# O/0936/24

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3707646**

**IN THE NAME OF SOLALABS LTD**

**AND**

**AN OPPOSITION THERETO BY S. L. LEIGHTON**

**UNDER NO. 430496**

## Background and pleadings

1. On 7 October 2021, Solalabs Ltd ("the applicant") filed trade mark application number 3707646 for the word "Solaverse" ("the contested mark"). The application was published in respect of the following goods and services:

> Class 9: Video game programs; Video games software; Video game software; Downloadable video game programs; Downloadable video game software; Computer video game software; Interactive video game programs; Video game computer programs; Game programs for arcade video game machines; Video games programs [computer software]; Software programs for video games; Games software for use with video game consoles; Video and computer game programs; Pre-recorded video tapes featuring games; Video games on disc [computer software]; Computer programs for video and computer games; Interactive entertainment computer software for video games; Programmed video games contained on cartridges [software]; Downloadable interactive entertainment software for playing video games; Electronic downloadable publications in the field of video games; Video games [computer games] in the form of computer programs recorded on data carriers; Game software; Games software.
>
> Class 28: Video game consoles; Hand-held electronic video games; Token-operated video game machines; Games; Arcade games.
>
> Class 35: Retail services in relation to games.
>
> Class 41: Video game services; Video game entertainment services; Video game arcade services; Providing online video games; Providing on-line video games; Computer and video game amusement services; Entertainment services in the nature of video games; Providing online information on computer and video game strategies.
>
> Class 42: Video game software development; Video game software design; Computer programming of video games; Programming of video game software;

Computer programming of video and computer games; Design and development of video game software.

2. The application is opposed by Senna Lewis Leighton. Mr Leighton claims that the application was filed in bad faith and requests that it be refused in full under s. 3(6) of the Trade Marks Act 1994. His case appears to be as follows:

- Between May and September 2021, Mr Leighton began designing and developing a metaverse concept under the name "SolaVerse";

- On 6 October 2021, he registered the domain name "TheSolaverse.com", along with three other "thesolaverse" domains;

- Also on 6 October 2021, Mr Leighton posted a tweet on https://twitter.com/solaverse_nft which read "October 31st, 2021";

- On 7 October 2021, that tweet was replaced by a tweet reading "November 11th, 2021";

- The contested mark was filed on 7 October 2021;

- Prior to 7 October 2021 but no earlier than late September 2021 the entity behind the applicant was promoting via twitter.com/solaverse_2146 an "NFT Metaverse sandbox" project called "SOLAVERSE 2146" said to be "coming in 2022";

- Mr Leighton's tweet on 6 October will have caused the applicant to conclude that Mr Leighton would be both a competitor and the "first to market";

- Consequently, the application was a calculated attempt to hinder Mr Leighton's entry into the market. The applicant's primary motivation was to interfere with Mr Leighton's interests in the "SOLAVERSE" mark, not to further its own interests in "SOLAVERSE 2146".

Mr Leighton also asserts that it is relevant that:

i) The applicant knew that Mr Leighton used "SOLA" alone and in combination, e.g., in the name "SOLASTARS", to identify his goods and services;

ii) By 27 October 2021, the profile picture for the applicant's Solaverse 2146 Twitter profile had been changed to resemble that of Mr Leighton's The SolaVerse profile;

iii) On 13 October 2021, Mr Leighton filed, through his company, an application for "The SolaVerse" in classes 9 and 42.[1] The applicant was aware of the application by 14 October 2021 but waited until 8 November 2021 to issue a letter before action, which required a response by 15 November 2021. This is said to be calculated to cause maximum disruption to the revised launch date of 11 November 2021;

iv) On 20 October 2021, the director of the applicant applied for the mark "SOLA" in respect of goods and services in nine different classes, including 9, 35, 41 and 42;[2]

v) On 21 December 2021, the applicant, as SolaLabs Ltd, applied to register trade mark number 3735263 for the word "Solaverse" in class 36, for a specification identical to that of UK trade mark number 3734781 for "The SolaVerse", owned by Senna Ltd (Mr Leighton's now-dissolved company).[3]

vi) Mr Leighton also notes that there was a further application for "Solaverse" in class 9 under number 3743704 on 16 January 2022 but makes no specific allegation in this regard.[4]

3. The applicant filed a defence and counterstatement denying the grounds and putting Mr Leighton to proof. The applicant says that:

- The "Sola Group" includes Solapave Holdings Ltd and Solalabs Ltd. Since 2014 it has obtained a number of trade marks including the word "SOLA" across 32 countries;

[1] UK trade mark number 3709487. This trade mark was opposed by the present applicant and the proceedings were consolidated. However, the trade mark became bona vacantia and the application was deemed withdrawn, leaving only the present application to be decided.
[2] UK trade mark number 3712477. This application has been withdrawn.
[3] UK3735263 is now withdrawn.
[4] The register entry for this trade mark shows it was made by SolaLabs Ltd and is also now withdrawn.

- It manufactures software and hardware, and the classes applied for cover its products;

- Its board first discussed the “Solaverse project” in 2020, at which time a domain name was purchased;

- It had no knowledge of Mr Leighton’s activities prior to filing the application. It conducted “standard due diligence searches” at the beginning of September and again prior to filing. It found only one trade mark (UK801507517) and no company names of concern, which led it to conclude that it was “safe to register it”. The application was “sanctioned” on 4 September 2021;

- It had no knowledge of Mr Leighton before 13 October 2021, when it contacted him by private message. This was followed on 8 November 2021 by a letter from the applicant’s solicitors to Mr Leighton’s company;

- It purchased “Solaverse.com” over two years prior to filing the trade mark application and the domain names “Solaverse.org”, “Solaverse.io” and “Solaverse.app” eight days before Mr Leighton’s purchase of his domain names (which it accepts took place on 6 October 2021);

- Solalabs and Solaverse posted job advertisements on 2 October 2021;

- It disputes whether Mr Leighton posted his first tweet on 6 October 2021 and asserts that the account had no audience at the time. The applicant’s position is that even if the tweet were posted as alleged, it is fanciful that anyone noticed it prior to the application being filed;

- Solapave has been marketing itself as blockchain enabled since 2018. The applicant was “marketing digital space within the game months prior” and “achieved our presale target in September when we built up to announcement”;

- “Solaverse 2146 was introduced after the opponents’ [sic] aggressive approach so that our staff could recognise our own work and team”;

- The Twitter branding has not been changed.

4. Both parties filed evidence. Neither party requested a hearing, nor did they file written submissions in lieu. This decision is therefore taken following a careful reading of all of the papers.

5. Neither party is professionally represented.

**Relevance of EU law**

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. This is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

**Evidence**

7. As I have indicated, both parties filed evidence. Mr Leighton provides evidence on his own behalf. The applicant's evidence is provided by Dominic Mangles, the applicant's director. Each of the witnesses gives an account of events both prior to and following the filing of the contested mark, as well as some documentary evidence to support their version of events. As both have exhibited appendices to their statements which are identified only by a single letter or number, I will preface any references to the appendices with the witness's initials, SL or DM respectively, for the sake of clarity.

8. Regrettably, as is so often the case, the witnesses have not confined themselves to giving an account of the facts but have included submissions in their statements. The format of the witness evidence is also somewhat difficult to follow, as they have both used their statements to respond to other documents in these proceedings. This poses a particular difficulty in the case of the applicant's evidence, which does not identify the document to which Mr Mangles is responding. Given the timing of the evidence filing and consolidation, and that the statement is headed for the opposition to Senna Ltd's trade mark (which no longer forms any part of these proceedings), it appears likely that the comments are responses to the form TM8 and counterstatement filed by Mr Leighton in that case. It is, however, not clear.

9. Both parties have levelled a number of accusations at the other side. I have read all of the evidence carefully but I will refer in this decision only to the matters necessary to decide this opposition.

10. Neither witness was cross-examined.

**Bad faith**

The law

11. An objection to a trade mark on the grounds of bad faith is provided for at s. 3(6) of the Act, which reads:

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

12. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening,* Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening),* Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening),* Case T-507/08, EU:T:2011:46. So far as relevant to the present case, it summarised the law as follows:

> "68. The following points of relevance to this case can be gleaned from these CJEU authorities:
>
> 1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
>
> 2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52]."

13. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

14. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3032 (Ch) (approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Ltd & Ors* [2010] EWCA Civ 110).

15. It is also clear from the case law that the mere fact that an applicant for a trade mark knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton Mağazacilik*. The applicant may have reasonably believed that it was entitled to apply to register the mark, such as where there had been honest

concurrent use of the marks: *Hotel Cipriani*. However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat Trade Mark* [2003] RPC 11, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited v DDTM Operations LLC* [2019] EWHC 769 (Ch).

16. An accusation that a party has acted in bad faith is serious. It is necessary for a party alleging bad faith to prove, on the balance of probabilities, that the applicant acted in bad faith. The relevant date for the assessment of the applicant's conduct is the date on which the contested application was filed, i.e., 7 October 2021. It is true that evidence from after that date may be relevant if it casts light on the applicant's state of mind at the relevant date. However, it must be stressed that it is the applicant's state of mind at the relevant date which matters. Evidence which shows poor conduct on the part of the applicant after the relevant date will only assist an opponent if it reveals that the applicant's intentions at the time when it filed the mark were incompatible with accepted standards of ethical behaviour or honest commercial and business practices. In short, even if the applicant's behaviour after the filing date is open to criticism, that is not of itself determinative of bad faith.

Findings of fact: chronology

17. The events prior to the relevant date appear to be as follows. On 6 June 2020 the domain name solaverse.com was registered.[5] It was updated on 21 October 2021. Mr Mangles says that "we" registered it but the name of the purchaser is redacted in the exhibit. There is no indication in the documentary evidence of who registered the domain originally or the nature of the update in October 2021.

18. On 4 September 2021, Mr Mangles emailed his solicitor as follows:

> "We need some trademarks [sic] ASAP for Solaverse

[5] SL Appendix 2; DM Appendix X.

> Specifically in gaming, virtual worlds, we're building a metaverse with some technology partners as a showcase place but also a gaming universe with NFT characters (the SolaPunks)
>
> There is currently Solarverse reserved for pigments out of Delaware, US with extension to U.K. that might need appeasing.
>
> Also thank you for the report on the dynamic charging. I've begun writing up what we have on that so far with a view to the R&D finishing on it in Jan/Feb".[6]

19. The domain names "solaverse.io" and "solaverse.org", along with domain privacy and protection, were purchased by Dominic Mangles on 28 September 2021.[7]

20. On 2 October 2021, a tweet was posted on the Solaverse 2146 account which says "in development for 2022" and that job advertisements can be found on the website.[8] The print provided by Mr Leighton is dated 13 October 2021 but he does not appear to claim that the profile or handle were different at the earlier date.[9]

21. At 19:51 on 6 October 2021, five account names or handles which included the name "Solaverse" were present on Twitter.[10] One of these is "Solaverse 2146", with the handle "@Solaverse_2146".

22. At 20:14 on 6 October 2021, Mr Leighton posted a tweet on "SolaVerse @solaverse_nft" which read "October 31st, 2021".[11] There are no images or branding for the account shown on what is, apart from the Twitter bird and some redaction, a black screen.

23. SolaLabs Ltd was incorporated on 7 October 2021.[12] The "Standard Industrial Classification" of its activities is 58210, which Mr Mangles, unchallenged, says corresponds to publishing of computer games. On the same day, the contested trade mark was filed.

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[6] DM Appendix K.
[7] DM Appendix X1.
[8] SL Appendix 7; DM Appendix T.
[9] See Mr Leighton's witness statement at §11 of the section headed "personal statement of events".
[10] SL Appendix 5.
[11] SL Appendix 1.
[12] DM Appendix A.

24. There is, additionally, evidence that Mr Leighton's Twitter account was created in May 2021.[13] The print which has been adduced shows the profile name "The SolaVerse" and the handle "@the_solaverse". The print is not dated and, given that the content includes accusations that the applicant's account is fake, appears to post-date the relevant date. Mr Leighton confirmed in his evidence that he adopted the "@the_solaverse" handle on 13 October 2021. My understanding is that Twitter profile names may also be changed at any time. Consequently, although the evidence shows that an account was created in May 2021, it does not establish that either the profile or handle used the word "solaverse" at that time.

Analysis and conclusions

25. I accept that Mr Leighton posted a tweet from his "SolaVerse" account on 6 October 2021, the day before the relevant date. However, the tweet was posted in the evening, the day before the application was filed. There is no indication that the parties were known to one another prior to 6 October 2021 and no reason why the applicant would be actively monitoring Mr Leighton's account. Pre-application checks should be made but Mr Mangles' email of 4 September 2021 suggests that this had already been done. It is not unreasonable, in my judgement, for the checks to have been carried out as early as the beginning of September. Nor is it necessary for additional clearance searches to be carried out on the filing day itself. That would plainly be impractical. It is unclear whether the searches which were carried out extended to Twitter but Twitter is, as I understand it, primarily a blogging site rather than a place where goods and services are sold, though it may be used for promotion. Its utility for revealing traders who might be using the name over and above trade mark registers or general website searches is likely to be limited. I do not consider that the applicant can be criticised for a failure to perform a specific search on Twitter. In my view, it is not inevitable that the applicant must have seen Mr Leighton's tweet, nor am I prepared on the evidence before me to infer that the applicant would have seen it, prior to the application.

26. Mr Leighton also says that he registered various domain names including "solaverse" on 6 October 2021. The applicant accepted this in its counterstatement (§4); Mr Mangles' statement admits the registrations but disputes the timing. My view

[13] DM Appendix L.

is that, absent good reason, the applicant cannot resile from its original acceptance. No reasons at all have been given for the change in position. Nevertheless, given the proximity to the relevant date and that these were simply registrations rather than functioning websites offering goods/services for sale or even indicating what the sites may be used for in future, the existence of the domain registrations is not sufficient to show that the applicant either knew of Mr Leighton's activities or that its sole motivation for the trade mark application was to prevent Mr Leighton's entry into the same market.

27. There is a discrepancy in the applicant's case about when it first became aware of Mr Leighton. It is said in the applicant's counterstatement (signed by Mr Mangles under a statement of truth) that "Solaverse 2146 was introduced after the opponents' [sic] aggressive approach so that our staff could recognise our own work and team".[14] However, the counterstatement also asserts, as does Mr Mangles' witness statement, that the applicant was first alerted to Mr Leighton's tweet on 13 October 2021, when they were contacted by their solicitors in Singapore over legal concerns about the promotion of cryptocurrency in the tweet.[15] There is clear evidence from Mr Leighton that the "Solaverse 2146" Twitter profile was visible on Twitter on 6 October 2021. Mr Leighton's evidence is that the first contact from the applicant/Mr Mangles was on 13 October 2021.[16] To state the obvious, if the Solaverse 2146 profile was created after the applicant found out about Mr Leighton, and it was already visible on 6 October, the applicant cannot have been ignorant of Mr Leighton until 13 October. On balance, as the applicant first contacted Mr Leighton on 13 October and in view of the detail in Mr Mangles' account of how Mr Leighton's tweet was brought to the applicant's attention, I consider that it is probable that the applicant was unaware of Mr Leighton before 13 October 2021. The first contact from the applicant to Mr Leighton was a very short message (on Twitter) to assert its rights. There is no obvious reason why the applicant would wait a week to send such a message.

28. The above finding means that the account relating to the creation of "Solaverse 2146" in the counterstatement is incorrect. In my view, it probably reflects a desire to portray the applicant in a more favourable light and/or Mr Leighton in a less favourable one. Bearing this in mind, along with the change in position outlined at paragraph 26,

[14] Counterstatement, §10.
[15] Witness statement, §21.
[16] See SL Appendix 9.

above, I have approached Mr Mangles' unsupported narrative evidence with some caution, because of the risk that his version of events is coloured by his partiality. However, despite the inconsistencies in the applicant's case, the evidence establishes, in my view, that Mr Mangles, who appears to be the driving force behind the applicant, had an interest in the "Solaverse" sign prior to the filing date. That is not to say that the applicant's evidence is consistent or convincing in every respect. Mr Leighton has cast doubt on whether the applicant, or the entity behind it, really purchased the "solaverse.com" domain name on 6 June 2020 or whether the applicant purchased that domain after the relevant date. The documentary evidence is not determinative either way; the applicant has not filed any response to Mr Leighton's challenge. Mr Mangles says in his evidence that "we" purchased the domain name in June 2020 but I agree with Mr Leighton that, if someone connected to the applicant (it could not have been the applicant, as it was not yet incorporated) registered the domain for solaverse.com in June 2020, one would have expected to see reply evidence putting it beyond doubt.

29. I also note that, in amongst many criticisms of Mr Mangles and the applicant, and wholly unsupported allegations of fabrication of documents, Mr Leighton points out that an invoice purporting to show use of "Solaverse" in connection with the sale of metaverse-related goods in September 2021 names the provider as SolaLabs Ltd.[17] As the applicant was then not yet incorporated, this casts some doubt on the authenticity of the document. However, SolaLabs Ltd was incorporated only 9 days later. This may, therefore, be indicative of an administrative oversight and I am not persuaded that, of itself, the discrepancy clearly shows that the invoice was fabricated. In any event, there is other, stronger evidence that the applicant had used "Solaverse" prior to 6 October 2021 and the relevant date.

30. The instruction to solicitors on 4 September 2021 to apply for the contested mark, the registration of domain names containing "solaverse" at the end of September 2021 and the undisputed tweet from the "Solaverse 2146" account of 2 October 2021 all pre-date Mr Leighton's tweet and indicate that at the relevant date the applicant, or those behind it, had plans to use the sign "solaverse". In addition, there is evidence that licence agreements and a "MetaHuman Creator" (the latter for creating or

[17] DM Appendix G.

modifying characters) were accepted in September 2021.[18] The screenshot is dated 2022 but the user appears to be logged in as "SOLAVERSE". It is not clear if the username could have been changed after the relevant date but the agreements support the claim to an intention to produce computer games before the relevant date (and Mr Leighton's tweet).

31. Mr Mangles has also provided an account of how the application came about. He says that "Sola" and "SolaPave" have been in use since August 2014 in relation to "a solar paving system that features a screen for video/user interface" but that "[during] covid we were forced to pivot into creating a digital version of the product and so in June 2020 started to craft a game […]. We registered Solaverse.com and had requested our IP lawyer register the name at this time."[19] Although the pivot from solar paving to computer games is surprising, and there is no evidence to support the claim that the applicant has traded as a manufacturer of software and hardware, the email to solicitors indicates that Mr Mangles did intend to use the "Solaverse" mark in relation to computer games. This appears to have culminated in a public announcement that a product would be released in 2022 connected with the "Solaverse 2146" name, before Mr Leighton tweeted on 6 October.

32. Mr Leighton's own case is that prior to 7 October 2021 but no earlier than late September 2021 the entity behind the applicant was promoting via twitter.com/solaverse_2146 an "NFT Metaverse sandbox" project called "SOLAVERSE 2146" said to be "coming in 2022". The fact that the applicant was doing so points strongly towards both the applicant having genuine intentions to trade under the mark and that the applicant was acting to protect its own interests, rather than solely filing a blocking registration. I find some support for this conclusion in a "whitepaper" provided, though I do not need to rely on this document for my findings.[20] The document describes the applicant's "Solaverse", which appears to be a computer game incorporating sale of NFTs. There are references in the document to 2021 which

[18] DM Appendices E, E1, E2
[19] See also DM Appendices H-J and a Singaporean trade mark registration at DM Appendix D.
[20] The exhibit is strictly inadmissible as the only header sheet reads "APPENDICES E- EPIC GAMES END USER LICENCE AGREEMENTS". This plainly relates to other exhibits; the white paper is not otherwise labelled but it appears to be intended to be appendix C to Mr Mangles' statement. The applicant was invited to remedy the defect on multiple occasions (official letters dated 13 May 2024, 5 June 2024 and 10 July 2024) but did not do so. Mr Leighton has not taken issue with the exhibit and referred to it in his own evidence.

suggest it is from that year. There is nothing to indicate whether it was prepared before the relevant date but Mr Leighton accepts that it was published before his own whitepaper.[21] The detail about the applicant's "metaverse" concept, coupled with the fact that it was published before Mr Leighton's own version, points towards a genuine intention to market a product under the "Solaverse" trade mark.

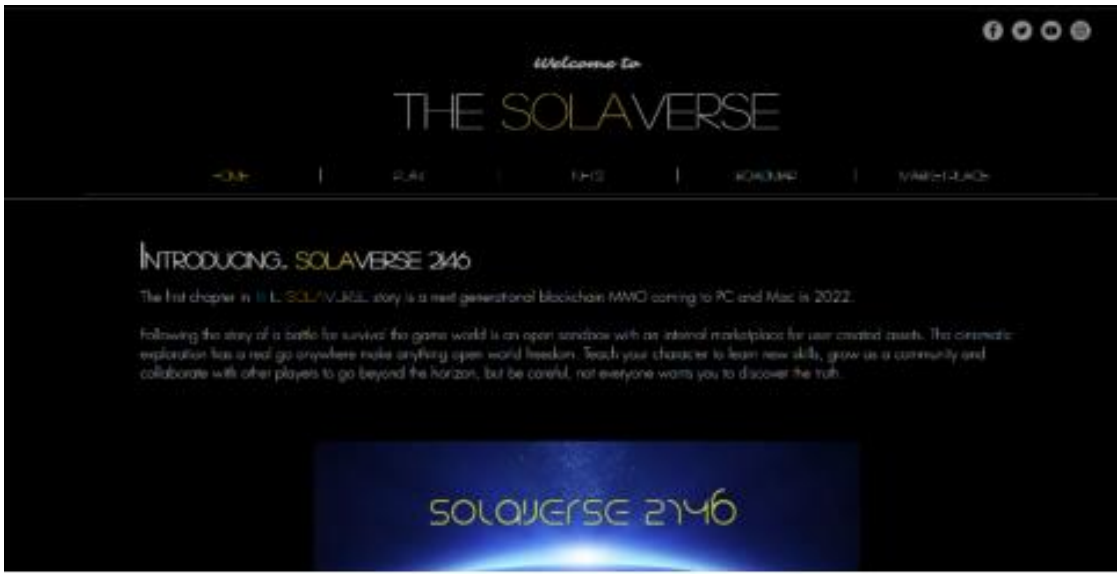
33. I have not overlooked Mr Leighton's evidence that he first created documents relating to his own "SolaVerse" concept in May 2021.[22] The evidence is not convincing because all of the documents were modified on 24 November 2021 and there is nothing to show their names or content at an earlier date. The specific date matters not, however, because the crucial point is that the evidence does not show that these documents could have become known to the applicant: the evidence is from Mr Leighton's computer document library. The only possible public statement from Mr Leighton prior to his 6 October tweet was the existence of a Twitter account using "SolaVerse". However, there were no posts relating to the sign, still less any indication that a business was trading under it. There is no evidence whatsoever to show use of "SOLASTARS" or any other "SOLA"-prefixed sign by Mr Leighton.

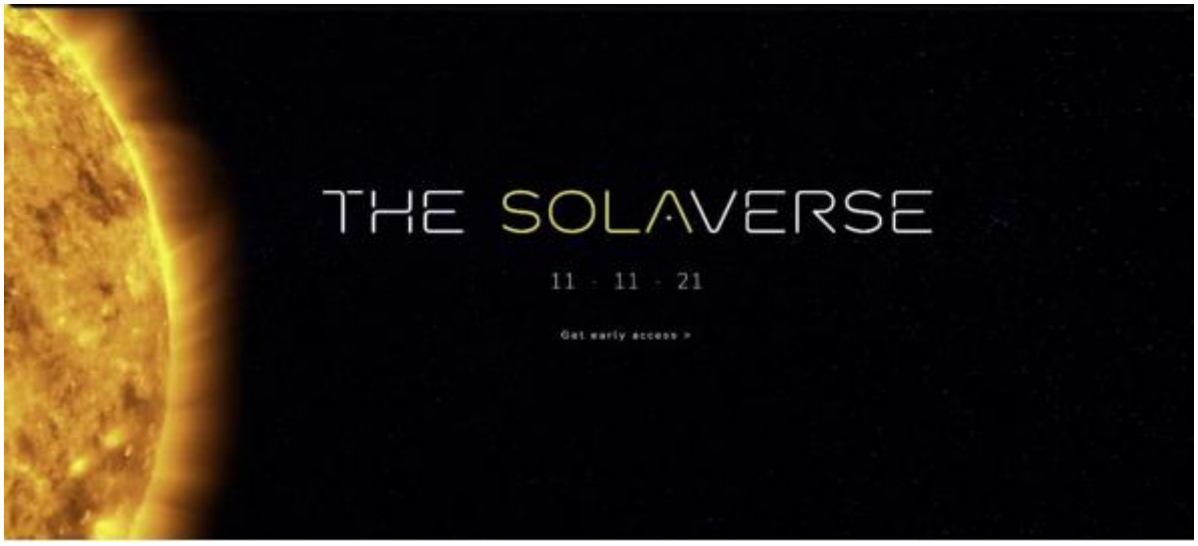
34. Mr Leighton accepts that "Solaverse" it is a "common" name and provides evidence of several parties using it.[23] This suggests that the name is not particularly imaginative (it appears to derive from the "Solana" blockchain and "metaverse") and it is not, therefore, surprising that more than one individual has thought of it. Absent any clear indication of an ethically dubious motivation, the fact that the mark is not highly distinctive, or even that it is descriptive, is not sufficient for bad faith. It is also not grounds for bad faith that the applicant beat Mr Leighton, or anyone else who might wish to use the mark, to the trade mark application, without more. There is nothing more.

35. The parties have provided evidence from after the relevant date detailing their various interactions. It is not an edifying spectacle. Mr Leighton accuses the applicant of copying his "brand". In relation to the parties' websites, he complains that the

[21] Witness statement, heading "Key points response to Dominic Mangles witness statement", paragraph 2, fifth bullet.
[22] SL Appendix 4.
[23] Mr Leighton's statement, §3. In addition to the tweet already described, see also SL Appendices 6 and 19.

applicant's website (the first image below, from 25 October 2021) copies the branding on his own website (the second image, from 13 October 2021):




36. Mr Leighton also complains about changes in the applicant's Twitter profile, shown below:


37. Mr Leighton asserts that the second image shows that his profile, a representation of which is below, was copied:


38. The presentation of “sola” in yellow, in contrast to white for the other parts of “THE SOLAVERSE”, is the same as Mr Leighton’s website and the typefaces are very similar. However, the blue and orange devices, respectively, are quite different. The appearance of “SOLA” on its own on a circular background on the applicant’s later profile is, in all likelihood, not a coincidence. Both parties are probably trying to assert rights in “SOLA” alone and it is entirely possible that this move by the applicant was prompted by having seen Mr Leighton’s profile. However, the main difficulty for Mr Leighton’s case is that all of these images date from after the relevant date. Put shortly, the fact that the parties rapidly descended into acrimonious exchanges and other unimpressive behaviour after the relevant date does not in itself establish that the applicant’s intentions at an earlier point in time were reprehensible. In the absence of any evidence, or grounds for a legitimate inference, that the applicant had any knowledge of Mr Leighton at the relevant date, I do not find this evidence establishes bad faith in filing the trade mark application.

39. Much the same applies to the later trade mark filings made by the applicant. Absent clear evidence that the applicant had any knowledge at all of Mr Leighton and his intentions and/or that the applicant’s filing of the application was solely for the illegitimate purpose of blocking Mr Leighton’s business interests, all that this evidence shows is that the applicant’s behaviour degenerated after the relevant date.

40. In relation to the interactions after the relevant date more generally, none of the evidence shows that the applicant attempted to extract any kind of benefit, monetary or otherwise, from Mr Leighton as a result of the trade mark application. There is, for example, no offer to sell him the trade mark. On the contrary, the applicant attempts (or, as Mr Leighton asserts, those connected to the applicant attempt) to restrain Mr Leighton's use on the grounds that his is a "fake" account, unrelated to and encroaching on the applicant's business and pre-existing rights. This indicates that the applicant believed it had a genuine claim to the exclusive use of "solaverse" for video-game-related goods and services. The business might have been little more than an idea at the time but I see nothing which demonstrates that the application was filed in bad faith.

41. A further objection made by Mr Leighton appears to be that the application is for "Solaverse" solus, rather than "Solaverse 2146". There is nothing in this. It is common for businesses to protect their signs in entirety or in part. For example, a business may protect the name of their brand with the logo, or the name and logo separately. One of the reasons for doing so is that the scope of protection may be greater for one or the other. To take the present case as an example, the similarity between "Solaverse" on its own and another mark using the same or similar word is likely to be higher than if there were an additional point of difference because of the numbers "2146". This would put a claimant in a better position for enforcing their mark. An application for the word "Solaverse" is consistent with normal business practices and I do not consider that this would fall short of ethical norms.

42. I also see nothing in Mr Leighton's complaints about the applicant's formal letter before action not issuing until 8 November which discloses what may have been in the applicant's mind at the relevant date. The date of the letter may have disrupted Mr Leighton's plans and it is true that there was some delay. However, I do not consider either of these sufficient to infer bad faith at the relevant date. In particular, the delay was not unreasonable, given that it involved instructing solicitors, and is not indicative of any particular motivation.

43. In conclusion, I find that Mr Leighton has not established to the civil standard (i.e., on the balance of probabilities) that at the relevant date the applicant had any knowledge of him or his alleged business plans, including the tweet he posted on 6

October 2021 and the domain name registrations purchased on the same day. His claim fails for this reason. Further, the applicant has demonstrated to the required standard that its primary motivation for applying for the trade mark was to protect a sign which it intended to use in trade. The opposition is therefore dismissed.

**Conclusion**

44. The opposition has failed in its entirety. The application will proceed to registration.

**Costs**

45. The applicant has been successful and is entitled to an award of costs. Unless there are reasons why another approach may be appropriate, the tribunal awards costs on a contributory rather than compensatory basis. I see no reason to depart from this principle here. The Litigants in Person (Costs and Expenses) Act 1975, the Civil Procedure Rules Part 46 and the associated Practice Direction set the amount payable to litigants in person at £19 per hour.

46. The applicant filed a costs pro forma setting out the time it spent on each aspect of the claim. However, this includes time on its opposition to Senna Ltd's application, which was consolidated with these proceedings at the time. As the applicant did not file a notice of opposition and as there was no hearing in this case, the figures for these aspects of the case must relate exclusively to the proceedings against Senna Ltd's application, the costs for which are not before me. There is no official fee for a form TM8, which is the only form the applicant filed in the present opposition.

47. I accept that, as an unrepresented litigant, the applicant will have had to take some time to familiarise itself with the grounds of opposition. The notice of opposition is not especially prolix but the counterstatement is thorough. The time claimed for "considering forms filed by the other party" will include considering forms in Senna Ltd's application, which is not before me, though as the present opposition was filed first and the issues overlapped to a significant extent, the lion's share of the time will have been expended in this case. I consider that 6 hours is reasonable for the pleadings.

48. The applicant has not been professionally represented at any stage of these proceedings but the claim in relation to the preparation and consideration of evidence/ submissions includes 23 hours of professional time, totalling £7,670, split across two law firms and one barrister. The first entry is for "reconnaissance and information gathering". Reconnaissance is not a cost reasonably related to the proceedings. It is not clear to what "information gathering" relates. If it was advice specific to the case, the applicant should have made it clear, because there is no obvious reason to award the costs for professional representation. The second appears to concern the professional representation for preparing the applicant's opposition against Senna Ltd's application: those representatives came off the record before that opposition was consolidated with the present case. The third entry is for a barrister's review and preparation of written submissions. Written submissions were not filed in this case, so this also appears unrelated to the present opposition. That leaves 15 hours for preparation of evidence on the part of the applicant itself. Only one set of evidence was filed which was adopted across both oppositions. 15 hours is a reasonable figure.

49. I award £399 to Solalabs Ltd as a contribution towards the cost of the proceedings, calculated as follows:

| | |
|---|---|
| Filing and considering the pleadings: | £114 (6 hours) |
| Filing and considering evidence: | £285 (15 hours) |
| **Total:** | **£399** |

50. I order Senna Lewis Leighton to pay Solalabs Ltd the sum of £399. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 27th day of September 2024**

**Heather Harrison**
**For the Registrar**
**The Comptroller-General**