

O-017-05

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 723200
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD)**

AND

**THE APPLICATION FOR PARTIAL REVOCATION THERETO
UNDER NO 81325
BY OMEGA ENGINEERING, INC**

TRADE MARKS ACT 1994
In the matter of registration no 723200
of the trade mark:
OMEGA CONSTELLATION
in the name of Omega SA (Omega AG) (Omega Ltd)
and the application for partial revocation thereto
under no 81325
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 723200 of the trade mark OMEGA CONSTELLATION, 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 1 April 1954. At the time of the filing of the application for revocation 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 3 October 1960 (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 3 October 1965 or from the earliest date thereafter at which the registrar is satisfied that the grounds for revocation under either section 46(1)(a) and/or 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) Since the filing of the counterstatement Swiss has submitted two partial surrenders of the goods encompassed by its registration. On 24 December 2003 Swiss restricted its specification to *jewellery, precious stones; horological instruments; parts and*

fittings therefor. On 7 December 2004, Swiss filed a further partial surrender, restricting the goods of its registration to *horological 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) In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. In that case Lord Walker stated:

"40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the

Act, which is at the heart of the first appeal:"... 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."(This language is word for word the same as the English language version of Art.10.2(a) of the Directive.)

41 The word "elements" can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) "elements" must have a weaker sense (of "features" or even, as Mr Bloch came close to submitting, "details").

42 The deputy judge touched on this and some related points in paras [18-22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark's distinctive character was altered (not substantially altered).

43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who:

"normally perceives a mark as a whole and does not proceed to analyse its various details."

The quotations are from para.[26] of the judgment of the Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

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

14) At the hearing it became clear that the issues in dispute related to whether there was evidence of genuine use in relation to clocks, what would be a fair description of any goods which were not the subject of revocation or were not revoked and whether the use of the trade mark shown was use in a form which does not alter the distinctive character of the mark in the form in which it was registered. 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 watches and clocks that there is any evidence of use of the trade mark. There is a reference in a catalogue for the 1996-1967 collection to matching cufflinks being available. However, there is no indication that the trade mark itself was used in relation to these cufflinks. Consequently, I will consider the evidence only in relation to what represents the goods that remain in contention between the two sides, clocks.

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 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:



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 JFM5 refers to this design feature for Constellation timepieces as does some of the promotional material exhibited at JFM2). All but the first picture of a clock give serial numbers. Mr Moody exhibits invoices relating to the clocks. These are invoices from the parent company to SMH (UK) Limited (a previous name of Swatch) and Swatch. Various invoices with references to CONSTELLATION clocks (referred to as CONSTELLATION or CONST) have been exhibited (unfortunately they have not been exhibited in chronological order):

20 February 1996	1 CONSTELLATION clock @ 4,155 Swiss francs
31 May 1996	10 CONSTELLATION clocks @ 175 Swiss francs each
26 March 2003 each	2 CONSTELLATION outdoor clocks @ 1,650 Swiss francs
8 April 2003	2 CONSTELLATION outdoor clocks @ nil cost
26 June 2003	1 CONSTELLATION clock @ 2,950 Swiss francs
20 June 2003 francs	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
21 March 2003	4 CONSTELLATION wall clocks @ 295 Swiss francs each
6 June 2003	2 CONSTELLATION wall clocks @ 395 Swiss francs each
20 June 2003	5 CONSTELLATION wall clocks @ 300 Swiss francs each
	5 CONSTELLATION wall clocks @ 450 Swiss francs each
21 March 2002 francs	1 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs
5 June 2002 francs	1 CONSTELLATION outdoor clock 2 faces @ 2,950 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 each	4 CONSTELLATION outdoor clocks @ 1,570 Swiss francs
26 February 2001 francs	1 CONSTELLATION outdoor clock 2 faces @ 3,770 Swiss francs
23 May 2001 francs	4 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs
	3 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs each
18 April 2001 francs	1 CONSTELLATION outdoor clock 2 faces @ 6,500 Swiss francs
	3 CONSTELLATION outdoor clocks @ 1,070 Swiss francs
each	1 CONSTELLATION outdoor clock 2 faces @ 2,950 Swiss francs each
3 April 2001 each	5 CONSTELLATION outdoor clocks @ 2,950 Swiss francs
	1 CONSTELLATION outdoor clock @ 6,500 Swiss francs
24 October 2001	1 CONSTELLATION outdoor clock @ 6,500 Swiss francs
30 November 2001	1 CONSTELLATION outdoor clock @ 6,500 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
19 October 2000	2 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs
1 December 2000	3 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs each
29 December 2000	3 CONSTELLATION outdoor clock 2 faces @ 2,750 Swiss francs each
1 December 2000	4 CONSTELLATION outdoor clocks @ 1,570 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
8 October 1998	1 CONSTELLATION clock @ 1,550 Swiss francs
22 October 1998	1 CONSTELLATION outdoor clock 2 faces @ 2,750 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 JFM 6 tie various of the clocks to invoices by the serial numbers.

16) I consider it appropriate to first consider whether the nature of the use shown upon the pictures of the clocks is use in a form which does not alter the distinctive character of the trade mark in the form in which it was registered. This is the only use that is shown outside of the invoices. On the invoices either CONSTELLATION or CONST appears. The words OMEGA CONSTELLATION do not appear. The invoices all bear:



at their top. I do not consider that the invoices show any use of the trade mark in the form that is registered. 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 is representative of the creating or preserving 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 invoices, none to retailers, in my view represent internal use and so could not assist Swiss, even if they did show use of the trade mark.

17) Ms Arenal argued that the use upon the clocks was use of the trade mark as well as the trade mark :



CONSTELLATION.

In considering her argument it is useful to consider some of the words of Lord Walker again:

“45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar,

through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who:

"normally perceives a mark as a whole and does not proceed to analyse its various details".

I can envisage the average consumer as seeing one trade mark containing all three elements or two separate trade marks:



and CONSTELLATION or three separate trade marks. Owing to the distance between the top elements and the bottom element, I cannot readily envisage that the use will be seen as use of O as one trade mark and OMEGA Constellation as a second different trade mark; which is what Ms Arenal's proposition entails. Such an interpretation strikes me as very forced and unnatural. The relevant issue is to judge the particular nature of use shown. I am of the view that the use shown upon the pictures of the clocks, the only external use, will be perceived as use of all three elements as separate trade marks or the trade mark:



and the trade mark Constellation in joined up handwriting as one composite trade mark or the use of:



as one trade mark and Constellation in joined-up handwriting as another trade mark. I consider that the presence of O, in the context of the use, does make a great deal of difference and means that the use shown is use in a form which does alter the distinctive character of the mark in the form in which it was registered. On this basis I do not think it necessary to consider whether the nature of the use of CONSTELLATION, in joined-up handwriting and in title case and at some distance from the rest of the trade mark also affects the matter. I notice, although it certainly has not been an influence upon my decision, that Mr Moody in paragraph 14 of his witness statement, on the two occasions that he refers to the trade mark, refers to it as O OMEGA CONSTELLATION. This may be a simple repeated error, although I assume care was taken in drafting a witness statement, or may reflect how Mr Moody sees the trade mark. The only time that the trade mark, as registered, is shown in use is in the catalogues and promotional material describing watches. In the numerous catalogues showing watches, it does not appear on any illustration of a watch. I

consider that use shown is use in a form which does alter the distinctive character of the mark in the form in which it was registered and so is not use for the purposes of section 46(1) and (2) of the Act.

18) In the event that I am wrong in my decision in relation to whether the use shown represents use in a form that does alter the distinctive character of the trade mark, I will go on to consider whether the use would save the trade mark in respect of clocks.

19) By my calculations, in the years 2000 to 2003 (up to 27 June 2003) the invoices show respectively 34, 131, 67 and 72 CONSTELLATION clocks being sent to Swatch in the United Kingdom. As I have stated the invoices are what I consider internal invoices, from one part of the company to another. 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 the 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 CONSTELLATION watches, in not one catalogue is there a picture of a clock. There is no promotional material relating to clocks. There are no price lists relating to clocks. There are no invoices to retailers, despite Mr Moody stating that Swatch sells “these clocks e.g. to jewellery retailers throughout the UK”. Mr Moody does not show this by exhibited material. The detail in his witness statement is vague. He refers to OMEGA CONSTELLATION branded jewellery including watches and clocks. However, he gives no turnover figures for clocks separately.

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. 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, 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 CONSTELLATION 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 under the trade mark in the United Kingdom.

20) Consequently, if I am wrong in my finding in paragraph 17, 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 upon this basis.

Conclusion

21) 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, another revocation brought by US against a Swiss registration, 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 jewelled. 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.

As there is no evidence of genuine use of the trade mark for any goods, other than those above, the partial revocation will take effect from 3 October 1965.

COSTS

22) 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 81328. 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 £1375. (The amount is different from that awarded in revocation action no 81328 as there was less evidence for US to consider.) 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 13th day of January 2005

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