

European Union: DUCK ... DUCK... GO! The Popular Search Engine Wins Invalidation Action against Pirate's Identical Registration in the EU

By [Robin L. Warren](#)

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Many of us are familiar with the children's game "Duck Duck Goose." A circle of children, all sitting with their legs tucked, eager to spring up once they are selected with a mighty thump on their head and the yell of "Goose!" and off they go.... around and around, until someone is caught, or not.

The name for the ethical search engine duckduckgo.com derives from this children's game, rendering the brand name DUCKDUCKGO highly distinctive for search engine services.

Use of the search engine has rapidly grown since it first launched in 2008, especially due to increasing widespread concerns over privacy on the Internet – the DUCKDUCKGO search engine does not track its users' information and/or search histories. As we see with many clients who grow in popularity, pirates track their rise and rush to file applications in jurisdictions where trademark rights are "first to file," hoping to cash in on a high monetary reward once the true brand owner enters the market. And so in 2016, the third party called Tesla Investment Trading Limited (unrelated to the famous car company) filed an identical application for DUCKDUCKGO in the EU covering DuckDuckGo's identical services of interest – "providing search engines for the internet."

Fross Zelnick advised DuckDuckGo to file an invalidation action against Tesla's registration based on bad faith as DuckDuckGo did not have any prior applications or registrations in the EU. We argued that there was no way Tesla was unaware of DuckDuckGo's search engine at the time it filed its application, and so was clearly attempting to rip off DuckDuckGo's brand. DuckDuckGo and Tesla each filed their own fresh applications for DUCKDUCKGO and opposed each other pending the outcome of the invalidation action.

We worked with Bomhard IP and the DuckDuckGo team to gather evidence and craft a strong affidavit and brief showing the reputation of its mark from its launch until mid-2016 (Tesla's filing date) to prove Tesla's bad faith. DuckDuckGo was able to provide us with excellent press clippings, public facing analytics (i.e., number of daily searches from various time periods and jurisdictions), and various additional promotional materials from the relevant period.

Tesla responded to the invalidation action by filing evidence of its use of the mark in an effort to show it was a legitimate business that used the mark DUCKDUCKGO in good faith. But, on closer review, much of the evidence appeared fabricated and/or irrelevant. For example, Tesla submitted employment contracts using a cryptocurrency that was not active at the time of the contract, and several press releases showing different date formats than those found on the real websites.

After reviewing the evidence and arguments asserting Tesla's bad faith, the EUIPO Cancellation Division agreed that there was no way Tesla did not know about DuckDuckGo's search engine when it filed its application in mid-2016, and that the evidence showed Tesla's dishonest intentions. The decision was based particularly on the evidence showing DuckDuckGo's significant use of its DUCKDUCKGO mark by mid-2016, both globally and in the EU (including use in nearly all EU member states), the identical service covered by Tesla's application (providing search engines), and the distinctiveness of the mark itself. All the above made a coincidence extremely unlikely, and the EUIPO noted that Tesla failed to provide any plausible explanation as to how the mark was created. The Office also criticized all of Tesla's evidence, finding it "very unconvincing" and "absolutely insufficient" to show any real use or any genuine attempt to use the mark in the EU.

The EUIPO concluded that Tesla likely "filed the mark with the intention to sell it later with large profit, in view of the growing renown of the applicant's search engine and, in consequence, the growing value of the trademark."

This is a great outcome for DuckDuckGo, especially since it can be difficult to secure a successful outcome in an invalidation action based on bad faith in the EU. One could say, Tesla is now DUCK... DUCK... GONE!

CLIENT QUOTE:

"A great team and a great decision – Fross Zelnick navigated this case with expertise and a strong strategy. We could not be more pleased with the outcome."

Megan Gray, General Counsel and Vice President of Public Policy for DuckDuckGo