

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 699057
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD)**

**AND THE APPLICATION FOR PARTIAL REVOCATION THEREOF
UNDER NO 80072
BY OMEGA ENGINEERING, INC**

TRADE MARKS ACT 1994
In the matter of registration no 699057
of the trade mark:



in the name of Omega SA (Omega AG) (Omega Ltd)
and the application for partial revocation thereof
under no 80072
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 699057 standing in the name of Omega SA (Omega AG) (Omega Ltd) (referred to as Swiss from herein). The trade mark was registered on 12 December 1951. It is currently registered for the following goods:

nautical, surveying, weighing, measuring, signalling, checking (supervision) and life-saving instruments and apparatus; teaching instruments and apparatus (other than material); and calculating machines. CANCELLED IN RESPECT OF "Calculating machines". CANCELLED IN RESPECT OF instruments and apparatus, all for measuring, signalling and checking (supervision) of heat and temperature for scientific and industrial use

The goods are in class 9 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 goods encompassed by the specification with the exception of sports timing equipment. US states that to the extent that the aforesaid goods extend beyond sports timing equipment 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 by it or with its content for all the goods of the registration with the exception of life-saving and weighing instruments and apparatus. Swiss states that the registration should not be revoked except in relation to life-saving and weighing instruments and apparatus. Swiss seeks an award of costs.

4) Both sides filed evidence. 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 Timothy Edwin Colman

5) Mr Colman is the brand director of Omega Electronics (OE) in the United Kingdom. Mr Colman states that OE was established in order to sell electronic and timing equipment under various OMEGA trade marks in the United Kingdom. He states that from the mid 1970s until 1984 OE traded under the name SSIH equipment and was a division of SSIH (UK) Limited. SSIH (UK) Limited was a wholly owned subsidiary of SSIH and later SMH group. Mr Colman states that around 1984 OE's name changed to Omega Electronic Equipment Limited. He states that the company continued to sell sports timing equipment and public display systems bearing OMEGA trade marks. Mr Colman states that around 1988 the name changed again to Omega Electronics Limited and in 1993 it was fully integrated into SMH (UK) Limited as a division. SMH (UK) Limited has since become Swatch Group (UK) Limited. Mr Colman states that the Swatch Group Limited, based in Switzerland, is the parent company of a worldwide group of companies including OE, Swatch Group (UK) Limited and Swiss. He states that OE has remained a division and uses various OMEGA trade marks including the trade mark the subject of this revocation action (the trade mark) with the consent of Swiss as do other companies within the group, including Omega Electronics SA.

6) Mr Colman states that US concedes that Swiss have used that trade mark in relation to sports timing equipment. Nevertheless, for the sake of completeness he exhibits evidence in relation to use of the trade mark upon these goods in the United Kingdom. He exhibits a catalogue. A reference on page 1 states, amongst other things:

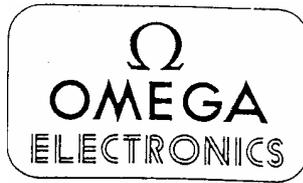
“in sports, with the timekeeping of 21 Olympic games, of the most important international swimming and athletic meets, along with CART (Championship Auto Racing Teams) car racing in the USA, Canada, Australia and Japan;”

A reference on 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.”

The only goods that I can see in the catalogue are wrist watches.

7) Mr Colman exhibits copies of invoices. These invoices are from Omega Electronics SA to Omega Electronics Ltd. They run from July 1996 to November 2000. Until August 1997 the trade mark shown in the invoices is:



After this date the trade mark shown is:



8) The invoices are for the following goods: scoreboards, timing apparatus, software, loudspeakers, start apparatus, touchpads, lane harnesses, cameras, HE supply power systems, engineering work, shot clocks, goal lamp sets, engineering support, lamps for driver boards, power supplies. Mr Colman states that OE purchased the goods from Omega Electronics SA and then sold them within the United Kingdom and, to a lesser extent, to the Republic of Ireland.

9) Mr Colman states that through OE Swiss provide a wide range of equipment which they also install, maintain and repair under the trade mark. He states that this equipment includes the following: touch-pads, anemometers, 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.

10) Mr Colman exhibits copies of invoices from Omega Electronics SA relating to United Kingdom sales and services under the trade mark from 1996 – 2000. Some of these are for services rather than goods. The goods in the invoices are mostly covered by Mr Colman's list in paragraph 16 above. All the invoices are from Omega Electronics

SA in Switzerland to Omega Electronics Ltd in the United Kingdom. Until sometime in 1997 the word OMEGA in combination with the Greek letter O appears in the following format:



Afterwards it appears in the following format:



11) Mr Colman 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 Colman states that one invoice is for public information display systems at Milton Keynes and Watford train stations.

12) Mr Colman states that OE uses the trade mark in the United Kingdom with the consent of Swiss. He states that OE buys goods branded with the trade mark from Omega Electronics SA and then sells them on to customers in the United Kingdom such as councils, sports centres, construction companies, schools, British Telecommunications PLC, pharmaceutical and other companies. Mr Colman exhibits further invoices for the period 1996 to 2000. Certain of the invoices are for services rather than goods. The goods and services 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:



13) Mr Colman states that he exhibits copies of catalogues, newsletters and publicity material distributed in the United Kingdom between 1996 and 2001. 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 10 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.

14) Other material includes the following:

- from 1999 to 2001. The use of O and the word OMEGA is in the form shown in the lower trade mark in paragraph 10.
- 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 10. 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 10, 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 10 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 10.

- 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 10.
- 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 10.
- 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 10.
- 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 10.
- 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 10.
- 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 10.

- 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 10.

15) Mr Colman states that the turnover for the goods of the registration sold under the trade mark has been greater than the following for the years 1997 – 2001 (years ending on 31 December).

1997	£600,000
1998	£700,000
1999	£800,000
2000	£800,000
2001	£1,000,000

Mr Colman does not give any indication as to how this is distributed in relation to the goods of the registration.

US’s evidence

First witness statement of David John Crouch

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

17) 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 Swiss’s and US’s specifications designed to resolve the disputes in those countries. Sandwiched between the market specific provisions is paragraph 4, which 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

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

Witness statement of Peter W Peterson

19) 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.

20) 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 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.

21) 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.

22) 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. They also 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

23) 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.

24) 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.

25) 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 it 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.”

26) 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.”

27) 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.

28) Ms Sauser Rupp states that owing to his experience Mr Colman has a much more detailed overview of the activities of OE in the United Kingdom than she could have.

29) 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 Peter W Peterson

30) 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.”

31) 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).”

32) 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.

33) 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 30 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.

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

35) 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

36) 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.”

37) 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.”

38) 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.

39) 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.

40) Mr Colman 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 Stierli 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. A good number of the goods listed are not encompassed by the specification, are not even in the class eg glue and grease. Mr Colman, and Mr Stierli, seem to have thrown the kitchen sink – complete with two day’s washing up – into the proceedings. The list that Mr Colman gives appears to relate more to all the goods that Swiss use in the production of their products rather than goods which bear the trade mark and/or are encompassed by the specification. There may well be grease and screws in the products of Swiss. This does not mean that its trade mark is used in relation to them in any meaningful sense. Mr Colman’s use of the list shows that he considers that Swiss can claim use for every part of its products. He needs to substantiate his claim with exhibited evidence. Certain of the goods he lists, which do fall within class 9, would be best classified as parts and

fittings eg cell and reflector mounts. Swiss's specification does not include parts and fittings. Mr Colman states that Swiss produce slats bearing the trade mark for fixing prominently "in to this kind of equipment". I find it difficult to envisage how such slats are fixed to screws, grease, glue, isolater studs, bulbs and washers etc. Anyway all the goods just mentioned, with the exception of isolater studs, do not seem appropriate to the class or the specification; along with other goods. The use of slats would appear to imply use on the finished exterior product, not every washer, nut and bolt of the product. Taking these factors into account I consider that Mr Colman's statement needs to be viewed with some circumspection. The onus is upon Swiss to show use by solid and objective evidence. Consequently, I consider that I must consider the statement of Mr Colman in conjunction with the exhibited evidence and draw my conclusions from that.

41) 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 represent 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.

42) Ms Arenal claimed that use had been shown for nautical apparatus and instruments. This appeared to be on the basis that there is a picture of a sail with the trade mark upon it, there is a picture of a clock or timer at Cowes with the trade mark upon it and certain of the wristwatches are for use in water or at sea. None of the goods actually fall within the class anyway. A boat is in class 12 and a sail in class 22; besides this the use would appear to be promotional or "t-shirt" use. It is not possible to tell if the picture from Cowes is of a clock or a timer. Whether one or the other it hardly matters, neither could be described as nautical apparatus and instruments. A watch is a watch; whether for use at sea it falls in class 14. Consequently, use upon a wristwatch is not use in relation to the class 9 goods of the registration. I consider that Ms Arenal was somewhat optimistic in her claims in relation to nautical apparatus and instruments. I can find no evidence of use of the trade mark in relation to such goods.

43) 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."

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 considering the meaning of the specification and how the goods upon which the trade mark has been used should be described I bear in mind the comments of Aldous LJ and Neuberger J. I will consider the specification on the basis of the normal meaning of the words within the context that the wording is derived from the class heading of the International Classification of Goods and Services. In considering how to describe the goods upon which the trade mark has been used I will consider how the normal consumer would be likely to describe such goods, in my opinion.

44) Swiss might have sold goods to schools, or a school, this does not make the goods *teaching instruments and apparatus (other than material)*; schools buy a large amount of goods. Just because they buy goods they are clearly not turned into *teaching instruments and apparatus (other than material)*. I can find no concrete evidence to support a claim that the trade mark has been used in relation to *teaching instruments and apparatus (other than material)*.

45) English Dictionary (5th Ed 2000) defined surveying as:

“n. 1. the study or practice of measuring altitudes, angles, and distances on the land surface so that they can be accurately plotted on a map. 2. the setting out on the ground of the positions of proposed construction or engineering works.”

There is not a shred of evidence that Swiss have used the trade mark in relation to goods which would fall within the parameters of the above description of surveying.

46) The evidence of Swiss showed use of the trade mark in relation to public information display apparatus. However, I cannot see how such goods are encompassed by the specification of the registration. Ms Arenal argued that *signalling instruments and apparatus* would encompass such goods as they receive a signal. Just because a product receives a signal it does not make it a piece of signalling apparatus. Televisions and radios receive signals, it would not be normal to describe them as signalling apparatus. I need to consider both the terms in question within the parameters set by Aldous LJ and Neuberger J, in a normal fashion within the context. Ms Arenal seems to me to be torturing and twisting the meaning of both terms. I do not consider that the specification

of the registration encompasses public display apparatus. It is certainly not decisive to my finding but I think worthy of note that the goods shown in the literature would not appear to be the sorts of things that would have even existed in 1951, when the application was made.

47) With the exception of public information display apparatus all the goods for which use has been shown are for use in sport. Ms Arenal clung to the claim that certain of the equipment is for *checking*. However, the *checking* is qualified, it is *checking (supervision)*. I find it a stretch of the imagination to describe the various apparatus for which use has been shown as *checking instruments and apparatus*. The elastic can stretch no further and must snap when it is put in the context of supervision. It is difficult to see how supervision is taking place within the context of goods for use in sport in general and in relation to the goods of Swiss in particular. I find nothing, applying the Aldous LJ and Neuberger J criteria, that could lead me to accept that Swiss has shown use of its trade mark in relation to *checking (supervision)*.

48) Mr Morcom submitted that the specification should be limited to “sports timing equipment; but excluding any such goods for scientific and industrial use”. I consider this too restrictive. Swiss has, I believe, shown use of the trade mark in relation to goods that measure other things than time eg distance. It has also shown use in relation to equipment that can be used for signalling ie equipment for judges to communicate with each other. I have no doubt that Swiss have supplied a wide range of equipment for sporting use in a wide variety of sports.

49) I cannot see that it is practical to follow the “red tea caddy” route and try to itemise all the goods in relation to which the trade mark has been used. By limiting the goods to all being for use in sport I will be setting the goods within a clear parameter which does not leave the terms *measuring and signalling instruments and apparatus* as being too broad within the context of the evidence of use shown.

50) The existing specification includes two cancellations. I consider it necessary to incorporate the effect of these into the revised specification. The effect of a revocation cannot be to include goods that were previously excluded. I consider that the registration should be revoked to the extent that the specification will read:

measuring and signalling apparatus and instruments, all for use in sport; but not including calculating machines nor instruments and apparatus for measuring, signalling and checking (supervision) of heat and temperature for scientific and industrial use

51) It could be argued that the second part of the exclusion clause could be removed as it is effectively redundant in relation to the new specification. However, there is a “history” between the two sides and the exclusion would appear to be as a result of that “history”. Although technically the exclusion should be removed I do not propose so to do. It does no harm in its presence but could do harm in its absence in relation to the conflicts between the two sides.

52) 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 would 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.

53) Mr Morcom argued that the registration should be revoked from 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. I believe it 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, 12 December 1951. It would also seem rather unrealistic to expect a proprietor to have records from over fifty years before. In such circumstances I cannot be satisfied that the registration should be revoked from a date earlier than the date of the application.

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

measuring and signalling apparatus and instruments, all for use in sport; but not including calculating machines nor instruments and apparatus for measuring, signalling and checking (supervision) of heat and temperature for scientific and industrial use

with effect from 14 September 2001.

55) To a major extent US have been successful in this case and so is entitled to a contribution towards its costs. This is one of four revocation actions between the parties. US have filed the same evidence in each of the proceedings. Part of the evidence of Swiss is also very similar in each of the proceedings. I take this repetition of evidence into account in deciding the award of costs. I order Omega SA (Omega AG) (Omega Ltd) to pay Omega Engineering, Inc the sum of £1600. 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 30 day January 2003

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