

O-224-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2596361
BY BADOO MEDIA LIMITED
TO REGISTER THE TRADE MARK**



**IN CLASSES 9, 25, 35, 38, 41, 42 & 43
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 103063 BY
BLINKX UK LIMITED**

BACKGROUND

1) On 30 September 2011, Badoo Media Limited (hereinafter the applicant) applied to register the trade mark shown on the front page. The application was examined, amended and accepted, and subsequently published for opposition purposes on 30 December 2011 in Trade Marks Journal No.6920. Prior to the main hearing the applicant removed aspects of its specification and the listing below reflects the latest changes:

In Class 9: Computer software development tools; computer software for use as an application programming interface (API) to allow access to online services for social networking; software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, web links and images via the Internet and other communications networks; computer software for building social networking applications and allowing for data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; downloadable software in the field of social networking; downloadable software in the nature of a mobile application.

In Class 35: Advertising, business management; advertising and promotion services and information services relating thereto; all provided on-line from a computer database or the Internet; compilation of advertisements for use as web pages on the Internet; provision of space on websites for advertising goods and services; business administration services for the processing of sales made on the Internet; organisation, operation and supervision of loyalty and incentive schemes; opinion polling.

In Class 38: Email and instant messaging services; chat services; provision of online chat rooms; providing access to online services relating to social networking, social introduction and dating; audio, text and video broadcasting services over computer or other communication networks, including uploading, posting, displaying and electronically transmitting data, information, audio and video images; providing access to an online network service.

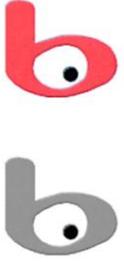
In Class 41: Publishing services; information services relating to entertainment or education, provided on-line from a computer database or the Internet; providing on-line electronic publications (not downloadable); operating chat rooms.

In Class 42: Design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others.

In Class 45: Social introduction, networking and dating services; match making services; online dating, friendship, introduction and social networking services; compilation, creation and maintenance of a register of domain names.

2) On 1 March 2012 Blinkx UK Limited (hereinafter the opponent) filed a notice of opposition, subsequently amended. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification
 <p>LIMITATION: The applicant claims the colour red as an element of the first mark in the series.</p>	2360670	13.04.04 / 31.12.04	9	<p>Computer software and computer programs; software and programs for content retrieval from the Internet and from local sources to include world news content, general web based content, local e-mail and office documents; language independent computer software that automates the processing of un-structured, semi-structured and structured information and data in any digital domain; computer software infrastructure that enables computers to form an understanding of a piece of text such as web page, e-mails, voice, images, data and/or information and people; computer software that enables comprehensive and fully automated portal infrastructure for content with Internet and intranet sites; computer software that enables flexible, scaleable and fully automated e-commerce content infrastructure for managing and personalising e-commerce content to enable high quality transactions; computer software that enables comprehensive tool kit for adding other software solutions or customisation according to a company's or individual's needs; computer software solutions that understand conceptual information independently of variations in tagging schemes or a variety of applications in use; computer software that automatically inserts tags and automatically hyperlinks similar or related information; computer software enabling business to implement intelligent, scaleable and automated applications that handle multi-media content; computer software that automatically brings relevant information to employees as they work; computer software that provides online customer service plug-ins to existing infrastructure to build an automated customer response application; computer software that automates the processing of un-structured information across all digital domains; computer software that automates key operations upon un-structured information such as e-mails, voice data and/or information, graphic, web page and people thus able to power any application dependent upon any type of information including e-commerce, customer relationship management, knowledge management, enterprise information, portals and on-line publishing; computer software and programs for searching, retrieving and profiling information by computer systems, computer networks, the Internet, intranets, databases and other digital domains; software and programs for providing access to the Internet and running web site searches; computer software that enables and/or provides concept matching, agent creation, agent re-training, agent matching, agent alerting, categorisation, title generation, taxonomy generation, summarisation, clustering, ranking, scoring, evaluation, active matching and retrieval of information, data, content and/or text; software and programs for searching, retrieving, profiling, managing, sorting, selecting and/or storing information available via the computer systems, computer network, the Internet, intranets, databases and other digital domains; software and programs capable of adapting their behaviour according to a user's instructions or responses; software and programs that enable on-line publishers and corporations to create, analyse and extract information from the computer systems, computer network, the Internet, intranets, databases and other digital domains and to automatically maintain and navigate customised portal sites; software and programs with added intelligence involving text; software and programs which deliver to users information via desktop computers, mobile telephones, personal digital apparatus and other handheld digital devices; software and programs which analyse and extract ideas and profiles in text from the computer systems, computer network, the Internet, intranets, databases and other digital domains thus</p>

			<p>enabling them to profile users based on data and/or information which is then produced and/or read and delivered to the user matching this profile; software and programs which provide information from the computer systems, computer network, the Internet, intranets, databases and other digital domains which enables users to be automatically alerted to the existence of other people whose interests coincide with their own and to be given their e-mail and telephone details; computer software and programs capable of adapting their behaviour according to a user's instructions or responses by personalising and profiling end-users the retrieval, profiling, management, and delivery of data in knowledge management, new media, and e-commerce software applications; computer software and programs for the delivery or exchange of business information to desktop computers, mobile telephones, personal digital apparatus and other handheld digital devices; computer software and programs utilising a processing engine capable of working with an arbitrary structure to provide information; computer programs and computer software having a search capability/functionality for knowledge management/enterprise portal systems or to be implemented in the computer systems, computer network, the Internet, intranets, databases and other digital domains and e-commerce sites; information retrieval software and programs; computer programs and computer software which provides an automated e-commerce content infrastructure; computer programs and computer software having an automated application which can handle multimedia, e-commerce, customer relationship management, knowledge management, enterprise information portals and on-line publishing; computer programs and computer software for alerting users to the development of news stories, financial events and the latest sports results and to other stories and/or information and to provide users with links, sound bites or video footage of latest events as selected by the user; computer programs and computer software which provides information to a mobile telephone, personal apparatus and/or handheld device or to a portal site; speech recognition software; computer programs and computer software for e-mail management software, customer relationship management, e-business, customer care, e-mail routing and security, content delivery or for client server systems; computer programs and computer software for use by and/or with the broadcast and media industries; computer programs and computer software for the provision of productivity solutions for the handling of broadcast news, digital television, convergent media and real time content for business and consumer purposes; computer software and computer programs for fetch frameworks to facilitate the implementation of custom fetch modules; computer software and computer programs to provide the overlapping functionality of modules, namely importing, scheduling and indexing; computer software and computer programs for taking and/or assembling a repository of unstructured data, agents and/or profiles and automatically partitioning the data so that similar information (such as data with related features) is clustered together, each cluster representing a concept area within the knowledge base and containing a set of items with common properties; computer software and computer programs all capable of integration with other software to provide secure access and communication and/or user identification and entitlement; computer software and computer programs which enable a manually intensive legacy keyword system to become an automated infrastructure putting information into context; computer programs and computer software which enables users to automatically form a contextual understanding of people's interests, behaviour and on-going interaction with any type of information regardless of format, location or device.</p>
		37	Maintenance of computers.
		38	Providing on-line access to the Internet, including providing access to the Internet for the purpose of running web site searches either on-line or off-line; providing search engines for obtaining, maintaining and delivering data from a database, on a global computer network or to a mobile telephone or to a personal digital apparatus and other handheld digital devices or to desktop computers; retrieval and profiling of information via networks, databases and/or the Internet.

			42	Consultancy, design, analysis, development and implementation services relating to computers, software and programs; maintenance and updating of software, computer software and computer programs; licensing, rental and/or leasing of computer software and computer programs.
 <p>Colour claimed: Red</p>	CTM 3998887	20.08.04 / 21.12.05	9	<p>Computer software and computer programs; software and programs for content retrieval from the Internet and from local sources to include world news content, general web based content, local e-mail and office documents; language independent computer software that automates the processing of un-structured, semi-structured and structured information and data in any digital domain; computer software infrastructure that enables computers to form an understanding of a piece of text such as web page, e-mails, voice, images, data and/or information and people; computer software that enables comprehensive and fully automated portal infrastructure for content with Internet and intranet sites; computer software that enables flexible, scalable and fully automated e-commerce content infrastructure for managing and personalising e-commerce content to enable high quality transactions; computer software that enables comprehensive tool kit for adding other software solutions or customisation according to a company's or individual's needs; computer software solutions that understand conceptual information independently of variations in tagging schemes or a variety of applications in use; computer software that automatically inserts tags and automatically hyperlinks similar or related information; computer software enabling business to implement intelligent, scalable and automated applications that handle multi-media content; computer software that automatically brings relevant information to employees as they work; computer software that provides online customer service plug-ins to existing infrastructure to build an automated customer response application; computer software that automates the processing of un-structured information across all digital domains; computer software that automates key operations upon un-structured information such as e-mails, voice data and/or information, graphic, web page and people thus able to power any application dependent upon any type of information including e-commerce, customer relationship management, knowledge management, enterprise information, portals and on-line publishing; computer software and programs for searching, retrieving and profiling information by computer systems, computer networks, the Internet, intranets, databases and other digital domains; software and programs for providing access to the Internet and running web site searches; computer software that enables and/or provides concept matching, agent creation, agent re-training, agent matching, agent alerting, categorisation, title generation, taxonomy generation, summarisation, clustering, ranking, scoring, evaluation, active matching and retrieval of information, data, content and/or text; software and programs for searching, retrieving, profiling, managing, sorting, selecting and/or storing information available via the computer systems, computer network, the Internet, intranets, databases and other digital domains; software and programs capable of adapting their behaviour according to a user's instructions or responses; software and programs that enable on-line publishers and corporations to create, analyse and extract information from the computer systems, computer network, the Internet, intranets, databases and other digital domains and to automatically maintain and navigate customised portal sites; software and programs with added intelligence involving text; software and programs which deliver to users information via desktop computers, mobile telephones, personal digital apparatus and other handheld digital devices; software and programs which analyse and extract ideas and profiles in text from the computer systems, computer network, the Internet, intranets, databases and other digital domains thus enabling them to profile users based on data and/or information which is then produced and/or read and delivered to the user matching this profile; software and programs which provide information from the computer systems, computer network, the Internet, intranets, databases and other digital domains which enables users to be automatically alerted to the existence of other people whose interests coincide with their own and to be given their e-mail and telephone details; computer software and programs capable of adapting their behaviour according to a user's instructions or</p>

				<p>responses by personalising and profiling end-users the retrieval, profiling, management, and delivery of data in knowledge management, new media, and e-commerce software applications; computer software and programs for the delivery or exchange of business information to desktop computers, mobile telephones, personal digital apparatus and other handheld digital devices; computer software and programs utilising a processing engine capable of working with an arbitrary structure to provide information; computer programs and computer software having a search capability/functionality for knowledge management/enterprise portal systems or to be implemented in the computer systems, computer network, the Internet, intranets, databases and other digital domains and e-commerce sites; information retrieval software and programs; computer programs and computer software which provides an automated e-commerce content infrastructure; computer programs and computer software having an automated application which can handle multimedia, e-commerce, customer relationship management, knowledge management, enterprise information portals and on-line publishing; computer programs and computer software for alerting users to the development of news stories, financial events and the latest sports results and to other stories and/or information and to provide users with links, sound bites or video footage of latest events as selected by the user; computer programs and computer software which provides information to a mobile telephone, personal apparatus and/or handheld device or to a portal site; speech recognition software; computer programs and computer software for e-mail management software, customer relationship management, e-business, customer care, e-mail routing and security, content delivery or for client server systems; computer programs and computer software for use by and/or with the broadcast and media industries; computer programs and computer software for the provision of productivity solutions for the handling of broadcast news, digital television, convergent media and real time content for business and consumer purposes; computer software and computer programs for fetch frameworks to facilitate the implementation of custom fetch modules; computer software and computer programs to provide the overlapping functionality of modules, namely importing, scheduling and indexing; computer software and computer programs for taking and/or assembling a repository of unstructured data, agents and/or profiles and automatically partitioning the data so that similar information (such as data with related features) is clustered together, each cluster representing a concept area within the knowledge base and containing a set of items with common properties; computer software and computer programs all capable of integration with other software to provide secure access and communication and/or user identification and entitlement; computer software and computer programs which enable a manually intensive legacy keyword system to become an automated infrastructure putting information into context; computer programs and computer software which enables users to automatically form a contextual understanding of people's interests, behaviour and on-going interaction with any type of information regardless of format, location or device.</p>
			38	<p>Providing on-line access to the Internet, including providing access to the Internet for the purpose of running web site searches either on-line or off-line; providing search engines for obtaining, maintaining and delivering data from a database, on a global computer network or to a mobile telephone or to a personal digital apparatus and other handheld digital devices or to desktop computers; retrieval and profiling of information via networks, databases and/or the Internet.</p>
			42	<p>Consultancy, design, analysis, development and implementation services relating to computers, software and programs; maintenance and updating of computers, software, computer software and computer programs; licensing, rental and/or leasing of computer software and computer programs.</p>
	<p>CTM 3998903</p>	<p>20.08.04 / 14.11.05</p>	9	<p>Computer software and computer programs; software and programs for content retrieval from the Internet and from local sources to include world news content, general web based content, local e-mail and office documents; language independent computer software that automates the processing of un-structured, semi-structured and structured information and data in any digital domain; computer software infrastructure that enables</p>

		<p>Priority date of 13.04.2004 claimed re UK 2360670</p>	<p>computers to form an understanding of a piece of text such as web page, e-mails, voice, images, data and/or information and people; computer software that enables comprehensive and fully automated portal infrastructure for content with Internet and intranet sites; computer software that enables flexible, scaleable and fully automated e-commerce content infrastructure for managing and personalising e-commerce content to enable high quality transactions; computer software that enables comprehensive tool kit for adding other software solutions or customisation according to a company's or individual's needs; computer software solutions that understand conceptual information independently of variations in tagging schemes or a variety of applications in use; computer software that automatically inserts tags and automatically hyperlinks similar or related information; computer software enabling business to implement intelligent, scaleable and automated applications that handle multi-media content; computer software that automatically brings relevant information to employees as they work; computer software that provides online customer service plug-ins to existing infrastructure to build an automated customer response application; computer software that automates the processing of un-structured information across all digital domains; computer software that automates key operations upon un-structured information such as e-mails, voice data and/or information, graphic, web page and people thus able to power any application dependent upon any type of information including e-commerce, customer relationship management, knowledge management, enterprise information, portals and on-line publishing; computer software and programs for searching, retrieving and profiling information by computer systems, computer networks, the Internet, intranets, databases and other digital domains; software and programs for providing access to the Internet and running web site searches; computer software that enables and/or provides concept matching, agent creation, agent re-training, agent matching, agent alerting, categorisation, title generation, taxonomy generation, summarisation, clustering, ranking, scoring, evaluation, active matching and retrieval of information, data, content and/or text; software and programs for searching, retrieving, profiling, managing, sorting, selecting and/or storing information available via the computer systems, computer network, the Internet, intranets, databases and other digital domains; software and programs capable of adapting their behaviour according to a user's instructions or responses; software and programs that enable on-line publishers and corporations to create, analyse and extract information from the computer systems, computer network, the Internet, intranets, databases and other digital domains and to automatically maintain and navigate customised portal sites; software and programs with added intelligence involving text; software and programs which deliver to users information via desktop computers, mobile telephones, personal digital apparatus and other handheld digital devices; software and programs which analyse and extract ideas and profiles in text from the computer systems, computer network, the Internet, intranets, databases and other digital domains thus enabling them to profile users based on data and/or information which is then produced and/or read and delivered to the user matching this profile; software and programs which provide information from the computer systems, computer network, the Internet, intranets, databases and other digital domains which enables users to be automatically alerted to the existence of other people whose interests coincide with their own and to be given their e-mail and telephone details; computer software and programs capable of adapting their behaviour according to a user's instructions or responses by personalising and profiling end-users the retrieval, profiling, management, and delivery of data in knowledge management, new media, and e-commerce software applications; computer software and programs for the delivery or exchange of business information to desktop computers, mobile telephones, personal digital apparatus and other handheld digital devices; computer software and programs utilising a processing engine capable of working with an arbitrary structure to provide information; computer programs and computer software having a search capability/functionality for knowledge management/enterprise portal systems or to be implemented in the computer systems, computer network, the Internet, intranets, databases and other digital domains and e-commerce</p>
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			<p>sites; information retrieval software and programs; computer programs and computer software which provides an automated e-commerce content infrastructure; computer programs and computer software having an automated application which can handle multimedia, e-commerce, customer relationship management, knowledge management, enterprise information portals and on-line publishing; computer programs and computer software for alerting users to the development of news stories, financial events and the latest sports results and to other stories and/or information and to provide users with links, sound bites or video footage of latest events as selected by the user; computer programs and computer software which provides information to a mobile telephone, personal apparatus and/or handheld device or to a portal site; speech recognition software; computer programs and computer software for e-mail management software, customer relationship management, e-business, customer care, e-mail routing and security, content delivery or for client server systems; computer programs and computer software for use by and/or with the broadcast and media industries; computer programs and computer software for the provision of productivity solutions for the handling of broadcast news, digital television, convergent media and real time content for business and consumer purposes; computer software and computer programs for fetch frameworks to facilitate the implementation of custom fetch modules; computer software and computer programs to provide the overlapping functionality of modules, namely importing, scheduling and indexing; computer software and computer programs for taking and/or assembling a repository of unstructured data, agents and/or profiles and automatically partitioning the data so that similar information (such as data with related features) is clustered together, each cluster representing a concept area within the knowledge base and containing a set of items with common properties; computer software and computer programs all capable of integration with other software to provide secure access and communication and/or user identification and entitlement; computer software and computer programs which enable a manually intensive legacy keyword system to become an automated infrastructure putting information into context; computer programs and computer software which enables users to automatically form a contextual understanding of people's interests, behaviour and on-going interaction with any type of information regardless of format, location or device.</p>
		35	Retrieval and profiling of information via networks, databases and/or the Internet.
		38	Providing on-line access to the Internet, including providing access to the Internet for the purpose of running web site searches either on-line or off-line; providing search engines for obtaining, maintaining and delivering data from a database, on a global computer network or to a mobile telephone or to a personal digital apparatus and other handheld digital devices or to desktop computers.
		42	Consultancy, design, analysis, development and implementation services relating to computers, software and programs; maintenance and updating of computers, software, computer software and computer programs; licensing, rental and/or leasing of computer software and computer programs.

b) The opponent contends that it has used its trade marks since 2004 and has acquired goodwill and reputation. The opponent contends that the mark in suit is identical or very similar to its marks. It states that both parties' marks consist of a letter "b" in lower case, and has a dot in the open space of the letter that makes the letter look like an "eye". Both marks would be verbally referred to a "b" device. It also contends that the goods and services of the two parties are identical or similar. The mark in suit therefore offends against Section 5(2)(b) of the Act.

c) The opponent also relies upon the three marks above when it contends that use of the mark in suit would take unfair advantage of or be detrimental to the distinctive

character and repute of its marks. The mark in suit therefore offends against Section 5(3) of the Act.

d) The opponent has used its signs shown above in the UK in relation to internet search software and internet search engine services and associated computer software, online and offline computer services, advertising and telecommunications services since at least 2004. As a result the opponent owns substantial goodwill in its signs and registration or use of the mark in suit will lead to misrepresentation that the applicant is in some way connected to the opponent or otherwise endorsed by the opponent. This will lead to damage by lost sales and/or dilution of its distinctive sign and the reputation and goodwill attached thereto. The mark in suit offends against Section 5(4)(a) of the Act.

3) On 11 June 2012 the applicant filed a counterstatement, subsequently amended, denying all the grounds but did request the opponent to prove use of its marks.

4) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 14 May 2013. At the hearing, the opponent was represented by Ms Whelbourn of Messrs Novagraff UK, whilst the applicant was represented by Mr Cuddigan of Counsel instructed by Messrs Bond Dickinson LLP.

OPPONENT'S EVIDENCE

5) The opponent filed an affidavit, dated 25 September 2012, by Julia Blystone the Chief Marketing Officer of Blinkx UK Ltd, a position she has held since April 2007. She states:

“2. Blinkx first began using the trade mark B device in 2004 when the company was founded. In 2005, Blinkx launched its video search engine. Since that time Blinkx has extended its activities to a wide range of internet technologies and digital video distribution.”

And:

“9. Blinkx provides internet video services that allow users to access all types of videos and related audio recordings including but not limited to, for example, news, television shows, sporting events and movies. Blinkx also licences the software to third parties to provide them with the ability to offer similar services.”

6) Ms Blystone states that her company pioneered access to video on the internet and has a reputation as the premier destination for videos and online television. She states that the website attracts a large number of users e.g in the month of March 2008 there were 56 million unique users. In the financial year 2008 annual revenue was US\$14million and approximately 130,000 euros was spent in the EU promoting the opponent's services. No details of UK/EU revenues are provided, nor are any details given as to how the promotional funds were expended. She states that her company

have won many awards, but whilst these are named it is not clear if they are UK/EU awards. She also provides the following numbered exhibits:

- 1: Printouts of the opponent's website which merely provide a history of the company. This has the device element used as the initial letter in the company name "blinkx".
- 2: Company guide showing how the opponent uses its mark: It would appear to use the device above the word "blinkx"; or in a text only version where the initial letter "b" of the word "blinkx" is the device element.
- 3: A sample invoice dated 31 August 2011 from the US office to a customer also in the USA. This uses the device element registered above the plain font word "blinkx".
- 4: Printouts from the opponent's website. Two are dated in 2012, after the relevant date. The other is from 2008. It is unclear what this exhibit is intended to show as there is little or no detail upon it. All the web pages have the word "blinkx" where the initial letter "b" is replaced by the b device mark, at the top of the page.
- 5: Financial results for 2011. These appear to be global figures with no breakdown for the UK/EU. This is headed by the device element used as a replacement for the letter "b" in "blinkx".
- 6: Internet articles. The first item is dated 15 October 2010 and is from an internet blog. It relates to the opponent's intention of raising additional finances by offering shares in the company. The company is listed on the London stock exchange but the story and those on attached pages appear to be aimed at the USA, given the way that the dates are shown and the content of the other stories. It refers to the opponent by its name in normal font with no use of the device element. The second internet blog is dated 20 May 2010 and discusses use of the opponent's search engine on a mobile phone. It refers to the opponent as "Blinkx", with no use of the device element. The third item is an undated report relating to the opponent's financial results for 2010. Again, there is no use of the device element simply the company name in normal font. None of the three articles appear to be linked to a newspaper or magazine.
- 7: This consists of what appear to be press articles, all of which are dated in 2012, after the relevant date. Three appear to be UK based and show use of the name of the company in the form "Blinkx" without a device element, and are:

Cambridge News: it discusses the share price and profits forecasts of the company.

Metro: this simply provides an overview of the company specifically stating that it offers online videos and tv shows;

Marketing Week: this again simply offers the most basic overview of the opponent's services;

Others appear to from the USA: *Media Post*; *C21 media.net*; *The Drum*; *TechCrunch*; *Mashable*. In all of these the company is referred to by name with the word "blinkx" in normal font, sometimes with the letter "b" being in uppercase, other times in lower case.

APPLICANT'S EVIDENCE

7) The applicant filed a witness statement dated 6 December 2012, by Michelle Kennedy who describes herself as Head of Legal at the applicant company. She comments that the evidence filed by the opponent does not detail what goods or services the opponent's marks have been used on or indeed where they have been used. She also provides her opinions on whether the marks/goods/services are similar, as well as commenting on her views on each of the grounds of opposition. She also refers to "state of the register" evidence, none of which are of assistance to me. She states:

"16: In contrast to the Blinkx services, the applicant's principal activities are the setting up and management of a social networking site which offers particular features and games enabling its members to be introduced to other members who have registered with that site. In particular, the applicant has never used the Badoo mark in relation to the provision of commercial video search engine facilities and has no intention of doing so in the future."

OPPONENT'S EVIDENCE IN REPLY

8) The opponent filed a second affidavit, dated 12 February 2013, by Ms Blystone. She provides the following numbered exhibits:

- 8: This consists of website prints which show the word "blinkx" at the top of the page where the letter "b" has been replaced by the device element. They all have copyright dates for 2007-2009 inclusive. Two prints show a "wall" of television screens with what appear to be different television shows upon each of them. There are also mentions of "products and solutions" most of which have the word "blinkx" in them in normal font. The write up states that the site offers 35 million hours of video which can be searched.
- 9: This is a list of domain names that are owned by the opponent. Most are completely unconnected to the word "blinkx". Others which do contain the word "blinkx" show that the opponent has registrations in a number of European countries and the UK. The registrations are dated prior to the application date in

the instant case. In all cases the word “blinkx” is in normal font with no use of the device element.

- 10 & 11: These consist of two documents, presumably prepared by the opponent, which provide information regarding the features of the core service offered and also describes the various products offered. The basic feature appears to be a video search engine and the products appear to be based around the same feature but also offer the chance to view television programmes, films, music videos etc. This exhibit contains no evidence that any of these products are actually being offered to the public. The word “blinkx” at all times is in normal font with no use of the device mark.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) I first turn to the ground of opposition based on section 5(2)(b) which reads:

5.-(2) A trade mark shall not be registered if because -

- (a)
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

12) The opponent is relying upon its trade marks listed in paragraph 2 above which are clearly earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the dates of both parties’ marks, the opponent’s marks are subject to proof of use. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if-

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

(4) For these purposes-

- (a) use of a trade mark includes use in a form 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

(7) Nothing in this section affects –

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

13) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the marks has been made. In the instant case the publication date of the application was 30 December 2011, therefore the relevant period for the proof of use is 31 December 2006 – 30 December 2011. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

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

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the

mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

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

14) The opponent has provided evidence that it offers via its website access to videos and television programmes. However, it is not clear that this service is being targeted at consumers in the UK or EU. The opponent has offered no figures for users from the UK or EU. It has provided no turnover figures for the UK or EU. There is a single claim to have promoted the mark in the EU when Ms Blystone states that 130,000 Euros were spent in the EU on promotion in 2008, however, no details as to what these monies were spent on was provided. Nor are any examples of the usage provided which would show that the registered marks were used. There are no examples of the marks registered being used solus, only as part of the word “Blinkx” where the device takes the place of the letter “b”. The use shown is solely upon the website pages. The press articles mention the opponent by name (Blinkx) but do not use the opponent’s registered marks. These press articles mention the basic business of the opponent but it is more in the context of its financial results and share price, not with UK consumers using the service. The fact that the company is listed on the London stock exchange is perhaps the reason for such coverage but this does not equate to using the mark in the UK/EU. There is no evidence that the opponent sought to attract UK/EU users or advertisers. If the opponent had genuinely used its mark in the UK/EU it would have had a plethora of items that it could have filed, at the very least the number of UK/EU visitors to its site, which I assume it must have details of in order to attract advertisers. The absence of any such evidence and the reliance on the “we are on the internet, it is global and so includes the UK/EU” simply does not wash. These issues were put to the opponent’s representative and the following exchanges were part of the rational behind the opponent’s case.

“MS. WHELBOURN: No, but you also have to look at the fact that the company started in the UK.

THE HEARING OFFICER: So?

MS. WHELBOURN: So its reputation started in the UK.

THE HEARING OFFICER: You have offices in London, you have offices in California, so what is that office in London doing? It as sure as heck is not doing anything so far as the evidence is concerned. Where are letters to advertisers in the UK and the European Union?

MS. WHELBOURN: We failed to file them.

THE HEARING OFFICER: Or is it simply that you have a plate in someone's office in order to have a listing on the London Stock

Exchange?

MS. WHELBOURN: I suspect that might be the case now but that is not how the company started.”

And:

“MS. WHELBOURN: It started out in 2004 as a UK business. It has expanded globally since then. It has moved its offices primarily to the US because that is where the Chief Executive Officer decides to live.

THE HEARING OFFICER: In other words, what you are saying to me is, because you started out in the UK and because you now provide stuff on the internet, you have to have use in the UK?

MS. WHELBOURN: Yes.”

15) The opponent has failed to provide any evidence of use of its mark and as such it has fallen at the first hurdle. There is no use of the device mark, even in a variant form which shows use of the mark in the UK/EU in an effort to create a market. The ground of opposition under Sections 5(2)(b) and 5(3) must fail.

16) Clearly, the evidence provided also fails to show that the opponent has any goodwill in the marks relied upon under its ground of opposition under section 5(4), and so the opposition under section 5(4)(a) must also fail.

CONCLUSION

17) The opponent has failed under Sections 5(2)(b), 5(3) and 5(4)(a) against the whole of the specification applied for.

COSTS

18) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Considering the other side's evidence	£600
Preparing for and attending a hearing	£1,000
TOTAL	£1,800

19) I order Blinkx UK Ltd to pay Badoo Media Ltd the sum of £1,800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of May 2013

**George W Salthouse
For the Registrar,**

the Comptroller-General