

O-054-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION Nos. 2417958 AND 2426529
STANDING IN THE NAME OF
LCD ENTERPRISES LIMITED**

AND

**IN THE MATTER OF THE CONSOLIDATED REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER Nos. 83435 & 83437
BY CHIPPERFIELD ENTERPRISES LIMITED**

BACKGROUND

1) LCD Enterprises Limited (hereinafter the registered proprietor) has the following trade mark registered in the UK:

Mark	Number	Date Applied for and date registered	Class	Specification
CHIPPERFIELD CIRCUS	2417958	29 March 2006 / 10 November 2006	28	Toys, toy vehicles, scale model vehicles, teddy bears, plush toys.
CHIPPERFIELD'S CIRCUS	2426529	7 July 2006 / 12 January 2007	28	Toys, toy vehicles, scale model vehicles, teddy bears, plush toys.

2) By an application dated 23 March 2009 Chipperfield Enterprises Limited applied for a declaration of invalidity in respect of these registrations. The grounds are, in summary:

a) The applicant has been using the mark CHIPPERFIELD CIRCUS in the UK since 1835 in respect of circus performances, and since the 1960s in respect of collectable toys. As such it has built up a goodwill and reputation in respect of the mark in the UK. The marks of the registered proprietor have been registered in breach of Sections:

- 3(6) as the registered proprietor acted dishonestly by registering the marks;
- 3(3)(b) as the marks are such as to deceive the public as to the origin of the products;
- 5(1) as the goods and marks are identical to the applicant's earlier mark;
- 5(2)(a) as the marks are identical to the earlier mark of the applicant and the goods are similar;
- 5(3) as the trade marks are identical and are used in respect of goods and services which are dissimilar;
- 5(4)(a) as the applicant has goodwill in the identical mark in the UK;
- 6(1)(c) because the mark of the applicant is well known as defined by sections 55 and 56 of the Trade Marks Act 1994;
- 60(3)(a) as the registration of the trade mark is in the name of a person who is an agent or representative of a person who is the proprietor of the mark in a convention country.

3) I note that in the statement of grounds the applicant does not provide any details of an earlier trade mark, nor has any evidence been provided with the statement to back up any of the other grounds.

4) The registered proprietor filed a counterstatement denying the above grounds. The registered proprietor also states that the applicant is not the successor in title to any trade mark rights that James Chipperfield may have had. They also deny that the applicant is the proprietor of any trade

mark rights or that the applicant has used the name CHIPPERFIELD in relation to goods in Class 28.

5) Both sides filed evidence. Both ask for an award of costs. The matter came to be heard on 16 November 2010 when the registered proprietor was represented by Mr Austin of Messrs Chapman Molony and the applicant by Mr Tritton of Counsel instructed by Messrs RT Coopers Solicitors.

APPLICANTS' EVIDENCE

6) The applicant filed nine witness statements. The first, dated 26 February 2009, is by Richard Chipperfield who describes himself as "the Managing Director and the sole beneficial owner of the applicant company" adding that it was incorporated in July 1968. He states that his company is the rightful owner of the marks CHIPPERFIELD CIRCUS and CHIPPERFIELD'S CIRCUS. He states that his company has filed an application for the trade mark CHIPPERFIELD CIRCUS in respect of goods in Class 28. He states:

"My family has been trading continuously since 1835 under the Earlier Trade Marks in respect of the circus. The Applicant owns Chipperfield Enterprises Limited and is the rightful owner of the Earlier Trade Marks. The Earlier Trade Marks belong to my family and are still in use by the Applicant in respect of the circus in which there are performances from time to time outside the UK and the name continues to be used in relation to genuine collectable Corgi Toys that are being sold globally through auctions and especially on the internet through eBay and other websites ("the Toys"). Further and/or in the alternative, the Earlier Trade Marks are still household names globally."

7) Much of his statement is a reiteration of the grounds of invalidity, or are couched in the terms of the Trade Marks Act, and so do not assist me in my decision. A number of the exhibits are also duplicated. He also supplies a great deal of information on the registered proprietor including share holdings and turnover which are not relevant to my decision. He states that the registered proprietor employed a lady named Adrienne Fuller who was a Corgi employee for many years and who dealt with Mr Chipperfield personally when she was at Corgi in relation to the manufacture of various toys. After the demise of Corgi, it is stated that the registered proprietor company was set up to manufacture diecast toys including ones with the name CHIPPERFIELD upon them as the original Corgi toys were sought after collectables. This is the basis of the bad faith claim.

8) Mr Chipperfield states that the name CHIPPERFIELD is known with regard to circus performances world-wide. However, it later emerges in his statements that the use of the name in relation to circus events in the Far East is in fact controlled by a different legal entity. It also becomes apparent that much of his evidence pre-dates the existence of the applicant company and that in the absence of an assignment of goodwill this evidence is irrelevant. This point was accepted by Mr Tritton at the hearing.

9) There are a number of references to Corgi die-cast models/toys. However, it would appear that there were three distinct issues of such items by Corgi/Mettoy/Mattel. The evidence on this is somewhat confused as there are a number of references to "Corgi" models and their values but it is less certain which period is referred to on each occasion. The first issue would seem to be in the early sixties (although sales continued until 1971), the second version in the years 1994/95 and the final issue during 1996/97. He states:

“88. Mattel took over Corgi and launched a new range of Toys in 1994-1995. They produced 12 sets of Toys with one released every month. They were released with a full catalogue featuring Carl Moore’s Chipperfield model circus for backdrop photographs. Each product comprised the following:-

The model or models
One of 12 replica posters
One of 12 collector cards”

10) Mr Chipperfield states that in the 1970s the circus featured on television around the world including on Christmas Day. However, no details are provided. He also provides a list of items such as catalogues, plates, badges, posters, and newspapers etc that are now regarded as collectables. However, he provides no details as to how the applicant was involved with the production of any of these items. He also provides a number of exhibits:

- RC15, 17, 18, 21, 22: Excerpts from a book which show the circus, and a selection of vehicles with the Chipperfield’s logo in the UK in the period 1970-1980.
- RC19: A photograph of various items of memorabilia such as toys, horse brasses, posters and calendars. The only date is that upon a calendar which is dated 1995 and produced for Corgi.
- RC 23: A selection of posters used in the UK dated 1973-1995.
- RC24-30: Pages from the Corgi book about Chipperfield die-cast models with references to models produced in the 1990s, the latest date relating to diecast toys produced is 1997.

11) Mr Chipperfield provided a second statement, dated 4 November 2009. He states that in the 1970s there were a number of television specials on Chipperfield’s Circus by Thames television. He provides copies of the contracts and also a recent royalty statement, dated July 2009, which shows that the programmes are still being sold around the world, although not in the UK.

He also mentions that Mary Chipperfield, although being part of the family, is not connected with his company and that the applicant has prevented her using the Chipperfield name; although no corroboration or details were provided.

12) The third witness statement, dated 5 November 2009, is by Matthew Schrader who works for the applicant’s trade mark attorney. He provides copies of the website of Oxford Diecast Ltd, owned by the registered proprietor which shows use of the marks which the registered proprietor has registered upon diecast vehicles or toys.

13) The fourth witness statement, dated 3 November 2009, is by John Stansfield the Finance Director of Hornby Hobbies Ltd. His company currently own the Corgi brand. He states that he believes that the Corgi toys produced in the 1960s and also those in 1994/95 were licensed by the applicant. He also states that a third range of toys produced during 1996/97 by Corgi Toys were also licensed by the applicant. No actual documentation regarding these licenses is filed. However, an internal document held on file by Corgi and obtained by Hornby following a buy out shows eight models, including “Mary Chipperfield and 3 liberty horses figures with stool”. The computer printout shows the licensee as the applicant company and the period of the agreement 1 April 1996-31 March 2001.

14) The fifth witness statement, dated 5 November 2009, is by Malcolm Stanley Clay the Secretary of the Association of Circus Proprietors of Great Britain, a position he has held for thirty years. He states that since the late 1960s Chipperfield's Circus has been run by the applicant company. Prior to this it was run by the Chipperfield family. He states that Chipperfield's circus ceased touring the UK in the 1980s. He states:

"I have seen a number of models, dating from the 1960s, of toy cars/trucks/circus vehicles displaying the name "Chipperfield's Circus" and have always associated them with Chipperfield's circus as most recently operated by the applicant. Most of the earlier models are replicas of the actual vehicle owned by the circus."

15) The sixth witness statement, dated 5 November 2009, is by Rosanna Cooper the applicant's Trade Mark Attorney. She states that she has seen original full size posters of Chipperfield's Circus dating back to 1948. In a second statement also dated 5 November 2009, Ms Cooper states that she is an expert in the optimisation of websites and a very experienced e-marketer. She states:

"2. On or around 25 January 2009, I personally searched for the keywords CHIPPERFIELD CIRCUS and CHIPPERFIELD'S CIRCUS in Google. I retrieved a number of web pages (ranking 1-20 in Google Search Engine) on E-bay and the website with URL www.oxforddiecast.co.uk owned by the proprietor ("the Website") and/or relating to the proprietor. The majority of the webpages owned by the proprietor were optimised with the keyword "CHIPPERFIELD CIRCUS". See exhibits "RC2" and "RC6" for some of the pages that were retrieved.

3. I have over seven years experience in optimisation of websites. In addition, I train individuals and companies in optimisation of websites. When I searched for the keywords CHIPPERFIELD CIRCUS and CHIPPERFIELD'S CIRCUS, in order for the search results to retrieve the website and all of the other results for the said keywords, the proprietor had to have been optimised [sic] the webpages of its website for those keywords. This means that the source codes representing each of the webpages of the website had to have been optimised i.e. changed to include these keywords. When a website is developed, it usually has very basic codes. What then happens is that the owner of the website, in order to obtain ranking in search engines, would get the webpages optimised. This is the only way in which Google and the other search engines could rank these webpages. If a webpage is not optimised then Google and/or the other search engines are unable to rank that page i.e. they cannot retrieve this page when a search is carried out for a specific keyword or keywords. Webpages are optimised for specific keywords to attain the desired results. Therefore, the proprietor optimised its webpages for the key words CHIPPERFIELD CIRCUS and CHIPPERFIELD'S CIRCUS with the intention of deceiving the public.

4. When I carried out a search in January 2009, I had taken a look at the "metatags" of the webpages of the proprietor and the other source codes displayed on the website and they included the key words CIRCUS and CHIPPERFIELD'S CIRCUS.

5. Therefore, it is clear that the proprietor deliberately set out to mislead members of the public into the geographical origin of the Toys.

6. On or around 28 May 2009, I again searched for the same keywords in Google, however, this time there were no webpages of the proprietor's retrieved. When a search is carried out

in Google, there are page numbers at the bottom, I went to the very last page number and there were no pages of the proprietor retrieved. I then looked at the source codes of the websites and there were no keywords in the source codes for CHIPPERFIELD CIRCUS and/or CHIPPERFIELD'S CIRCUS.

7. Therefore, between January and May 2009 (as soon as the proprietor was alerted to the applications for revocation and invalidity of the applicant) the proprietor removed and [sic] reference to the keywords on its website. The proprietor clearly knew that the use of these keywords in its "metatags" and other parts of the source codes were illegal as the proprietor could be found guilty in the courts for cyber squatting. Further and/or in the alternative, the proprietor by removing the keywords from its webpages has clearly demonstrated that the proprietor knew that the proprietor did not have any rights to the name CHIPPERFIELD CIRCUS and, more importantly, clearly demonstrated that the proprietor's intention was to mislead the public all along as to the geographical origin of the toys."

16) The eighth statement, dated 25 February 2009, is by David Jamieson the author of a book entitled Chipperfield Circus published in 1997. He states that one thousand copies of a special edition of his book were provided for Corgi and made available to Corgi Club members. He states that the book originally sold for £20 and is now changing hands at £150.

17) The ninth statement, dated 4 March 2009, is by John Benham a solicitor. He worked for Chipperfield as an animal keeper in 1975. Referring to the diecast models manufactured by Oxford diecast, he states:

"I had assumed that as with the Corgi models some years ago, that these had been produced with the authority and permission of Chipperfield's Circus but I am amazed to learn that this is not the case."

REGISTERED PROPRIETORS' EVIDENCE

18) The registered proprietor filed two witness statements. The first, dated 17 December 2009, is by Lyndon Charles Davies the Managing Director of the registered proprietor and also the majority shareholder of Oxford Diecast Ltd. He states that he has been in the diecast industry for thirty years having worked for Corgi and Mettoy amongst others prior to setting up his own companies. He states that both his companies investigate the trade mark implications prior to launching any new product. They search the UKIPO database as well as using a trade mark attorney who supplements such searches. Where an owner of a trade mark is identified they negotiate an agreement to use the mark. They have reached agreement with companies such as, *inter alia*, Land Rover, Ford, BMW, GM, VW, Royal Mail, AA, Eddie Stobart and the BBC. At exhibit LCD2 he provides copies of the packaging used which has an acknowledgement of the trade mark ownership upon it. He states that a search on the two marks in suit prior to applying for them revealed that no-one had the marks registered. He was also aware that Chipperfield Circus had not performed for at least 10 years, i.e. in the 1990s according to Wikipedia. At exhibit LCD3 he provides a print-out from the Wikipedia website which corroborates this statement. He therefore concluded that the mark had been abandoned with regard to circuses. Further, from his knowledge of the industry he was aware that Corgi had made no use of the mark for at least ten years. Believing the mark to have been abandoned he made his applications.

19) Mr Davies then describes receiving a phone call asking for payment for use of the mark. He responded in writing with a proposal of payment of £2,500, (exhibit LCD5). This was rejected and

no further negotiations took place. He also refutes the comments of Ms Cooper. Pointing out he was the legal owner of the marks used he states:

“The conclusion she draws is in any case factually incorrect, - as a metatag expert, she would know that the website <http://web.archive.org> keeps information on websites from the past. That website has listings on our websites back to 2000 under the link.

http://web.archive.org/web/*/http://www.oxforddiecast.co.uk

These show that we first introduced the CHIPPERFIELD range in 2007 (after the trade mark applications had proceeded to registration). The current metatags are unchanged relative to those used in 2007.

In any case, although I do not claim to be a metatag expert, I do know that metatags were a way of listing keywords on a web page, to help rank the content of the page in the search. Google ignores these when ranking a page and looks essentially at the webpage content, which is partly why Google became so successful. So metatags are no longer important since Google has become the dominant search engine.”

20) The second witness statement, dated 17 December 2009, is by Hedley William Austin the registered proprietor’s Trade mark Attorney. He has over thirty years of experience and advised Corgi and Mettoy regarding the use of other people’s trade marks which, under the Trade Marks Act 1938 had to be associated with a “Registered User” agreement with the Trade Marks Registry. He states:

“To the best of my knowledge, the only cases on which companies such as Corgi paid licensing fees were when a Registered User Agreement could be put in place and tied to specific trade mark registration.”

21) He continues:

“3. Because of the requirements imposed by the Trade Marks Act 1938, licensing or merchandising barely existed until the 1980’s and only took off after the Trade Marks Act 1994 came into force. So I would expect that any arrangement between Chipperfield and “Corgi” in the 1960’s (actually, that would have been Mettoy, not Corgi) would not have been a trade mark licence, but some other form of commercial agreement, possibly involving payment by Mettoy to Chipperfield for endorsement or possibly a payment by Chipperfield for Mettoy to produce promotional items.”

22) Mr Austin also provides copies of pages from a website which describes the alleged maltreatment of animals over the years by Mr Richard Chipperfield and Mary Chipperfield. It states that as a result of the undercover filming of animals being ill treated, such as allegedly being beaten with metal bars, that the public no longer accepts that animals such as lions, tigers elephants etc should be used in circuses and that Chipperfield Enterprises had ceased operating in the UK by approximately 2003. The article also mentions tracking Mr Chipperfield to France where it is alleged he had moved to avoid exposure of his training methods.

23) The registered proprietor also filed written submissions. It is pointed out that much of the applicant’s evidence consists of opinion and submissions. Further, that the volume of such in the applicant’s evidence has meant that far more time was spent going through the evidence than

would have been the case if the applicant's statements had contained solely evidence. The evidence of Ms Cooper re the use of metatags is commented upon and it is pointed out that the situation commented upon amounted to using a legally registered trade mark and was therefore perfectly acceptable. It is accepted that:

“For the avoidance of doubt the proprietor accepts that there was at one time a circus called Chipperfield's circus which had a significant reputation, but it is further submitted that the evidence clearly shows that the circus ceased many years ago.”

24) Lastly, the submissions states:

“It is not accepted that the applicant for revocation has at any time been the rightful owner of that reputation; and it is not accepted that the applicant for revocation has at any time had a reputation in toys or diecast vehicles, or the like.”

APPLICANT'S EVIDENCE IN REPLY

25) The applicant filed two witness statements. The first, dated 12 March 2010, is by Richard Chipperfield who has provided evidence earlier. He states that his company licensed Mattel/Corgi Classics to use the mark, and this expired in 2001. He states that diecast toys were produced until 1997, although he believes that the sales continued until 2001. He states that the television shows were important as they were shown around the world and this provided Corgi with a wide client base. He states that the television shows have not been broadcast in the UK since the 1970s. He also provides a timetable of events:

- December 1989: Chipperfield Circus toured the UK.
- 1990-1991: Along with Gerry Cottle a circus under the Chipperfield name took place in Crystal Palace.
- 1991-1996: Chipperfield Circus in Britain was presented by Tony Hopkins under the name Chipperfield Circus. The takings in the first year were over £1million.
- 1998: The applicant provided acts under the Chipperfield name to a circus in the USA for five years.
- 1990s: A different company was set up to perform in Asia.
- 2000 – to date: The applicant had one animal act performing in France, Germany and Monaco. He states that he also provides consultancy services worldwide.

26) He states: “All the revenue generated from the live circus and its activities, from the sale of the Corgi toys and royalties from the television shows went to CEL [the applicant]. However, the circus was a cash in-hand business, so all the staff would be paid first and it was after they were all paid that we would determine what was left to plough into CEL.”

27) At paragraph 8 he states:

“8. It is thus not the case that the mark CHIPPERFIELD CIRCUS was abandoned whether for circus entertainment or otherwise. Whilst there has been no performing circus in the UK

called CHIPPERFIELD CIRCUS since 12 to 14 years ago, the name and my family are still well-known in the circus field.”

28) Mr Chipperfield alleges that Mr Davies, Ms Fuller and Ms Fuller’s father all worked for Corgi and knew that Corgi had produced a range of diecast models of circus vehicles with the name CHIPPERFIELD’S CIRCUS upon them. He also claims that at the time that the registered proprietor launched its range of toys in 2007, he was in discussions with a number of toy manufacturers to bring out a new range of CHIPPERFIELD CIRCUS toys. He states that whilst the registered proprietor sells his toys for £5, the ones he wanted to bring out would have sold for hundreds of pounds as there are a number of Corgi models on sale for £400-£600. He also claims that “we had dissociated CEL and all of our activities from her [Mary Chipperfield] in the 1950s..”. However, I note that the diecast toy range in the late 1990s which he apparently licensed included one which had Mary Chipperfield named upon it, see paragraph 13 above.

29) He further claims that the registered proprietor should have been aware that Chipperfield Enterprises Ltd was still a going concern in 2006 as a result of publicity regarding animal cruelty, which mentioned that the applicant company was training animals in barbaric conditions in the UK.

30) The second witness statement, dated 12 March 2010, is by Jenny Cooper who works for the applicant’s trade mark attorney. She carried out what she refers to as an informal survey. This consisted of asking people aged over 25 (although she admits to being bad at guessing ages) questions having shown them a mocked up item of packaging. The item had “Chipperfield Circus” printed upon it and it contained a model produced by the registered proprietor which also had Chipperfield Circus printed upon it. The questions put to members of the public were:

- 1) Does this name mean anything to you?
- 2) What would you think if you saw this package?

31) The answers provided were written down at the time but for the most part were not verbatim, although these were then amended to make them appear verbatim in the printed version. I do not find this survey reliable, and believe that the public were being encouraged to speculate upon issues.

APPLICANT’S FURTHER EVIDENCE

32) The applicant filed a further statement by Ms Cooper, dated 21 October 2010. She states that two documents have just become available, although the second exhibit is identical to that filed by the registered proprietor (exhibit LCD5). The other exhibit is a license agreement between Corgi Classics Ltd and the applicant dated 1 April 1996. The license allows for a payment of 3% and expires after five years.

33) That concludes my review of the evidence filed in these proceedings insofar as I consider it necessary.

DECISION

34) As a preliminary point the applicant for invalidity sought to file additional evidence in the form of a witness statement, dated 15 November 2010, by Ms Cooper. The statement is provided to file, as an exhibit, an agreement signed by the applicant and New World Circus Ltd on 3

September 2010 allowing New World Circus Ltd to use the name Chipperfields Circus. I regard this as having no bearing upon my decision and further question why it was not filed until late afternoon on the day prior to the hearing by fax. I declined to allow the evidence into the case.

35) At the hearing all of the grounds for invalidity were withdrawn except for those under Sections 5(4)(a) and 3(6). Mr Tritton also accepted that the applicant could not rely upon any goodwill prior to its incorporation in July 1968 as no assignment of goodwill had been provided as part of the evidence.

36) Section 47 of the Trade Marks Act 1994 reads:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(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) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

37) I shall first consider the ground of invalidity under Section 5(4)(a) which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

38) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive

and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

39) I also note the comments of Pumfrey J in *South Cone Incorporated v JackBessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

40) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should

show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

41) First I must determine the date at which the applicant’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07*. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

42) In their evidence the registered proprietor claims to have first used their marks after the marks had achieved registration and so the date of the earliest application, 29 March 2006, should be the relevant date. However, if the registered proprietor had used their trade marks prior to this then this use must also be taken into account. It could, for example, establish that the registered proprietor is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the registered proprietor’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.”

43) It was accepted at the hearing by the applicant that they could not rely upon any evidence of use of the name CHIPPERFIELD CIRCUS prior to its incorporation in 1968. There is some confusion as to when the name was last used in relation to a circus in the UK. According to Mr Clay, the Secretary of the Association of Circus Proprietors of Great Britain, it was in the 1980s. He is an independent witness and his statement was filed by the applicant. However, there are claims that the circus toured the UK in 1989 and that thereafter the name was used by Tony Hopkins from 1991-1996 in the UK. The evidence of such use is very limited, but is not challenged by the registered proprietor. At the very least I have to accept that from 1968-1989 the name CHIPPERFIELD CIRCUS was used in the UK by the applicant and that during this time, it featured on television, in particular upon Christmas Day. There is also evidence of exhibit items of memorabilia, such as calendars, plates and badges being produced up until 1995 (RC19). I also note that copies of posters used in the UK during the period 1968-1995 have been provided as part of the evidence and this was also unchallenged. Overall the evidence shows considerable use, at least in the 1970s and 1980s. There is an absence of figures regarding the number of shows performed in the UK, the average audience size or the annual turnover and promotional figures. I suspect this is in part due to the comments made by Mr Chipperfield at paragraph 26 above which suggests that his business was run in a somewhat informal manner, which whilst it might raise questions from HRMC does not concern this decision.

44) I must also take account of the use of the name CHIPPERFIELD upon diecast toys during the period 1968-1997. During this time there were three distinct issues of toys. The first began prior to

the incorporation of the applicant, but continued to be sold in shops until the early 1970s. Since then they have become highly prized, as indeed are most toys that are forty plus years old. Considerable evidence of their sale upon the website eBay has been filed. I accept that these diecast toys were produced by third parties such as Corgi and Mettoy, but I agree with the applicant that the average consumer would assume that the toys were produced in agreement with the circus. I accept that in the last batch of toys issued which the applicant claims to have authorised and been paid for, one refers to Mary Chipperfield who, according to the applicant has nothing to do with the applicant's business (paragraph 11 refers). Again, this might cast doubt upon the conduct of the applicant but is not relevant to this decision. The fact that the earlier toys continue to be sold would assist in keeping the name of the circus in the public mind, although I note that the last issue of new toys took place in 1997 and so as at the relevant date less than ten years had passed. The majority of any goodwill would have accrued to the manufacturer of the toys, however, I believe that there would have been a spill-over of goodwill to the applicant.

45) In considering the issues I note that much of the evidence that I rely upon are mere statements which are largely uncorroborated. However, I have also noted that it is unchallenged. I take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme O/161/07* where he commented on the issue of unchallenged evidence and cross examination:

“Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficult in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] *BusLR* 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically)."

46) I am conscious that the use by the applicant with regard to circus performances and diecast toys ceased approximately ten years prior to the relevant date. In considering the issue of goodwill I refer to two cases, *Ad-Lib Club Limited v Granville* [1971] FSR 1 and *Sutherland v. V2 Music Ltd* [2002] EMLR 28. In the latter case, Laddie J. held:

"H6. 1. If a party abandoned a business and the goodwill associated with it, he could not subsequently bring proceedings for passing off to protect that goodwill. He had relinquished any interest in the goodwill, and it was likely that he would be unable to show any damage because there was nothing left to damage. The temporary cessation of a business, however, did not necessarily destroy the goodwill in that business, although over time the goodwill would shrink and eventually disappear. As long as the owner of the goodwill had not abandoned it, it remained an asset protectable from damage by passing-off proceedings. Destroying the goodwill so that it was no longer an attractive force which would help the owner's business was but one form of damage of which the court could take notice. *Star Industrial Co. Ltd v. Yap Kwee Kor* [1976] F.S.R. 256 applied. *Ad-Lib Ltd v. Granville* [1972] R.P.C. 673 and *Thermawear Ltd v. Vedonis* [1982] R.P.C. 44 followed .

H7. 2. The law of passing off protected the goodwill of a small business as much as the large, but the court would not intervene to protect a goodwill which any reasonable person would consider as trivial.

H8. 3. It was likely that during the period 1993 to 1995 Liberty 1 was known to some tens of thousands of members of the public and admired by a significant number of them. Although memories of Liberty 1 must have faded for very many of them by 2001, the impact which Liberty 1 had made on the public had not disappeared. Although the case was very close to the borderline, Liberty 1 had retained a residual reputation among members of the public. In addition, Liberty 1 had a continuing, if small, reputation in the music industry."

47) In *The Law of Passing-Off* (third edition) Christopher Wadlow at 3-178 states:

“The better view is that if a business is deliberately abandoned in circumstances which are inconsistent with its ever being recommenced then the goodwill in it is destroyed unless contemporaneously assigned to a new owner. Otherwise, the goodwill in a discontinued business may continue to exist and be capable of being protected, provided the claimant intended and still intends that his former business should resume active trading. It is not necessary that the prospect should be imminent, but the mere possibility of resumption if circumstances should ever change in the claimant’s favour is not enough. The claimant’s intention to resume business may the more readily be believed where the original cessation was forced on him by external circumstances, but this factor is not conclusive either way.”

48) The registered proprietor contends that the applicant had abandoned the circus business, in the wake of public disquiet over the perception that noble creatures such as tigers were being subjected to ill treatment simply for their edification. The public’s knowledge of the threat of extinction faced by such animals in the wild and the growth of other entertainment/educational establishments such as safari parks have combined to change the public perception and replace the wonderment that used to accompany such performances to almost outright hostility. I quite understand how the registered proprietor came to such a view but it was nevertheless incorrect. Especially as the applicant never provided any statement to the press that the business was being abandoned, it was mere supposition by third parties which was then reported almost as fact upon various websites. Although the use of wild animals has been severely curtailed in civilised countries such as the UK, the use of the name Chipperfield is still used for circus performances albeit considerably different in content when compared to their heyday. The years of use up until 1995/7 would still have provided the applicant with goodwill in both circus performances and diecast toys, and despite no use since then there would have remained as at March 2006 a residual goodwill.

49) At paragraph 48 above I determined that the applicant IPC had goodwill in the mark “CHIPPERFIELD CIRCUS” for circus performances and diecast toys at the relevant date. The residual goodwill in circus performances is not in any doubt given the length of time that the mark has been in use and the extent of its use. However in case I am wrong regarding diecast toys I also take into account, when considering the issue of misrepresentation, the findings in *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] F.S.R. 155 where Mr. Justice Falconer held:

“(1) That the plaintiffs had established high reputation in the mark LEGO which extended beyond the field of toys and construction Kits; the mark LEGO was wholly distinctive of them and had in fact become a household word;

(2) The reputation of the plaintiffs mark and their goodwill was wide enough to extend to goods such as garden sprinklers and other irrigation equipment;

(3) That the use of the trade mark LEGO in relation to products of the defendants would mislead persons into thinking that those products were the goods of or connected with the plaintiffs;

(4) That expert evidence based on the results of a properly conducted survey of public opinion was admissible as evidence proving an external fact, namely public opinion: [G.E. Trade Mark \[1969\] R.P.C. 418, Ch.D.](#) ; [\[1970\] R.P.C. 339, C.A.](#) and [\[1973\] R.P.C. 297,](#)

H.L. ; Customglass Boats Ltd. v. Salthouse Brothers Ltd. [1976] R.P.C. 589, considered;

(5) In the law of passing off as it has recently developed, there was no limitation in respect to the parties' fields of activity. Nonetheless, the proximity of the defendants' field of activity to that of the plaintiffs would be relevant as to whether the acts complained of in a particular case amounted to a misrepresentation; Erven Warnink BV v. J. Townend & Sons (Hull) Ltd. [1980] R.P.C. 31 H.L., applied ;

(6) In relation to misrepresentation, the plaintiffs had established that there was a real risk that a substantial number of persons among the relevant section of the public would in fact believe that there was a business connection between the plaintiffs and the defendants;

(7) The effect of the defendants continuing to use LEGO in relation to their products would destroy that part of the plaintiffs' reputation in their mark LEGO and the goodwill attached to it. In view of the nature and extent of the plaintiffs' reputation in the mark LEGO, such use was calculated to injure the plaintiffs' goodwill in the sense that it was a reasonably foreseeable consequence that it would do so;

(8) As a substantial number of persons would think that the use of LEGO on or in relation to the defendants' products would indicate that they were the plaintiffs' goods, the inability of the plaintiffs to control such use involved a real risk of injury to their reputation in the mark and hence to their goodwill: *Draper v. Trist* (1936) 56 R.P.C. 429; Henderson v. Radio Corporation Pty. Ltd. [1969] R.P.C. 218, considered ;

(9) The defendants' criticism of the market survey was not justified to any substantial extent.”

50) I will take into account the comments of Morritt L J in the Court of Appeal in *Neutrogena Corporation and Another. v Golden Limited and Another* [1996] RPC 473, when he said, in effect, that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant's products in the belief that they were the registered proprietor's.

51) The applicant has not established a reputation in circus performances as strong as that shown by LEGO, but it is considerable and has been built up over decades of use. Its residual goodwill and reputation in diecast toys would have been much weaker but I believe that because the name of the circus is written upon the side of each vehicle, and the vehicles themselves are novel consisting of specialised vehicles to transport animals there would have been some residual goodwill in existence at the relevant date. Clearly, the marks and the sign are identical. To my mind, the public would assume a link between the circus and the toys which carry the name of the circus and will presume that the circus has authorised their production. In reaching this view I have taken into account the decision in the *Adam Opel GmbH v Autec* Case [2010] E.T.M.R. 50. In that case it was held that “the relevant consumers merely regarded the Opel Blitz logo affixed to the defendant's model car as a reproduction of detail of the original car, as a reproduction of the trade mark which the faithfully reproduced original car affixed on exactly the same space, and did not regard it as a reference to the trade origin of the model car bearing the sign.” However, in the

instant case the reproduction was not just of a standard road car made in the tens of thousands, but specific “one of a kind” vehicles which also bear the name CHIPPERFIELD.

52) I must now go on to consider if the applicant has suffered, or is likely to suffer, damage as a result of this misrepresentation. Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that “he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill”.

53) In the current case, people familiar with Chipperfield’s Circus would expect toys under the same name to be from the same or a linked undertaking as it had been in the past. I have already found that, as such, there is a real likelihood of deception amongst a substantial number of the relevant public. Taking all this into account and considering the identity of the marks, I conclude that the applicant’s residual goodwill will be damaged in that, the applicant may, for example, be denied the opportunity to license its name due to the presence on the market of the registered proprietor’s toys.

54) The consequence of my findings is that the applicant’s request for invalidity in respect of the ground under Section 5(4) (a) of the Act is successful, and that applications 2417958 and 2426529 should be deemed to have never been made.

55) I now turn to consider Section 3(6) which reads:

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

56) Section 3(6) has its origins in Article 3(2)(d) of the Directive, the Act which implements Council Directive No. 89/104/EEC of 21 December 1988 which states:

“Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that....

(c) the application for registration of the trade mark was made in bad faith by the applicant.”

57) The Directive gives no more clue as to the meaning of “bad faith” than the Act. Subsequent case law has avoided explicit definition but has not shirked from indicating its characteristics. In *AJIT WEEKLY Trade Mark* [2006] RPC 25, Professor Ruth Annand sitting as the Appointed Person held as follows:

“[35] ... Bad faith is to be judged according to the combined test of dishonesty for accessory liability to breach of trust set out by the majority of the House of Lords in *Twinsectra Ltd v Yardley* [2002] 2 AC 164, with *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 providing the appropriate standard, namely acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.....

[41] ... the upshot of the Privy Council decision in *Barlow Clowes* is: (a) to confirm the House of Lords’ test for dishonesty applied in *Twinsectra*, i.e. the combined test [footnote omitted]; and (b) to resolve any ambiguity in the majority of their Lordships’ statement of that test by making it clear that an enquiry into a defendant’s views as regards normal

standard of honesty is not part of the test. The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant's conduct is dishonest judged by ordinary standard of honest people, the defendant's own standards of honesty being irrelevant to the objective element....

[44] In view of the above and in particular the further clarification of the combined test given by the Privy Council in *Barlow Clowes*, I reject Mr Malynicz's contention that the Hearing Officer erred in failing to consider the registered proprietor's opinions on whether its conduct in applying for the mark fell below ordinary standard of acceptable commercial behaviour."

58) In asserting that the marks were registered in bad faith, the onus rests with the applicant for invalidity to make a prima facie case. A claim that a mark was registered in bad faith implies some action by the registered proprietor which a reasonable person would consider to unacceptable behaviour or, as put by Lindsay in the *Gromax* trade mark case [1999] RPC 10:

"includes some dealings which fall short of the standards of acceptable commercial behaviour".

59) The issue must be determined on the balance of probabilities. On the basis of these authorities it is clear that a finding of bad faith may be made in circumstances which do not involve actual dishonesty. Furthermore, it is not necessary for me to reach a view on the registered proprietor's state of mind regarding the applications for registration if I am satisfied that its actions in applying for the marks in the light of all the surrounding circumstances would have been considered contrary to normally accepted standards of honest conduct.

60) I was referred to the ECJ decision in *Chocoladefabriken Lindt & Sprungli AG v Franz Hauswirth GmbH* where they ruled that all the relevant factors must be taken into account such as:

"The fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;

the applicant's intention to prevent that third party from continuing to use such a sign; and

the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought."

61) I am also aware of the comments of Mr Arnold Q.C. (as he was then) acting as the Appointed Person in *BRUTT Trade Marks* [2007] RPC 19 where he said:

"Cross-examination

23. It is the function of cross-examination to assist the tribunal to resolve conflicts of evidence. I agree with the hearing officer in thinking that cross-examination would have assisted him in the present case. It does not follow, however, that cross-examination is essential in a case where bad faith is alleged or that the tribunal cannot assess evidence or make findings of fact in its absence. Fairness requires that adverse findings should not ordinarily be made against a witness, such as a finding that he has acted in bad faith,

without the witness having the charge put to him and being given an opportunity to answer it: see *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607 at 623. It should be borne in mind, however, that in proceedings such as these evidence is served sequentially and that giving a witness a proper opportunity to deal with a point will not necessarily require cross-examination.

More importantly, perhaps, if the opportunity for cross-examination is passed up, the consequence is that the tribunal must assess the evidence on that basis rather than refraining from considering the evidence and reaching a conclusion. It is instructive to remember that OHIM and the courts in most civil law jurisdictions consider themselves perfectly well-equipped to make findings that parties have acted in bad faith without the benefit of cross examination.”

62) In the instant case the registered proprietor was well aware that the applicant had granted permission for diecast toys to be produced with its name upon them. However, the companies who had carried out this work had ceased trading and the applicant appeared to have been forced by a number of factors, such as public opinion, laws on animal welfare etc, to have abandoned the circus business in the UK. Certainly the use of the name CHIPPERFIELD in relation to circus performances was at best sporadic in the period 1990-1996. I also take into account that the registered proprietor carried out a search of the Register and took reasonable steps to ascertain whether the mark was in use. It was claimed by the applicant that other manufacturers of diecast vehicles approached him in 2007 and that the range of toys would have sold for hundreds of pounds. There is no corroboration for this contention and I find it difficult to accept that brand new items would be sold for prices exceeding those for toys which are forty years old, in perfect condition and in the original packaging. It is a truism that most items appreciate in value if kept in perfect condition and that they are usually worth considerably more than current products, even if the current products are more technically advanced or correct. To my mind despite the fact that the registered proprietor was aware of the history of the applicant it was not acting in bad faith when it applied for the trade marks as it genuinely believed that the applicant had effectively abandoned the business.

63) The ground of invalidity under Section 3(6) fails.

COSTS

64) Throughout the evidence, the applicant for invalidity referred to itself as having run a circus since 1834, whereas in fact it is a legal entity which only came into existence in 1968, and to which the earlier goodwill accrued by the Chipperfield family was not assigned. The majority of the evidence filed by the applicant pre-dates its incorporation and is therefore not relevant, a point accepted at the hearing by Mr Tritton. Further, evidence was provided regarding activities in the Far East and this was said to have enhanced the claimed world-wide reputation of the applicant. However, in later evidence rounds it became apparent that the activities in the Far East are under the auspices of a different legal entity. I would have expected the Solicitor advising the applicant to have ensured that the evidence filed was cogent and relevant. The registered proprietor contended that they spent a great deal of time reading and re-reading the evidence in an attempt to gain a clear history of the applicant from the confused muddle of evidence provided, much of which consisted of legal phrases, opinion, submission with the odd relevant fact dripped in periodically. As I also had such issues I have no doubt that the registered proprietor’s contention is correct.

65) I also note that of the eight original grounds of opposition filed only two were pursued at the hearing and one of those failed. I also note that it was only just prior to the hearing that six of the grounds were abandoned. The applicant therefore failed on seven of the eight grounds. As such, despite the fact that the registered proprietor's marks are ruled to have been invalid and deemed never to have been made I am nonetheless awarding the registered proprietor costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering and commenting on the other side's evidence	£1100
Preparing for and attending a hearing	£900
TOTAL	£2,300

66) I order the applicant (Chipperfield Enterprises Ltd), to pay the registered proprietor (LCD Enterprises Ltd) the sum of £2,300. 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 17 day of February 2011

**G W Salthouse
For the Registrar
the Comptroller-General**