

O-007-05

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 699058
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD)**

AND

**THE APPLICATION FOR PARTIAL REVOCATION THERETO
UNDER NO 81328
BY OMEGA ENGINEERING, INC**

TRADE MARKS ACT 1994
In the matter of registration no 699058
of the trade mark:



in the name of Omega SA (Omega AG) (Omega Ltd)
and the application for partial revocation thereto
under no 81328
by Omega Engineering, Inc

BACKGROUND

1) On 27 June 2003 Omega Engineering, Inc, which I will refer to as US, filed an application for the partial revocation of trade mark registration no 699058:



(the trade mark), standing in the name of Omega SA (Omega AG) (Omega Ltd), which I will refer to as Swiss. The trade mark was registered on 28 November 1951. At the time of the filing of this application it was registered for the following goods:

All goods included in class 14.

2) US seeks partial revocation of the registration by virtue of section 46(1)(a) of the Trade Marks Act 1994 (the Act) as qualified by section 46(5) of the Act. US claims that within the period of five years following the date of completion of the registration procedure or within the period of five years following 6 December 1955 (being the earliest date for which evidence of the completion of the registration procedure has been confirmed), the trade mark has not been put to genuine use in the United Kingdom, by the proprietor or with its consent, in relation to the goods for which it is registered, other than for wristwatches and parts and fittings therefor and that there are no proper reasons for non-use. In addition or alternatively, US invokes section 46(1)(b) of the Act. It claims that genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods for which the trade mark is registered, other than for wristwatches and parts and fittings therefor, has been suspended for an uninterrupted period of five years and that there are no proper reasons for non-use.

3) US seeks that the partial revocation takes effect from 6 December 1960 or from the earliest date thereafter at which the registrar is satisfied that the grounds for revocation under either section 46(1)(a) and 46(1)(b) of the Act exist. US seeks an award of costs.

4) On 23 October 2003 Swiss filed a counterstatement. Swiss states that the application for revocation was filed without prior warning to it or its United Kingdom attorneys. Swiss claims that the trade mark has been used for *precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments*. It seeks an award of costs.

5) On 7 December 2004, Swiss filed a partial surrender, restricting the goods of its registration to *jewellery; horological and chronometric instruments; parts and fittings therefor*.

6) Both sides filed evidence.

7) The matter came to be heard on 9 December 2004, when US was represented by Mr Crouch of Bromhead Johnson; Swiss was represented by Ms Sofia Arenal of Mewburn Ellis.

DECISION

8) The grounds for revocation are under sections 46(1) (a) and (b) of the Act. Section 46 of the Act reads as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing

the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

9) Consideration has to be taken, also, of section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

10) Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made genuine use of the trade mark in suit, or that there are proper reasons for non-use.

11) The issue of use, and in particular genuine use, was considered by the European Court of Justice (ECJ) in *Ansul BV v. Ajax Brandbeveiliging BV [FNI]* Case C-40/01 [2003] RPC 40 where it held:

“36 "Genuine use" must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37 It follows that "genuine use" of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Art.10(3) of the Directive, by a third party with authority to use the mark.

38 Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39 Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.

43 In the light of the foregoing considerations the reply to the first question must be that Art.12(1) of the Directive must be interpreted as meaning that there is "genuine use" of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real,

particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

12) Ms Arenal made it clear at the hearing that the partial surrender had been made in order to give an opportunity for the proceedings to be settled. However, the surrender takes effect from the date that it was made. Consequently, it does not resolve any issues relating to the operative date(s) of any revocation. Therefore, it does not have an effect upon this decision. US did not withdraw its application for revocation on the basis of the partial surrender.

13) At the hearing it became clear that the issues in dispute related to whether there was evidence of genuine use in relation to clocks and jewellery and what would be a fair description of any goods which were not the subject of revocation. A large amount of the evidence relates to wristwatches, which are not a subject of this revocation. I did not understand Ms Arenal to argue that, outside of the goods remaining after the partial surrender, that there is any evidence of use of the trade mark. Consequently, I will consider the evidence only in relation to what represents the goods that remain in contention between the two sides, clocks and jewellery.

Jewellery

14) Part of the evidence in relation to jewellery consists of a declaration made by Gilbert Albert. Mr Albert is a designer of jewellery based in Geneva. From 1962 to 1966 Mr Albert designed and produced ranges of jewels and watches for Omega Bienne. The jewellery-watches and jewels which he has designed for Omega Bienne were exhibited by Omega Bienne under the trade mark at the exhibition *Meteorites et Bijoux* at Goldsmith's Hall in London from 10 to 26 November 1965. A copy of the catalogue for the exhibition is exhibited. The catalogue is mainly concerned with Mr Albert and his designs. The majority of the items exhibited have no reference to Omega. However, several of them – jewelled bracelet watches, brooches, pendant with watch, neck chain with pendant watch, jewelled necklaces with watches, jewelled necklace, neck chain with watch, bracelet, fob watches and a clock - are noted in the catalogue as having been designed by Mr Albert for Omega. There is no evidence in the catalogue of the use of the trade mark. Other matter is exhibited but it does not relate to United Kingdom use. In addition where this other matter shows use of the trade mark it is for watches, not for jewellery per se. The catalogue also states that since 1962 Mr Albert has designed the new collections of Omega jewellery watches.

15) Evidence is furnished by John Frederick Moody, who works for Swatch Group (UK) Limited, which I will refer to as Swatch. Swatch is a wholly owned subsidiary of The Swatch Group Limited of Switzerland which is the parent company of Swiss. Mr Moody states that the range of jewellery sold under the trade mark, since at least the 1950s, includes rings, necklaces, brooches, earrings, bracelets and cufflinks. I intend only to comment on those parts of the evidence, and particularly the exhibits, which relate to Swiss's jewellery in the United Kingdom, or possibly in the United Kingdom. I, therefore, for instance, will make no comment on exhibits in languages other than English. Mr Moody exhibits material relating to Mr Albert's exhibition at Goldsmith's Hall, which has been dealt with above.

15) A copy of a brochure entitled "Omega that gift that stands for time itself" is exhibited. Mr Moody states that this emanates from the 1960s. The brochure is mostly devoted to watches. However, it shows two necklaces and a ring. One of the necklaces and the rings are of the same design as a watch and they are presented together. The watches show O above the word OMEGA on the watches. Outside of the use shown on the watches that are illustrated, the only use of O above the word OMEGA is on the final page of the brochure. This use shows O to be much smaller in proportion to the word OMEGA than in the trade mark. A black and white copy of two pages is exhibited. The first page, with 1985 and Carol written on the top, shows the trade mark. The second page show a picture of jewellery. It appears to show a necklace, a pair of earrings, a ring and a brooch. Two handwritten serial numbers by the side of the items can just be made out, one is BJ 091 0132, the other BJ 091 95360. The latter number appears in a price list attached to the international catalogue of 1985. The recommended retail price of this latter item was £1950. There are three other serial numbers beginning with BJ in the price list. Included in the catalogue is a page showing jewellery. Next to the jewellery is a matching watch which bears the trade mark. This seems to be the same picture but in colour and far better quality than that to which I have just referred. Unfortunately, the reference numbers relating to the goods in the catalogue are not the same as those shown in the price list. Exhibited is a brochure entitled "Time in Style". This relates to a jewellery promotion in 1972. Included in the catalogue are various display cases for the jewellery which show use of O and the word OMEGA. The actual items are not specifically identified in the text. However, the pictures appear to show a necklace, earrings and what could be brooches and/or rings. A catalogue and list for the exhibition "Montres et Bijoux de Genève" at Goldsmiths' Hall London in 1975 is exhibited. Swiss was one of the exhibitors. However, the part of the catalogue and list relating to Swiss indicates that it was exhibiting watches rather than jewels. Various invoices from Swiss to Swatch are exhibited. On one, dated 12 February 2001, there is a reference to 200 OMEGA pins at 3 Swiss francs each. A catalogue entitled "Omega SA Gift Items 1999" is exhibited; included in the catalogue are OMEGA pins. These are gold plated and are in the form of the O symbol. The reference number of these pins is the same as that shown on the invoice referred to above. There is no indication that the catalogue is for use by the public. Indeed the nature of the goods indicates that they are for promotional use eg paper bags and a "welcome chocolate box". The rubric for the latter item states: "The packet allows you to insert an OMEGA catalogue, which doesn't come along with it." Two invoices to SMH (UK) Limited, a previous name for Swatch, are exhibited.

One, dated 28 April 1993, is for 100 épingles (pins) at 3 Swiss francs each; the other, dated 29 January 1996, is for 200 tie pins at 3 Swiss francs each (the goods share the same reference number and so are presumably the same). Four further invoices from Omega to Swatch are exhibited. They all show, inter alia, OMEGA pins. They are dated 29 January 2001, 11 February 2000, 6 June 2001 and 21 March 2002 and are respectively for 200, 200, 200 and 150 pins, all at 3 Swiss francs each. The final exhibit that I will deal with is a hard back booklet that bears the trade mark on the front, under which is written the word bijoux. Mr Moody describes this as being Swiss's latest collection of jewellery. However, he does not state if this jewellery is available, has been sold or promoted in the United Kingdom. He does not state that the booklet is available in the United Kingdom, no indication is given as to if, where and to whom it has been distributed. At the end of the booklet the following reference information is given: "Printed in Switzerland © OMEGA 2003 – 5400/0203/3336976 US". (The US is emphasised in the print, not my emphasis.) Necklaces, rings, bracelets and what appear to be earrings are shown in the booklet.

16) In considering what can be considered to be described as jewellery I have excluded the watches. This is an issue that has already been dealt with in BL 0/028/03, another revocation action between the same sides, which was the subject of an appeal in BL 0/393/03. The use upon watches that contained jewels was resolved by a specification which described them as jewel-watches. I did not understand Ms Arenal to be arguing that the use on watches was use on jewellery.

17) In considering the evidence of use I am struck by what is not there. Swiss has furnished numerous invoices. The only ones that contain anything that might be described as jewellery are those for the pins. These invoices are also from the parent company to its United Kingdom subsidiary and so it would seem reasonable that if any other jewellery had been sent to Swatch then there would be an invoice. Other than for pins there is not the slightest indication of use in United Kingdom of the trade mark since 1985 for what might be described as jewellery. There is the booklet from 2003. However, there is nothing to indicate that this booklet has ever been distributed in the United Kingdom before the date of the application for revocation, or at any time. A booklet that has a clear indication for United States use cannot have a bearing upon the issues before me. It might be that Swiss use the same literature in the United Kingdom. I do not know. The onus is upon Swiss. It would have been easy enough to state when, where and to whom the booklets were distributed. It did not. If there is a trade going on one would expect invoices. There are none. If there was a trade going on one would expect promotion after 1985. Swiss has supplied numerous catalogues. Again I am struck by what is absent from these catalogues since 1985, the absence of any reference to jewellery. I am concerned with genuine use in the United Kingdom. On the basis of the evidence before me I consider that the only goods which might be saved are the pins.

18) Mr Crouch submitted that the invoices represented internal use, being from the parent company to its United Kingdom subsidiary. Ms Arenal argued that as Swatch was a separate legal entity such use was not internal. I do not find Ms Arenal's argument very attractive. I find it difficult to see that the sending of the goods from the parent company

to its United Kingdom subsidiary, which acts as agent and distributor, represents external use, that it represents the creation or preservation of an outlet for the goods. I am fortified in my view by the finding of the ECJ in *Peak Holding AB v Axolin-Elinor AB* Case C-16/03. This judgment deals with exhaustion of right. However, it considers what can be considered to be putting onto the market and what cannot and is analogous:

“44 The answer to the first question must therefore be that Article 7(1) of the Directive must be interpreted as meaning that goods bearing a trade mark cannot be regarded as having been put on the market in the EEA where the proprietor of the trade mark has imported them into the EEA with a view to selling them there or where he has offered them for sale to consumers in the EEA, in his own shops or those of an associated company, without actually selling them.”

I think that the issue must be a judgement on the basis of commercial reality and not on a legal nicety. The matter does not end there, however. In all, there are seven invoices showing pins, covering the period from 28 April 1993 to 21 March 2002. 1250 pins were sent to the United Kingdom. Outside of the invoices the only reference to the pins is in the catalogue “Omega SA Gift Items 1999”. It might be considered reasonable to assume that the pins having been sent to the United Kingdom over some period would have appeared in the market. However, there are no invoices to retailers. It might be that the goods were then re-exported to another subsidiary. In *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-39/01 the Court of First Instance (CFI) at paragraph 47 held:

“In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

It seems to me that to assume that the goods were put onto the market is dangerously close to conjecture and supposition. In *Vitakraft-Werke Wührmann & Sohn GmbH & Co KG v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Case T-356/02 the CFI commented on the dangers of making suppositions:

“34 In the present case, the catalogues submitted to the Board of Appeal establish neither the fact that they were distributed to a potential Spanish clientele, nor the extent of any distribution, nor the number of sales made of goods protected by the mark. The intervener has provided no indication supported by evidence to enable any useful conclusions to be drawn in that regard. The mere existence of those catalogues could, at most, make it probable or credible that goods protected by the earlier marks were sold or, at least, offered for sale within the relevant territory, but it cannot prove that fact.”

19) Before continuing in relation to the use of the trade mark on pins, I will clarify the best possible position that I consider that Swiss can achieve. If the use of the pins is enough, then I do not see that use on one such very specific item would allow anything

wider than the goods themselves to remain in the specification. Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828 stated:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

If one was presented with a variety of items such as necklaces, rings and earrings, it would seem that the term jewellery could reasonably be used to describe the goods collectively. That is how the average consumer would describe such use, I believe; Mr Crouch agreed with this when I put the matter to him. However, one specific item is a very different matter. It would also seem perverse to give a broad specification where only one item has been shown. The specification can readily express the reality. As I have indicated, Swiss seems to have something of a case up to and including 1985 in relation to the use of the trade mark for jewellery at large. In reaching this conclusion I take into account that the further back one goes the more difficult it can be to produce evidence. I am of the view that one must deal with the matter on the basis of what can be reasonably expected. Nowadays, with digitisation it is far easier and convenient to keep records for lengthy periods. The problems of physical storage means that physical records are often subject to periodic destruction. That it not to state that a proprietor can avoid producing evidence when use is claimed some way back. In this case Swiss was able to produce numerous catalogues going back some period for goods that are not under challenge. The discrepancy between the number of such catalogues and those showing jewellery cannot be ignored. Swiss has also been generous in the number of invoices that it has furnished. Yet in all these invoices, only the pins turn up. Overall, if a little reluctantly, I accept that Swiss has just about discharged the onus upon it to show use of the trade mark upon jewellery up to and including 1985. From 1986, all it has are the pins.

20) The pins present a further problem in relation to their use. Their one appearance outside of the invoices is in the “Omega SA Gift Items 1999” catalogue. No figures for sales of the pins are given. As I have noted above, there is no indication that this was ever seen by the public at large. The contents of the catalogue indicates that the goods are for promotional purposes. There is no evidence or indication that Swiss has been maintaining a market in the pins. The pins could simply be worn by staff selling watches or given to customers, like the boxes of chocolates perhaps. There is nothing to indicate that if the pins did make their way out from Swatch that they were other than for promotional purposes; that they were used for anything other than maintaining a market in watches not in pins. There is not one invoice for a sale to a retailer. In considering

how to “interpret” the invoices, it is useful, I believe, to take into account that every possible item supplied from parent to subsidiary seems to be included; for instance, in invoice number 90237503 sets of OMEGA letters and watch stands are included and show a charge. The evidence does not convince me that in relation to pins, there was use that represents a marketing of these goods or intention to market them.

21) I do not consider that applying the *Ansul* judgment that it can be considered that there has been genuine use in relation to pins.

22) I find that the registration should be revoked in respect of all jewellery with effect from 1 January 1986.

Clocks

23) Mr Moody states that Swiss have sold clocks of various kinds under the trade mark in the United Kingdom. He states that these include table clocks and wall clocks. Mr Moody exhibits pictures of some of the wall clocks. These pictures show the trade mark in the top portion of the clock. In the bottom part of the clock the word Constellation, in joined-up handwriting appears. The pictures show some clocks that, from the descriptions printed above them, would appear to be for external use and some for internal use. The pictures do not form part of a catalogue. The clocks show the four claws, or griffes, that clamp the bezel to the case of Constellation timepieces (the booklet exhibited at JFM9 refers to this design feature for Constellation timepieces). All but the first picture of a clock give serial numbers. Mr Moody exhibits invoices relating to the clocks. Again these are invoices from the parent company to SMH (UK) Limited and Swatch. There are no invoices to retailers. Mr Moody states that Swiss sells these clocks to jewellery retailers in the United Kingdom. Mr Moody does not give any specific figures relating to sales of clocks. Various invoices with references to CONSTELLATION clocks are shown (unfortunately they have not been exhibited in chronological order):

20 February 1996	1 CONSTELLATION clock @ 4,155 Swiss francs
30 May 1996	10 CONSTELLATION clocks @ 175 Swiss francs each
28 August 1996	6 double face golf clocks with supports @ 5,425 Swiss francs each
25 April 1997	4 golf clocks @ 1825 Swiss francs each 2 golf clocks @ 3,065 Swiss francs each
26 March 2003	2 CONSTELLATION outdoor clocks @1,650 Swiss francs each 1 mother clock precitime @ 795 Swiss francs 1 mother clock precitime @ 1,055 Swiss francs
8 April 2003	2 CONSTELLATION outdoor clocks @ nil cost
26 June 2003	1 CONSTELLATION clock @ 2,950 Swiss francs 1 precitime mother clock @ 795 Swiss francs
20 June 2003	1 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs
10 January 2003	30 CONSTELLATION wall clocks @ 250 Swiss francs each
28 January 2003	10 CONSTELLATION wall clocks @ 395 Swiss francs each
21 March 2003	10 CONSTELLATION wall clocks @ 300 Swiss francs each

6 June 2003	4 CONSTELLATION wall clocks @ 295 Swiss francs each
20 June 2003	2 CONSTELLATION wall clocks @ 395 Swiss francs each
	5 CONSTELLATION wall clocks @ 300 Swiss francs each
	5 CONSTELLATION wall clocks @ 450 Swiss francs each
21 March 2002	1 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs
	1 mother clock centralino III @ 1,090 Swiss francs
5 June 2002	1 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs
	1 GPS mother clock @ 1,760 Swiss francs
18 January 2002	10 CONSTELLATION wall clocks @ 300 Swiss francs each
5 April 2002	15 CONSTELLATION wall clocks @ 300 Swiss francs each
11 April 2002	20 CONSTELLATION wall clocks @ 300 Swiss francs each
5 July 2002	10 CONSTELLATION wall clocks @ 250 Swiss francs each
20 September 2002	10 CONSTELLATION wall clocks @ 300 Swiss francs each
12 January 2001	4 CONSTELLATION outdoor clocks @ 1,570 Swiss francs each
	4 mother clocks centralino III @ 1,095 Swiss francs each
26 February 2001	1 CONSTELLATION outdoor clock 2 faces @ 3,770 Swiss francs
	1 mother clock centralino III @ 880 Swiss francs
23 May 2001	1 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs
	7 mother clocks centralino III @ 1,090 Swiss francs each
	3 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs each
18 April 2001	1 CONSTELLATION outdoor clock 2 faces @ 6,500 Swiss francs
	5 mother clocks centralino III @ 1,095 Swiss francs each
	3 CONSTELLATION outdoor clocks @ 1,070 Swiss francs each
	1 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs each
3 April 2001	5 CONSTELLATION outdoor clocks @ 2,950 Swiss francs each
	6 mother clocks centralino III @ 1,095 Swiss francs each
	1 CONSTELLATION outdoor clock @ 6,500 Swiss francs
24 October 2001	1 CONSTELLATION outdoor clock @ 6,500 Swiss francs
	1 mother clock centralino III @ 1,095 Swiss francs
30 November 2001	1 CONSTELLATION outdoor clock @ 6,500 Swiss francs
	1 mother clock centralino III @ 1,095 Swiss francs
31 August 2001	2 CONSTELLATION wall clocks @ 450 Swiss francs each
20 July 2001	2 CONSTELLATION wall clocks @ 295 Swiss francs each
20 July 2001	30 CONSTELLATION wall clocks @ 300 Swiss francs each
31 August 2001	10 CONSTELLATION wall clocks @ 450 Swiss francs each
12 October 2001	10 CONSTELLATION wall clocks @ 395 Swiss francs each
10 August 2001	2 CONSTELLATION outdoor clocks @ 1,570 Swiss francs each
	2 mother clocks centralino III @ 1,095 Swiss francs each
19 October 2000	2 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs each
	2 mother clocks centralino III @ 1,095 Swiss francs each
1 December 2000	3 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs each
	3 mother clocks @ 1,095 Swiss francs each

29 December 2000	3 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs each
	3 mother clocks centralino III @ 1,095 Swiss francs each
1 December 2000	4 CONSTELLATION outdoor clocks @ 1,570 Swiss francs each
	4 mother clocks centralino III @ 1,095 Swiss francs each
10 May 2000	3 CONSTELLATION outdoor clocks @ 641 Swiss francs each
	1 CONSTELLATION wall clock @ 395 Swiss francs
27 April 2000	10 CONSTELLATION wall clocks @ 250 Swiss francs each
8 September 2000	10 CONSTELLATION wall clocks @ 250 Swiss francs each
16 February 2001	15 CONSTELLATION wall clocks @ 450 Swiss francs each
	30 CONSTELLATION wall clocks @ 300 Swiss francs each
12 February 2001	5 CONSTELLATION wall clocks @ 300 Swiss francs each
12 April 1999	1 CONSTELLATION outdoor clock 2 faces @ 2,560 Swiss francs
23 September 1999	1 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs
	1 mother clock centralino III @ 1,095 Swiss francs
8 October 1998	1 CONSTELLATION clock @ 1,550 Swiss francs
	1 mother clock centralino III @ 1,095 Swiss francs
22 October 1998	1 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs
	1 mother clock centralino III @ 1,095 Swiss francs
2 April 1998	1 CONSTELLATION wall clock @ 235 Swiss francs
22 June 1998	6 CONSTELLATION wall clocks @ 395 Swiss francs each
	6 CONSTELLATION wall clocks @ 235 Swiss francs each
	6 CONSTELLATION wall clocks @ 230 Swiss francs each
10 July 1997	2 CONSTELLATION clocks @ 375 Swiss francs each
13 June 1997	1 CONSTELLATION clock @ 375 Swiss francs
27 May 1997	1 CONSTELLATION clock @ 240 Swiss francs
20 August 1997	1 CONSTELLATION clock @ 195 Swiss francs
31 May 1996	10 CONSTELLATION clocks @ 175 Swiss francs each
28 April 1995	4 CONSTELLATION clocks @ 1500 Swiss francs each
27 April 1995	2 CONSTELLATION clocks 2 faces @ 4945 Swiss francs each
27 April 1995	1 CONSTELLATION clock @ 5385 Swiss francs
15 July 1994	15 CONSTELLATION clocks @ 250 Swiss francs each
10 February 1993	5 CONSTELLATION clocks @ 375 Swiss francs each
15 September 1993	5 CONSTELLATION clocks @ 250 Swiss francs each
26 October 1993	1 CONSTELLATION clock 2 faces @ 4,800 Swiss francs

The details which have been highlighted relate to clocks for which there are instructions to deliver them directly to Signs By Design Ltd of West Drayton rather than SMH(UK) Limited. The invoice for 10 May 2000 appears to be for various promotional items for a golf tournament, it includes stands for golf clocks, tee markers, little OMEGA flags and OMEGA stickers. The invoice for 12 February 2001 is for a large amount of what appears to be promotional material. The pictures exhibited at JFM10 tie various of the clocks to invoices by the serial numbers. I have no idea what mother clocks are, most of them have a net weight of 1 kilogram. From the term it is not clear whether this phrase refers to complete clocks or a part of a clock. From the cost, size and the fact that there is a reference to stands for them, it appears likely that golf clocks are clocks used at golf

tournaments. However, as there is no evidence of the actual use of the trade mark on either mother clocks or golf clocks, I do not consider that any alleged use in relation to such goods can assist Swiss.

24) In her submissions Ms Arenal made reference to the “Omega International Catalogue 1985” where there is a reference to the most complicated table clock in the world having been created for Swiss. There is no indication that more than one of the clocks was made, nor that any of them have ever been sold or available in the United Kingdom.

25) Swiss’s clearest and best evidence relates to the CONSTELLATION clocks, where the pictures of the clocks are tied to the actual goods and so one can see the use of the trade mark. By my calculations, in the years 2000 to 2003 (up to 27 June 2003) the invoices show respectively 34, 128, 67 and 72 CONSTELLATION clocks being sent to Swatch in the United Kingdom. Again, all the invoices are what I consider internal invoices, from one part of the company to another. Again virtually all the invoices show prices, however, again this tells me little, as virtually all transactions between the two companies are given a monetary value. In each of the years 1993, 1995 and 1996 a clock was sent directly to Signs By Design Ltd; the name of the company suggests that its business is one of signage. There is no hint in the invoices of table clocks referred to by Mr Moody. Certain of the clocks are for exterior use. All of the clocks illustrated show the four griffes which is a design feature of CONSTELLATION watches, which can also be seen from the numerous illustrations of CONSTELLATION watches in the various catalogues. The absences in the evidence are of concern. Swiss has supplied numerous catalogues showing watches, a few showing jewellery and one showing promotional material. No clocks appear in a catalogue. There are no invoices to retailers despite Mr Moody stating that Swatch sells “these clocks e.g. to jewellery retailers throughout the UK”. The number of sales of clocks is not great, however, if the trade falls within the requirements of the *Ansul* judgment, this in itself would not represent an impediment to Swiss’s case. The form of use shown on the clocks illustrated is use of the trade mark, in my view. I have considered the following in coming to a view as to the position in relation to whether the nature of the use satisfies the requirement of the *Ansul* judgment:

- absence of invoices to retailers;
- despite numerous catalogues being displayed absence of clocks in catalogues;
- the CONSTELLATION clocks, which are the only ones to show use of the trade mark, in design and name reflect a long term and successful brand of wristwatch;
- various of the clocks are clearly for external use and so could readily be used by jewellers who retail OMEGA products;
- the number of clocks imported;
- the presence of the clocks on certain invoices with various promotional items.

On the basis of the evidence before me, taking a global appreciation, I do not believe that Swiss has been trying to establish or maintain a market for clocks. Taking into account the core business of Swiss, watches, and all other factors I come to the conclusion that the clocks are used to promote Swiss’s watches and to identify OMEGA stockists; they are not used for establishing or maintaining a market for watches per se. If Swiss had

provided documented evidence of sales to jewellery retailers the outcome would have been different. This would have, as a matter of fact, established the maintenance of a market, if not necessarily a large one, and would have pulled Swiss within the requirements of the *Ansul* judgment. In my view, Swiss has signally failed to **show** the nature of any claimed trade in clocks in the United Kingdom.

26) I find that Swiss has failed to establish any genuine use of the trade mark in relation to clocks and that the registration should be revoked for such goods with effect from 6 December 1960.

Conclusion

27) At the hearing Mr Crouch accepted the use of the trade mark for various types of wristwatches. Taking into account the judgment of Professor Annand in BL 0/393/03 and the scope of the application for revocation I consider that watches at large should be left in the specification. I also take note of Ms Arenal's concern, expressed at the hearing, that any specification should reflect the nature of certain of the watches ie that they are bejewelled. A specification of watches will cover all types of watches. However, owing to the nature of Swiss's business, I can well understand the concern for a belt and braces approach to the specification; to mark out clearly the nature of certain of the goods. Taking these factors into account, I consider that the specification that should remain should follow that allowed by Professor Annand (although as the starting specifications are different it cannot be the same):

watches and jewel-watches; all being made of precious metals or imitations of precious metals; watches and jewel-watches; parts and fittings for all the aforesaid goods.

This is the specification which will have effect from 1 January 1986. However, prior to this date there was sufficient proof of use upon jewellery to allow maintenance of the specification upon such goods. **Consequently, the specification from 6 December 1960 until 31 December 1985 is limited to:**

watches and jewel-watches; all being made of precious metals or imitations of precious metals; watches and jewel-watches; parts and fittings for all the aforesaid goods; jewellery.

COSTS

28) Omega Engineering, Inc having been successful is entitled to a contribution towards its costs. A great deal of the evidence from both sides in this case is the same as that in revocation action no 81325. The statements of cases are also very similar. I take this into account in deciding the award of costs. I order Omega SA (Omega AG) (Omega Ltd) to pay Omega Engineering, Inc the sum of £1575. 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 11th day of January 2005

**David Landau
For the Registrar
the Comptroller-General**