction *for the products or services in question*. It follows, therefore, that it is not enough that the business has goodwill for other products and services.

47. Further, Lord Neuberger stated at paragraph 66 (a paragraph cited by the Hearing Officer at Decision, paragraph 34):

> 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.

48. Lord Neuberger's suggestion that *Maxwell v Hogg* would need to be overruled for a claimant to bring a passing off claim without goodwill (which must be in relation to the

relevant product or service) based on substantial advertising clearly shows that *Maxwell v Hogg* remains the law. Contrary to the Respondent's submission, I am bound by *Maxwell v Hogg*. Accordingly, as there was no goodwill in the Blink browser engine (the product) the extensive advertising by Google during the three-week period is not enough to found a claim of passing off in the relevant respect.

Co-ordinating an open source project

49. Google's alternative case is that in the three-week period it developed goodwill in a coordinated an open source project (called Blink). As I have already explained, I think it is possible for goodwill to be generated in an open source project (as well as the software product itself).

50. Further, while I have overturned the conclusions reached based on the Hearing Officer's finding of fact in paragraph 35 of her Decision, there is no reason to overturn the finding itself. Accordingly, as a matter of fact, on the relevant date the technical community would be fully aware that BLINK would be the name of Google's new browser engine and more importantly that there is an open source development project behind it.

51. This leaves the only issue whether there were customers (that is developers) working on source code or otherwise before 23 April 2013 so that there was sufficient goodwill in the United Kingdom. Google's evidence in this regard is not particularly helpful. It is clear from the evidence that almost immediately developers got on board with the project (see the C:Net article of 4 April 2013: see paragraph 31 above). I am also happy to accept that the developer market for a product like this is incredibly specialised, quite small in absolute terms, and responds very quickly.

52. While there was no specific evidence that any UK developer was involved, based on the Hearing Officer's finding and, in particular, the market share and the number of developers who engaged with the project immediately, it is more likely than not that there were sufficient domestic developers to generate sufficient goodwill in the United Kingdom by 23 April 2013. This is supported to some degree by the fact that the Appellant, while not engaging with the Google project as a developer, was aware of it and took steps as soon as it was announced.

53. As the outcome of an open source software project would be software, in my judgment it does not matter that Google is providing open source project coordination services and not software. The relevant public for both would be the same and while conceptually there is a difference (one being a product/good the other a service), it is probably not one which would be of any significance to software developers. Indeed, there are numerous decisions at EUIPO, cited by Google, where provision of software services to end users has been considered complimentary to the software product itself and so the goods and services are similar (*digi.me v Total Tim*, Opposition B 2,876,756, 28 June 2018 at 3; *Pitney Bowes Software v Spectrm Publishing*, Opposition B 2,914,979, 11 July 2018 at 2 being two recent examples).

54. The Hearing Officer concluded that a misrepresentation was inevitable from the notional use of the mark in suit (see Decision, paragraph 39). While her conclusion was based on the field of activity being identical, in my judgment the inevitability of the misrepresentation is not diminished even with the theoretically different fields of activity I have identified above.

55. In relation to damage, the Hearing Officer's conclusion was that the parties were in direct competition with one another in the provision of browsers (Decision, paragraph 41). I would express it differently as Google were not yet in the browser engine market. Developers who access browser software engines code or similar from the Appellant (assuming it were open access) might undertake to update or improve the code in the belief they are doing so as part of the Google project. In due course, when such developers submit the code to Google to be considered for its Blink project, it may be rejected as it is no longer the same. Accordingly, the diversion of software developers' time (and so money's worth) from the Google project is the damage caused to Google's goodwill.

56. While I have come by a different route, I ultimately uphold the Hearing Officer's decision that section 5(4)(a) obtains and so Google succeeds in respect of its application for invalidation.

Bad faith

57. I do not need to consider whether the application was made in bad faith. However, the Hearing Officer made certain findings which I do not think are correct. There was evidence that the Appellant used a tag line including "<blink>" before the relevant date. However, on the evidence I have seen, such use was not trade mark use and would not have created any prior rights in that mark.

58. When considering bad faith generally, it must be remembered that if the Appellant had had prior unregistered rights, it would have been entirely proper, and commercially sensible, to apply to shore them up with a registration the moment he became aware of Google's launch (this may have been what the Court of Justice was referring to in C-529/07 *Lindt* [2009] ECR I-4893 at paragraph 51 and 52; see the case comment from Moscona, "Bad faith as grounds for invalidation under the Community Trade Mark Regulation" [2010] EIPR 48 at 49).

59. As the Appellant did not have prior rights, the question as to whether the application was made in bad faith should have been whether Mr Toker (as the directing mind of the Appellant) honestly (but erroneously) believed the Appellant had prior rights when he made the application. And if he did believe such rights existed was his other conduct sufficient to find bad faith in all the circumstances. However, as I do not need to consider these questions, I will refrain from doing so.

Conclusion

60. The appeal is dismissed and, accordingly, the application for invalidation of the mark is successful. As the Respondent was unsuccessful on some of the issues, and successful on others, I make no order as to costs in relation to this appeal.

PHILLIP JOHNSON
THE APPOINTED PERSON
24 September 2018

Representation:

For Appellant: Mr Alp Toker, director of Nuanti Limited appeared in person.

For Respondent: Mr Leighton Cassidy and Mr Jude Antony of Fieldfisher LLP.