

**TRADE MARKS ACT 1938 (AS AMENDED)  
TRADE MARKS ACT 1994**

**IN THE MATTER OF AN Application by  
Citizen Tokei Kabushiki Kaisha for the  
registration of the mark in Class 14**

**AND IN THE MATTER OF Opposition thereto  
by Omega S.A. under No 43032**

**TRADE MARKS ACT 1938 (AS AMENDED)**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN Application by**

5 **Citizen Tokei Kabushiki Kaisha for the  
registration of a trade mark in Class 14**

**AND IN THE MATTER OF Opposition thereto**

**by Omega S.A. under No 43032**

10

**BACKGROUND**

On 15 February 1994, Citizen Tokei Kabushiki Kaisha applied under Section 17 of the Trade  
Marks Act 1938 for the registration of the trade mark SPACE MASTER in respect of:-

15

Watches, clocks, horological instruments; parts and fittings for all the aforesaid goods; all  
included in Class 14; but not including any such goods incorporating radios.

On 24 August 1995, Omega S.A. of Switzerland filed notice of opposition. The grounds of  
opposition are, in summary, that:-

20

1. The opponent is the registered proprietors of registered trade mark No 770409, which  
consists of the word SPEEDMASTER, which is registered in respect of 'watches' and is  
confusingly similar to the applicant's mark. Registration would therefore be contrary to  
Section 12(1) of the Trade Marks Act 1938.

25

2. The opponent uses the mark SPEEDMASTER and promotes the mark as having a  
'space image' it being the first watch to be worn on the moon. Registration of the mark  
applied for would be contrary to Section 11 of the Trade Marks Act 1938 because use of  
the applicant's mark would be liable to cause confusion.

30

3. The application should be refused in the exercise of the Registrar's discretion under Section 17 of the Trade Marks Act 1938.

5 The applicant subsequently filed a counterstatement admitting that the opponent is the proprietor of registration 770409, but denying all the grounds of opposition. In particular, the applicant contends that the watch sold by the opponent under the mark OMEGA SPEEDMASTER PROFESSIONAL had a "space image" only while moon travel was topical, primarily in 1966 but occasionally in more recent years with astronauts' reminiscences; that the opponent has associated the watch with other events, notably the Olympic games; that any association in the public's mind  
10 between the opponent's product and a "space image" is slight and would not contribute significantly to any confusion between the marks. Both sides seek an award of costs.

The matter came to be heard on 11 December 1998 when the applicant was represented by Mr M Foreman of Marks & Clerk, Trade Mark Agents, and the opponent was represented by Mr M  
15 Edenborough of Counsel, instructed by Mewburn Ellis, Trade Mark Agents.

By the time this matter came to be heard the Trade Marks Act 1938 had been repealed. However, in accordance with the transitional provisions set out in Schedule 3 to the Trade Marks Act 1994 I must continue to apply the provisions of the old law to these proceedings. Accordingly, all  
20 further references to provisions of the Act are references to the provisions of the Trade Marks Act 1938.

### **OPPONENT'S EVIDENCE**

25 The opponent's evidence takes the form of a Statutory Declaration dated 21 August 1996 by Hans Kurth who is a Director of Omega S.A.. Mr Kurth states that the opponent is the proprietor of the trade mark SPEEDMASTER which has been registered in the UK in respect of watches since 1957. Mr Kurth further states that the mark has been used continuously in the UK for at least 30 years since the early 1960's. He provides wholesale sales figures for watches sold under  
30 the mark since 1988. These show that wholesale turnover in watches in 1988 was £57k. Turnover increased significantly in 1989 to £454k rising further to over £900k in 1992 before

falling back somewhat to £649k in 1993. Figures are provided for advertising expenditure. These show that between 1988 and 1993 the opponent normally spent about £80k per annum promoting goods under the mark. However, these figures are estimated on the basis that approximately 10% of the opponent's advertising expenditure relates to SPEEDMASTER watches. Advertising is said to have occurred through British magazines available on news stands throughout the UK.

A number of exhibits are attached to Mr Kurth's declaration which demonstrate the promotion of the opponent's mark. The most relevant of these (because it consists of promotional material made available to the public in the UK) is exhibit HK1. Included within this exhibit is a copy of an entry in the September 1984 edition of Modern Jeweller. It features the opponent's Omega Speedmaster Professional watch which, it claims, had been chosen as the official timepiece of the 1984 US Open. The advertisement also refers to a number of Omega watches other achievements including the fact that the Omega Speedmaster Professional was chosen by NASA and worn by Neil Armstrong when he stepped onto the moon. Also included is a copy of an advertisement which is said to have appeared in Car magazine in September 1989. It also features the opponent's Omega Speedmaster Professional watch below a picture of astronaut in a space suit walking on the moon. The following appears under the words "Significant Moments":-

"Omega always marks significant moments. At the Olympics. In the space program. In significant lives like yours. The Omega Speedmaster. For space exploration. And for you."

A copy of the same advertisement for the Omega Speedmaster Automatic, but this time featuring a picture of sprinters crossing a finishing line is also included. Also included is an example of a promotional booklet for the Speedmaster watch from 1989. It also features a picture of an astronaut on the front cover and the space theme is continued inside with an endorsement from an astronaut and picture of the back of the watch with the caption:-

"The words "First Watch Worn on the Moon" engraved on the case testify that it is the genuine Space Watch."

It appears from this picture that the back of at least one version of the Omega Speedmaster

Professional is also engraved with the legend “Flight-Qualified by NASA for all manned space missions.” It is claimed that this watch is the only watch “flight qualified” by NASA, and that it has been so qualified and used since 1965. Not surprisingly later advertisements, such as one that appeared in the Economist of 12 June 1993, continue the same “First watch worn on the Moon” theme.

Mr Kurse points out that the mark SPEEDMASTER appears on the face of the watch (in script with the Omega above and Professional below, both in plain type). He also points out that the opponent is the proprietor of the registered trade marks SEAMASTER and FLIGHTMASTER, which are also registered for watches. In his view this adds to the likelihood of confusion.

### **APPLICANT’S EVIDENCE AND OPPONENT’S EVIDENCE IN REPLY**

The applicant’s evidence takes the form of a Statutory Declaration dated 23 September 1997 by Aidan Vaughan Clarke, who is a partner in Marks & Clerk, the applicant’s Trade Mark Agents. Mr Clarke provides details of a considerable number of trade marks registered in Class 14 which either begin with the word ‘Space’ or end with the word ‘Master’ and which are not in the ownership of the opponent. I do not intend to summarise these marks in detail because, for reasons which I will explain later, I do not intend to rely upon them in reaching my decision.

Mr Clarke also provides a copy of a report by Probe International following a survey of Omega stockists in the UK. I do not intend to summarise this evidence either. At the hearing, Mr Edenborough challenged it on the ground that it consists of multiple hearsay and was therefore inadmissible as a matter of law following *St Trudo Trade Mark* 1995 RPC 370. Mr Foreman accepted (as I think he was bound to do) that this challenge was well founded. Accordingly, I find that this evidence is inadmissible and I will make no further reference to it.

The opponent filed evidence in reply. I see no need to summarise that either because it consists of statements of opinion and responses to points the applicant has made which either I do not intend to rely upon or, in the case of the survey evidence, admit at all.

## DECISION

Both parties seek to pray in aid of their positions the fact that there are other marks registered in the UK in Class 14 which contain either the prefix SPACE or the suffix MASTER. In the case of Beck, Koller & Company (England) Limited's Application (64 RPC 1946 76 @ 83, lines 26-30) the Assistant Comptroller held that, in opposition proceedings, the Registrar is not entitled to make presumptions, in either parties favour, that other registered marks have been put into use during the relevant period. In the absence of evidence of user, the existence of other registrations is irrelevant. The opponent has filed some evidence (in the form of price lists) that the mark SEAMASTER has been used but these only show use after the relevant date, which it is well established is the date of the application under opposition - 15 February 1994. I therefore intend to determine the matter entirely by reference to the proven earlier registration and use of the mark SPEEDMASTER.

The established tests under Sections 11 and 12(1) of the Act are those set down in the case of Smith Hayden's application (1946) 64 RPC 93 at page 101, as adapted by Lord Upjohn in the Bali trade mark case (1969) RPC 472. Adapted to the matter at hand the tests may be expressed as follows:-

Under Section 11

"Having regard to the use of the mark Omega Speedmaster Professional, is the tribunal satisfied that the mark applied for SPACE MASTER if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

Under Section 12(1)

"Assuming user by Omega S.A. of their mark SPEEDMASTER in a normal and fair manner for any of the goods covered by the registration of this mark, is the tribunal satisfied that there will be no reasonable likelihood of confusion or deception amongst a substantial number of persons if the applicant also use their mark SPACE MASTER normally and fairly in respect of any of the goods covered by their proposed registration?"

I will deal the Section 12 point first. I don't think that I should have regard to the space/moon promotional theme used by the opponent when considering the likelihood of confusion under this heading. Only notional "normal" use of the earlier mark should be considered under Section 12. Both specifications include watches. The matter therefore falls to be determined primarily by way of a comparison of the respective marks taking account of any relevant circumstances in the trade in these goods.

Before me, Mr Edenborough submitted that the marks were similar enough to be confused. In his submission the common ending MASTER coupled with the same beginning SP- , resulted in marks with a high degree of overall similarity. Mr Edenborough argued that the risk of confusion would be increased by the associated meanings of SPACE and SPEED and not lessened by the fact that the applicant's mark consisted of two words whereas his client's mark consists of two words conjoined into one. Mr Edenborough also pointed out that trade marks on watches normally appeared in fairly small script and similar marks were therefore more likely to be confused.

For his part, Mr Foreman contended that the words SPACE and SPEED were well known words with different meanings and that this, coupled with the fact that his client's mark consisted of two words, would help to avoid confusion. He further pointed out that the word MASTER had laudatory overtones and was not therefore so distinctive that the presence of this word in both marks was such as to immediately suggest common trade origin.

I find myself in disagreement with Mr Edenborough's submission that the public would *prima facie* attribute similar or associated meanings to the words SPACE and SPEED. Nevertheless, there is undeniably a degree of similarity between the marks when compared as wholes and, taking account also of the small size of trade marks on watch faces, it is with some hesitation that I have come to the view that the degree of similarity between SPACE MASTER and SPEEDMASTER is insufficient to give rise to a real likelihood of confusion under Section 12.

I next consider the position under Section 11. Under this heading I must consider the actual user of the opponent's mark. This benefits the opponent to the extent that I can take account of any

increased likelihood of confusion that may arise from the space/moon connection that the opponent has nurtured through their promotional activities, but it also provides some assistance to the applicant because the comparison under this heading is between the applicant's mark and the mark actually used by the opponent - Omega Speedmaster Professional.

5

Mr Foreman very fairly accepted that the opponent believed that a connection had been established in the public's mind between the Omega Speedmaster watch and 'space', but he contended that this was not borne out by the evidence which, in his submission, showed only limited attempts to create such an association, and which was more directly aimed at creating an association with the moon landing than 'space' per se. Mr Foreman pointed to the evidence that the opponent had, at different times, also linked the Omega Speedmaster watch to other events, such as the US Open and the Olympics.

10

Not surprisingly, Mr Edenborough took a different view of the evidence. In his view it showed that it was likely that the opponent had created a considerable association in the public's mind between the Omega Speedmaster Professional watch and the NASA space program. In his view this increased the likelihood that the applicant's use of SPACE MASTER would lead to confusion with his client's earlier use of Speedmaster. In Mr Edenborough's submission this likelihood would not be lessened to any significant degree by the absence of his client's house mark or the word "Professional", which he argued was a non-distinctive word which contributed very little to the job of distinguishing his client's watches.

15

20

In my view the evidence provides some support to the opponent's claim that they have, over a period of many years, sought to foster in the public's mind an association between their Omega Speedmaster watch and the NASA space program. This association has focussed primarily on the fact that the opponent's watch was worn on the first moon landing, but it has gone wider than that. It is true that, at different times, the opponent has also sought to promote their goods by reference to other well known events, but this appears to me to have been more in the nature of smaller "one off" promotions. And even where this has been done the 'space/moon' theme has also sometimes featured. I am therefore prepared to accept that, at the relevant date, a number or persons in the UK, probably a substantial number, would have been aware of the opponent's

25

30

promotion of the Omega Speedmaster Professional as the first watch worn on the moon and the only watch endorsed by NASA for manned space missions. In other words there would have been some association between one of the opponent's watches and manned moon missions and/or space missions in general.

5

That appears to me to have a bearing on the likelihood of confusion. The applicant's best case is that the mark SPACE MASTER is unlikely to be confused with the SPEEDMASTER watch because the words SPACE and SPEED are well known words with no obviously associated meaning. However, if the public have reasonable cause to associate the Speedmaster watch with 'space' the distinguishing power of that word is considerably reduced. It is well established that the comparison of marks should not simply entertain the likelihood of confusion from a side by side comparison, but should also take account of circumstances where one trade mark is seen or ordered by someone with only an imperfect recollection of the other trade mark (see for example, Luxmore L.J. speech in *Rysta v Aristoc* - 1943 60 RPC 87 @ 108 later supported by House of Lords -1945 62 RPC 65).

10

15

In the circumstances described above, it appears to me that use of the applicant's mark is likely to give rise to a real tangible danger of those persons who have seen the opponent's advertisements for their Speedmaster watches, mistakenly believing that the SPACE MASTER watch is the one they have seen advertised. At the very least they would have reasonable cause to wonder whether it is the same watch. I bear in mind that in *Jellinek's trade mark* [1946] 63 RPC 59 at 78, Romer J. said:-

20

25

30

"It is not necessary in order to find that a mark offends Section 11 to prove that there is an actual probability of the deception leading to a passing off or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products came from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the Court has to be satisfied not mainly that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register."

If I am right that there is a real tangible danger of confusion in the light of the opponent's actual user of Speedmaster, the next question is whether the fact that the opponent has generally used the mark Speedmaster as part of the composite mark 'Speedmaster Professional' and in conjunction with the house mark OMEGA, sufficient to avoid any confusion with the applicant's mark. I consider the following facts to be relevant:

1. In use on the watch face the word Speedmaster appears below the house mark OMEGA and above the mark 'Professional';

2. The word Speedmaster is given prominence because it is a little larger than the other words and is presented in a form of script (whereas the other words appear in plain letters);

3. The opponent promotes the 'manned space missions' connection with their Speedmaster model in particular because it - or at least a version of it - is the model endorsed by NASA and worn on space flights including the moon landings;

4. There is a small amount of evidence of use of the word Speedmaster separated from the OMEGA mark - for example on the front of the promotional brochure from 1989 referred to on page 3 above.

I agree with Mr Edenborough's submission that the secondary mark 'Professional' is a weak mark. I doubt whether its absence is likely to be sufficient to avoid any confusion that would otherwise arise. The fact that the opponent has generally used the Speedmaster mark with the OMEGA house mark is a more significant point. The circumstances are somewhat similar to those that pertained in the BULOVA ACCUTRON trade mark case (1969 RPC 102). Deciding that the mark was confusingly similar to the registered trade mark ACCURIST, Stamp J. incorporated the following words of the Assistant Registrar into his judgement (at page 109, lines 28-33):-

"...I think that there is a tangible danger that a substantial number of persons will confuse the ACCUTRON component of the mark applied for with ACCURIST, and consequently

will conclude that the goods emanate from the same trade source as ACCURIST watches, believing that the BULOVA component, if it makes an impact, is a house mark or another mark of the same concern.”

5 Although in this case it is the earlier mark which has been used with a second mark which is obviously a house mark, I believe that the reasoning is still relevant. I do not think that the absence of the house mark OMEGA from the applicant’s mark can be relied upon to avoid any confusion that would otherwise arise through an imperfect recollection of the Speedmaster trade mark used by the opponent. I am mindful that the onus is on the applicant to persuade me that  
10 there will not be confusion and, despite the eloquent arguments put forward by Mr Foreman at the hearing, I am not so persuaded. In the result the opposition under Section 11 succeeds.

The opposition having succeeded under one of the mandatory grounds for refusal, the question of the Registrar’s discretion does not arise.

15 The opposition having succeeded the opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £900.

**Dated this 19 Day of January 1999**

20  
  
**Allan James**  
**For the Registrar**  
25 **The Comptroller General**

30