

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 1456848
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD)**

**AND THE APPLICATION FOR PARTIAL REVOCATION THEREOF
UNDER NO 80065
BY OMEGA ENGINEERING, INC**

TRADE MARKS ACT 1994
In the matter of registration no 1456848
of the trade mark:



in the name of Omega SA (Omega AG) (Omega Ltd)
and the application for partial revocation thereof
under no 80065
by Omega Engineering, Inc

BACKGROUND

1) On 14 September 2001 Omega Engineering, Inc (referred to as US from herein) filed an application for the partial revocation of trade mark registration no 1456848 standing in the name of Omega SA (Omega AG) (Omega Ltd) (referred to as Swiss from herein). The trade mark was registered on 18 March 1994. It is currently registered for the following services:

maintenance and repair of horological and chronometric instruments, jewellery, goods in precious metal or goods coated therewith, weighing and optical apparatus and instruments, and of public information display apparatus and instruments; maintenance and repair of measuring, checking and signalling apparatus and instruments; information services relating to all the aforesaid; all included in Class 37; but not including maintenance and repair of heat and temperature measuring, checking and signalling apparatus and instruments, all for scientific and industrial use.

The services are in class 37 of the International Classification of Goods and Services.

2) US states that the registration has not been used by Swiss for at least five years for the services encompassed by the specification with the exception of maintenance and repair of horological and chronometric instruments (not being for scientific or industrial use). US states that to the extent that the aforesaid services extend beyond maintenance and repair of horological and chronometric instruments (not being for scientific or industrial use) the registration should be revoked under section 46(1) (a) of the Trade Marks Act 1994 (the Act) or in the alternative under section 46(1)(b) of the Act.

3) On 2 January 2002 Swiss filed a counterstatement. Swiss states that the trade mark has been used in the United Kingdom for the full range of services covered by the registration. Swiss furnish evidence to show use of the trade mark. Swiss seeks an award of costs.

4) Both sides filed evidence.

5) The matter came to be heard on 22 January 2003 when US was represented by Mr Christopher Morcom QC, instructed by Bromhead & Co, and Swiss was represented by Ms Sofia Arenal of Mewburn Ellis.

Swiss's evidence

Witness statement of Peter Stierli

6) Mr Stierli is the vice president and chief finance officer of Swiss. He states that:



(the trade mark) has been used in the United Kingdom during the last five years by Swiss or with its permission, for example by The Swatch Group (UK) Limited, Omega Electronics SA and the United Kingdom business Omega Electronics, which is a division of The Swatch Group Limited. Mr Stierli states that the Swatch Group Limited is the parent company of a group of companies including Swiss and other companies within the group, including those mentioned, who use the trade mark with the consent of Swiss. He states that use has been upon all the services covered by the registration.

7) Mr Stierli states that US concedes that there has been use of the trade mark for maintenance and repair of horological and chronometric instruments (not being for scientific or industrial use). Nevertheless, for the sake of completeness he exhibits evidence relating to the use of the trade mark in relation to maintenance and repair of horological and chronometric instruments in the United Kingdom. He exhibits a brochure issued in 1998 to English speaking countries, including the United Kingdom, which he states relates largely to Swiss's range of "watches, jewellery/goods of, or coated with, precious metal". He states that at page 72 it also refers to the after sales-service for maintaining and repairing timepieces, jewellery and goods in/coated with precious metals. He states that Swiss's time-keeping services are mentioned on pages 1 and 5. He states that there is also a reference to video matrix scoreboards on page 5.

8) The reference on page 1 states, amongst other things:

"in sports, with the timekeeping of 21 Olympic games, of the most important international swimming and athletic meets, along with CART (Championship Auto Racing Teams) car racing in the USA, Canada, Australia and Japan;"

9) Page 5 refers to OMEGA time keeping at various Olympic Games. It also states:

“like the first 1/1000 of a second Photofinish camera, the world’s first electronic timing and the OMEGAscope’s elapsed time race time superimposed on the TV screen. OMEGA is also the inventor of the giant video matrix scoreboards installed in most modern sports stadiums around the world.”

10) Despite the comments of Mr Stierli the only goods that I can see in the catalogue are wristwatches.

11) Page 72, which Mr Stierli refers to, reads as follows:

“AFTER-SALES SERVICE IN 130 COUNTRIES

By purchasing an OMEGA, the client receives not only a watch rich in 150 years of watchmaking experience and know-how but also access to an exceptional worldwide service network in 130 countries. These rigorously selected “ambassadors” of OMEGA’s World Service Organization, in connection with the brand’s distributors, offer the client impeccable product service worthy of the great tradition of Swiss watchmaking.

Through seminars and training periods held at OMEGA headquarters in Switzerland or on the markets, OMEGA technicians continually train and inform the service network. Adequate tools and spare parts are supplied to watch repairmen to assure excellent after-sales service.

Naturally, OMEGA watches are guaranteed internationally against all manufacturing defects. Throughout the entire guarantee period, the client simply shows his duly filled in guarantee card to OMEGA agents or service centers throughout the world to receive any service required free of charge.

Beyond the period of guarantee, the OMEGA worldwide network continues to provide top quality service to its clients. The advertising slogan of the fifties says it perfectly: “OMEGA, the watch the world has learned to trust”.

I can see nothing in the above that relates to anything other than watches.

12) Mr Stierli exhibits catalogues for 2000 and 2001. The catalogues are catalogues of wristwatches. Mr Stierli makes mention of, for example, page 3 of the 2001 catalogue. This refers to official timekeeping at Olympic Games and the wearing of OMEGA watches by astronauts. It also states:

“The word of OMEGA is seen in the timepieces on display in the windows of the best watch retailers and jewellery stores in over 130 countries. They are exclusive wristwatches worn by elegant and famous ambassadors....”

At the back of the catalogues there are pages dealing with after sales service which are couched in much the same terms as I have quoted in paragraph 11 above.

wind gauges, graticules, thermistors, fixing plates, amplifiers, speakers, battery chargers, microphones, clocks, scoreboards, bags, keyboards and keyboard assemblies, cables, film drive motors, false digits, buttons, thyristors, glue, grease, fasteners, scoreboard lamps, PC boards, photo cells, O-rings, flash units, start transducers, starter horns, power supplies, headsets, bulbs, lane harnesses, timers, software, driver boards, square keys, consoles, cameras, rivets, information display boards and systems, controllers for clocks, tripods, starting gates, optical blocks and 4 axis supports, shock absorbers, circuit boards, loud speakers, rubber wipers, power transistors, latches for pressure plates, headsets, cable winders, buzzers, filters, start blocks, pictograms, lamps, kits for judges, penalty panels, connection boxes, printer electrodes, starting platforms, plugs, mounting frames, deck plates, timing computers, LCD displays, paper rolls, data handling modules, gate line indicators, electronic distance measuring units, security clips, brushes for start blocks, washers, shock absorbers, screws, interface boxes, isolator studs, remote control cameras, reflectors, hand switches, lenses, fuses, zoom lenses, adaptors, converters, diskettes, flash starts, contact strips, dynamometers, mouse mats, touch-pad testers, transportation cases, reflectors, batteries, installation material and manuals, display units, start/stop/reset hand switches and cell and reflector mounts, and slats bearing the Greek letter O or the word OMEGA.

17) Mr Stierli states that he exhibits copies of invoices from Omega Electronics SA relating to United Kingdom sales and services under the trade mark from 1996 – 2000. A lot of these are for goods rather than services. The goods in the invoices are mostly covered by Mr Stierli's list in paragraph 16 above. I have recorded all the services provided, as shown by the invoices below. All the invoices are from Omega Electronics SA in Switzerland to Omega Electronics Ltd in the United Kingdom. I have only given the cost of the service where it is a non-repair service.

4 April 1996 Back after repair, control and test OVG-4 character generators
2 February 1996 Back After Repair, Control and Test – photocells – material and manpower Driver pc board
1 November 1996 Back after repair, control and test – driver PCBs and Interface PCB
1 November 1996 Back after repair, control and test – console, PC Board, timing apparatus
6 December 1996 Back after repair, control and test ORA amplifier, driver boards
9 October 1996 Back after repair, control and test PCB Textline
27 September 1996 Engineering cost for the Glasgow East End Leisure Centre £30,230
15 August 1996 Back after repair, control and test PCBs
9 August 1996 Back after repair, control and test PC Boards
31 May 1996 Back after repair, control and test printed circuit board
6 June 1996 Back after repair, control and test Scan-O-Vision control rack, PC boards
1 April 1997 Sunderland Football Club – engineering work for scoreboards – 67,810.55 Swiss Francs
25 April 1997 Back after repair, control and test Driver PCBs
14 March 1997 Back after repair, control and test Photocells
1 February 1997 Back after repair, control and test ORA amplifier, PC board
8 February 1997 Back after repair, control and test PCB

15 December 1997 Engineering for scoreboard project Derby County – 8,212.30 Swiss Francs, engineering for scoreboard project Tottenham Hotspur – 10,516.50 Swiss Francs
 18 December 1997 Back after repair, control and test phocell, timing apparatus, pushbutton, tapeswitches
 27 November 1997 Back after repair, control and test camera OSV1
 10 October 1997 Back after repair, control and test PSBs, PSUs, Power supply PCBs
 8 August 1997 Back after repair, control and test MTL-551 controller
 30 July 1997 Back after repair, control and test Driver PCB, timing computer
 16 July 1997 Back after repair, control and test timing devices
 18 July 1997 Back after repair, control and test Power supply refurbished
 5 May 1997 Back after repair, control and test and calibration – timing computer
 12 May 1997 camera repaired by the supplier
 16 December 1998 Engineering work for Hampden Park Project 21,983.30 Swiss Francs, engineering work for Milton Keynes National Hockey Stadium Project 3,790.10 Swiss Francs
 3 December 1998 Back after repair, control and test textline PCB, HawkEye camera
 1 November 1998 Back after repair, control and test control console
 2 September 1998 Back after repair, control and test UN2-MS3 console
 7 July 1998 Back after repair, control and test ORA amplifier, flash unit, PCB
 19 June 1998 Back after repair, control and test Sportissimo wind-gauge, Hawk Eye camera
 1 May 1998 Back after repair, control and test textline PCB
 7 April 1998 Back after repair, control and test universal harness module
 11 March 1998 Back after repair, control and test Hawk Eye pcb
 13 February 1998 Back after repair, control and test console, pushbuttons, photocells, Hawk Eye PCB
 19 February 1998 Back after repair, control and test Driver PCB, UN2 main pcb, UN2 personal foul pcb
 7 January 1998 Back after repair, control and test false start cable reels, Sportissimo penalty clock
 5 January 1999 Back after repair, control and test Driver PCB
 11 February 1999 Back after repair, control and test UN2 PCB
 25 March 1999 Back after repair, control and test UN2 PCB, shot clocks Sportissimo
 23 April 1999 Back after repair, control and test UN2-MS3 consoles, Hawk Eye camera
 12 May 1999 Back after repair, control and test Driver PCBs
 28 May 1999 Back after repair, control and test ARES timing device, disquette
 2 September 1999 Back after repair, control and test UN2-BA console
 22 October 1999 Back after repair, control and test Hawk Eye camera
 26 November 1999 Back after repair, control and test Eureka Driver
 5 August 1999 engineering support ref to JJB Stadium project 8,384.10 Swiss Francs
 8 July 1999 Back after repair, control and test Flash unit
 6 August 1999 Driver PCB repaired under warranty
 14 July 2000 Back after repair, control and test Scoreboard controller
 10 August 2000 Back after repair power supply boards
 8 August 2000 Back after repair OSVPro camera
 8 December 2000 Back after repair StartTime amplifier, lamp drivers

8 September 2000 Back after repair OSV Pro camera
 18 February 2000 Back after repair, control and test Eureka driver PCB, cable double reels
 9 May 2000 Back repair Start time units Back after repair, control and test Pcb OSVHE camera
 1 May 2000 Back after repair, control and test Eureka driver PCB
 8 June 2000 Back after repair ARES swimming Back after repair, control and test Flash lamp
 1 September 2000 Back after repair – acoustic start, amplifiers
 12 October 2000 Back after repair – Eureka pcb lamp drivers
 19 October 2000 Back after repair – tone pcb driver, tone power supply, UN2 pcb

18) Until May/June 1997 the word OMEGA in combination with the Greek letter O appears in the following format:



Afterwards it appears in the following format:



19) Mr Stierli states that Swiss's activities encompass a wide range of fields. He refers to an invoice which relates to public information display systems for SilverLink, a United Kingdom train operator. A further invoice, he states, is for a customer information display board supplied to the restaurant Smiths of Smithfield. Mr Stierli states that one invoice is for public information display systems at Milton Keynes and Watford train stations.

20) Mr Stierli exhibits further invoices which he states relate to maintenance and repair services supplied under the trade mark in the United Kingdom from 1996 to 2000. Many of the invoices are for goods rather than services. The goods and services all relate to sports timing systems, display boards, photofinish systems and scoreboards. The word OMEGA in combination with the Greek letter O appears in the following format:



21) Mr Stierli states that maintenance and repair services have been provided to a wide range of companies and organisations including recreation centres, councils, football clubs, sports stadiums, construction companies, British Telecommunications Plc and management companies. Mr Stierli exhibits copies of maintenance contracts between OE and various customers. (The use of the word OMEGA in combination with the Greek letter O appears in the format shown in paragraph 20.) The contracts exhibited are all for sports/leisure centres. The contract for Stourport Sports Centre is for the maintenance of a scoreboard and control cable. The contract for Wyre Forest Glades Leisure Centre is for maintenance of indoor scoreboards and associated control consoles. The contract for Crown Pools is for a timing system, scoreboards, acoustic start system and fixed wiring system, all for a swimming pool. The contract for the Queen's Leisure Centre is for the maintenance of a swim timing system and a scoreboard. The final contract covers Ponds Forge International Sports Centre, Don Valley Stadium and Hillsborough Leisure Centre. This encompasses various items which seem to fall into these main categories: scoreboards, sports timing apparatus, photofinish cameras, timer displays, telephones for judges and referees of water sports. Mr Stierli states that the approximate number of United Kingdom maintenance contracts has been as follows:

1996	38 covering 50 sites
1997	38 covering 50 sites
1998	40 covering 52 sites
1999	40 covering 52 sites
2000	42 covering 54 sites
2001	45 covering 57 sites

22) Mr Stierli exhibits copies of catalogues and publicity material distributed in the United Kingdom between 1996 and 2001 which he states show samples of Swiss's products and services supplied under the trade mark. He states that the approximate turnover for customer services in relation to the products of Swiss from 1997 – 2000 was £3,532,000.00.

23) Part of the material relates to equipment for sporting activities taking place in swimming pools eg water polo, swimming and diving. This includes timing systems and equipment, start systems and equipment, scoreboard systems and equipment, various clocks, touch pads. The leaflets show for the most part use of the lower trade mark shown in paragraph 18 in some form, the number of rectangular bars blocks vary. The trade mark as registered appears on the front of a computer monitor shown in a brochure from 1996 for ARES 21 sports timing equipment. In two of the leaflets pictures of scoreboards are shown and these have O to the left hand side of the word OMEGA.

24) Other material is as follows:

- A brochure for Passenger Information Systems. It is indicated that this was used from 1999 to 2001. The use of O and the word OMEGA is in the form shown in the lower trade mark in paragraph 18.

- A leaflet for a time keeping system for track and field. This includes such goods as scoreboards, wind gauges, telephones, distance measurement systems, false start systems, start systems and photo-finish systems. The trade mark shown on the leaflet is:



It is indicated that this leaflet was used in 2001.

- A leaflet for TRANSTIME, which appears to be a timing system for sporting activities. The leaflet shows use of the lower trade mark in paragraph 18. It is indicated that this leaflet was used between 1998 and 2001.
- A brochure for Athletics Timing Assemblies. It is indicated that this brochure was used between 1990 and 2001. The trade mark shown is the upper trade mark in paragraph 18, with the difference that the colours are reversed as the background is dark. The registered trade mark appear on the fifth page upon an advertisement board which forms the background in a picture of runners crossing the finish line and on the same page on various cameras. The registered trade mark also appears on diagrams showing a mobile false start station and a central control console.
- There are two pieces of material relating to GALACTICA software. This software is designed for use with scoreboards and allows images to be displayed as well as textual data. It is indicated that the material comes from 2000 to 2001 and 1996 to 2001. The trade mark used is the lower trade mark of paragraph 18 or the trade mark display above in this paragraph. In one leaflet the registered trade mark is shown in the reproduction of an image from a computer screen showing a timer.
- A leaflet for Xenon Matrix score/display boards. It is indicated that this was used between 1996 and 2000. The trade mark shown is the lower trade mark in paragraph 18.
- A leaflet for a false start monitoring system. It is indicated that this was used in 2000 and 2001. The trade mark used is in the form of that displayed in this paragraph above.
- A leaflet giving the history of Omega Electronics in three languages. It is indicated that was used in 2000 and 2001. It refers to various of the products which have already been considered in this summary. The trade mark does not appear in any shape or form. There is a partial picture of a swimming pool in

which can be seen O and at a little distance to its left the partially obscured letters, the letters that can be seen are OM.

- A leaflet for the Olympic Games in Sydney in 2000. The trade mark appears as above in this paragraph. The pictures of the equipment shown show use of the trade mark SWATCH. The equipment referred to is that which has already been noted.
- A leaflet showing a giant mobile video screen in Milan. It is indicated that it was used in 2000 and 2001. The trade mark is in the form of the lower trade mark in paragraph 18.
- A POWERTIME leaflet. It is indicated that this was used between 1997 and 2001. It relates to sports timing equipment. The trade mark is in the form of the lower trade mark in paragraph 18.
- A leaflet about timing systems for sporting activities. It is indicated that it was used in 2000 and 2001. The trade mark shown is in the format of that shown above in this paragraph.
- A leaflet entitled “Match Time”. It is indicated that was used between 1996 and 2001. The goods are timing apparatus and display boards for team games such as water polo and basketball. The trade mark is in the form of the lower trade mark in paragraph 18.
- A leaflet relating to systems for timekeeping and scoring for swimming, diving, synchronised swimming and water polo. It is indicated that this was used between 1997 and 2000. The trade mark is in the form of the lower trade mark in paragraph 18.
- A leaflet showing a giant screen and clock in Stade Charlety in Paris. The trade mark is in the form of the lower trade mark in paragraph 18.
- A booklet entitled OGM 5005. It is indicated that this was used between 1990 and 2001. The OGM 5005 is an electronic timer-printer which operates in real time. It has different modules for different sports and different purposes in sports. The trade mark is in the form of the lower trade mark in paragraph 18.
- A booklet entitled “Time and Sport Story”. It is indicated that it was used between 1990 and 2001. It deals with the history and development of sporting chronometry and photo-finish technology. The trade mark is in the form of the lower trade mark in paragraph 18.

US's evidence

First witness statement of David John Crouch

25) Mr Crouch is a trade mark attorney at Bromhead & Co. Mr Crouch exhibits an agreement from 1994 between Swiss and US.

26) From the recitals to the 1994 Agreement it seems that a worldwide Agreement resulted specifically from proceedings entered into or threatened in Hong Kong and Germany. It contains provisions (paragraphs 1 to 3 and 5 to 7) which set out amendments to US's and Swiss's specifications designed to resolve the disputes in those countries. Sandwiched between the market specific provisions is paragraph 4, this sets out the basis for a worldwide settlement. It reads as follows:

"4. Henceforth from the signing of this Agreement and effective in all countries of the World:-

a. OMEGA ENGINEERING INCORPORATED undertakes not to use, register or apply to register any trademark consisting of or containing the word OMEGA or the Greek letter O or any mark containing elements colourably resembling either of those two elements in respect of computer controlled measuring, timing and display apparatus, unless intended for science or industry.

b. OMEGA SA undertakes not to use, register or apply to register any trademark consisting of or containing the word OMEGA or the Greek letter O or any element colourably resembling either of those two elements, in respect of "Apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow".

c. OMEGA SA will not object to the use or registration by OMEGA ENGINEERING INCORPORATED of any trademark consisting of or containing the word OMEGA or the Greek letter O or any element colourably resembling either of those two elements in respect of apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow."

Second witness statement of David John Crouch

27) Mr Crouch exhibits a witness statement by Mr Peter W Peterson.

Witness statement of Peter W Peterson

28) Mr Peterson is an attorney-at-law in the United States of America. He states that in proceedings between US and Swiss in the United States of America he conducted a pre-

trial discovery deposition of Christiane Sauser Rupp, on 27 June 2001. Ms Sauser Rupp appeared as a witness for Swiss under rule 30(b)(6) of the US Federal Rules of Civil Procedure. Mr Peterson states that her testimony was the testimony of Swiss rather than testimony of her personal knowledge. Mr Peterson exhibits pages 1 to 13 and 54 to 61 from the transcript of Ms Sauser Rupp's testimony, the transcript runs to some 213 pages.

29) A good part of the exhibit is background about Ms Sauser Rupp and the relationship between Swiss and the Swatch Group. In Ms Sauser Rupp's deposition she comments on goods sold under the OMEGA trade mark by Swiss. She states Swiss sells watches under the name OMEGA and the Greek letter O. She also states that some gift items have been sold under OMEGA such as earrings, necklaces and rings. She also comments that some leather goods have been sold under the trade mark OMEGA, also umbrellas, cups and equipment relating to golf as Swiss sponsors golf tournaments. She also advises that chocolate is sold under OMEGA. Ms Sauser Rupp states that these goods are mainly for the promotion of OMEGA watches. Ms Sauser Rupp states that Swiss sells mainly wristwatches under OMEGA. She states that Swiss no longer sells pocket watches.

30) Ms Sauser Rupp states that only Omega Electronics would be licensed to sell timers under OMEGA but that at the time of her deposition they were not so doing. She states:

“They have some timing devices which can well include a timer, but not independent timer, a simple device like that.”

Ms Sauser Rupp states that repair of OMEGA goods is conducted under the trade mark OMEGA.

31) Ms Sauser Rupp is asked about the products of Omega Electronics. She states that they sell all types of products relating to the timing of sports events. Also they sell passenger information displays and big displays screens for stadiums and other premises. She states that one of these displays is in a restaurant in the United Kingdom. Ms Sauser Rupp states that a radio frequency identification system has also been developed. She advises that radio frequency identification systems will be used for access control. Ms Sauser Rupp states that various sporting timing devices and systems are sold and “camera or photo finish camera”. She states that in her time with the Swatch Group no timing devices have been sold under the OMEGA trade mark for science or industry.

Further evidence of Swiss

Witness statement of Christiane Sauser Rupp

32) Ms Sauser Rupp is legal counsel at the legal department of The Swatch Group Limited. She states that the legal department of The Swatch Group is responsible for legal matters concerning Swiss.

33) Ms Sauser Rupp confirms that she was deposed as per the evidence of Mr Peterson. She states that the proceedings concerned an action brought in July 2000 by Swiss against

US, Omega Press Inc and Omega Scientific Inc for cyber squatting. Ms Sauser Rupp states that she “understands” that the latter two companies are related to US. She states that the action followed the registration by Omega Press Inc and Omega Scientific Inc of the domain names “omegawatch.com” and “omegatime.com”. She states that her comments were made in the context of proceedings in the United States of America rather than in the context of a revocation action in the United Kingdom.

34) Ms Sauser Rupp states that it is clear from her deposition that she is a legal advisor and that she has no direct involvement in the running of Swiss or Omega Electronics SA. She states that although she has a general overview of the activities of each company she does not have extensive first hand knowledge of the range of the products and services or other detailed aspects of their businesses. She states that in page 12 of her deposition, which has been exhibited by Mr Peterson, asked whether she knew of the history of Omega Electronics SA she answered, “No, I don’t know it very well”. At page 13 she was able to confirm that the offices of Omega Electronics SA are in Bienne but she could not confirm the exact address. At page 14 she confirmed that she did not handle any matters for Omega Electronics SA, Ms Sauser Rupp exhibits the relevant page. In pages 166 and 167 of the deposition she stated:

“As I told you, I am not responsible of Omega Electronics and I cannot give you an answer which will be final. I knew that Omega Electronics goes... sells its products through some of our subsidiaries. For example, in England we have Swatch Group, U.K., which has an Omega Electronics Division which sells that kind of products. I know that in some other countries they work with independent distributors.”

35) Ms Sauser Rupp states that on page 57 of her deposition, which has been exhibited by Mr Peterson, there is the following:

“Q. Are you familiar with the products that Omega Electronics sells under the Omega mark?
A. Well, within this particular litigation I spoke with Omega Electronics to have an idea of what their products were.”

36) Ms Sauser Rupp states that while the statements made in her deposition were made in good faith and to the best of her knowledge she does not have a highly detailed knowledge of the products and services of Omega Electronics SA/Omega SA. She states that her comments under deposition cannot fairly be taken to comprise an exhaustive list of the products and services of these companies. She states that an omission that now occurs to her is that Swiss sells clocks, although she knows that it does. Ms Sauser Rupp exhibits copies of invoices relating to the sales of clocks in the United Kingdom by Swiss. The invoices are all from Swiss to SMH (UK) Limited. The items recorded upon them are variously described as constellation clocks, double face golf clocks and golf clocks. The invoices emanate from 1996 and 1997.

37) Ms Sauser Rupp states that owing to his experience Mr Stierli has a much more detailed overview of the activities of Swiss than she could have.

38) Ms Sauser Rupp states that she does not see what the relevance of the 1994 agreement, exhibited by Mr Crouch, is in the context of this case.

Further evidence of US

Further witness statement of David John Crouch

39) Mr Crouch exhibits a further witness statement by Mr Peter W Peterson.

Further witness statement of Peter W Peterson

40) Mr Peterson states that he represented US in litigation against Swiss. He states that one case involved an action brought by Swiss against US on 27 September 2000, Civil Action No 3000 CV 1848 JBA. Mr Peterson states that in the course of discovery in this litigation he served Swiss with a notice of deposition of Swiss pursuant to Fed R Civ P 30(b)(6). He exhibits a copy of the notice of deposition. In this case Swiss was the plaintiff. Included in the notice is the following:

“The deposition shall include the following topics:

1. Plaintiff’s Internet web site(s).
2. Plaintiff’s domain names.
3. The 1992 and 1994 Agreements and the negotiations leading to the 1992 and 1994 Agreements.
4. All trademarks owned by plaintiff, in any country, including but not limited to those containing the term OMEGA or the Greek letter O.
5. All products and services sold by plaintiff under any trademark, in any country, consisting of or containing the word OMEGA or the Greek letter O.”

41) Mr Peterson goes on to comment on the nature and effect of depositions made under the Federal Rules of Civil Procedure and in particular the effect of rule 30(b)(6). Mr Peterson states:

“In the latter instance, under Rule 30(b)(6), the organisation named in the deposition notice “shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify... The persons so designated shall testify as to matters known or reasonably available to the organisation.” The answers given by the Rule 30(b)(6) witness are binding on the organisation. “To satisfy Rule 30(b)(6), the corporate deponent has an affirmative duty to make available ‘such number of persons as will’ be able ‘to give complete, knowledge and binding answers’ on its behalf.” *Reilly v. NatWest*

Markets Group, Inc., 181 F. 3d 253, 268 (2d Cir. 1999), *cert. denied*, 120 S.Ct. 940 (2000) (internal citations omitted).”

42) Mr Peterson goes on to comment on the deposition of Ms Sauser Rupp, which has already been referred to by both sides. Mr Peterson states that pages 134-137 were designated by Swiss as being “confidential” under a protective order entered by Judge Arterton.

43) Mr Peterson comments on Ms Sauser Rupp’s position in the proceedings. He comments on the topics listed in the rule 30(b)(6) notice (these are referred to in paragraph 40 above) and that Ms Sauser Rupp was prepared to answer questions on these topics. Mr Peterson comments that the term plaintiff as defined in the notice relates not only to Swiss but also to any parent or affiliate to Swiss, such as Swatch Group and Omega Electronics.

44) Mr Peterson refers to the evidence of Ms Sauser Rupp which I have commented upon above.

45) Mr Peterson states that Swiss’s counsel was given an opportunity to cross-examine Ms Sauser Rupp on the matters raised during Mr Peterson’s questioning. He exhibits the pages of the transcript relating to the cross-examination by Swiss’s counsel of Ms Sauser Rupp and notes that she did not modify any of her answers to the questions about goods sold or licensed by Swiss under the OMEGA trade marks.

DECISION

46) 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.”

47) 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.”

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

49) 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 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.”

Certain of the findings of the Court in the above case relate specifically to the effects of rule 22 of Commission Regulation (EC) No 2868/95 and so do not have a direct bearing on these proceedings. However, paragraph 47 is not about the specific application of rule 22 but about the general basis of showing use.

50) Mr Stierli makes some broad statements in his statement. I need to consider how these are substantiated through exhibits. He gives a list of goods. It is the same list that Mr Colman gives for Swiss in another revocation case which involves the two sides. The accompanying wording to this list does not seem to have been carefully considered. Mr Stierli states that the equipment listed is installed, maintained and repaired by Swiss. However, the list includes such goods as glue, grease, screws and rivets. I am unclear as to how Swiss install, maintain and repair goods such as these. Ms Arenal was unable to enlighten me. The list of goods appears to be for the main part goods which are used in the repair and maintenance of the goods of Swiss; not the goods which are the primary object of the repair and maintenance. Comparing the exhibits to the statement of Mr Stierli, taking into account the general nature of some of his statements which puts them more into the realm of claims, the identical nature of part of his statement and that of Mr Colman and the findings of the Court of First Instance in *Kabushiki Kaisha Fernandes v OHIM*, I consider that the contents of Mr Stierli's statement must be dealt with some circumspection.

51) As has been shown in the summary of the evidence Omega Electronics SA and OE have used the trade mark in a variety of forms in conjunction with the word electronics. I have had some doubts as to whether this use is use of the trade mark as registered or use in a form differing in elements which do not alter the distinctive character of the trade mark. However, Mr Morcom accepted that the trade mark(s) used represents use of the trade mark as registered or use in a form differing in elements which do not alter the distinctive character of the trade mark. Consequently, I will say no more about this issue.

52) A different matter arises in relation to the use for *maintenance and repair of horological and chronometric instruments, jewellery, goods in precious metal or goods coated therewith. Maintenance and repair of horological and chronometric instruments*

has not been attacked by US. However, it is necessary to look at these services as Swiss has argued that use in relation to these services also relates to use in relation to *maintenance and repair of jewellery, goods in precious metal or goods coated therewith*. The exhibits relating to the repair of watches, which is the evidence which goes to *maintenance and repair of horological and chronometric instruments*, show that the service has been carried out by Swatch Group (UK) Limited. The “Worldwide Service Centres Network” booklet advises the customer in the United Kingdom to contact Swatch Group (UK) Limited. The repair invoices are headed Swatch Group (UK) Limited. The only mention of OMEGA is in the description of the product that has been repaired. The repair service has been supplied under the sign of Swatch Group (UK) Limited, not under the trade mark of Swiss. The service has been supplied for Swiss but not by Swiss. The service is clearly identified with Swatch Group (UK) Limited. There is no evidence that the service has been supplied under the trade mark. All the evidence shows that the service has been effected under the name Swatch Group (UK) Limited, there is none that shows it being effected under the trade mark. On this basis if the extrapolation into *maintenance and repair of jewellery, goods in precious metal or goods coated therewith* was justified it would do Swiss no good as there is no evidence of the service being supplied under the trade mark.

53) The evidence furnished all relates to the maintenance and repair of wristwatches, whether that be the watch mechanism, the strap or the case etc. 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.”

How would the customer describe the service? I have little doubt that he/she would describe it as watch repair. Even if the wristwatch was of precious metal or encrusted with diamonds the repair is to the goods, being wristwatches. Swatch Group (UK) Limited repair the watches of Swiss, that is what they do, that is what happens. Swiss could not retain the registration in respect of *maintenance and repair of jewellery, goods in precious metal or goods coated therewith* because of the reasons given in paragraph 52 or this paragraph. Swiss has not furnished “solid and objective evidence of effective and sufficient use of the trade mark on the market concerned” for these services.

54) Swiss has furnished evidence in the form of invoices and contracts for services. In considering the services supplied it is helpful to consider the goods in which Swiss trade also. The maintenance and repair all relate to the goods of Swiss and so the goods

represent the context in which the services are supplied. The goods and the services relating to them can, I believe, be put into two compartments: public information display apparatus and a variety of goods for sporting purposes. The latter goods encompass a wide variety of products including goods for timing, equipment for judges to communicate with and to co-ordinate and show their decisions and photo-finish equipment. From the evidence I have little doubt that Swiss supply, maintain and repair a variety of equipment for measuring, checking and signalling for sports purposes. Such goods as photo-finish equipment and photocells appear to come within the category of *optical apparatus and instruments*. The latter is not the most clear and helpful of phrases, being a child of the class heading of class 9 of the International Classification of Goods and Services. Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

In this case the context is the class heading of class 9 of the International Classification of Goods and Services and I have read the specification on this basis.

55) I have no doubt from the evidence that Swiss supply the service of maintaining and repairing public information display apparatus and instruments. Mr Morcom was of the view that this could cover a variety of goods and should be limited. To me it seems a proper and appropriate description of both the goods of Swiss and the service that it supplies in relation to them. Taking into account the words of Aldous LJ and Neuberger J above, I cannot see how or why the service should be further limited. Ms Arenal conceded that there was no evidence of use of the trade mark in relation to the services relating to weighing. For the other services it seems to me that the evidence shows that Swiss supplies a large amount of equipment which it maintains and repairs, all the equipment being for sporting purposes. I cannot see that it is practical to follow the “red tea caddy” route and try to itemise exactly what goods are maintained and repaired by Swiss. There also I believe must be a certain leeway for maintenance and repair service as the use of the service is greatly dependant on the reliability of the product. The service is not used until there is a requirement for it through product failure or because there is a service cycle. In this case the position of Swiss is strengthened, in my view, because as well as there being evidence relating to product repair there is also evidence of maintenance contracts. The key to its trade, and the service engendered by that trade, is, in my view, the area in which the goods are used. By restricting the services to the sphere of activity I hope that I am not being overly generous but being practical and reflecting the reality of the situation.

56) I turn now to *information services*. Ms Arenal referred to consultation services that Swiss supply and to its maintenance contracts which include information. The various contracts exhibited state that specified back-up services will be provided if applicable. Two of the invoices refer to provision of maintenance and telephone back-up services. There do not appear to be any invoices or contracts relating to consultation and consultation is, anyway, not the same as information services. *Information services* is a somewhat vague term, even when only relating to certain of the services. Is it simply enough for a client of Swiss to telephone it and be given information? If this is the case the world and his wife could claim to be supplying *information services*. Two invoices include telephone back-up for the maintenance contract. I cannot see that this back-up would be anything other than the provision of information or advice. In the context of the services I would consider information and advice as being interchangeable. If *information services* are maintained in the specification they will need to be limited as they are at the moment, to information about the main services that are provided. If the main service is not provided the information cannot be supplied, there is a mutually dependant relationship.

57) I have had some difficulty in reaching a conclusion about the *information services*. There is a limited amount of evidence that such services have been supplied. In the end I have come to the conclusion that taking into account the limited evidence and the mutually dependent relationship with the main services that these services should remain in the specification. I think that if one is supplying maintenance and repair services that one is inevitably going to supply a parallel information service; to advise what to do before, for instance, an engineer comes out or to avoid the need to send an engineer out at all.

58) Consequent on the above I find that the specification of the registration should read as follows:

maintenance and repair of measuring, checking, optical and signalling apparatus and instruments, all the goods being maintained and repaired being for use in sport; maintenance and repair of horological and chronometric instruments and of public information display apparatus and instruments; information services relating to all the aforesaid; all included in Class 37; but not including maintenance and repair of heat and temperature measuring, checking and signalling apparatus and instruments, all for scientific and industrial use

I have amended the order of the specification in order to try and avoid any ambiguities. I have not tampered with the *maintenance and repair of horological and chronometric instruments* as these services were not the subject of the revocation action.

59) Mr Morcom argued that the registration should be revoked from 18 March 1999, five years after its registration. For the sake of convenience I will quote section 46(6) again:

“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.”

The registration has been attacked under section 46(1)(a) and (b). The grounds for revocation state that the registration “has not been used by the Proprietor of the mark for at least five years”. Even though the grounds quote 46(1)(a) I consider that the clear import of this wording is that the trade mark has not been used for five years at the date of the filing of the application for revocation. Taking this into account I believe it is not surprising that Swiss concentrated upon the five year period prior to the filing of the application. I do not consider that it should be penalised for not dealing with the period from the date of registration, 18 March 1994. In such circumstances I cannot be satisfied that the registration should be revoked from a date earlier than the date of the application.

60) US filed a copy of an agreement between it and Swiss and a copy of part of the transcript of the deposition of Ms Sauser Rupp. From the submissions of Mr Morcom it would appear one of the reasons for the filing of this evidence was to put the nature of the business of Swiss into a clear context and to show the limits of that business. In this case I do not think that anything turns upon this evidence. Ms Sauser Rupp’s evidence has to be put into the context of the proceedings in which it was given. These were not non-use proceedings, if they had it is very likely Swiss could have used a different representative(s). It cannot be reasonably expected, in my view, that Ms Sauser Rupp would have an encyclopaedic knowledge of all the goods of Swiss. She had the necessary knowledge for the context of the proceedings, very different proceedings relating to very different issues. I can see nothing in her deposition which should suggest that Swiss have not used the trade mark for the remaining services of the specification.

61) It is my decision, therefore, that the registration should be partially revoked with effect from 14 September 2001. From 14 September 2001 the specification will be limited to:

maintenance and repair of measuring, checking, optical and signalling apparatus and instruments, all the goods being maintained and repaired being for use in sport; maintenance and repair of horological and chronometric instruments and of public information display apparatus and instruments; information services relating to all the aforesaid; all included in Class 37; but not including maintenance and repair of heat and temperature measuring, checking and signalling apparatus and instruments, all for scientific and industrial use

62) Each side has been partly successful in this case. I consider, therefore, that each side should bear its own costs and I make no award of costs.

Dated this 30 day of January 2003

**D.W.Landau
For the Registrar
the Comptroller-General**