

O/1042/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS


IN THE MATTER OF APPLICATION NOS. 505039 AND 505041

TO REVOKE ON THE GROUNDS OF NON-USE
REGISTRATION NO. UK00801255609 AND
INTERNATIONAL REGISTRATON NO.
771474 FOR THE MARKS:



IN CLASSES 9 & 14

AND



IN CLASS 14

OWNED BY
OMEGA SA (OMEGA AG) (OMEGA LTD.)

BACKGROUND AND PLEADINGS

1. These proceedings concern the following trade marks that are owned by Omega SA (Omega AG) (Omega Ltd.) (“the proprietor”):



Registration no. UK00801255609¹

Filing date 21 April 2015; registration date 12 May 2016

Registered for the following goods:

Class 9: Spectacles, sunglasses, magnifying glasses; frames and chains for spectacles and sunglasses; higher spectacles incorporating greater functionality (smart glasses) and connected spectacles; cases for spectacles, sunglasses and magnifying glasses; batteries, cells, chargers, adapters.

Class 14: Timepieces and chronometric instruments as well as parts and accessories for the aforesaid goods, watch chains, presentation cases for timepieces, cases for timepieces; smart watches with extended functionality and connected watches as well as parts and accessories for the aforesaid goods.

(“the proprietor’s first mark”)



International Registration no. 771474

International registration date 24 September 2001; date of protection of the international registration in the UK 21 June 2002

¹ The proprietor’s first mark is a comparable trade mark based on a pre-existing International Registration that designates the EU (being IR no 01255609). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IRs designating the EU.

Priority date 1 May 2001

Registered for the following goods:

Class 14: Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes; jewelry, precious stones; horological and chronometric instruments.

("the proprietor's second mark")

2. On 27 June 2022, Samsung Electronics Co., Ltd. ("the applicant") applied to partially revoke both of the proprietor's marks. The applicant seeks the revocation of the proprietor's class 14 goods save for "analogue watches". The class 9 goods in the proprietor's first mark are not subject to the revocation application and will, regardless of the outcome of this decision, remain registered with effect from the original registration date for the mark. Both applications were brought in reliance upon sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 ("the Act").
3. Beginning with the application aimed at the proprietor's first mark, the period during which the applicant alleges non-use under section 46(1)(a) is the five years after registration of the mark, being 13 May 2016 to 12 May 2021 with revocation sought from 13 May 2021. Under its section 46(1)(b) ground, the applicant is alleging non-use of the mark for the period of 27 June 2017 to 26 June 2022, with revocation sought from 27 June 2022, being the date of the application at issue.
4. As for the application aimed at the proprietor's second mark, the period during which the applicant alleges non-use under section 46(1)(a) is the five years after the date of protection of the mark in the UK, being 22 June 2002 to 21 June 2007 with revocation sought from 22 June 2007. Under its section 46(1)(b) ground, the applicant is alleging non-use of the mark for the period of 27 June 2017 to 26 June 2022, with revocation sought from 27 June 2022, being the date of the application at issue.
5. The proprietor filed counterstatements wherein it defended all of the goods subject to the applications.

6. Both parties filed evidence in chief with the proprietor also filing written submissions alongside its evidence. A hearing took place before me on 31 July 2023, by video conference. The proprietor was represented by Mr Daniel Selmi of 3 New Square, acting upon the instruction of Dentons, being the proprietor's legal representatives. The applicant was represented by Mr David Stone of Allen & Overy, who have represented the applicant throughout these proceedings.
7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

8. The proprietor's evidence in chief came in the form of the joint witness statement of Ms Mireille Koenig and Mr Antoine Haller dated 5 December 2022. Ms Koenig is the Chief Legal Officer at The Swatch Group Ltd ("the Swatch Group"), a position she has held since 2016. Mr Haller is the Head of Trademarks and Designs at the Swatch Group, a position he has held since 2021. Prior to taking this role, Mr Haller was an Anti-counterfeiting Officer at the Swatch Group. Their statement is accompanied by 53 exhibits, being MKAH1 to MKAH53. The evidence explains that both Ms Koenig and Mr Haller are authorised signatories of the proprietor and confirms that the proprietor belongs to the Swatch Group. A list of the companies within what is referred to as the Swatch Group is provided in the evidence, of which the proprietor is one.²
9. I note that the proprietor's evidence consists of exhibits in a foreign language. Translations of the same are included in the evidence and, in support of the

² MKAH1

accuracy of the same, witness statements (all of which are dated 6 December 2022) have been provided by Mr Jacob Cutler, Ms Teresa Adelson and Mr Robert Downs. All of these individuals are translators at Transperfect Legal Solutions and their evidence relates to translations to English from Italian, Polish and Spanish, respectively. I do not intend to summarise each statement but note that they confirm (1) what parts of Ms Koenig and Mr Haller's evidence has been translated and (2) the witnesses' belief that the translations are accurate.

10. The applicant's evidence came in the form of the witness statement of Mr David Stone dated 1 March 2023. As set out above, Mr Stone is the applicant's legal representative and is, therefore, duly authorised to give evidence on the applicant's behalf. Mr Stone's statement is accompanied by nine exhibits, being DAS1 to DAS9.

11. Given the voluminous nature of the evidence filed, I do not consider it appropriate or necessary to summarise the entirety of the evidence throughout the course of my decision. I will, however, summarise it to the extent that I consider it necessary to do so at the relevant parts of my decision. For the avoidance of doubt, I confirm that I have taken all of the evidence and submissions into account.

PRELIMINARY ISSUES

12. Throughout these proceedings and at the hearing, the parties made a number of arguments and submissions that I consider necessary to discuss as preliminary issues to my decision.

High Court proceedings and the related revocation proceedings

13. Throughout these proceedings, there has been reference by both parties to proceedings in the High Court of England and Wales between the applicant and several companies within the Swatch Group (the proprietor being one of them).³ The outcome of the High Court proceedings was the granting of an injunction in

³ *Montres Breguet SA & Ors v Samsung Electronics Co. Ltd* [2022] EWHC 1127 (Ch)

favour of the Swatch Group.⁴ The applicant claims that during those proceedings, the Swatch Group confirmed that it had not used its marks for 'smartwatches' and that it became apparent that there was no use for other goods contained in the specifications of other marks owned by companies within the Swatch Group. As a result, the applicant claims that the injunction is based on the overly broad specifications of the Swatch Group's marks, for which there is no use. Consequently, the applicant now seeks the present revocation actions against the proprietor's marks. In addition to these proceedings, there are 12 other revocation actions brought by the applicant against 18 different trade marks owned by various companies within the Swatch Group.

14. On the point of the High Court proceedings, I note that there has also been mention of the judgment of Falk J wherein she stated at paragraph 175 that:⁵

“Marks such as those associated with Omega, Longines, Tissot and Swatch are very well-known. Their reputation is obvious. [...] Further, I would observe that the developers of apps using identical or similar signs to the marks clearly intended to imitate or at least to pay homage to the relevant marks, including exclusive marks such as Jaquet Droz. That rather demonstrates the existence of a reputation.”

15. While I accept that it may very well be the case that the proprietor and other companies within the Swatch Group enjoy a reputation, this is not at issue here. Further, it does not follow that because Falk J found there to be a reputation in the marks at issue before her then I must reach a similar conclusion here, i.e. that there has been genuine use of the marks at issue in the UK. Instead, my decision is based on an assessment of the evidence before me whilst taking into account the relevant case law and legislation. Falk J's determination regarding a reputation is not relevant to this decision and I will say no more about it.

⁴ The judgment of the High Court is presently subject to an appeal due to be heard on 5 and 6 December 2023

⁵ A copy of the full judgment is exhibited at DAS3

Relevant periods

16. As set out above, there are two sets of relevant periods for each of the revocation applications. The earlier periods are the ones relevant to the 46(1)(a) grounds with the latter periods being relevant to the 46(1)(b) grounds. In its counterstatements, the proprietor clarified that it only sought to rely on use insofar as it covers the latter relevant periods. As such, the proprietor's evidence only focused on the later relevant periods. The basis for this was set out at the hearing by Mr Selmi wherein he confirmed that the proprietor relies on the provisions set out at section 46(3) of the Act which set out that:

“46 (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.”

17. So long as I am satisfied as to use and provided that said use commenced or resumed prior to the period of three months before the application dates of the present proceedings, I agree with the proprietor's position in that the earlier relevant periods are of no real consequence to the genuine use assessment I must make. That being said, it follows that if there is no use in respect of the latter relevant periods, the proprietor's failure to file any evidence in relation to the earlier relevant periods means that the revocations will take effect from the earliest sought revocation dates. So while I will make no reference to the earlier periods in my assessments below, they may still have effect on these proceedings.⁶ For ease of

⁶ On this point, I note that revocation of the undefended goods in the Class 9 mark will take effect from the earlier date.

reference going forward, I will only refer to the one relevant period for each revocation application, being 27 June 2017 to 26 June 2022 for both marks.

The proprietor's evidence

18. Prior to the hearing, the applicant filed a skeleton argument that contained detailed and extensive criticisms of the proprietor's evidence. Having reviewed and considered the issues raised by the applicant, I note that the majority of them relate to criticisms of the evidence insofar as they fail to demonstrate genuine use. While Mr Stone did not seek to raise all of these issues at the hearing, Mr Selmi set out that it was not appropriate for the applicant to raise these issues at such a late stage in the proceedings (being the skeleton argument stage) without formally challenging the evidence. While this point is noted, it is not necessary that the applicant raises such issues in evidence or request to cross-examine witnesses. On the contrary, it is common in proceedings before the Tribunal for an opposing party to raise issues with the sufficiency of the other side's evidence at the hearing stage or via written submissions in lieu. Further, I remind myself that the onus is on the party bearing the burden of proving use to file its best case as evidence in chief. Having said that, I do appreciate that where the party challenging the evidence appears to have avoided criticising the accuracy or sufficiency of it during the written procedure, only to unveil an extensive attack on its accuracy and sufficiency after the evidence rounds have closed, there is potential for unfairness. In the present case, I appreciate that the applicant's critique of the proprietor's evidence is extensive and was not unveiled until mere days before the hearing. However, in respect of the former point, I remind myself that the evidence filed in these proceedings was voluminous and spread over 53 exhibits. In such circumstances, it is not unsurprising that any criticisms of the same would also be extensive. In respect of the latter point, I note Mr Selmi's issues with the applicant's approach but note that he did not seek to make an application to allow for the proprietor to file evidence in response to the criticisms made. While I will say no more about this issue, I wish to point out, for the avoidance of doubt, that while I will give consideration to the applicant's criticisms, the conclusions I will reach in this decision will be based on my own assessment of the evidence before me.

19. Having said all of the above, I am of the view that there are two issues that I wish to directly address. The first relates to the applicant's claim that the proprietor's witnesses are not persons properly qualified to know the nature of the use of the marks. This is on the basis that they are members of the proprietor's legal team rather than the business itself. This issue is noted but I agree with Mr Selmi on this point in that it is not appropriate for the applicant to only seek to raise the issue at such a late stage in these proceedings. If the applicant wished to take issue with this point then it should have mentioned it in its evidence, thereby potentially prompting evidence in reply whereby the proprietor's witnesses could directly address the point. Without a direct challenge, I see no reason why I should disbelieve the proprietor's evidence simply because it came from employees in the Swatch Group's legal and trademarks teams. On this point, I note that evidence filed on behalf of companies is commonly given by persons of the same or similar employment status and such evidence is routinely accepted into proceedings before the Tribunal without issue.

20. The second issue raised relates to the evidence at large being discredited by the false statement by Ms Koenig and Mr Haller that "it is clear from the above that Omega has made genuine use of its Marks for the goods on their specifications during the period in question."⁷ The applicant argues that this statement is 'obviously incredible'⁸ as the evidence clearly does not demonstrate use for everything. While this argument is noted, I do not agree. Even if it is not the case that the evidence shows genuine use for *all* goods in the proprietor's specification, the claim that it has is not sufficient to discredit the accuracy of the proprietor's evidence as a whole.⁹ Without any direct challenge to the evidence, I consider it reasonable to proceed on the basis that, if use is not shown for all goods, it may simply have been the case that Ms Koenig and Mr Haller believed that it had. This

⁷ See paragraph 25 of the witness statement of Ms Koenig and Mr Haller

⁸ In making this point, Mr Stone referred to the wording used in the case of *Pan World Brands Ltd v Tripp Ltd* [2008] RPC 2.

⁹ On this point, I refer to paragraph 44 of DRYSHOD (Case BL O/243/19) wherein Mr Phillip Johnson, sitting as the Appointed Person, set out that it was plainly wrong in law to suggest that just because some part of a witness's evidence are inaccurate, other parts should not be accepted.

is not, in my view, an intentionally misleading statement that prompts me to question the truthfulness of the statement as a whole.

New Limitation proposals

21. As set out above, the applicant's pleaded case in respect of the marks is that it be limited to just 'analogue watches'. During these proceedings, the applicant provided an alternative position, being a claim that the marks only survive in respect of 'watches other than smartwatches'. This issue first came to the Tribunal's attention via written correspondence from the applicant on 29 March 2023 and the proprietor's subsequent response on 6 April 2023. The proprietor sought to oppose the alternative argument being raised at such a late stage in these proceedings on the basis that it had not been specifically pleaded. After further correspondence between the parties, the Tribunal confirmed via email on 4 July 2023, that in revocation proceedings it is open for the Hearing Officer to reframe a trade mark specification by reference to the evidence filed and that it did not follow that if the application were to succeed, the specification could only be limited to that of the applicant's pleaded case. Instead, the Tribunal confirmed that the Hearing Officer may reach alternative conclusions based on the evidence filed and the issue as to whether such an amended specification should make reference to the exclusion of 'smartwatches' or not is something that the parties were free to make submissions on.

22. I note that in its skeleton argument prior to the hearing and also via oral submissions from Mr Stone at the hearing, the applicant sought to introduce a further alternative specification, being "watches other than smartwatches and connected watches". While Mr Selmi did not further the proprietor's opposition to the introduction of these alternative specifications at the hearing, he did raise the issue in his skeleton argument. As confirmed in the Tribunal's response discussed above, it is open to me during the course of this decision to determine a fair specification of the goods at issue in light of both the evidence before me and the relevant case law (cited in full below). As such, I am of the view that the applicant is entitled to raise the alternative arguments in respect of a fair specification.

23. So long as I am satisfied that the evidence and case law support such a finding, it may be that I conclude on a fair specification in line with one of the applicant's submitted specifications. Alternatively, I may conclude in line with the proprietor's position (that the proprietor maintains its class 14 specification in full) or conclude with finding an alternative term that I deem to constitute a fair specification (again, so long as the evidence and case law support such a finding).

DECISION

24. Section 46 of the Act states:

"46. - (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) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 in 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) [...]

(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 existing at an earlier date, that date”.

25. Given that the proprietor’s first mark is a comparable mark, paragraph 8 of part 1, schedule 2A is relevant. It reads:

“8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

26. Section 100 is also relevant, which reads:

“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.”

27. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and

simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

28. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”¹⁰ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark”¹¹ is not, therefore, genuine use.

29. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13 (“*Plymouth Life*”), wherein Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly

¹⁰ *Jumpman*, Case BL O/222/16

¹¹ *Ibid.*

demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

[...]

28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

30. In addition, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

31. The proprietor’s first mark is a comparable mark based on an earlier IR designating the EU. This means that use of that mark in the EU prior to (and including) IP Completion Day (being 31 December 2020) is relevant to the present assessment.¹² By virtue of being a Member State prior to this date, the UK still forms part of the relevant territory of the EU. From 1 January 2021 onwards, however, the relevant territory is the UK only. In relation to the period during which

¹² See paragraph 4 of Tribunal Practice Notice 2/2020

use in the EU is relevant, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

32. As for the proprietor’s second mark, this is an international registration that has designated the UK for protection. As such, the relevant territory for this mark is the UK only.

33. In respect of the framing of a fair specification, I remind myself of the case of *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, wherein Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

34. Further, I note the case of *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular

goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

35. Before proceeding to consider the relevant assessment, I wish to discuss the volume of the proprietor’s evidence. By my count, the proprietor’s evidence in chief (excluding the translated evidence and cover pages for the exhibits) is 272 pages in length. While this falls within the guidelines of the Tribunal, being 300 pages for evidence in chief as set out in Tribunal Practice Notice 1/2015 (“the TPN”), I note that there is a significant amount of evidence wherein several pages of documents are laid out on one page. While not an exhaustive list of examples where this practice has taken place, I refer to Exhibit MKAH24 which is made up of just seven pages but contains 25 pages worth of social media posts, Exhibits MKAH32 to MKAH34 which are all presented as just one page each but are clearly multiple pages from websites condensed onto one page elongated page¹³ and Exhibit MKAH35 which consists of 36 invoices over 16 pages and is followed by print-outs from 26 webpages displayed over 4 pages. The evidence has been filed in such a way that it is clearly an attempt at circumventing the TPN without having to seek directions permitting the filing of evidence in excess. I note that this issue was not picked up by the Tribunal upon the filing of the evidence. Given its status as admissible evidence before the Tribunal, it is incumbent upon me to consider the

¹³ I note that these pages, when printed into the hearing bundle, were illegible so it is only possible to view them in an electronic format.

evidence in full so I must, therefore, consider the evidence as filed. That being said, I do wish to express that this approach is inappropriate in proceedings before the Tribunal and will be considered further when it comes to making an assessment as to costs.

36. During these proceedings, the parties made various submissions in respect of the evidential burden and the case law that is relevant to the assessment of proof of use. The applicant's argument boiled the position down to being a three step test in that I must first examine the evidence relied on, then I must consider what does that evidence prove, as a whole, before making a determination as to what a fair specification is based on the use shown. The proprietor's argument in response was that this was a 'divide and conquer' approach which did not take a wholistic view of the evidence. While I agree that I must take the evidence as a whole, this does not mean that just because it is voluminous and detailed that it is satisfactory in showing genuine use for all goods at issue. On this point I agree with the applicant in that if there are individual issues with different items of evidence that renders that specific evidence of little or no assistance, then that must affect the overall evidential picture. While I am entitled to make inferences based on the evidence before me, the sheer volume of evidence coupled with the fact that the proprietor is a large company does not simply mean that I must make every inference in favour of the proprietor. Put simply, if I am not satisfied that such an inference is reasonable to make then I will not make it. On this point, I remind myself of the comments of Mr Daniel Alexander Q.C. in *Plymouth Life* (cited above and also referred to by the applicant at the hearing) that I will be justified in rejecting evidence if it is insufficiently solid. I do not consider this a necessarily controversial approach and I will proceed to assess genuine use in the way outlined in the case law.

37. In determining the issue of genuine use, I consider it appropriate to undertake a detailed assessment of the evidence in respect of the goods at issue separately and, at the same time (so long as use is proven), make a determination as to the fair specification of those goods. That being said, where I consider it appropriate

to do so, I will seek to group any relevant goods together. I will deal with the marks at issue in turn.

The proprietor's first mark

38. The construction of the proprietor's first mark's specification is such that its class 14 list of goods only consists of two terms, namely "timepieces and chronometric instruments as well as parts and accessories for the aforesaid goods, watch chains, presentation cases for timepieces, cases for timepieces" and "smart watches with extended functionality and connected watches as well as parts and accessories for the aforesaid goods". Despite the proprietor's use of commas (as opposed to semi-colons, being the punctuation used to denote separate terms) in its first term, it is clearly intended to cover a range of separate goods. As such, I will assess these separate goods individually.

39. I note that in the proprietor's skeleton argument, it worded the specification of this mark as follows:

"Timepieces and chronometric instruments as well as parts and accessories for the aforesaid goods, watch chains, presentation cases for timepieces, cases for timepieces [...] as well as parts and accessories for the aforesaid goods."

This is an inaccurate representation of how the specification is actually presented. I accept that parts and accessories covers 'timepieces and chronometric instruments', however, I do not accept that it covers 'watch chains, presentation cases for timepieces or cases for timepieces'. If it were the case that "parts and accessories for the aforesaid goods" formed its own separate term that fell at the end of the specification then it could be said to apply to all of those terms that came before it, however, it does not. Further, I note that the wording of the second term also includes 'parts and accessories' but as this is included in an entirely separate term that specifically relates to 'smart watches with extended functionality and connected watches', it cannot be said to apply to goods in a preceding term. If it was the proprietor's intention to have 'parts and accessories' relating to all goods

in its specification then it should have separated it from the other terms by use of a semi-colon.

*Timepieces and chronometric instruments*¹⁴

40. In considering the evidence before me, I have no hesitation in finding that the proprietor has genuinely used its first mark for goods that fall within the above term in the UK during the relevant period.¹⁵ While the evidence on this point is extensive and I see no reason to go over it in full detail, I note that, as an example, the proprietor has provided sample invoices that show the sales of £21,979,186.09 worth of watches between 2018 and 2022.¹⁶ The evidence sets out that these sales figures cover just a sample of the total sales by the proprietor. Regardless, I consider that the sale of over £21 million worth of watches during the relevant period to be sufficient. In addition, the proprietor also enjoyed a presence throughout the relevant period across various print publications such as the Economist, GQ and Time Magazine, all of which are shown in evidence to have significant circulation figures.¹⁷ Further, the applicant, in limiting its claim to revocation of all goods bar analogue watches, clearly accepts such use for some type of watch.

45. While I appreciate that watches are a type of timepiece and chronometric instrument, I am of the view that these terms are broader than just watches and can include any other good that can be used to indicate the time. As such, the only type of good for which the proprietor has shown use that can be said to fall within the above term are watches. On this point, the proprietor submitted that there are a number of authorities that provide support for the full specification being maintained despite use only being shown for one category of goods. These authorities include the *Euro Gida* and *Titanic Spa* cases (both of which are cited above). In addition, the proprietor made reference to the case of *Guccio Gucci SPA*

¹⁴ I appreciate that the term, as registered, includes “as well as parts and accessories for the aforesaid goods.” However, for ease of reference, I will address the parts and accessories as separate goods below.

¹⁵ I will consider the parts and accessories element of this term further below.

¹⁶ See paragraph 6 of the witness statement of Ms Koenig and Mr Haller

¹⁷ See, for example, paragraph 12 of the witness statement of Ms Koenig and Mr Haller and Exhibit MKAH21

(Case BL O/424/14) and a Tribunal decision, being *IWATCH* (Case BL O/307/16), wherein the Hearing Officer determined that the use of watches and the parts and fittings of the same was sufficient to grant a fair specification for the broader term which, in that case, was “horological and chronometric apparatus and instruments”. In response, the applicant referred to the case of *Roger Maier and Another v ASOS*¹⁸ in support of the argument that where terms are sufficiently broad and have identifiable sub-categories within them that are capable of being viewed independently, then use in relation to only one or more of those sub-categories does not constitute use of the mark in relation to all the other sub-categories.

41. Because I consider that it is of no relevance, I will discuss the proprietor’s reference to the *IWATCH* decision first. At paragraph 39 of that decision, the Hearing Officer confirmed that the use of “horological and chronometric apparatus and instruments” was not contested by the applicant and, further, he set out that nothing turned on this issue. Therefore, I fail to see how it is relevant to the assessment I must now make. Conversely, I note that there is an additional UK IPO decision before me (as submitted by the applicant) wherein a different Hearing Officer found that use of watches alone was such that a specification of ‘horological and chronometric instruments’ was unsustainable and, in that case, the term was limited to ‘watches’.¹⁹ While these decisions are noted, neither of them are binding upon me and I will say no more about them.

42. Moving to the actual application of the aforementioned case law, I note that the wording of the test set out in *Euro Gida* was that it must be based on ‘the perceptions of the average consumer’. As for *Titanic Spa*, I note that at paragraph 47(iv), Mr Justice Carr looked at how an average consumer would fairly describe goods²⁰ in relation to which the trade mark has been used. Further, the latter case explains that use in relation to one sub-category will not constitute use in relation to all other sub-categories of goods. Similarly, I note that, as per paragraph 65 of *ASOS*, a specification is not to be cut down to precise goods for which the mark

¹⁸ [2015] EWCA Civ 220

¹⁹ *HAMILTON & INCHES*, Case BL O/090/17

²⁰ While services are specifically referred to in the *Titanic Spa* case, the question applies equally to goods, as is the case here.

has been used if the average consumer considers that the goods used form their own sub-categories. In such a scenario, the mark must be limited accordingly. Lastly, the *Guccio Gucci* case sets out that the real question is not whether a narrow specification would suffice, but whether the wide specification is justifiable and makes more sense. The answer to this question is, as set out by Mr Alexander Q.C., dependent upon (to some degree) the nature of the wider specification.

43. For the most part, the wording of the tests set out in the case law discussed above confirm that the assessment of a fair specification is, in essence, focused on the perception of the average consumer. In considering that position, I am not convinced that average consumers would, upon viewing a range of watches (regardless of if they were digital, automatic or analogue), seek to use the broader term of *timepieces and chronometric instruments*. Instead, the average consumer is likely to be satisfied that the term ‘watches’ (being all that the use covers) forms its own sub-category of goods and use that term to describe the use put forward by the proprietor. As a result (and to borrow the wording used in the *Guccio Gucci* case), I am not convinced that this broader specification is justifiable and neither does it make more sense in light of the use made of it. As such, I conclude that the proprietor should not be permitted to retain the full term.

44. In light of the above, the issue now before me is what specification is appropriate. The applicant’s case is that the specification should be limited to either “analogue watches” or “watches other than connected watches or smartwatches”. During the hearing, Mr Selmi set out that the average consumer would not categorise the goods in such an artificial way. In respect of the term ‘analogue watches’, I agree with Mr Selmi and I see no reason why the average consumer would, upon being confronted with a series of watches, seek to describe them using the precise type of watch that they are. Even if it were the case that an undertaking only sold analogue watches (or digital ones, for that matter), I see no reason why the average consumer would look to make such a distinction in their description of the same. As a result, I reject the applicant’s pleaded case that these goods should be limited to ‘analogue watches’.

45. In considering the alternative argument that the specification should be limited to ‘watches other than connected watches and smartwatches’, I make a similar finding to that reached above. Put simply, I see no reason why the average consumer would look to articulate specific exclusions when considering the use made of the goods by the proprietor. In considering this point, I remind myself that the applicant argued that the present situation can be likened to goods such as ‘alcoholic beverages, except beers’ in class 33 on the basis that it is a term that explicitly excludes goods from another class (beers are natural to class 32).²¹ While this is noted, the average consumer is unlikely to get into such a level of granularity when describing what goods the proprietor sells and I agree with Mr Selmi’s argument that such a term is artificial. As a result, I reject the applicant’s alternative case that these goods should be limited to ‘watches other than connected watches and smartwatches’.

46. I consider that the most appropriate conclusion in the circumstances is that the term be limited to “watches”. This is on the basis that when confronted with the use before me, the average consumer would simply refer to it as covering “watches”. Further, I consider that this term is a suitable sub-category of goods and is sufficiently broad enough so as to offer appropriate protection to the proprietor. Further, it is not too limiting that it can be said to strip the proprietor of any fair protection associated with the use made of the mark.

47. In respect of the fair specification point, I note that submissions were put before me regarding the effect of the Nice Classification. At the hearing, Mr Selmi made reference to the case of *Pathway*²² wherein Carr J held, at paragraph 79 of his judgment, albeit obiter, that the Nice Classification would be relevant to revocation if the term were unclear or imprecise. In the present case, the arguments of the applicant are noted, however, as set out above, the assessment I must make is based on the perception of the average consumer. Put simply, I find that the average consumer would view “watches” as being a term that is sufficiently clear

²¹ Additional references to other goods were mentioned but, for illustrative purposes, I have only mentioned one example.

²² *Pathway IP SARL v Easygroup Ltd* [2018] EWHC 3608 (Ch)

and precise in describing the goods at issue. As a result, I see no reason why the Nice Classification would be relevant and I find that the addition of an exclusion regarding 'connected watches' and 'smartwatches' would not assist in adding clarity. I consider that the exclusion of such in a class 14 specification serves no purpose (they are naturally excluded by virtue of being class 9 goods, in any event) and would not be something that average consumers would refer to in their description of the goods shown in evidence.

Parts and accessories for the aforesaid goods (being parts and accessories for timepieces and chronometric instruments).

48. I turn now to consider parts and accessories of timepieces and chronometric instruments. In my view, parts and accessories are different types of goods and I will, therefore, conduct an assessment in respect of them separately. I will consider 'parts' first.

Parts.

49. The proprietor claims that it sells component parts for its watches including watch movements and that it offers its customers a number of authorised service centres in the UK which, amongst other things, perform repairs and replace broken watch parts. The evidence in support of this claim is by way of a number of invoices provided by the proprietor that it claims to show sales of watch parts. The first set of invoices are UK invoices that show a total of £5,321.54 worth of watch parts.²³ There is also a set of invoices that relate to sales in Spain.²⁴ In addition, a breakdown of the Spanish invoices is provided that shows total sales figures of €51,854.40 for 2017 to 2020.²⁵ Lastly, the proprietor has confirmed that it has 26 services centres (seven being Omega boutiques and the others being third party companies) in London alone (with many more across the UK).²⁶

²³ MKAH35

²⁴ MKAH36

²⁵ MKAH37

²⁶ MKAH38

50. The applicant has raised a number of criticisms with this evidence and claims that where the invoices cover internal shipments to other companies within the Swatch Group, they are to be treated as internal invoices and, as per the case of *Ansul* (cited above), should be disregarded. While the recipients of the goods on the invoices are Swatch Group companies, I am satisfied that they are parts of the distribution arm of the group and constitute distribution invoices. Therefore, I consider that they should be treated in the ordinary way, i.e. as if they were shipped to third party retailers. In such circumstances, it is ordinary for distribution invoices to be used to support a claim of use. Therefore, I consider it reasonable to infer from the invoices that they were meant for onward sale to consumers in that country and I have nothing before me to suggest that these goods were not eventually sold on to consumers.

51. While I appreciate that the figures in relation to watch parts are not particularly high, I remind myself that use does not have to be quantitatively significant for it to be deemed genuine. I also appreciate that the watch parts may be provided as part of a repair service, however, I consider that this still covers the actual provision of goods. It is my view that when a customer requires that a part of his/her watch be replaced, the provision and installation of that replacement part, regardless of whether that good is seen or not (in the event it is an internal part), still constitutes the use of those goods and their provision to the end consumer. So taking the evidence as a whole into account and bearing in mind the size of the proprietor's business in respect of watches at large, I am satisfied to find that the proprietor has made genuine use of parts for watches during the relevant period. While the term covers parts for timepiece and chronometric instruments, the only evidence before me in respect of these goods relates to *parts for watches* and not for any other type of good.

Accessories.

52. As far as I understand it, accessories for timepieces and chronometric instruments is a broad term that can cover goods such as cases, straps, stands, winders, repair kits and cleaning kits. While there is evidence relating to watch cases, this is very

limited and, as I will come to discuss further below, this is of no assistance to the proprietor's case. Having considered the evidence before me, I can only find 74 sales of goods that can be said to be watch straps.²⁷ The narrative evidence regarding the invoices sets out that they are example invoices that are part of a larger collection of invoices. In addition to these invoices, there is evidence before me in relation to what is described as a bracelet in invoices.²⁸ However, I note that these bracelets are not those that are affixed to watches but, instead, are jewellery bracelets (more on this below). These goods cannot, therefore, be considered watch accessories and are, therefore, of no assistance to the present issue.

53. I have my own criticisms of the proprietor's evidential approach to the goods at issue in these proceedings in that, in order for me to find use, a number of inferences are required. It appears to me that the proprietor's position is that because it is a large company, any sales associated with goods it sells must be sufficient to prove genuine use. While I do not consider that such an inference is reasonable in any and all instances, I am more receptive to it when the goods can be said to be those associated with watches. This is on the basis that, as I have found above, the proprietor is a large watch producer. So while the evidence in relation to watch straps is lacking, I consider that it is reasonable to infer that the sales associated with these goods is likely to be sufficient to demonstrate genuine use of the same. In making this finding, I have also borne in mind the general cost of the watches before me in evidence (some retail in excess of £6,490 and some even sell for as high as £14,970).²⁹ In light of the higher cost for the proprietor's watches, I consider it reasonable to infer that the frequency with which customers would require replacement watch straps would be lower and at a more significant cost than those for more every day watches. As a result, I consider that any sales associated with such goods would naturally be lower and I do not consider that this necessarily means that the proprietor has not genuinely sought to create or maintain a market share in such goods. Further, for a watch in this price category,

²⁷ See MKAH35, page 5 of MKAH45 and MKAH46

²⁸ MKAH42

²⁹ See, for example, pages 1 and 3 of Exhibit MKAH49

it is reasonable to conclude that the customer would return to the producer to purchase an authentic watch strap.

54. Taking all of the above into account, I consider a fair specification for the term “timepieces and chronometric instruments as well as parts and accessories for the aforesaid goods” to be “watches; parts and straps for the aforesaid goods”

Watch chains.

55. At the hearing, Mr Selmi set out that the proprietor construed watch chains as being watch straps. In doing so, Mr Selmi took me to evidence of watch straps. I do not consider that this is the correct approach. A watch strap is not a watch chain or vice versa. While there is evidence relating to watch straps, there is nothing before me that can be said to cover watch chains. As such, there is no evidence of genuine use for the above goods.

Presentation cases for timepieces, cases for timepieces.

56. I note that it was put forward at the hearing that ‘case for timepieces’ can be interpreted to cover the external casing/shell of the timepiece itself. For the avoidance of doubt, I do not consider that this is the case and, instead, the term will be viewed as being a case for storage of a watch.

57. The proprietor claims that it has used its first mark on the above goods because not only does it sell them individually but because “watches themselves have also been, and continue to be, sold as both the watch and watch box.”³⁰ Undated example photos of the watch boxes as displayed on the proprietor’s website are provided in evidence.³¹ There are also print-outs from various publications from across the EU from within the relevant period that show images of boxes branded with the proprietor’s first mark.³² These are noted but there is nothing within this

³⁰ Paragraph 16 of the witness statement of Ms Koenig and Mr Haller

³¹ MKAH29

³² MKAH31

evidence showing the boxes/cases on their own or without reference to the watches sold within them. In respect of this point, the proprietor argues that the sale of a watch covers the sale of a watch box also as it comes in a box so it is, therefore, sufficient to demonstrate use for the above goods. At the hearing, Mr Stone opposed this position and stated that, as an analogy, the sale of a cake that comes in a box is not an effort to create or maintain a market share for boxes. Instead, it is simply the sale of a cake and does not constitute use of boxes. I agree with Mr Stone's position on this issue and find that while it may be true that a watch sold under the proprietor's first mark includes a box or case, this is not genuine use in relation to those goods. Such a claim is, in my view, unsustainable.

58. In respect of the claim to have actually sold watch cases, I note that this is very limited and stems from invoice evidence that shows just 69 watch boxes between 2020 and 2022.³³ The narrative evidence confirms that these invoices are from the Swatch Group (UK) Limited and are to third party corporate customers in the UK. The applicant has criticised this evidence in that there is nothing to suggest that these cases were sold to customers as just cases and, instead, argued that it was probable that the cases were provided to retailers who would provide them to customers when that customer purchased an Omega watch from them. Therefore, the applicant argues, as it did above, that this does not constitute an attempt to create or maintain a share in the UK market for the above goods. On this point, and having considered the evidence myself, I am minded to agree with the criticisms raised by the applicant. Put simply, the evidence before me in respect of these goods is insufficiently solid so as to enable me to find that these goods were actually sold as individual items to end customers in the UK. Instead, I find that the evidence the evidence shows nothing more than the fact that these goods were shipped to third party retailers and does not enable me to make any finding as to whether these were sold as goods in their own right or whether they were just used as part of the packaging. Alternatively, it is possible that the cases may have also been used as display cases at the retailers' stores.³⁴ I am, therefore, of the view

³³ MKAH30

³⁴ See, for example, the second print-out that is included on page one of MKAH31, which shows a larger box that presents five of the proprietor's 2020 Olympic Games collection watches. There is nothing before me to suggest

that the evidence does not demonstrate a genuine attempt to create or preserve a market share for the above goods in the relevant territory during the relevant period. As a result, I find that no genuine use has been provided for the above goods.

*Smart watches with extended functionality and connected watches as well as parts and accessories for the aforesaid goods.*³⁵

59. In seeking to defend the above goods, the proprietor submits that some Omega watches have advanced functionalities. While I note that reference to 'some', only one was raised at the hearing (and I see no further 'advanced' watches in the evidence), being the 'Omega Speedmaster X-33 Skywalker' watch. In reference to the functions of this watch, the proprietor has filed a print-out of an article dated 8 October 2019 that is taken from 'Hodinkee',³⁶ being what the proprietor refers to as a specialist watch website. The article discusses the functions of the watch and these include features such as the watch having an LCD display and an extremely loud alarm. Further, this watch has been used in manned space flight by the European Space Agency and is currently (seemingly as at the date of the article) aboard the International Space Station. I note that the watch also has a high precision quartz movement, a low power mode and displays both a local time zone and another time zone. It also features a pre-programmed calendar, a chronograph, a countdown timer, a Mission Elapsed Time function and a Phase Elapsed Time function. These features are all noted but I fail to see how any of them qualify the watch as a smartwatch. It is my view that the additional functions discussed are all fairly standard for a watch. For example, the alarm may be extremely loud but I do not consider this to be a 'smart' function. The same applies for the low power mode, the additional time zone function, calendar, timer and

that this box was ever sold individually to consumers and, instead, I consider it reasonable to conclude that it is a display box for use in retail stores.

³⁵ At the hearing, it was explained that this term is translated from the originally filed French wording and the accurate translation of the first part of the term should read "watches with extended functionalities (smart watches)". However, it was submitted that this did not make any material difference.

³⁶ MKAH26

additional time functions.³⁷ Further, I appreciate that this watch may be used by astronauts and pilots, however, that does not mean that it is a smartwatch.

60. I reiterate my point above wherein I mentioned that the proprietor claims that ‘some’ of its watches have advanced functionalities. However, as also stated above, there is nothing that points me to which watches it is referring to. As a result, the only assessment I can make in respect of the present goods is on the basis ‘Speedmaster X-33 Skywalker’ watch. I have found that this is not a smartwatch and neither can it be said to be a connected watch. While I do appreciate that it has some extended functionality, the construction of the present term is that it be a ‘smart watch with extended functionality’ and not a *watch with extended functionality*. By not being a smartwatch, it cannot be said to fall within this term. As a result, I find that any use of this watch by the proprietor cannot satisfy use of goods under the above term. Therefore, I find that the proprietor’s claim to have genuinely used the above goods must fail.

The proprietor’s second mark

Horological and chronometric instruments.

61. Following the same reasoning as discussed at paragraphs 43 to 50 above in relation to the term “timepieces and chronometric instruments as well as parts and accessories for the aforesaid goods” in the proprietor’s first mark, I find that the same outcome applies here, namely that the above term should be limited to “watches”.

Jewelry.

62. The proprietor’s evidence sets out that it sells jewellery for men and women under both marks (but is only relevant to the second mark as its first mark is not protected for such goods). The proprietor sets out that these goods are marketed as ‘fine jewellery’ as well as accessories such as bracelets, rings and cufflinks. In respect

³⁷ On the latter point, I note that the narrative evidence, at paragraph 14, simply states that these functions simply allow the user to count elapsed times and while these may be used for flight. They are not smart functionalities.

of sales of these goods, I note that the evidence includes invoices that the witnesses state to be sample invoices of various OMEGA jewellery goods sold to UK customers.³⁸ The invoices are dated between 2018 and 2021 and the narrative evidence states that they make up a total wholesale of £58,497.82. As these are wholesale figures, it is not possible to determine the actual level of turnover to consumers. However, I have calculated the amount of sales that can be attributed to these invoices and (taking into account that some invoices are duplicated) I note that they cover approximately 335 items during the relevant period. After each set of invoice, the proprietor has provided print-outs from its website and those of third party retailers that seemingly show the goods covered by the preceding invoices. I note that a number of these goods include the proprietor's second mark but some do not. While these print-outs are undated, I have no reason to believe that they do not cover those goods sold via the invoices.

63. In addition to the invoice evidence discussed above, the proprietor has provided an excerpt from its 2018 fine jewellery collection catalogue that it states has been 'sold' over 300 times in the UK.³⁹ The catalogue shows products such as rings, necklaces, pendants, cufflinks and a watch. While the jewellery items shown do not obviously show the proprietor's second mark, the catalogue itself is branded as such.⁴⁰ It is not stated what type of catalogue this is, be it a retailer's catalogue or one aimed at consumers. It appears to me that, upon review, the catalogue is one aimed at end consumers. Even so, the fact that it was only distributed over 300 times is not particularly indicative of widespread use of the catalogue. In addition to the catalogue, images from the proprietor's website dated 15 March 2022 are provided and this shows a range of OMEGA branded rings, necklaces, earrings, pendants, bracelets and charms.⁴¹ These images cover a large number of items of jewellery, and while it is clear that some of them (such as the rings and cufflinks, for example) show the proprietor's second mark, it is not clear that all of them do. Lastly, there are a number of images showing three cufflinks, one ring and a

³⁸ MKAH41 to MKAH46

³⁹ MKAH39

⁴⁰ On this point, I note that the proprietor's first mark is shown which includes a representation of the proprietor's second mark and as per the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, such use would be acceptable as use of the second mark as part of a composite mark.

⁴¹ MKAH40

necklace.⁴² While the ring and the cufflinks show the proprietor's second mark, the necklace does not. These print-outs are undated but the narrative evidence confirms that the photographs are from within the relevant period.

64. Before moving to assess the level of sales associated with the goods at issue, I consider it necessary to discuss the proprietor's use of its second mark on such goods. As set out above, a number of the goods do not show the proprietor's second mark. On this point, I note that the narrative evidence of Ms Koenig and Mr Haller confirms that the jewellery items are sold under 'the OMEGA marks'.⁴³ While it may not be readily apparent from the images that all of the goods themselves are branded as such, I have no reason to disbelieve the proprietor's evidence that they are indeed sold under the mark at issue.

65. I have no evidence or submissions regarding the size of the market but I am of the view that it is likely to be an enormous market with an annual turnover in excess of billions of pounds. Clearly, when compared to such a market, the sales figures are low. Having said that, I remind myself that use does not need to be quantitatively significant for it to be deemed genuine. While the sales figures are relatively low and the wholesale invoices do not assist as to pointing to actual turnover, I note that the evidence before me is that the jewellery goods sold by the proprietor range from rings that cost £150 to bracelets that cost £2,780. Further, I note that the cufflinks range from £230 to £1,320, the majority of rings shown retail for prices in the region of £1,000 and the earrings range from £340 to £2,240.⁴⁴ For the most part, the proprietor's goods are reasonably expensive and I consider it reasonable to infer that the totality of sales for goods at such costs assists in painting a stronger picture in respect of the existence of genuine use. Taking the evidence as a whole, I am of the view that this constitutes a genuine attempt by the proprietor to use its mark on "jewellery". Given that the use covers cufflinks, earrings, necklaces, pendants, rings and bracelets, I am satisfied that the average consumer would not

⁴² MKAH41

⁴³ See paragraph 20 of the witness statement of Ms Koenig and Mr Haller

⁴⁴ On this point, I note that the earring prices are shown in the undated print-outs following the invoices but, as above, I have no reason to disbelieve that this is reflected of the price during the relevant period or, at least somewhere in the region of the same.

look to individually categorise the use but would, instead, describe it as covering “jewellery”. As a result, I conclude that the proprietor is entitled to retain the present term.

Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes.

66. The proprietor claims that an Omega-affiliated company has developed its own exclusive, proprietary precious metal alloy and that such use is use of precious metal goods. While this is noted, the evidence sets out that these metals are used under their own trade marks, being SEDNA, MOONSHINE and CANOPUS GOLD. These are not, therefore, metals that are sold under the proprietor’s second mark. While the proprietor may sell goods that incorporate these metals, the metals themselves are not actually sold under the proprietor’s second mark and I fail to see how use of the same could constitute genuine use of the proprietor’s second mark. This argument is, therefore, disregarded.

67. An additional argument put forward by the proprietor is that it produces and sells timepieces and fine jewellery in precious metals, their alloys or coated therewith. I am of the view that such an argument may only sustain a claim that the proprietor has used its second mark for ‘goods made of these materials or coated therewith not included in other classes’. I appreciate that the evidence demonstrates that the proprietor’s watches and jewellery goods in precious metals and their alloys.⁴⁵ However, I remind myself that I have found use for both “watches” and “jewellery” and I am of the view that in retaining these goods, the proprietor is permitted to use them in precious metals and their alloys (or coated therewith). Given that these are the only goods for which I have found use, I am of the view that the above term would be limited accordingly, i.e. “watches and jewellery made of precious metals, their alloys or coated therewith”. In my view, retaining such a term does not add anything beyond the protection afforded by the aforementioned terms. Therefore,

⁴⁵ See, for example, MKAH40 in respect of jewellery and MKAH48 in respect of watches.

I do not consider it necessary to permit the retention of the above term in the proprietor's second mark.

Precious stones.

68. I appreciate that the proprietor sells goods that incorporate precious stones.⁴⁶ However, the above term does not cover goods made of or incorporating precious stones but, instead, covers the actual precious stones themselves. As the applicant put forward at the hearing, there is no evidence to suggest that the proprietor operates in the diamond trade, for example. As such, there is nothing before me to suggest that the proprietor has used its mark on the sale of precious stones and, without such, I am not willing to find that it has made a genuine attempt to create or preserve a market share in the same. Therefore, I find that no evidence of genuine use has been provided for "precious stones".

CONCLUSION

69. The outcome of this decision is that both marks are to be partially revoked for the following goods:

The proprietor's first mark

Class 14: Timepieces and chronometric instruments as well as parts and accessories for the aforesaid goods, watch chains, presentation cases for timepieces, cases for timepieces; smart watches with extended functionality and connected watches as well as parts and accessories for the aforesaid goods.

⁴⁶ See, for example, MKAH48, which shows watches that incorporate diamonds.

The proprietor's second mark

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; precious stones; horological and chronometric instruments.

70. The marks may, however, remain registered for the goods that I have determined as being reflective of a fair specification and those goods that were not subject to the present application. Those goods are as follows:

The proprietor's first mark

Class 9: Spectacles, sunglasses, magnifying glasses; frames and chains for spectacles and sunglasses; higher spectacles incorporating greater functionality (smart glasses) and connected spectacles; cases for spectacles, sunglasses and magnifying glasses; batteries, cells, chargers, adapters.

Class 14: Watches; parts and straps for the aforesaid goods.

The proprietor's second mark

Class 14: Watches; jewellery.

71. As I have set out above, the proprietor did not seek to file any evidence in respect of the earlier relevant periods in respect of the 46(1)(a) grounds. Instead, it chose to rely on the provision set out in section 46(3) of the Act. This means that where the marks are to be revoked, they are to be done so from the earliest dates sought. Therefore, the revoked goods under the proprietor's first mark have an effective revocation date of 13 May 2021 and those under the proprietor's second mark have an effective revocation date of 22 July 2007.

COSTS

72. In the parties' skeleton arguments, they indicated their intention to claim costs off the scale. As I have mentioned above, these proceedings are connected to a series of 13 different revocation applications between the parties. At the first hearing of the connected proceedings, it was decided that the issue of costs was not to be addressed at any of the connected hearings. Instead, the parties requested that the issue of costs be dealt with at the conclusion of all matters. I agreed with this proposal.

73. In discussing the issue of costs at that hearing, it was mentioned that the parties wished to file additional documents in support of their claim for off-scale costs. So while I make no decision on costs at this stage, I do hereby direct the parties to file any written submissions and additional documentation in support of their costs claim within 28 days from the date of issue of this decision. Upon the receipt of these submissions and additional documents, I will list one hearing to deal with the costs for all of these connected matters.

APPEAL PERIOD

74. For the avoidance of doubt, I wish to point out that the appeal period relating to this decision will not begin to run until I have issued my supplementary decision on costs.

Dated this 6th day of November 2023

A COOPER
For the Registrar