

O-241-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2374683
IN THE NAME OF TIK TIK LTD IN RESPECT OF THE FOLLOWING TRADE
MARK IN CLASS 14:**

DUFFER

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY
THERE TO UNDER NO. 83762
BY DUFFER OF ST GEORGE LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF registration no. 2374683
in the name of Tik Tik Ltd
in respect of the following trade mark in Class 14:**

DUFFER

and

**the application for a declaration of invalidity
thereto under no. 83762 by Duffer of St George Limited**

BACKGROUND




1) Raj Seha applied for the registration (“the registration”) of the above mark on 4 October 2004 and the registration procedure was completed on 15 April 2005. An assignment to the current proprietor, Tik Tik Ltd (Hereafter “Tik Tik”), was recorded on 10 November 2010. The registration covers the following goods in Class 14:



Watches, clocks; horological and chromometric instruments; jewellery.

2) On 4 May 2010, Duffer of St George Limited (hereafter “St George”) applied for the registration to be declared invalid. The grounds of the application are as follows:

- St George is the proprietor of eight earlier registrations all consisting of or containing the distinctive element DUFFER, DUFFERS, or DUFFER OF ST.GEORGE. It contends that since its first use of these marks in 1994 they have established a reputation in the UK. Tik Tik’s mark, therefore, falls foul of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (“the Act”) and should be invalidated under Section 47(2) of the Act. The earlier registrations relied upon are:

Relevant Details and Mark	Specification of goods and services
CTM*2191351 Duffer Filing date: 20 April 2001 Registration date: 12 August 2002	Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices. Class 9: Spectacles; spectacle frames. Class 25: Clothing, in particular trousers, jackets, T-shirts, pullovers, sweat-shirts, shirts, shawls, bermuda-shorts, underwear, scarfs, socks, coats,

	skirts; hats, caps, in particular baseball caps; shoes.
<p>CTM2431229</p>  <p>Filing date: 29 October 2001 Registration date: 12 March 2003</p>	<p>Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 9: Spectacles; spectacle frames.</p> <p>Class 25: Clothing, in particular trousers, jackets, T-shirts, pullovers, sweat-shirts, shirts, shawls, bermuda-shorts, underwear, scarves, socks, coats, skirts; hats, caps, in particular baseball caps; shoes.</p>
<p>CTM3538774</p> <p>St. George by Duffer</p> <p>Filing date: 13 November 2003 Registration date: 30 March 2005</p>	<p>Class 9: Spectacles; spectacle frames.</p> <p>Class 18: Leather and imitations of leather, and goods made of these materials (included in class 18); trunks and travelling bags; umbrellas, parasols and walking sticks.</p> <p>Class 25: Clothing, in particular trousers, jackets, T-shirts, pullovers, sweat-shirts, shirts, shawls, bermuda -shorts, underwear, scarfs, socks, coats, skirts, hats, caps, in particular baseball caps, shoes.</p>
<p>CTM2065951</p>  <p>Filing date: 30 January 2001 Registration date: 4 October 2002</p>	<p>Class 16: Printed matter; pager bags; tissue-pager; all included in class 16.</p> <p>Class 24: Woven garment labels, all included in class 24.</p> <p>Class 25: Clothing; shoes, boots; hats, caps.</p>
<p>2191270</p>  <p>Filing date: 10 March 1999 Registration date: 22 October 1999</p>	<p>Class 25: Footwear, clothing, headgear.</p>
CTM2191344	Class 3: Soaps; perfumery, essential oils, cosmetics,

<p>Duffers</p> <p>Filing date: 20 April 2001 Registration date: 23 June 2005</p>	<p>hair lotions; dentifrices.</p> <p>Class 9: Spectacles; spectacle frames.</p> <p>Class 25: Clothing, in particular trousers, jackets, T-shirts, pullovers, sweat-shirts, shirts, shawls, bermuda-shorts, underwear, scarfs, socks, coats, skirts; hats, caps, in particular baseball caps; shoes.</p>
<p>CTM2322535</p>  <p>Filing date: 27 July 2001 Registration date: 7 October 2002</p>	<p>Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 9: Spectacles, spectacle frames.</p> <p>Class 25: Clothing, in particular trousers, jackets, T-shirts, pullovers, sweat-shirts, shirts, shawls, bermuda-shorts, underwear, scarfs, socks, coats, skirts; hats, caps, in particular baseball caps; shoes.</p>
<p>CTM2191427</p>  <p>Filing date: 20 April 2011 Registration date: 3 September 2002</p>	<p>Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 9: Spectacles; spectacle frames.</p> <p>Class 25: Clothing, in particular trousers, jackets, T-shirts, pullovers, sweat-shirts, shirts, shawls, bermuda-shorts, underwear, scarfs, socks, coats, skirts; hats, caps, in particular baseball caps; shoes.</p>

*Community Trade Mark

- At the relevant date, St George was in a position to prevent use of Tik Tik's mark on the basis of the law of passing off because St George had a reputation and goodwill in the UK identified by the signs DUFFERS and DUFFER OF ST GEORGE. The registration therefore falls foul of Section 5(4)(a) of the Act and should be invalidated under Section 47(2).

3) Mr Sedha subsequently filed a counterstatement arguing that the application for invalidation should fail in respect of all the grounds claimed.

4) Only St George filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 29 June 2011 when the applicant for invalidation, St George was represented by Alan Fiddes for Urquhart-Dykes & Lord LLP. Tik Tik was not represented at the hearing and it also chose not to file any written submissions.

St George's Evidence

5) This takes the form of eleven witness statements. Ten of these are from individuals involved in the fashion industry, three of which are from the same company and another states that he represents "a number of names". One identifies himself as being from the Office of Fair Trading. All state that they "have been involved in the fashion industry" since a variety of dates, varying from 1985 to 2001, but they do not explain in what capacity. The statements all use a consistent form of wording and several witnesses have chosen to personalise a template version of the statement by merely hand writing their details at the relevant points in the statement.

6) All these witnesses state that they are "fully aware of the reputation of the Duffer of St George brand and in particular their use of DUFFER as a trade mark in the United Kingdom in respect of clothing and other fashion accessories" and "in view of their reputation, if I were to see the use of DUFFER on a watch I would believe that it had come from Duffer of St George Limited".

7) The final witness statement, dated 14 December 2010, is by Marco Cairns, design director of St George. He explains that, together with his business partner, Eddie Prentergast, he founded St George's predecessor in title in 1984. Originally, it was a small-scale retailer selling vintage clothing and accessories such as footwear, glasses and watches. In 1987, it began producing its own collection of reproduction vintage clothing. By 1993, a few additional stores were opened, including its flagship store in Convent Garden, London. As the business grew, relationships were developed with other companies that have been supplied with its clothing. A list of some of these companies is provided at Exhibit MC1 and lists Debenhams plc, Harrods, Selfridges, Aspecto, JD and Scotts.

8) Mr Cairns states that the business generated the following turnover:

Year	Turnover (£)
2000	4,925,599
2001	8,531,271
2002	5,970,020
2003	4,939,349
2004	4,629,295

9) He states that historical information for the same period relating to promotional spend is no longer available, but at Exhibit MC2 he provides examples of promotional material issued at that time together with a press article from the same period. The first page of this promotional material is titled "Press from Duffer Archive 1986-2002". These exhibits illustrate use of DUFFER, DUFFER ST GEORGE and DSG appearing on or in respect of men's clothing and shoes.

10) Mr Cairns states that St George also sold watches and a number of press cuttings and advertisements are provided at Exhibit MC3 to illustrate this. These show that St George was selling *Pulsar* branded retro LED digital watches. One of these exhibits is from *Style* magazine and dated 21 September 1997. A further exhibit showing these watches is dated 1998.

11) Exhibit MC3 also contains a number of press articles including an undated page from an unknown source, titled "6 of the best signet rings". A monogram ring available from Duffer St George is one of the six rings illustrated. The ring bears the monogram DSG. Another article is an interview with the founders of St George that appeared in *Draper* magazine on 20 March 2004. A text box appearing on the first page of this article, titled, "Duffer Details" discloses that "retail is 20% of the £8.5m turnover business", "Non-Duffer brands are 20% of the retail business", "Export is 20%-30% of overall sales", "UK stockists: Sport, 70, Shield, 19, and tailoring, 8" and "Number of stores: 2". On the second page, a list of historical facts about the business are provided, including that the DUFFER business began in 1984 and celebrated its 20th anniversary in 2004 and that in 1999, "Duffer wins *Sky* magazine fashion award for best Menswear Label and *Menswear/FHM* award for Retailer of the Year."

12) A further article in the same exhibit appeared in the *Telegraph Magazine*. Although undated, the text gives a strong indication that it was published in about 2004 e.g. "...the two men who created [Duffer's two Covent Garden stores recount] a history that began 20 years ago this year." The article records that, at that time, it was a global business with a £10 million annual turnover and that it turned down an approach from the retailer *Marks and Spencer*. The article discusses the impact of the brand upon British male fashion, concluding that it was at least comparable as "any other British designer of the past two decades". An article from the business section of the *Times* newspaper, dated 14 August 2001, discloses that DUFFERS wholesaling division sells to some 80 stores in the UK including *Harrods*, *Harvey Nichols* and *Selfridges* as well as six hundred stores overseas.

13) An undated article from an unattributed publication announces that "Debenhams has signed streetwear brand The Duffer of St George to its Designers At Debenhams roster. Called St George by Duffer the men's casualwear and accessories range will be launched in stores for autumn 04." An article that appears in *Drapers* magazine on 9 October 2004 records how "St George by Duffer" proved to be *Debenham's* "best ever launch".

14) Numerous other press articles, such as the *Independent Review*, all dated between 2001 and 2004 discuss the brand and provide further confirmation of the facts detailed above, as well as fashion focused articles in magazines such as *Loaded*, featuring DUFFER men's clothing.

15) Exhibit MC4 consists of copies of photographs, or in one case, a newspaper article, all undated showing celebrities such as Jamie Oliver, Nicole Appleton and Victoria Beckham wearing sweatshirts bearing the DUFFER mark.

16) Exhibit MC5 and Exhibit MC6 are copies of photographs of how St George and Tik Tik use their marks. Mr Cairns points out that both parties use their word marks with a coat of arms.

DECISION

The legislation

17) The case has proceeded to final determination on the basis of Section 5(2) (b), Section 5(3) and Section 5(4)(a) of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47(2) of the Act. The relevant parts of Section 47 of the Act read as follows:

“47. - (1) ...

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

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

(b) ...

Section 5(3)

18) I find it convenient to begin with a consideration of the ground for opposition under Section 5(3) of the Act. This reads as follows:

“5.-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

19) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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.”

20) All of the marks relied upon by St George are all registered and have filing dates that pre-date the filing date of Tik Tik’s registration. Therefore, all these marks qualify as earlier marks as defined by Section 6 of the Act. However, for the purposes of my considerations I will base my analysis only on St George’s CTM2191351 DUFFER as this appears to represent its best case.

21) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (LOADED)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc (MASTERCARD)* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7, *Davidoff & Cie SA v Gofkid Ltd (DAVIDOFF)* [2003] ETMR 42, *Intel Corporation Inc. v CPM United Kingdom Ltd (INTEL)* [2009] RPC 15, *L’Oreal v Bellure* [2010] RPC 1 and *Whirlpool Corp v Kenwood Limited* [2010] RPC 2.

22) The applicable legal principles arising from these cases are as follows:

a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *CHEVY*).

b) Under this provision the similarity between the marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier mark and the later mark or sign (*Adidas Salomon v Fitnessworld*, paragraphs 29-30).

c) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).

d) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting marks, within the meaning of *Adidas-Salomon and Adidas Benelux*. (*INTEL*)

e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the CJEU in *CHEVY*, paragraph 30).

f) Whether use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).

g) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation (*Spa Monopole v OHIM*).

h) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*INTEL*).

i) Taking unfair advantage of the distinctive character or repute of a mark relates not to detriment caused to the earlier mark but to the advantage taken by the third party. Such an advantage may be unfair even where the use is not detrimental to the distinctive character or to the repute of the mark (*L'Oreal v Bellure*). It is not sufficient to show that an advantage has been obtained. There must be an added factor of some kind for that advantage to be categorised as unfair (*Whirlpool Corp v Kenwood Limited*).

Reputation

23) From the CJEU's comments in *CHEVY* it is known that for a reputation to exist, the relevant marks must be known by a significant part of the public concerned and that particularly important considerations are the market share held by the marks, the intensity, geographical extent and duration of use and the level of promotion undertaken. Further, the CJEU also comments, in its judgment

in *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH (PAGO)*, Case C-301/07, that a reputation in one Member State may be sufficient for the purposes of establishing a reputation of a CTM.

24) The evidence illustrates that the DUFFER mark has been in use continuously since the 1980s in respect of retail services and in respect of its clothes collection since 1994. Exhibits from St George's archive illustrate the prominent use of DUFFER on its clothing in a number of promotional materials labelled as being from the period 1986 to 2002. Turnover for the five years prior to the relevant date was in the region of £4.5 million to £6 million and with one year peaking at over £8.5 million. It is also clear from the evidence that St George has had a significant impact upon the UK fashion industry. The DUFFER mark and the St George business has been showcased in a variety of national newspapers, newspaper supplements and also in fashion and lifestyle magazines all before the filing date of Tik Tik's registration. An article that appeared in *The Times* newspaper in 2001 disclosed that DUFFER goods were available, at that time, from 80 stores around the UK including such well-known stores as *Harrods*, *Harvey Nichols* and *Selfridges*.

25) The evidence also illustrates that St George also uses other marks, in particular DUFFER OF ST GEORGE and DUFFERS. The exhibits show these marks and the DUFFER mark being regularly used together in the same promotional material and referred to interchangeably in press articles. Whilst the two additional marks exhibit differences to the mark DUFFER, the natural contraction of DUFFER OF ST GEORGE is DUFFER. Therefore, it is my view that this use assists in establishing a reputation in the mark DUFFER.

26) Taking all of the above into account, I conclude that the mark DUFFER is known by a significant part of the public concerned in the UK and that at the relevant date it had been used for some 17 years with an increasingly broad geographical spread across the UK. It has been widely promoted in the national press and was sold, not only through a couple of its own-branded stores, but also by well known and widespread department stores. Taking account of the guidance, particularly in *CHEVY* and *PAGO*, I conclude that such use is sufficient to establish a strong reputation in respect of St George's CTM for the mark DUFFER and in respect of *men's clothing and hats*.

The Link

27) Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. I am mindful of the recent comments of the CJEU in *INTEL* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The CJEU also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

28) It is self evident that the respective marks are identical, both consisting of the single word DUFFER. Whilst the word does have a meaning, namely “an incompetent or stupid person”¹, it has no meaning in relation to St George’s goods and therefore its mark is endowed with a reasonably high level of distinctive character.

29) Most of the respective goods share common characteristics at a very high level of generality, namely they may all be described as fashion items and therefore can all be described as complimenting each other aesthetically. However, it has been commented upon by the GC in Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi* (paragraph 27) and Case T-116/06 *Oakley v OHIM – Venticinque* (paragraph 86), that consumers may search for a range of goods with an “aesthetic harmony” and this is a common feature of the entire fashion and clothing sector but is too general a factor to justify a finding that all the goods concerned are complementary and, thus, similar. Such a finding may be fatal to an attack based upon Section 5(2)(b) of the Act, however, Section 5(3) of the Act can apply whether the goods at issue are similar or not.

30) The evidence demonstrates that at least in 1997 and 1998, St George sold *Pulsar* branded vintage watches. At the hearing, it was contended by Mr Fiddes

¹ "duffer". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 30 June 2011 <<http://oxforddictionaries.com/definition/duffer?rkey=anzWNM&result=1>>.

that it is common for watches and clothing to share common trade channels being sold in the same retail outlets. Further evidence filed in support of this assertion is the ten witness statements from, what Mr Fiddes described as “knowledgeable, independent third parties”. All attest to being aware of the reputation of the Duffer of St George and to believing that if they saw a watch bearing the DUFFER mark, they would believe that it had come from St George. Nine (three of which are from the same company) of these appear to represent companies where the link to the fashion industry, and to St George, is not explained. The tenth is from an individual from the Office of Fair Trading, however, the reason why he has knowledge of the fashion industry is not explained. In the absence of further information regarding these individuals and the nature of their relationship with St George and the fashion industry, I find that these statements do not advance St George’s case to any great extent.

31) Nevertheless, having concluded this, St George in its evidence, illustrates that it sells its clothing through department stores such as Debenhams, Selfridges and Harrods. In such environments, as well as in its own retail stores, I accept that the full range of fashion items may be sold. I believe I am qualified to comment, as I am an average consumer of fashion goods (as are most, if not all, adults in the UK). In this capacity, I can say that consumers are familiar with costume jewellery, watches, clothing, bags and sunglasses all being sold from a single concession within a department store or from bespoke fashion goods shops. The consumer is familiar with brands being extended from clothing to other fashion items such as accessories, watches and jewellery etc.

32) Taking account of all of the above, it is clear to me that the consumer will make the necessary link between the respective goods.

Heads of damage

33) It is well established by the CJEU that the heads of damage applicable under article 8(5) of Regulation No 40/94 (Section 5(3) as incorporated into the Act) are threefold, namely: 1) detriment to distinctive character, 2) detriment to repute, 3) unfair advantage of the distinctive character or repute. It has been established that such damages must be demonstrated by real, as opposed to theoretical, evidence and it cannot be assumed merely because the earlier mark has a substantial reputation (see *MASTERCARD*).

34) At the hearing Mr Fiddes argued that use, by Tik Tik, of its mark in respect of *watches* would result in it taking unfair advantage of the distinctive character and repute of St George’s mark and that, by extension, the same finding should exist in respect of *jewellery*. He conceded that the case was less strong when considering use in respect of *clocks*.

35) As I have already commented above, it is common place on the high street for there to be brand extension from clothes to other fashion items, such as

shoes, accessories, jewellery and watches and also for such goods to be sold from the same sales outlets. The consumer is therefore familiar with seeing the marks of traders in the fashion industry being used on such a range of goods. With this in mind and the fact that St George has built a significant reputation in respect of *men's clothing and hats*, when the consumer sees the same mark upon *watches* or *men's jewellery* it will be assumed that there is a commercial connection between the goods. Such a connection is likely to result in Tik Tik taking unfair advantage in that it may, for example, benefit from being associated with promotional activities relating to the earlier mark. Whilst not conclusive in itself, and notwithstanding my previous criticisms, St George's evidence from the third party witnesses lends some support for this.

36) St George has also produced evidence to illustrate that TikTik uses a coat of arms as well as the word DUFFER upon its packaging for watches and Mr Fiddes contended that this is directly influenced by St George's brand style as it too often uses a coat of arms, in particular with the words THE DUFFER OF ST GEORGE. Whilst not conclusive when considered in isolation, this provides further support for the contention that Tik Tik is taking unfair advantage of the repute of St George's mark.

37) Taking all of the above into account, on the balance of probability, I find that the application for invalidation is successful insofar as it relates to Tik Tik's *watches* and *jewellery*. Further, as the terms *horological and chronometric instruments* also cover *watches* this decision extends to these terms also. *Clocks*, on the other hand, because they are not personal fashion items, will not be associated with *men's clothing and hats* bearing the same mark. As such, the application for invalidation fails in respect of these goods.

38) Tik Tik's registration therefore survives in respect of *clocks* only.

39) In light of these findings, the invalidation action is largely successful. As such it is not necessary for me to go on to consider the grounds based upon Section 5(2)(b) and Section 5(4)(a) of the Act. Certainly, St George will not be able to improve upon its level of success in respect of Section 5(3) of the Act.

COSTS

40) The invalidation action having been substantially successful, St George is entitled to a contribution towards its costs. Mr Fiddes argued that it would be appropriate for costs to be at high end of scale or even slightly higher because it only came to light two days before the hearing that Tik Tik would not participate in the hearing and neither did they intend to file any submissions. Mr Fiddes inferred from this that Tik Tik is no longer interested in the mark and should have simply surrendered the mark. I do not see this as necessarily being the case and there are numerous alternative reasons, not least the issue of affordability of being represented at the hearing, for not attending. As such, I dismiss Mr Fiddes

claims for any enhancement to the award of costs. It is appropriate that costs are awarded according to the published scale.

41) In making the award, I take account that only St George filed evidence and that a hearing has taken place. I award costs on the following basis:

Preparing Application and statement and considering statement in reply	£500
Preparing evidence	£700
Preparing and attending hearing	£500
TOTAL	£1700

42) I order Tik Tik Ltd to pay Duffer of St George Limited the sum of £1700. This sum is 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 8th day of July 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**