

O/1043/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS.
505038, 505040 AND 505043

TO REVOKE ON THE GROUNDS OF NON-USE
REGISTRATION NOS. UK00801256550, UK00002552141
AND UK00900225698 FOR THE MARKS:

TISSOT

IN CLASSES 9, 14, 18, 25, 28, 35 & 41

AND

TISSOT NAVIGATOR

AND

TISSOT

IN CLASS 14

OWNED BY
TISSOT SA

BACKGROUND AND PLEADINGS

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

TISSOT

Registration no. 801256550¹

Filing date 29 January 2015; registration date 1 June 2016

Registered for the following goods in classes 9 and 14:²

Class 9: Apparatus for recording, transmission and reproduction of sound or images; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus enabling the playing of compressed sound files (mp3); calculating machines and data processing equipment, computer hardware for data processing, computer programs, computer software, software for mobile phones, tablets and other electronic mobile devices; firmware, software packages; downloadable image files; downloadable music files; downloadable text files; downloadable computer data files; games for mobile telephones, for computers and for digital personal stereos; electronic game software for mobile telephones, for computers and for digital personal stereos; computers, portable computers, handheld computers, personal computers, mobile computers, wrist computers, tablet computers and mobile devices and computer, personal digital assistants, electronic organizers, personal digital assistants, digital personal stereos, mobile telephones and new-generation mobile telephones incorporating extended functions

¹ The TISSOT and figurative marks are comparable trade marks based on a pre-existing EUTM (being EUTM no. 01256550) or a pre-existing International Registration that designates the EU (being IR no 0225698), respectively. 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.

² This mark is registered for additional goods and services in classes 18, 25, 28, 35 and 41. These are not reproduced here as they are not subject to the present revocation. However they are, for the sake of completeness, included in the **Annex** to this decision.

(smartphones); portable electronic devices for wireless data reception and/or transmission; apparatus and instruments for telecommunication and communication, mobile telecommunication systems; electronic apparatus for accessing the Internet and sending, receiving, recording and storing of short messages, electronic messages, telephone calls, faxes, video-conferences, images, sound, music, text and other digital data; electronic apparatus for wireless receiving, storing and transmitting of data or messages; electronic apparatus for global positioning [GPS] and displaying maps and transport information; electronic devices for detecting, monitoring, storing, surveillance and transmitting data relating to the user activity, namely position, itinerary, distance traveled, heart rate; portable digital electronic apparatus and software related thereto; altimeters; barometers; pedometers; distance measuring apparatus; distance recording apparatus; card reading/writing systems, bar code readers; electronic key holders; electronic pens [visual units]; electronic translators; downloadable electronic publications; magnetic identification bracelets; clock radios; time recording apparatus; time clocks [time recording devices] electronic apparatus incorporating a time display; revolution counters, goal counters, countdown devices, starting counters; electronic display boards, display screens; bags, cases and covers for telephones, computers and other portable and mobile electronic devices; optical apparatus and instruments, particularly spectacles, sunglasses, magnifying glasses; cases for spectacles, magnifying glasses and sunglasses; power supplies, namely batteries and cells for electronic apparatus and computers, batteries and cells for timepieces and chronometric instruments, apparatus for converting electronic radiation to electrical energy, namely photovoltaic solar modules, systems and components and all related system components.

Class 14: Precious metals and their alloys and goods made of these materials or coated therewith included in this class; jewelry, jewelry boxes, cases, precious stones; timepieces and chronometric instruments, presentation cases for timepieces, cases for timepieces.

("the TISSOT mark");

TISSOT NAVIGATOR

Registration no. 2552141

Filing date 5 July 2010; registration date 31 December 2010

Registered for the following goods:

Class 14: Horological and chronometric instruments.

("the NAVIGATOR mark"); and

TISSOT

Registration no. 900225698

Filing date 15 April 1996; registration date 12 November 1998

Registered for the following goods:

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith; jewellery, precious stones, horological and chronometric instruments, cases for watches [presentation], watches, parts of watches, watch movements.

("the figurative mark")

2. On 27 June 2022, Samsung Electronics Co., Ltd. ("the applicant") applied to partially revoke all of the proprietor's marks. The applicant seeks the revocation of all of the class 9 goods in the TISSOT mark and the partial revocation against the class 14 goods of all of the proprietor's marks, save for "analogue watches". All three applications were brought in reliance upon sections 46(1)(a) and 46(1)(b) of

the Trade Marks Act 1994 (“the Act”). I will discuss the effective revocation dates for the separate proceedings below.

3. Beginning with the application aimed at the TISSOT 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 2 June 2016 to 1 June 2021 with revocation sought from 2 June 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 NAVIGATOR 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 1 January 2011 to 31 December 2016 with revocation sought from 1 January 2017. 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. Lastly, for the application aimed at the figurative 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 November 1998 to 12 November 2003 with revocation sought from 13 November 2003. 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.
6. The proprietor filed counterstatements wherein it defended all of the goods subject to the applications.³
7. Both parties filed evidence in chief with the proprietor also filing written submissions alongside its evidence. A hearing took place before me on 1 August 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.

³ It is noted that, prior to the hearing, the proprietor’s skeleton argument struck through a wide range of the class 9 goods in respect of the TISSOT mark and confirmed that they were no longer being defended.

The applicant was represented by Mr David Stone of Allen & Overy, who have represented the applicant throughout these proceedings.

8. 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

9. The proprietor's evidence in chief came in the form of the joint witness statement of Ms Mireille Koenig and Mr Antoine Haller dated 6 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 54 exhibits, being MKAH1 to MKAH54. 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.⁴

10. I note that the proprietor's evidence consists of evidence in a foreign language. Translations of the same have been provided. In support of the accuracy of these translations, witness statements (all of which are dated 6 December 2022) have been provided by Mr Matthew Schneider, Mr Craig Thomas Smith and Mr Matthew Reselli. All of these individuals are translators at Transperfect Legal Solutions and their evidence relates to translations to English from German, French and Italian, respectively. I do not intend to summarise each statement but note that they

⁴ MKAH1

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.

11. The applicant's evidence came in the form of the witness statement of Mr David Stone dated 22 February 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 twelve exhibits, being DAS1 to DAS9.

12. 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.

13. For the avoidance of doubt, I confirm that I have taken all of the evidence and submissions into account.

PRELIMINARY ISSUES

14. 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

15. 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).⁵ The outcome of the High Court proceedings was the granting of an injunction in favour of the Swatch Group.⁶ The applicant claims that during those proceedings, the Swatch Group confirmed that it had not used its marks for 'smartwatches' and

⁵ *Montres Breguet SA & Ors v Samsung Electronics Co. Ltd* [2022] EWHC 1127 (Ch)

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

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 action against the proprietor's marks. In addition to these proceedings, there are 12 other revocation actions brought by the applicant against 17 different trade marks owned by various companies within the Swatch Group.

16. During the hearing, the parties took me to the transcript of the cross-examination of Mr Sylvain Dolla, being the Chief Executive Officer of the proprietor and a Member of the Extended Group Management Board for the Swatch Group. The applicant sought to point out that, during the cross-examination of Mr Dolla in the High Court, he confirmed that the proprietor and the Swatch Group generally made a decision not to enter the smartwatch market and that the Swatch Group had never sold a smartwatch. Further, Mr Dolla confirmed that the Swatch Group decided to keep away from the smartwatch market as it is understood as a commodity.⁷ I note that in the present case (unlike the 12 others), Mr Dolla is an employee of the proprietor. He is also a member of the Extended Group Management Board so the applicant's position is that his comments can be taken to apply to all members of the Swatch Group. While that may be the case, I do not consider that the comments of Mr Dolla in the High Court, despite being under oath, are relevant to the assessment I must make at present. While they are noted, my present assessment is based on the evidence before me and if that evidence is satisfactory in demonstrating use of a smartwatch, then that is sufficient to warrant a finding of genuine use of the same. If not, then no such protection will be granted. Mr Dolla's comments, therefore, have no effect on the assessment before me and I will say no more about them.

⁷ A copy of the transcript of the cross-examination of Mr Dolla is exhibited at DAS5

Reputation of the proprietor as found by Falk J in the High Court proceedings

17. Throughout these proceedings, there has also been mention of the judgment of Falk J in the High Court proceedings wherein she stated at paragraph 175 that:⁸

“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.”

18. 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. 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.

Relevant periods

19. 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:

⁸ A copy of the full judgment is exhibited at DAS3

“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.”

20. 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 period in respect of the NAVIGATOR and figurative marks are of no real consequence to the genuine use assessment I must make.⁹ 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.¹⁰ For ease of reference going forward, I will only refer to the one relevant period for each revocation application, being 27 June 2017 to 26 June 2022.

The proprietor’s evidence

21. Prior to the hearing, the applicant filed a skeleton argument that contained detailed and extensive criticisms of the proprietor’s evidence. Having reviewed and

⁹ I make reference only to the first mark in respect of this point on the basis that there is a significant overlap between the 46(1)(a) period and 46(1)(b) period for the TISSOT mark so is of no real consequence so the issue discussed here is of no real consequence to that mark.

¹⁰ On this point, I note that revocation of the undefended goods in the Class 9 mark will take effect from the earlier date.

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 54 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.

22. 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.

23. The second issue raised relates to the evidence at large being discredited by the false statement by Ms Koenig and Mr Haller that "Tissot has made genuine use of the Marks between 27 June 2017 and 26 June 2022, in connection with the defended goods."¹¹ The applicant argues that this statement is 'obviously incredible'¹² 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.¹³ 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 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

24. As set out above, the applicant's pleaded case in respect of the class 14 goods is that they be limited to just 'analogue watches'. During these proceedings, the applicant provided an alternative position, being a claim that the marks only survive

¹¹See paragraph 32 of the witness statement of Ms Koenig and Mr Haller

¹² 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.

¹³ 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.

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.

25. I note that in its skeleton argument filed prior to 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.

26. 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

27. 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”.

28. Given that two of the proprietor’s marks are comparable marks, 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”.

29. 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.”

30. 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 Bunderversammlung 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 Marken 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].”

31. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”¹⁴ 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”¹⁵ is not, therefore, genuine use.

32. 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 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.

¹⁴ *Jumpman*, Case BL O/222/16

¹⁵ *Ibid.*

[...]

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.”

33. 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.”

34. The TISSOT and figurative marks are comparable marks based on either an earlier EUTM or an earlier IR designating the EU. This means that use of the marks in the EU prior to (and including) IP Completion Day (being 31 December 2020) is relevant to the present assessment.¹⁶ By virtue of being a Member State prior to this date, the UK still formed part of the relevant territory of the EU. From 1 January 2021 onwards, however, the relevant territory is the UK only. As for the NAVIGATOR mark, this is a UK registration meaning that the UK is the relevant territory for use of the same. In relation to the period during which 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

¹⁶ See paragraph 4 of Tribunal Practice Notice 2/2020

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.”

35. 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.”

36. 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.”

37. 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 exhibit cover pages) is 334 pages in length. This does not fall within the guidelines of the Tribunal, being 300 pages for evidence in chief as set out in Tribunal Practice Notice 1/2015 (“the TPN”). However, it is often the case that evidence that is not vastly in excess of the 300 page limit is accepted into Tribunal proceedings so I take no real issue with the page count of the evidence. However, 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 MKAH2 wherein the proprietor has presented multiple pages of its website over just three pages of documents (see pages six, seven and eight),¹⁷ Exhibit MKAH6 which consists of 85 pages of invoices printed over 34 pages and Exhibits MKAH22 to MKAH24 wherein multiple pages of evidence are condensed to just one page for the purpose of the overall page count. 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 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.

38. 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

¹⁷ I note that the pages referred to here, when printed into the hearing bundle, are illegible so it is only possible to view them in an electronic format. As further examples of this approach, see MKAH46 and MKAH51.

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 effect 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.

39. Before undertaking my assessment, I consider it necessary to assess the form of the mark in respect of the NAVIGATOR mark. This is on the basis that, as I will come to discuss below, the NAVIGATOR mark is not actually used as registered in the evidence.¹⁸ As for the TISSOT and the figurative marks, their use throughout the evidence is as they are registered (be that in line with the notional and fair use of the same or in accordance with *Collosum* (cited below)). Additionally, the issue in respect of their form was not raised by the applicant at the hearing (the issue was raised in respect of the NAVIGATOR mark) and I will, therefore, take it that the form of these marks is not at issue here.

¹⁸ As I will also come to discuss below, failure to use a mark as it is registered is not fatal to the reliance on that mark as provisions in the Act (see Section 46(2)) exist to allow for variant forms to be relied upon.

Form of the mark

40. The proprietor's evidence sets out that, on the brand's 100 year anniversary in 1953, it released the TISSOT NAVIGATOR.¹⁹ Further, I note that the evidence states that a version of the TISSOT NAVIGATOR watch was released in 2013 to celebrate the brand's 150th anniversary.²⁰ Firstly, the release dates of these watches was outside of the relevant period. Secondly, having reviewed the evidence, I note that the 2013 version was labelled as a TISSOT HERITAGE NAVIGATOR. At the hearing, the evidence that Mr Selmi took me to in relation to the NAVIGATOR mark was all in relation to TISSOT HERITAGE NAVIGATOR.²¹ I note that this evidence includes invoices covering sales of watches that the proprietor claims to be under the NAVIGATOR mark branding.²² Towards the end of this exhibit are two photos of the watches that the proprietor claims as being covered by the invoices (both of these are referred to as 'TISSOT WATCH HERITAGE NAVIGATOR'). I note that the watches contained in the invoices are simply described as 'HERITAGE, however, on further examination I note that their reference numbers are aligned with one of the watches shown at the end of the exhibit.

41. At the hearing, the applicant argued that the evidence of claimed use for the NAVIGATOR mark was not use of an acceptable variant of the same. Therefore, the applicant argued that there is no evidence containing the NAVIGATOR mark and the defence of the same must fail. The applicant has identified, as I have above, that the closest evidence in relation to the use of this mark is in the use of TISSOT HERITAGE NAVIGATOR. The applicant argues that the use of 'HERITAGE' between TISSOT and NAVIGATOR is such that it alters the distinctive character of the mark. I enquired with Mr Stone as to whether he had any arguments in respect of whether he considered that it was use in accordance with *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.²³ Mr Stone stated

¹⁹ See paragraph 7 of the witness statement of Ms Koenig and Mr Haller and page 3 of MKAH2

²⁰ MKAH4 and MKAH5

²¹ MKAH52

²² MKAH53

²³ This case set out that use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

that the mark has not been used as part of a composite mark but, instead, has a third mark, being 'HERITAGE' interpolated within it, thereby creating a different mark. Mr Stone acknowledged that the case may be different if the mark was for 'NAVIGATOR', solus, but it is not.

42. It is clear to me that the NAVIGATOR mark has not been used in the evidence. I am also of the view that the use before me is not use of the mark as registered in accordance with *Colloseum* (cited above) on the basis that it cannot be said to be use of the mark independently or as part of a composite mark. In respect of the assessment as to whether TISSOT HERITAGE NAVIGATOR or TISSOT WATCH HERITAGE NAVIGATOR is an acceptable variant of the NAVIGATOR mark, I refer to the case of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, wherein Mr Phillip Johnson, sitting as the Appointed Person, stated that:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

43. In considering the distinctive character of the NAVIGATOR mark, I am of the view that the word ‘TISSOT’ is the most distinctive and dominant component of the mark on the basis that it will, inherently, be viewed as either a made-up or foreign language word with no obvious meaning. As for ‘NAVIGATOR’, I accept that this is distinctive in its own right but by virtue of being a well-known English language word, it will be considered less distinctive. Further, I do not consider that the joining of TISSOT and NAVIGATOR can be said to form a unit with its own unitary meaning. Therefore, I find that the words have their own independent meanings.

44. As for the alteration, I note that this is the inclusion of the word ‘HERITAGE’ between the words ‘TISSOT’ and ‘NAVIGATOR’. It is my view that the word ‘HERITAGE’, when viewed by the average consumer on the goods at issue, will be seen as a reference to the past or the origin of the brand. This is not necessarily

descriptive of any goods but it is, in my view, suggestive of the type being offered, i.e. a version that is a replica or reproduction of an original version or an homage to the brand's origin/history. In considering the impact of the addition of 'HERITAGE' on the mark, I am of the view that it does not change the distinctive character of either of those words, the meanings of which will remain as I have set out above. I remind myself that, as per paragraph 16 of *Lactalis* (which is set out above), the addition of descriptive or suggestive words is unlikely to change the distinctive character. There is nothing in the case law to suggest that this only applies only to words added at the beginnings or ends of marks. Therefore, I find that it equally applies to words added in the middle. Taking all of the above into account, I am of the view that the addition of the word 'HERITAGE' in the middle of the mark does not alter the distinctive character of the mark as a whole and the use of TISSOT HERITAGE NAVIGATOR is, therefore, an acceptable variant of the NAVIGATOR mark. As for the use of TISSOT WATCH HERITAGE NAVIGATOR, I am of the view that the same finding reached above can also be reached in relation to that variant of the mark. Put simply, the word 'WATCH' is clearly descriptive of the type of goods upon which the mark is displayed following the same logic discussed above, it will not alter the distinctive character of the mark as a whole.

45. For the avoidance of doubt, the only use in relation to the NAVIGATOR mark that I will consider is the use of the aforementioned variants of the same. This is on the basis that, as set out in paragraph 16 of *Lactalis* (cited above), in circumstances where a mark consists of two distinctive elements such as a house mark and a sub-brand (which I consider to be the case here), it is not sufficient to prove use of only one of those distinctive elements. Therefore, while TISSOT may be the more dominant and distinctive element of the NAVIGATOR mark, its use in solus is not acceptable to prove use of the NAVIGATOR mark.

Genuine use

46. I will begin with the assessment of the NAVIGATOR mark. I do so for reasons that will become obvious below. I will then move to consider the TISSOT mark before finally considering the figurative mark.

The NAVIGATOR mark

47. The evidence before me regarding the level of sales associated with the NAVIGATOR mark covers the sale of just 13 watches in the UK during the relevant period.²⁴ While this is a vanishingly small level of use when compared against the relevant market in the UK for chronometric and horological instruments, the narrative evidence regarding these invoices sets out that they represent just a small fraction of the sales associated with this watch. It appears to me that the proprietor is simply asking me to make an inference that just because the witnesses say the level of sales shown is only a small fraction of the total sales then that must be sufficient to prove that there is genuine use. My problem in making such an inference is that there is nothing to suggest what is meant by 'a small fraction'. If it was the case that there was a significant level of sales associated with the NAVIGATOR mark then I consider it reasonable to expect that the proprietor should have provided further evidence of such.

48. Even looking at the evidence as a whole, I appreciate that there is marketing evidence and advertising evidence that relates to the TISSOT and figurative marks, however, there is nothing to suggest that level of advertising undertaking or marketing expenditure incurred by the proprietor exclusively in relation to the NAVIGATOR brand. Without such, I am unwilling to infer that the same evidence can be said to equally relate to the NAVIGATOR mark.

49. In the present circumstances, I not only remind myself of the comments of Mr Alexander Q.C. in *Plymouth Life* but also Section 100 the Act and reiterate that the burden is on the proprietor to prove use of its mark. In light of the aforementioned

²⁴ MKAH53

comments of Mr Alexander Q.C., I am entitled to be sceptical of the evidence before me, particularly given that it is my view that it is reasonable to expect more information surrounding the level of sales to be readily available to the proprietor and, therefore, before me in these proceedings. So while I note the evidence, I am of the view that, as a whole, it is insufficiently solid to allow me to reach a finding that there has been genuine use of the 'NAVIGATOR' mark.

The TISSOT mark

Class 14

Timepieces and chronometric instruments.

50. While I note that it is not in dispute as to whether there has been any genuine use of goods falling within this term, it is in dispute as to what a fair specification for the use shown would be. Consequently, I will conduct a brief assessment of the proprietor's use of goods within this term. I note that, as an example, the proprietor has provided sample invoices that show the sales of €698,186.34 in the EU and £363,438.84 in the UK worth of watches between 2017 and 2022.²⁵ The evidence sets out that these sales figures cover just a fraction of the total sales by the proprietor but no further information is provided as to the actual size of the use.

51. While the above issues with the vague sales figures are noted, additional evidence has been provided regarding marketing advertising and press coverage. The proprietor confirms that it has a considerable marketing and advertising budget but, as was the case with the turnover above, it has not specified how much. Again, I have some issue with this as I consider this information to be something that would have been relatively straightforward for the proprietor to provide. That being said, evidence is provided of Marketing Reports for Germany from 2017, January 2020 and November 2020.²⁶ I note that these all show various examples of the advertising efforts of the proprietor. So while the statement of a 'considerable

²⁵ See paragraph 9 of the witness statement of Ms Koenig and Mr Haller

²⁶ MKAH14, MKAH15 and MKAH16

marketing and advertising budget' is rather vague, I am of the view that the supporting evidence demonstrates that the proprietor has clearly undertaken some marketing efforts in the relevant territory. I note that the evidence includes press coverage that demonstrates that the proprietor enjoyed a presence throughout the relevant period across various print publications such as GQ (both the English and German versions), Grazia and Easyjet Traveller, all of which are shown in evidence to have significant circulation figures.²⁷

52. Lastly, I note that the evidence includes what is referred to as 'The Big Watch Survey'.²⁸ The narrative evidence sets out that this survey was run by the UK publication WatchPro, however, I note that, upon review, the survey was actually conducted by Hearst UK. I note that the evidence confirms that the survey was conducted between October 2016 and January 2017 wherein over 8,169 readers of what the article refers to as 'lofty magazines', being Esquire, Men's Health, Harper's Bazaar, Red and the Financial Times. It also confirms that the survey included customers of The Watch Gallery. The respondents were made up of 80% male and 20% female. The article provided sets out that it is important to note that the survey did not set out to understand the views of the entire British public. Of the results, I note that TISSOT is ranked 26th in the list of the 50 most wanted watches and 12th in the lists for 'owned timepieces' and 'likely next purchases' sections. While this evidence is noted, I must treat it with some caution on the basis that the respondents are very limited in number (over 8,000 people is far from indicative of the likely market for watches across the entirety of the EU) so are hardly indicative of the views of the wider public.

53. Taking all of the above into account, it is my view that the proprietor's evidence is sufficient to find that it has genuinely used its TISSOT mark on the above goods. That being said, the use relates to just watches and as the above term covers a broader set of goods, I must now consider a fair specification of the same. The proprietor submitted that there are a number of authorities that provide support for

²⁷ See, for example, paragraph 15 of the witness statement of Ms Koenig and Mr Haller and Exhibit MKAH22 to MKAH24

²⁸ MKAH54

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* (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*²⁹ 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.

54. 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’.³⁰ While these decisions are noted, neither of them are binding upon me and I will say no more about them.

55. 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

²⁹ [2015] EWCA Civ 220

³⁰ HAMILTON & INCHES, Case BL O/090/17

goods³¹ 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 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.

56. 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.

57. 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

³¹ While services are specifically referred to in the *Titanic Spa* case, the question applies equally to goods, as is the case here

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.³² As a result, I reject the applicant's pleaded case that these goods should be limited to 'analogue watches'.

58. 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).³³ 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'.

59. 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.

60. 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

³² On this point, I note that the TISSOT T-TOUCH range of watches all include some form of digital screen embedded in the watch face.

³³ Additional references to other goods were mentioned but, for illustrative purposes, I have only mentioned one example.

reference to the case of *Pathway*³⁴ 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 and precise in describing the goods at issue. As a result, I see no reason why the Nice Classification would be relevant and 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.

Precious metals and their alloys and goods made of these materials or coated therewith included in this class; precious stones.

61. The proprietor’s case in respect of the above goods is that some of its watches contain precious metals, precious metal alloys and precious stones. Evidence of a selection of these watches is provided.³⁵ No evidence of specific sales of these watches has been provided but I do not consider that anything turns on this. This is on the basis that I do not consider that use of watches in precious metals, their alloys or those that incorporate precious stones is sufficient use of “precious metals and their alloys” or “precious stones”. This is because the sale of goods made of or incorporating these materials is not a genuine attempt to create or preserve a market share in the actual materials themselves. As such, the proprietor’s reliance upon “precious metals and their alloys” and “precious stones” must fail.

62. While the above finding is noted, the same cannot be said for “goods made of these materials or coated therewith” (only relating to precious metals and their alloys, of course) as use of watches in these materials would, if proven, satisfy use of the

³⁴ *Pathway IP SARL v Easygroup Ltd* [2018] EWHC 3608 (Ch)

³⁵ See pages five to ten of MKAH12

same. While that may be the case, I do not consider that such an assessment is necessary in the present case. The reason for this is twofold. Firstly, only watches are shown in the evidence meaning that any such retainment of the above term would be limited to “watches made of precious metals, their alloys or coated therewith.” Secondly, I have found genuine use for “watches” and as that term is not limited to the materials for which those goods may be made with, it can reasonably be said to cover watches made of precious metals, their alloys or coated therewith. Therefore, the granting of a limited version of the aforementioned term offers nothing beyond that which is provided by the retaining of the term “watches”.

Jewelry.

63. The proprietor claims that, aside from watches (which it claims is a type of jewellery), it sells items of jewellery. Addressing the position in respect of watches being a type of jewellery, I am of the view that while watches and jewellery may overlap in trade channels, they are distinct categories of goods and are, therefore, not the same. As a result, I do not consider that the watch evidence is of any assistance to the proprietor on this point. As for the types of jewellery the proprietor’s claims to sell, I note that this relates to pendant watches³⁶ (that are described as ‘pocket watches exclusively for ladies’)³⁷ and pocket watches.³⁸ As two sub-categories of watches, I repeat what I have above in that use of these goods would not be described as use of jewellery, regardless of whether they were on chains or not. Such use is, therefore, of no assistance to the proprietor. Further, if I am wrong to find that a watch is not an item of jewellery, then the proprietor is adequately protected for such use by virtue of retaining “watches” in its specification. In my view, if watches are a subset of jewellery, then they would be a distinct category, which would be identified by the average consumer as reflective of the proprietor’s use.

³⁶ Page four of MKAH10

³⁷ Page one of MKAH41

³⁸ Page 12 and 13 of MKAH12

Presentation cases for timepieces, cases for timepieces; jewelry boxes, cases.

64. The proprietor's position in respect of the above goods is simply that TISSOT branded watches come in a watch box that are branded as TISSOT and that the proprietor trades in watch boxes in the UK and the EU.³⁹ Firstly, one of the above terms is for presentation cases and I do not consider that the provision of a box is the same as a presentation case, which is more likely to be a display case used in order to display or 'present' the watch so that people may view it. This is not the same as a watch being sold in a box. Secondly, I do not consider that just because a watch is sold in a watch box or presentation case, it satisfies the requirement of genuine use for the boxes or cases themselves. As rightly pointed out by the applicant, this is not demonstrative of the proprietor trying to maintain or create a market share in the watch box market sector (or watch case, presentation case, jewelry box or general case markets for that matter).

65. Even ignoring the above issues, I do not consider that the evidence before me is particularly compelling in demonstrating that the goods are actually sold to consumers. For example, there are invoices before me that show the provision of 540 'TISSOT NEW GENERATION WATCH BOXES'⁴⁰ but I note that the value of these items is limited (either two or three euros) and, within the description of these goods, it is confirmed that the value shown is for customs purposes only. Further, the narrative evidence confirms that these invoices cover the sale of goods to third party subsidiaries for onward sale to EU customers.⁴¹ In response to the proprietor's position in respect of this point, the applicant offered an explanation that the aforementioned issues mean that these invoices do not cover actual sales but, instead, the shipment of watch boxes to a retailer so that they may be used for placing watches in upon the sale of the watches themselves. On balance, there is no evidence before me of onward sales to end consumers of these goods (as opposed to them being used for storage/presentational purposes) and, as I have highlighted above, the burden is on the proprietor to demonstrate use. Absent any

³⁹ Images of the boxes as shown at MKAH40

⁴⁰ MKAH39

⁴¹ See paragraph 22 of the witness statement of Ms Koenig and Mr Haller

evidence in that regard, I am not prepared to make the inference that these invoices represent actual sales to end consumers. As a result, I find that the proprietor has failed to demonstrate that it has genuinely attempted to create or maintain a market for watch boxes during the relevant period. Therefore, I find that there is no genuine use in relation to the above goods.

Class 9

66. As I have set out above, while the proprietor initially defended all goods in class 9 of the TISSOT mark, it set out in its skeleton argument prior to the hearing that it no longer sought to defend some. These are set out below and, for the avoidance of doubt, they will be revoked from the earliest revocation date sought.

Magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus enabling the playing of compressed sound files (mp3); calculating machines and data processing equipment, computer hardware for data processing, computer programs, computer software, software for mobile phones, tablets and other electronic mobile devices; firmware, software packages; downloadable image files; downloadable music files; downloadable text files; downloadable computer data files; games for mobile telephones, for computers and for digital personal stereos; electronic game software for mobile telephones, for computers and for digital personal stereos; computers, portable computers, handheld computers, personal computers, mobile computers, [...] tablet computers and mobile devices and computer, personal digital assistants, electronic organizers, personal digital assistants, digital personal stereos, mobile telephones and new-generation mobile telephones incorporating extended functions (smartphones); portable electronic devices for wireless data reception and/or transmission; apparatus and instruments for telecommunication and communication, mobile telecommunication systems card reading/writing systems, bar code readers; electronic key holders; electronic pens [visual units]; electronic translators; downloadable electronic publications; magnetic identification bracelets; clock radios; bags, cases and covers for telephones,

computers and other portable and mobile electronic devices; optical apparatus and instruments, particularly spectacles, sunglasses, magnifying glasses; cases for spectacles, magnifying glasses and sunglasses.

67. As for the remaining defended goods, I will proceed in considering them below.

Wrist computers.

68. At the hearing, the proprietor's case in respect of the class 9 goods generally relied upon the TISSOT T-TOUCH watch. The evidence sets out that one of the most recently released models of the TISSOT T-TOUCH watch is the TISSOT T-TOUCH CONNECT SOLAR watch. A copy of the 2021 user's manual for the same is provided in the evidence.⁴² A print-out taken from the UK version of the proprietor's website is also provided.⁴³ I note that this is dated 22 June 2021 and was obtained from the internet archive facility, the Wayback Machine. In addition, I note that there is evidence of articles from three third-party publications wherein this watch is referred to as being a 'smartwatch'.⁴⁴

69. Having considered the evidence, I am of the view that this product is capable of being determined as a type of smartwatch. Therefore, it can be said to fall within the category of 'wrist computers' as constitute use of the above term. I make this finding on the basis that the evidence sets out that the watch can be connected to a smart phone via Bluetooth connection and I note that this allows for the wearer to be alerted to their emails, messages, calls and social media activity. Further, the watch has a 'find my phone' function that not only allows the user to find their phone by using their watch but also to allow the user to use their smartphones to find their watch. I also note that the watch has an activity tracker that provides the user with information as to their step count. Lastly, I note that the watch has an 'NBA mode' that allows the users to view the latest scores from their favourite NBA team and information as to upcoming fixtures. On the latter point, the applicant sets out that

⁴² MKAH45

⁴³ See MKAH46 which, while a .com website, include the letters 'en-gb' in the URL, confirming that it is the Great British English language site.

⁴⁴ MKAH50

the NBA is an American sports league and is, therefore, of limited interest to users in the UK. Regardless of whether that is the case or not, this is still a smart function.

70. The above being said, I have several issues with the evidence before me. Chief amongst them is the reference to 'TISSOT T-TOUCH' watches generally. While I accept that the latest model, being the CONNECT SOLAR, is a smartwatch, the evidence in respect of this watch stems only from late 2020 onwards.⁴⁵ There is nothing before me regarding any features for any of the other versions of watches in the TISSOT T-TOUCH range so I am unable to conclude whether they are 'smart' or not. On this point, I note that the evidence shows three watches branded TISSOT T-TOUCH II but these appear to be watches with a digital screen incorporated into the watch face and there is nothing to indicate they exhibit any smart functions.⁴⁶ Further, there is evidence of a 'TISSOT T-TOUCH EXPERT SOLAR' watch.⁴⁷ Again, this is noted but there is nothing to suggest that it is a smartwatch in the same way that the 'CONNECT SOLAR' watch is. It is, therefore, left for me to wonder as to what versions of the watch are considered smart or not. For example, could it be said that the only versions of the TISSOT T-TOUCH watch that fall within the designation of a smartwatch are branded with 'CONNECT' in their name? Without any specific evidence to guide me on this point, I am left to speculate and, in the absence of sufficiently solid evidence on this point, I am not willing to infer that any and all watches branded as a 'T-TOUCH' watches are smartwatches. Instead, I will take only the concrete evidence I have before me that the 'TISSOT T-TOUCH CONNECT SOLAR' is the only smartwatch offered by the proprietor. While on the topic of this evidence, I am of the view that it is reasonable to expect that if any and all watches bearing the 'TISSOT T-TOUCH' branding were smartwatches, that the proprietor should have filed evidence of such. Without this, I am not willing to make such an inference.

⁴⁵ On this point, I note that the Telegraph article at MKAH50 states that the watch launched 'at the end of last year', being 2020.

⁴⁶ See page 1 of MKAH10

⁴⁷ See MKAH11 and page 4 of MKAH12

71. In light of what I have said above, when considering the invoice evidence that the proprietor has provided,⁴⁸ I will only consider it insofar as it relates to sales of the TISSOT T-TOUCH CONNECT SOLAR. Some of the invoices are addressed to third party customers, presumably retailers, and some are to subsidiaries within the Swatch Group. The applicant's argument in respect of the invoices regarding Swatch Group subsidiaries is that they demonstrate internal use so, in accordance with *Ansul*, are not sufficient to prove genuine use. While the recipients of the goods on some of 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.⁴⁹

72. Having considered the invoices in respect of sales of TISSOT T-TOUCH CONNECT SOLAR smartwatches only, I have calculated a wholesale figure of £38,426.08 in the UK and approximately €1,172.08 in the EU (excluding the UK which, for some of the time period covered by the invoices was a Member State).⁵⁰ The sales of these products are concentrated between 16 November 2020 and 23 June 2022 meaning that the figures cover just 20 months of sales. As an additional point in respect of these invoices, I note that they cover wholesale prices and, therefore, are not necessarily reflective of the total level of sales attracted by the 'TISSOT T-TOUCH CONNECT SOLAR' smartwatch. For example, I note that the average UK wholesale price for this product is between £476 and £509 but the retail price is shown as being £880.⁵¹ In addition to the invoices provided, the proprietor has filed a breakdown of 'TISSOT T-TOUCH' sales between 2017 and

⁴⁸ MKAH47 and MKAH48

⁴⁹ It could be said that evidence of repeat custom to the same distribution company within the Swatch Group would be indicative of ongoing sales but I note that the details of the identity of these companies is redacted so I am unable to determine with any real accuracy whether these invoices cover repeated custom to the same entities.

⁵⁰ One 'T-TOUCH CONN.' entry does not show a wholesale price. However, I have calculated its wholesale value based on the minimum price for the same product in the same invoice.

⁵¹ See MKAH46

2020 in the EU.⁵² However, this evidence is not broken down in a way that enables me to determine what proportion of it relates 'TISSOT T-TOUCH CONNECT SOLAR' products. This is particularly an issue given that this product did not launch until late 2020 so any breakdown relating to 2020 is only likely to cover approximately two months of sales.

73. I have no evidence of the size of the smartwatch markets in the UK or EU but it is my view that they are likely to be exceedingly large markets with annual turnovers in excess of a billion pounds/euros each. Against these markets, the above sales figures are plainly very low. I remind myself that the proprietor's narrative evidence sets out that the evidence of sales provided represents only a small fraction of the total sales but I repeat my comments above in that there is nothing to suggest what a small fraction was. On this point, I see no reason why the proprietor could not have provided more sufficiently solid evidence in relation to the turnover associated with this product.

74. As I have set out above, the sales evidence does not reflect the entire evidential picture as there is also some limited press coverage which shows the 'TISSOT T-TOUCH CONNECT SOLAR'.⁵³ This evidence relates to articles from three publications, namely Oracle Time (dated February 2021), Luxury Editor (also dated February 2021) and The Telegraph (dated January 2021). Each article includes reference to the 'TISSOT T-TOUCH CONNECT SOLAR'. I have nothing before me to suggest the readership of the first two publications referred to. As for the remaining article from The Telegraph, I accept that this is a widely circulated publication in the UK.⁵⁴ However, the evidence provided relates to newspaper circulation and the article provided appears to be from the 'Luxury' section of the Telegraph's website. There is nothing to suggest (1) that this article featured in the newspaper itself or (2) the readership figures in relation to the specific section in which the article features. In addition, I note that marketing evidence has been

⁵² MKAH49 includes a breakdown but I note that no invoices are actually provided.

⁵³ MKAH50

⁵⁴ I note that, at MKAH51, circulation figures are provided showing a circulation of 319,817 for December 2019

provided, however, it only makes very limited reference to the 'TISSOT T-TOUCH CONNECT SOLAR'.⁵⁵

75. It is clear from the above assessment that I have a number of issues with the evidence before me, namely in respect of the limited sales figures and the vague statements as to a larger level of use. However, having said that, I remind myself that evidence of use need not be quantitatively significant in order for it to be genuine. Taking that into account, I am of the view that the level of sales, while not high in the context of the market as a whole, are reflective of a genuine attempt to create or preserve a market share in the goods at issue. I make this finding whilst also bearing in mind that the product did not appear to have launched until November 2020 (being the first appearance of this product in the invoices)⁵⁶ meaning that any such level of use is likely to be less significant given that the relevant period concluded just 20 months later. Lastly, I appreciate that the press coverage and marketing surrounding this product may not necessarily be extensive but it does, in my view, point to activity by the proprietor that is beyond token use and is, in my view, genuine. In my view, the same can also be said of the detailed user manual which, to me, indicates an additional and genuine attempt to create/maintain a market for the product.

76. While I am content to find genuine use for goods within the above term, I am of the view that 'wrist computers' is too broad in light of the use before me. I say this on the basis that while a wrist computer covers a smartwatch, I am of the view that it can be said to cover additional larger tablet-like devices that are mounted on the user's wrist for varying purposes (such a military or medical, for example). On this point, there is nothing before me that points to use of any other type of 'wrist computer' and I am of the view that when confronted with the proprietor's use, the average consumer would simply categorise it as covering smartwatches. As such, I consider that "smartwatches" is a satisfactory sub-category of wrist computers and would offer the proprietor protection for the use shown without stripping it of

⁵⁵ See page one of MKAH15 that shows an advert in Diffusion Magazine in Germany dated 3 November 2020

⁵⁶ This is also based on the fact that the press coverage referred to at fn. 44 above evidence alludes to a launch date of 'late 2020'. See MKAH50.

any appropriate level of protection. As a result, I hereby limit the above term to “smartwatches”.

Apparatus for recording, transmission and reproduction of sound or images; electronic apparatus for accessing the Internet and sending, receiving, recording and storing of short messages, electronic messages, telephone calls, faxes, video-conferences, images, sound, music, text and other digital data; electronic apparatus for wireless receiving, storing and transmitting of data or messages; electronic apparatus for global positioning [GPS] and displaying maps and transport information; electronic devices for detecting, monitoring, storing, surveillance and transmitting data relating to the user activity, namely position, itinerary, distance traveled, heart rate; portable digital electronic apparatus and software related thereto; altimeters; barometers; pedometers; distance measuring apparatus; distance recording apparatus; time recording apparatus; time clocks [time recording devices] electronic apparatus incorporating a time display; revolution counters, goal counters, countdown devices, starting counters; electronic display boards, display screens; power supplies, namely batteries and cells for electronic apparatus and computers, batteries and cells for timepieces and chronometric instruments, apparatus for converting electronic radiation to electrical energy, namely photovoltaic solar modules, systems and components and all related system components.

77. I remind myself that the proprietor’s position was that use of TISSOT T-TOUCH demonstrates use for all of its class 9 goods. In light of the findings I have made above, I do not consider that this is the case. So regardless of whether use of the TISSOT T-TOUCH CONNECT SOLAR watch covers the terms sets out above,⁵⁷ it follows that the proprietor has also failed to provide genuine use of any of the above goods.

⁵⁷ For example, I note that the evidence regarding the TISSOT T-TOUCH CONNECT SOLAR makes no reference to having either a GPS or heart monitoring function so would, in any event, fail to cover use of such goods.

The figurative mark

Class 14

78. The specification of the figurative mark is not too dissimilar to that which I have assessed above. As the relevant period and relevant territory for this assessment is the same as it was for the TISSOT mark assessed above, I am of the view that several of the findings I have reached above are applicable here, namely for the following goods:

Precious metals and their alloys and goods in precious metals or coated therewith; jewellery, precious stones, horological and chronometric instruments, cases for watches [presentation], watches.

79. This leaves the term “parts of watches, watch movements”. While included as just one term, I will assess them separately.

Parts of watches.

80. The narrative evidence sets out that the proprietor offers its customers a number of authorised service centres in the UK and the EU which, amongst other things, performs repairs and replaces broken watch parts on TISSOT branded watches. On this point, I note that there is evidence of the existence of a number of authorised service centres in the UK.⁵⁸ This evidence shows that there are 61 service centres across the UK. The evidence is from the proprietor’s website and is undated. While there is no way for me to determine how many of the 61 service centres were in operation during the relevant period, I am willing to infer that a significant proportion of them were. I note that the print-out provided is incomplete as it is overlaid with the filters that were selected for the search. I also note that of the four entries I can see, only one is under the control of the proprietor, with the remaining three seemingly being third party service providers. A customer service

⁵⁸ MKAH36

page from the proprietor's website is also included and I note that this includes a list of the services that it provides.⁵⁹ This includes diagnostic, cleaning and inspection services, replacement of water-resistant components, replacement of batteries and replacement of worn movement parts, amongst others. I am satisfied that this website is aimed at UK consumers as it includes warranty pricing in pounds. Further, while the print-out is undated, I have no reason to believe that these services were not provided to consumers during the relevant period.

81. While this evidence relates to the provision of services, it is my view that it can also extend to the provision of replacement parts in that it is likely that an entity providing the services would also be responsible for providing parts used in the course of the services. Having said that, the evidence of use is limited and I note that it includes just one invoice from 2019 regarding the provision of spare parts to a German third party corporate customer.⁶⁰ Having reviewed the invoice, I note that there are only eight entries that can be said to relate to the TISSOT branding. Aside from being simply referred to this invoice as 'Services Tissot', I have nothing in evidence to suggest what this invoice actually covers. Referring back to the list of repair services offered (being that discussed in the preceding paragraph), I am of the view that these entries could be said to cover diagnostic services, inspection, cleaning and oiling, accuracy adjustment or the calibration of functions. While they could equally cover the replacement of parts, the evidence is not clear and, without any form of clarity, I am unwilling to infer that they relate solely to the provision of replacement parts, be that a movement or other type of part. In any event, I do not consider that the evidence regarding eight potential examples of replacement parts being provided is sufficient to demonstrate use of the above goods.

82. All of the above being said, I have considered whether it would be appropriate for me to infer that due to the scale of the use shown by the proprietor in relation to watches that it must also have made genuine use of its mark in relation to watch parts. However, I do not consider that can be said for the present assessment. This is primarily on the basis that the total evidence before me regarding sales of

⁵⁹ MKAH37

⁶⁰ MKAH37

TISSOT watches is £363,438.84 and €698,186.34 across the relevant territory during the relevant period. The narrative evidence sets out that this is just a fraction of the total use but, as I have stated repeatedly throughout this decision, this is a vague statement and I am unable to determine with any real precision what the total evidential picture would look like. Further, I appreciate that there is additional evidence demonstrative of genuine use, for watches in general, by way of examples of advertising and press coverage. However, on balance, I do not consider that the proprietor has filed sufficient evidence that demonstrates a business operation that is so significant that the aforementioned inference is a reasonable one to make. On this point, I refer again to the case of *Plymouth Life* and *Dosenbach* as well as section 100 of the Act. Put simply, there is nothing sufficiently solid to suggest that the proprietor's provision of watch parts is demonstrative of a genuine attempt to create and maintain a market share in relation to the same.

83. Lastly, the proprietor argues that by selling watch straps, it constitutes use of the above term. While such an argument is noted, I do not consider that a watch strap is a part of a watch. Instead, I am of the view that the sale of a watch strap as a separate good is the sale of a watch accessory. Therefore, I do not consider that this argument carries any weight. Even if I am wrong on this point, the level of use associated with watch straps is very limited in that it covers just 11 (at best)⁶¹ sales in the relevant territory during the relevant period. This is vanishingly small use and, as was the case above, the evidence before is not so significant that it justifies a finding that use of these goods must be genuine.

Watch movements.

84. I have no doubt that the proprietor sells watches that include a watch movement and, in line with the proprietor's evidence, I do not doubt that these movements are made of high quality materials are integral to the proprietor's watches, their

⁶¹ I say this on the basis that I have no explanation as to what the goods covered in the invoice (such as "RUBBER 210 20 x 18 BLK TONGUE" or "SS BUCKLE 20 MM (DIVER)") are. For example, is the SS BUCKLE just the sale of a buckle or a strap that has a buckle? Regardless, I have taken a rather liberal approach and have counted all goods that can reasonably be said to cover straps

accuracy and their intense detail.⁶² I also appreciate that there is evidence before me that the watch movements are branded with the 'TISSOT' branding.⁶³ However, all that being said, there is nothing to demonstrate the actual provision of a watch movement as an independent offering (outside of being included in a watch). Based on the same issues relating to the 'parts of watches' evidence that I have assessed above and following the same reasoning discussed therein (namely that the evidence is insufficiently solid with regards to the actual provision of these particular goods), I find that the proprietor has failed to provide genuine use for the above goods.

CONCLUSION

85. The outcome of this decision is that all three of the proprietor's marks are to be partially revoked. I will discuss the NAVIGATOR mark further below but, for now, my findings above mean that the TISSOT and figurative marks are to be revoked for the following goods:

The TISSOT mark

Class 9: Apparatus for recording, transmission and reproduction of sound or images; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus enabling the playing of compressed sound files (mp3); calculating machines and data processing equipment, computer hardware for data processing, computer programs, computer software, software for mobile phones, tablets and other electronic mobile devices; firmware, software packages; downloadable image files; downloadable music files; downloadable text files; downloadable computer data files; games for mobile telephones, for computers and for digital personal stereos; electronic game software for mobile telephones, for computers and for digital

⁶² See paragraphs 18 to 19 of the witness statement of Ms Koenig and Mr Haller

⁶³ See Exhibit MKAH33, for example.

personal stereos; computers, portable computers, handheld computers, personal computers, mobile computers, wrist computers, tablet computers and mobile devices and computer, personal digital assistants, electronic organizers, personal digital assistants, digital personal stereos, mobile telephones and new-generation mobile telephones incorporating extended functions (smartphones); portable electronic devices for wireless data reception and/or transmission; apparatus and instruments for telecommunication and communication, mobile telecommunication systems; electronic apparatus for accessing the Internet and sending, receiving, recording and storing of short messages, electronic messages, telephone calls, faxes, video-conferences, images, sound, music, text and other digital data; electronic apparatus for wireless receiving, storing and transmitting of data or messages; electronic apparatus for global positioning [GPS] and displaying maps and transport information; electronic devices for detecting, monitoring, storing, surveillance and transmitting data relating to the user activity, namely position, itinerary, distance traveled, heart rate; portable digital electronic apparatus and software related thereto; altimeters; barometers; pedometers; distance measuring apparatus; distance recording apparatus; card reading/writing systems, bar code readers; electronic key holders; electronic pens [visual units]; electronic translators; downloadable electronic publications; magnetic identification bracelets; clock radios; time recording apparatus; time clocks [time recording devices] electronic apparatus incorporating a time display; revolution counters, goal counters, countdown devices, starting counters; electronic display boards, display screens; bags, cases and covers for telephones, computers and other portable and mobile electronic devices; optical apparatus and instruments, particularly spectacles, sunglasses, magnifying glasses; cases for spectacles, magnifying glasses and sunglasses; power supplies, namely

batteries and cells for electronic apparatus and computers, batteries and cells for timepieces and chronometric instruments, apparatus for converting electronic radiation to electrical energy, namely photovoltaic solar modules, systems and components and all related system components.

Class 14: Precious metals and their alloys and goods made of these materials or coated therewith included in this class; jewelry, jewelry boxes, cases, precious stones; timepieces and chronometric instruments, presentation cases for timepieces, cases for timepieces.

The figurative mark

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith; jewellery, precious stones, horological and chronometric instruments, cases for watches [presentation], parts of watches, watch movements.

86. However, the TISSOT and figurative marks are to remain registered for the following goods:

The TISSOT mark⁶⁴

Class 9: Smartwatches.

Class 14: Watches.

The figurative mark

Class 14: Watches.

⁶⁴ The TISSOT mark is also to remain registered for those goods and services that were not subject to the present revocation action, being those set out in the Annex.

87. Turning to the NAVIGATOR mark, I have found above that the proprietor has not proven use for this mark and, therefore, the application against it is to succeed in full. As a result, the NAVIGATOR mark is hereby revoked for all the following goods:

Class 14: Horological and chronometric instruments.

88. While I appreciate that I have found that 'analogue watches' is not a term that the average consumers would use when describing the use of watches, I remind myself that the pleaded case of the applicant is for the revocation of the NAVIGATOR mark for all goods save for 'analogue watches'. Therefore, in line with the pleaded case and the proprietor's failure to provide evidence in defence of the same, the application succeeds in full and, therefore I find that that NAVIGATOR mark may remain registered for the following goods:

Class 14: Analogue watches.

89. For the avoidance of doubt, where the marks are deemed revoked, the effective revocation dates are 2 June 2021 for the TISSOT mark, 1 January 2017 for the NAVIGATOR mark and 13 November 2003 for the figurative mark.

COSTS

90. 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.

91. 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

92. 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

ANNEX

Class 18

Leather and imitation leather, goods made of these materials not included in other classes; animal skins; trunks and suitcases; umbrellas and parasols; walking sticks; whips, harness and saddlery.

Class 25

Clothing, footwear, headgear.

Class 28

Games, toys; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; electronic games apparatus.

Class 35

Retail sale of timepieces, chronometric instruments, wrist computers and jewelry; presentation of timepieces, chronometric instruments, wrist computers and jewelry on all communication media for retail purposes; advertising by sponsoring; advertising promotion (sponsoring) of cultural and sporting events; commercial information via websites; compilation of information into computer databases; promotional services for sales and marketing; preparation and conducting of promotional and marketing events; customer loyalty program services; public relations services for establishing customer loyalty or increasing customer numbers; advertising; business management; business administration; office functions.

Class 41

Education; training; entertainment; sporting and cultural activities; organization of sporting and cultural events; organization and conducting of seminars, workshops, conferences, symposiums and congresses, organization of exhibitions, shows and events for educational, entertainment, sporting or cultural purposes, hosting of entertainment events; entertainment information; organization, presentation and production of shows and live performances; sports timing services.