

**O/1045/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 505050**

**TO REVOKE ON THE GROUNDS OF NON-USE  
REGISTRATION NO. UK00900509224 FOR THE MARK:**

**JAQUET-DROZ**

**IN CLASSES 14 & 28**

**OWNED BY**

**MONTRES JAQUET DROZ SA (MONTRES JAQUET DROZ AG)  
(MONTRES JAQUET DROZ LTD)**

## BACKGROUND AND PLEADINGS

1. These proceedings concern the following trade mark that is owned by Montres Jaquet Droz SA (Montres Jaquet Droz AG) (Montres Jaquet Droz Ltd) (“the proprietor”):

JAQUET-DROZ

Registration no. 900509224<sup>1</sup>

Filing date 7 April 1997; registration date 17 December 1998

Priority date 11 October 1996

Registered for the following goods:

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; among other, all horological and jewellery products, artistic automatic devices made of precious materials, in particular animated automatic devices incorporating precision mechanisms and movements similar to horological instruments; parts and components of the aforementioned goods included in class 14.

Class 28: Games and playthings, automatic play devices, artistic automatic devices, animated automatic devices, in particular so-called "android" automatic devices (writers, designers, musicians, etc), as well as the parts and components of the aforementioned goods included in class 28.

2. On 27 June 2022, Samsung Electronics Co., Ltd. (“the applicant”) applied to partially revoke the proprietor’s mark. The applicant seeks the revocation of only the class 14 goods, save for “analogue watches”. The application is brought in

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<sup>1</sup> The proprietor’s mark is a comparable trade mark based on a pre-existing EUTM (being EUTM no 509224). 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 EUTMs.

reliance upon sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“the Act”).

3. The period during which the applicant alleges non-use under section 46(1)(a) is the five years after registration of the mark, being 18 December 1998 to 17 December 2003 with revocation sought from 18 December 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.
4. The proprietor filed a counterstatement wherein it defended all of the goods subject to the application.
5. Both parties filed evidence in chief with the proprietor also filing written submissions alongside its evidence. A hearing took place before me on 2 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. The applicant was represented by Mr David Stone of Allen & Overy, who have represented the applicant throughout these proceedings.
6. 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**

7. The proprietor’s evidence in chief came in the form of the joint witness statement of Ms Mireille Koenig and Mr Antoine Haller dated 5 December 2022. Ms Koenig is the Chief Legal Officer at The Swatch Group Ltd (“the Swatch Group”), a position she has held since 2016. Mr Haller is the Head of Trademarks and Designs at the

Swatch Group, a position he has held since 2021. Prior to taking this role, Mr Haller was an Anti-counterfeiting Officer at the Swatch Group. Their statement is accompanied by 35 exhibits, being MKAH1 to MKAH35. 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.<sup>2</sup>

8. I note that the proprietor's evidence consists of exhibits in a foreign language. Translations of the same are included in the evidence and, in support of the accuracy of the same, witness statements (all of which are dated 6 December 2022) have been provided by Mr Craig Thomas Smith, Mr Bruce Director and Mr Matthew Schneider. All of these individuals are translators at Transperfect Legal Solutions and their evidence relates to translations to English from Italian, Polish and Spanish and German, respectively. I do not intend to summarise each statement but note that they confirm (1) what parts of Ms Koenig and Mr Haller's evidence has been translated and (2) the witnesses' belief that the translations are accurate.
9. The applicant's evidence came in the form of the witness statement of Mr David Stone dated 1 March 2023. As set out above, Mr Stone is the applicant's legal representative and is, therefore, duly authorised to give evidence on the applicant's behalf. Mr Stone's statement is accompanied by nine exhibits, being DAS1 to DAS9.
10. Given the voluminous nature of the evidence filed, I do not consider it appropriate or necessary to summarise the entirety of the evidence throughout the course of my decision. I will, however, summarise it to the extent that I consider it necessary to do so at the relevant parts of my decision. For the avoidance of doubt, I confirm that I have taken all of the evidence and submissions into account.

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<sup>2</sup> MKAH1

## PRELIMINARY ISSUES

11. 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

12. 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).<sup>3</sup> The outcome of the High Court proceedings was the granting of an injunction in favour of the Swatch Group.<sup>4</sup> The applicant claims that during those proceedings, the Swatch Group confirmed that it had not used its marks for ‘smartwatches’ and that it became apparent that there was no use for other goods contained in the specifications of other marks owned by companies within the Swatch Group. As a result, the applicant claims that the injunction is based on the overly broad specifications of the Swatch Group’s marks, for which there is no use. Consequently, the applicant now seeks the present revocation action against the proprietor’s mark. In addition to these proceedings, there are 12 other revocation actions brought by the applicant against 18 different trade marks owned by various companies within the Swatch Group.

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

“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

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

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

<sup>5</sup> A copy of the full judgment is exhibited at DAS3

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.”

14. 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 mark at issue before her then I must reach a similar conclusion here, i.e. that there has been genuine use of the mark at issue in the UK. Instead, my decision is based on an assessment of the evidence before me whilst taking into account the relevant case law and legislation. Falk J's determination regarding a reputation is not relevant to this decision and I will say no more about it.

#### Relevant periods

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

“46 (3) - The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations

for the commencement or resumption began before the proprietor became aware that the application might be made.”

16. 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 date of the present proceedings, I agree with the proprietor’s position in that the earlier relevant period is of no real consequence to the genuine use assessment I must make. That being said, it follows that if there is no use in respect of the latter relevant period, the proprietor’s failure to file any evidence in relation to the earlier relevant period means that the revocation will take effect from the earliest sought revocation date. So while I will make no reference to the earlier period in my assessment below, it may still have effect on these proceedings.<sup>6</sup> For ease of reference going forward, I will only refer to the one relevant period, being 27 June 2017 to 26 June 2022.

#### The proprietor’s evidence

17. Prior to the hearing, the applicant filed a skeleton argument that contained detailed and extensive criticisms of the proprietor’s evidence. Having reviewed and considered the issues raised by the applicant, I note that the majority of them relate to criticisms of the evidence insofar as they fail to demonstrate genuine use. While Mr Stone did not seek to raise all of these issues at the hearing, Mr Selmi set out that it was not appropriate for the applicant to raise these issues at such a late stage in the proceedings (being the skeleton argument stage) without formally challenging the evidence. While this point is noted, it is not necessary that the applicant raises such issues in evidence or request to cross-examine witnesses. On the contrary, it is common in proceedings before the Tribunal for an opposing party to raise issues with the sufficiency of the other side’s evidence at the hearing stage or via written submissions in lieu. Further, I remind myself that the onus is on the party bearing the burden of proving use to file its best case as evidence in chief. Having said that, I do appreciate that where the party challenging the

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

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 35 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.

18. 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 mark. 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.

19. The second issue raised relates to the evidence at large being discredited by the false statement by Ms Koenig and Mr Haller that "It is clear from the above that



Jaquet Droz has made genuine use of the Mark between 27 June 2017 and 26 June 2022, in connection with [all of the goods].”<sup>7</sup> The applicant argues that this statement is ‘obviously incredible’<sup>8</sup> 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.<sup>9</sup> 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

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

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<sup>7</sup> See paragraph 22 of the witness statement of Ms Koenig and Mr Haller

<sup>8</sup> 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.

<sup>9</sup> 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.

to the exclusion of 'smartwatches' or not is something that the parties were free to make submissions on.

21. 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.

22. 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 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**

23. 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”.

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

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

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

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

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

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

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

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

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

25. 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.”

26. 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 Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark:

*Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

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

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

27. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>10</sup> 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”<sup>11</sup> is not, therefore, genuine use.

28. 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.

[...]

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

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<sup>10</sup> *Jumpman*, Case BL O/222/16

<sup>11</sup> *Ibid.*



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.”

29. 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.”

30. The proprietor’s mark is a comparable mark based on an earlier EUTM. This means that use of the mark in the EU prior to (and including) IP Completion Day (being 31 December 2020) is relevant to the present assessment.<sup>12</sup> 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. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union noted that:

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

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than

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<sup>12</sup> See paragraph 4 of Tribunal Practice Notice 2/2020

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.”

31. 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.”

32. 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."

33. During these proceedings, the parties made various submissions in respect of the evidential burden and the case law that is relevant to the assessment of proof of use. The applicant's argument boiled the position down to being a three step test in that I must first examine the evidence relied on, then I must consider what does that evidence prove, as a whole, before making a determination as to what a fair specification is based on the use shown. The proprietor's argument in response

was that this was a 'divide and conquer' approach which did not take a wholistic view of the evidence. While I agree that I must take the evidence as a whole, this does not mean that just because it is voluminous and detailed that it is satisfactory in showing genuine use for all goods at issue. On this point I agree with the applicant in that if there are individual issues with different items of evidence that renders that specific evidence of little or no assistance, then that must affect the overall evidential picture. While I am entitled to make inferences based on the evidence before me, the sheer volume of evidence coupled with the fact that the proprietor is a large company does not simply mean that I must make every inference in favour of the proprietor. Put simply, if I am not satisfied that such an inference is reasonable to make then I will not make it. On this point, I remind myself of the comments of Mr Daniel Alexander Q.C. in *Plymouth Life* (cited above and also referred to by the applicant at the hearing) that I will be justified in rejecting evidence if it is insufficiently solid. I do not consider this a necessarily controversial approach and I will proceed to assess it in the ordinary way.

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

#### Class 14

##### *Horological and chronometric instruments.*

35. In support of a claim to have used the above goods, the proprietor has provided sample invoices covering sales to both internal companies within the Swatch Group for onward sales to UK consumers<sup>13</sup> and those that show sales to European corporate customers.<sup>14</sup> Following the invoice evidence, the proprietor has included

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<sup>13</sup> MKAH7

<sup>14</sup> MKAH8 to MKAH11

a number of images showing the range of watches that said invoices cover.<sup>15</sup> In respect of this evidence, the applicant argues that where the invoices cover internal shipments to other companies within the Swatch Group, they are to be treated as internal invoices and, as per the case of *Ansul* (cited above), should be disregarded. While the recipients of the goods on the invoices are Swatch Group companies, I am satisfied that they are parts of the distribution arm of the group and constitute distribution invoices. Therefore, I consider that they should be treated in the ordinary way, i.e. as if they were shipped to third party retailers. In such circumstances, it is ordinary for distribution invoices to be used to support a claim of use. Therefore, I consider it reasonable to infer from the invoices that they were meant for onward sale to consumers in that country and I have nothing before me to suggest that these goods were not eventually sold on to consumers.

36. A breakdown of the EU invoices has been provided in the narrative evidence that shows the wholesale of €461,836.61 worth of watches between 2017 and 2020.<sup>16</sup> As for the UK invoices, the evidence includes just one invoice from 2018 that shows the sale of one watch for a retail price of £4,248.00. The narrative evidence from Ms Koenig and Mr Haller sets out that the sales figures provided are not reflective of the total level of sales for JAQUET-DROZ watches and only represent a ‘fraction’ of the total sales in the EU. I have some issue with the reference to the use being representative of only a ‘fraction’ of the proprietor’s sales on the basis that this is a very broad and subjective statement. I have nothing to suggest what fraction is being referred to.

37. The proprietor claims that it has incurred significant advertising and marketing budgets. No figures of actual expenditure is provided; however, I note that the proprietor has filed evidence in support of such a claim. This includes copies of the proprietor’s catalogues during the relevant period.<sup>17</sup> The evidence sets out that these are widely distributed and the English language copies have been sent to 1,244 people in the EU between 2017 and 2021. While this is not a particularly

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<sup>15</sup> MKAH12

<sup>16</sup> See paragraph 7 of the witness statement of Ms Koenig and Mr Haller

<sup>17</sup> MKAH13 to MKAH16

widespread level of distribution, it is sufficient in demonstrating that the proprietor attempts to market its brand. In terms of examples of advertising, I note that the proprietor has provided evidence that shows the presence of adverts in *The Economist* magazine between 2017 and 2019.<sup>18</sup> I note that these show nine adverts across different editions of the magazine and clearly point to the incurring of some advertising expenditure. Further, in support of this point, I note that the proprietor has provided evidence as to the readership figures for *The Economist*.<sup>19</sup> I will not go over these in any detail save to say that they reflect a fairly widespread level of readership.

38. In my view, the turnover figures provided are, in comparison to the likely size of the watch market in the EU, are very low. Having said that, I bear in mind that (1) use does not need to be quantitative for it to be deemed genuine, (2) the nature of the goods shown in the evidence (being expensive goods) and (3) the clear attempts at advertising and marketing the brand. Taking all of the evidence into account, I am of the view that it is sufficient in demonstrating that it has genuinely used its mark on goods that fall within the above term. 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.

39. The proprietor submitted that there are a number of authorities that provide support for the full specification being maintained despite use only being shown for one category of goods. These authorities include the *Euro Gida* and *Titanic Spa* cases (both of which are cited above). In addition, the proprietor made reference to the case of *Guccio Gucci SPA* (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*<sup>20</sup> in support of the argument that

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<sup>18</sup> MKAH17

<sup>19</sup> MKAH18

<sup>20</sup> [2015] EWCA Civ 220

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.

40. 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'.<sup>21</sup> While these decisions are noted, neither of them are binding upon me and I will say no more about them.

41. 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 goods<sup>22</sup> 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

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<sup>21</sup> HAMILTON & INCHES, Case BL O/090/17

<sup>22</sup> While services are specifically referred to in the *Titanic Spa* case, the question applies equally to goods, as is the case here.



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.

42. 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 *horological 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 would use that term to describe the use shown 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.

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

44. 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).<sup>23</sup> 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'.

45. 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.

46. In respect of the fair specification point, I note that submissions were put before me regarding the effect of the Nice Classification. Throughout these proceedings, Mr Selmi made reference to the case of *Pathway*<sup>24</sup> 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 I find that the addition of an exclusion regarding 'connected watches' and 'smartwatches' would not assist in adding clarity. I consider that the exclusion of such in a class 14 specification serves no purpose (they are naturally excluded by virtue of being class 9 goods, in

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<sup>23</sup> Additional references to other goods were mentioned but, for illustrative purposes, I have only mentioned one example.

<sup>24</sup> *Pathway IP SARL v Easygroup Ltd* [2018] EWHC 3608 (Ch)

any event) and would not be something that average consumers would refer to in their description of the goods shown in evidence.

*Among other, all horological and jewellery products, artistic automatic devices made of precious materials, in particular animated automatic devices incorporating precision mechanisms and movements similar to horological instruments.*

47. The construction of the above term is such that it could be said to cover all horological and jewellery products and while there appears to be a focus on animated automatic devices incorporating precision mechanisms and movements, the term is not limited to these goods only. This is on the basis that 'in particular' is not a limitation in the same way that 'namely' is. In any event, the arguments during the hearing in respect of the above term focused on animated automatic device. At the hearing, Mr Selmi took me to some examples of goods that the proprietor claims to fall within the above term. For illustrative purposes, rather than attempt to describe these goods, I have reproduced images of them below together with the proprietor's description of the same:



BIRD REPEATER  
ALPINEVIEW - J031034205

Hand-engraved and hand-painted white mother-of-pearl dial. Hand-engraved 18-karat white gold case. Hand-engraved and hand-painted 18-karat white gold appliques. Mechanical automaton with animation featuring birds, hatching egg and waterfall. Minute repeater, hand-wound mechanical movement. Power reserve of 48 hours. Diameter 47 mm. Numerus Clausus of 8.



TROPICAL BIRD REPEATER  
J033034200

Hand-engraved and hand-painted white mother-of-pearl dial. Hand-engraved 18-karat white gold case. Hand-engraved and hand-painted 18-karat white gold appliques. Mechanical automaton with animated peacock, tropical leaves, hummingbird, toucan, dragonflies and waterfall. Minute repeater, hand-wound mechanical movement. Power reserve of 50 hours. Diameter 47 mm. Numerus Clausus of 8.

48. I note that there is additional evidence relating to an automated singing bird that sits within a cage.<sup>25</sup> However, the evidence sets out that this device was released circa 1780. While Mr Selmi referred to this product when making his submissions in respect of the background of the brand, he did not appear to rely on it in terms of genuine use for the above term. For the avoidance of doubt, this product is of no assistance to the present case given that there is no evidence of its sale during the relevant period.

49. I note that throughout the evidence, there are additional watches that contain some form of animated automatic device. This includes a range of watches that are embedded with additional bird devices (I note that these include pocket watches also)<sup>26</sup> and flower devices<sup>27</sup> that opens and closes at the touch of a button.

50. While I appreciate that the animated automatic devices are incorporated within the watches themselves, there is nothing before me regarding the sale of those goods in solus. I do not consider that the fact that they are embedded in the watch is sufficient to demonstrate use of those goods. On this point, I refer to the case of *Galileo International Technology, LLC v European Union*<sup>28</sup> wherein Floyd J stated at paragraph 48 that:

“The average consumer does not see the sale of a car as a sale of climate control systems or computers or satellite navigation systems, although cars are now often sold with such built-in functionality.”

51. While not a like for like comparison, the same principle applies here in that the average consumer, upon buying one of the proprietor’s watches shown or described above, would not see the sale of an automated animated device. While it may be an attractive force that the average consumer bases his/her purchase on, it is not the sale of an automated animated device and the consumer will,

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<sup>25</sup> See page 7 of MKAH2

<sup>26</sup> See pages 14 to 16 of MKAH2

<sup>27</sup> See pages 17 to 18 of MKAH2

<sup>28</sup> [2011] EWHC 35 (Ch)

instead, view the purchase as simply covering the selection of a watch. As such, regardless of any use of these specific watches, they do not constitute use of the above term. On this point, I note that the proprietor's mark remains protected for "watches" at large and I do not consider the lack of retainment for this term restricts the proprietor from using its mark on watches that incorporate automatic animations (in the same way as demonstrated in the examples in the evidence). Taking all of this into account, I find that the proprietor has filed no evidence of genuine use in respect of this term.

*Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; precious stones.*

52. 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. I note that in support of this claim, the proprietor has provided invoices that show the sale of €232,689.20 worth of 'timepieces with precious metals, their alloys or precious stones' in the EU between 2017 and 2020.<sup>29</sup> The proprietor argues that the use of precious metals and precious stones as parts of composite items establishes genuine use in relation to the constituents. At the hearing, Mr Selmi took me to a page of the proprietor's catalogue that sets out that the proprietor uses minerals and stones in its watches.<sup>30</sup> While I appreciate that the proprietor has filed evidence of sales for such goods, nothing much 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.

53. While the above finding is noted, the same cannot be said for "goods made of these materials or coated therewith" (insofar as it can be used to relate to precious metals

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<sup>29</sup> See MKAH8 to MKAH11

<sup>30</sup> See page 5 of MKAH13

and their alloys on the basis that no such protection exists for ‘precious stones’)<sup>31</sup> as use of watches in these materials would satisfy use of the 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”.

### *Jewellery.*

54. At the hearing and in respect of the above goods, Mr Selmi stated that jewellery has the same nature, purpose, end users and similar channels of distribution of the proprietor’s timepieces. I disagree with the claim that the nature and purposes are the same, however, such a claim is of no assistance in any event. The issue here is not whether such goods are similar but whether use of watches supports a claim that the proprietor should retain jewellery in its specification. 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 evidence demonstrating use in relation to watches is of any assistance to the proprietor on this point. Alternatively, if I am wrong to find that a watch is not an item of jewellery, then the proprietor is adequately protected for such by virtue of retaining “watches” in its specification. In my view, if watches are a subset of jewellery, then it would form its own distinct sub-category and would be identified as such by the average consumer.

55. The only additional evidence before me that can be said to cover goods under the above term is in relation to two pairs of cufflinks.<sup>32</sup> While the presence of these

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<sup>31</sup> On the basis that the above terms cannot be said to cover ‘goods made of precious stones’

<sup>32</sup> Page 9 and 25 of MKAH2

cufflinks is noted, there is nothing indicating any level of sales associated with them. Regardless of whether or not the proprietor operates a successful business operation in relation to watches, I am not willing to infer that the mere existence of two cufflinks in a catalogue is sufficient to demonstrate that the proprietor has genuinely used such goods. On this point, I am of the view that it is reasonable to expect evidence of such sales to have been provided by the proprietor. As a result and in light of my findings in the preceding paragraph, I find that there is no genuine use for “jewellery”.

*Parts and components of the aforementioned goods included in class 14.*

56. In light of the findings I have made throughout this decision, the above term is only applicable to ‘parts and components’ of watches. It appears to me that this is a position that the proprietor accepts on the basis that the only evidence referred to in support of such a claim is in relation to parts and components of its watches.

57. The proprietor’s evidence sets out that its watches are intricate goods made of many component parts which it sells to customers in the UK and EU. The proprietor confirms that it offers its customers an authorised after-sale service centre in the UK which, amongst other things, performs repairs and replaces broken watch parts.<sup>33</sup> A print-out taken from the proprietor’s website is provided that shows a Swatch after sales service in Southampton, UK. The evidence states that the first servicing of a JAQUET-DROZ’ timepiece at this service centre was in 2011 and the servicing of JAQUET-DROZ watches continues to this day. The only evidence in support of the provision of watch parts or components from this service centre is in the form of eight invoices dated between 4 August 2017 and 29 November 2018.<sup>34</sup> These invoices show the provision of nine watch straps and two watch buckles to the same address that is listed on the aforementioned print-out, being the Swatch services location. On balance, I am satisfied that while these invoices are internal (in the sense that they are provided to companies within the Swatch Group), they represent the provision of goods to end consumers who sought watch

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<sup>33</sup> See paragraph 21 of the witness statement of Ms Koenig and Mr Haller

<sup>34</sup> MKAH34

repair/replacements from the proprietor. While that may be the case, the level of sales associated covered by the invoices is miniscule and cover a limited period of just over one year in the UK only. I appreciate that the invoices are referred to as sample invoices but I have nothing sufficiently solid before me to assist me in determining the actual level of sales associated with these goods, let alone other types of watch parts/components. On this point, I am of the view that it would have been relatively straight forward for the proprietor to have provided information in respect of how many customers had used its services, even if it was limited to only providing sample invoices. Without anything further, I do not consider it appropriate to infer that the level of sales for watch parts and component would be at a level sufficient enough to demonstrate genuine use of the same. On this point, I refer again not only to Section 100 of the Act which places the burden of the proprietor, but also the case of *Plymouth Life* which sets out that I am entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material provided is inconclusive. In the present case, the mere provision of eight invoices covering the provision of 11 'replacement parts' for a period of just over one year is simply not enough to demonstrate genuine use of the above term.

## **CONCLUSION**

58. The outcome of this decision is that the proprietor's mark is to be revoked for the following goods:

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; among other, all horological and jewellery products, artistic automatic devices made of precious materials, in particular animated automatic devices incorporating precision mechanisms and movements similar to horological instruments; parts and components of the aforementioned goods included in class 14.



59. The mark may, however, remain registered for not only those goods that I have found use for (being those I have determined as being reflective of a fair specification) but also those class 28 goods that were not subject to this revocation. Those goods are as follows:

Class 14: Watches.

Class 28: Games and playthings, automatic play devices, artistic automatic devices, animated automatic devices, in particular so-called "android" automatic devices (writers, designers, musicians, etc), as well as the parts and components of the aforementioned goods included in class 28.

60. As I have set out above, the proprietor did not seek to file any evidence in respect of the earlier relevant period in respect of the 46(1)(a) grounds. Instead, it chose to rely on the provision set out in section 46(3) of the Act. This means that where the mark is to be revoked, it is to be done so from the earliest date sought. Therefore, the revoked goods under the proprietor's mark have an effective revocation date of 18 December 2003.

## **COSTS**

61. 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.

62. 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**

63. 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 6<sup>th</sup> day of November 2023**

**A COOPER**

**For the Registrar**