

O/1047/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 505032 AND 505096

TO REVOKE ON THE GROUNDS OF NON-USE  
REGISTRATION NOS. UK00903441722 AND  
UK00801328990 FOR THE FOLLOWING MARKS:

**BLANCPAIN**

IN CLASS 14

AND

**BLANCPAIN**

IN CLASS 9

OWNED BY

BLANCPAIN SA (BLANCPAIN AG) (BLANCPAIN LTD)

## BACKGROUND AND PLEADINGS

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

BLANCPAIN

Registration no. UK00903441722<sup>1</sup>

Filing date 23 October 2003; registration date 6 May 2005

Seniority date 27 February 1956

Registered for the following goods:

Class 14: Precious metals and their alloys and goods in precious metals, not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments.<sup>2</sup>

(“the proprietor’s first mark”)

BLANCPAIN

Registration no. UK00801328990

Filing date 22 September 2016; registration date 28 June 2017

Priority date 24 March 2016

Registered for the following goods:

Class 9: Apparatus for recording, transmission and reproduction of sound or images; electronic payment processing apparatus, apparatus for processing cashless payment transactions; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus used for playing compressed sound files (MP3 files); calculating machines and

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<sup>1</sup> The proprietor’s marks are comparable trade mark based on either a pre-existing EUTM (being EUTM no 3441722) or a pre-existing International Registration that designates the EU (being IR no 1328990). 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 or IRs designating the EU.

<sup>2</sup> The mark, as registered, consists of a typographical error in that it includes the term ‘horological and chronometric instruments’. Clearly, this is meant to be ‘horological and chronometric instruments’ and I will proceed to consider it as such for the remainder of this decision.

data processing equipment, software; 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, mobile computers, personal computers, wrist computers, smartwatches, electronic tablets and computerized and mobile devices, digital personal stereos, mobile telephones and new-generation mobile telephones with greater functionality (smartphones); telecommunication apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images, particularly mobile telephones and new-generation mobile telephones with greater functionality (smartphones); hand-held electronic apparatus for accessing the Internet and sending, receiving, recording and storing short messages, electronic messages, telephone calls, faxes, video conferences, images, sound, music, text and other digital data; handheld electronic apparatus for wireless reception, storage and transmission of data or messages; handheld electronic apparatus for monitoring or organizing personal information; handheld electronic apparatus for global positioning [GPS] and displaying maps and transport information; handheld electronic devices for detection, storage, monitoring, surveillance and transmission of data relating to user activity, namely position, itinerary, distance traveled, heart rate; covers for computers, portable and mobile telephones; optical apparatus and instruments particularly spectacles, sunglasses, magnifying glasses, smart glasses; cases for spectacles, sunglasses and magnifying glasses; batteries for electronic apparatus and computers, batteries for timepieces and chronometric instruments.

("the proprietor's second mark")

2. On 27 June 2022, Samsung Electronics Co., Ltd. (“the applicant”) applied to partially revoke the proprietor’s first mark and, on 8 July 2022, applied to fully revoke the proprietor’s second mark. In respect of the proprietor’s first mark, the applicant seeks the revocation of all goods, save for “analogue watches”. Both applications were brought in reliance upon sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“the Act”).
3. Beginning with the application aimed at the proprietor’s first mark, the period during which the applicant alleges non-use under section 46(1)(a) is the five years after registration of the mark, being 7 May 2005 to 6 May 2010 with revocation sought from 7 May 2010. Under its section 46(1)(b) ground, the applicant is alleging non-use of the mark for the period of 27 June 2017 to 26 June 2022, with revocation sought from 27 June 2022, being the date of the application at issue.
4. As for the application aimed at the proprietor’s second mark, the period during which the applicant alleges non-use under section 46(1)(a) is the five years after the date of protection of the mark in the UK, being 29 June 2017 to 28 June 2022 with revocation sought from 29 June 2017. Under its section 46(1)(b) ground, the applicant is alleging non-use of the mark for the period of 8 July 2017 to 7 July 2022, with revocation sought from 8 July 2022, being the date of the application at issue.
5. The proprietor filed counterstatements wherein it defended all of the goods subject to the application against the first mark but, in respect of the second, it only sought to defend some goods. Those goods that were not defended are as follows:

“Magnetic recording media, sound recording disks; compact disks; apparatus used for playing compressed sound files (MP3 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; mobile computers, personal computers, electronic tablets, digital personal stereos, mobile telephones and new-generation mobile telephones with greater functionality (smartphones); apparatus for recording, transmission,

reproduction of sound or images, particularly mobile telephones and new-generation mobile telephones with greater functionality (smartphones); handheld electronic apparatus for accessing the Internet and sending, receiving, recording and storing faxes and video conferences; smart glasses.”

6. Both parties filed evidence in chief with the proprietor also filing written submissions alongside its evidence. A hearing took place before me on 3 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.
7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE**

8. The proprietor’s evidence in chief came in the form of the joint witness statement of Ms Mireille Koenig and Mr Antoine Haller dated 5 December 2022. Ms Koenig is the Chief Legal Officer at The Swatch Group Ltd (“the Swatch Group”), a position she has held since 2016. Mr Haller is the Head of Trademarks and Designs at the Swatch Group, a position he has held since 2021. Prior to taking this role, Mr Haller was an Anti-counterfeiting Officer at the Swatch Group. Their statement is accompanied by 61 exhibits, being MKAH1 to MKAH61. 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>3</sup>

9. I note that the proprietor's evidence consists of exhibits in a foreign language. Translations of the same are included in the evidence and, in support of the accuracy of the same, a witness statement dated 6 December 2022 has been provided by Mr Matthew Schneider. Mr Schneider is a translator at Transperfect Legal Solutions and his evidence relates to translations from German to English. I do not intend to summarise Mr Schneider's statement but note that it confirms (1) what parts of Ms Koenig and Mr Haller's evidence has been translated and (2) his belief that the translations are accurate.
10. The applicant's evidence came in the form of the witness statement of Mr David Stone dated 20 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 nine exhibits, being DAS1 to DAS9.
11. Given the voluminous nature of the evidence filed, I do not consider it appropriate or necessary to summarise the entirety of the evidence throughout the course of my decision. I will, however, summarise it to the extent that I consider it necessary to do so at the relevant parts of my decision. For the avoidance of doubt, I confirm that I have taken all of the evidence and submissions into account.

## **PRELIMINARY ISSUES**

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

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<sup>3</sup> MKAH1

## High Court proceedings and the related revocation proceedings

13. Throughout these proceedings, there has been reference by both parties to proceedings in the High Court of England and Wales between the applicant and several companies within the Swatch Group (the proprietor being one of them).<sup>4</sup> The outcome of the High Court proceedings was the granting of an injunction in favour of the Swatch Group.<sup>5</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.

14. On the point of the High Court proceedings, I note that there has also been mention of the judgment of Falk J wherein she stated at paragraph 175 that:<sup>6</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 intended to imitate or at least to pay homage to the relevant marks, including exclusive marks such as Jaquet Droz. That rather demonstrates the existence of a reputation.”

15. While I accept that it may very well be the case that the proprietor and other companies within the Swatch Group enjoy a reputation, this is not at issue here. Further, it does not follow that because Falk J found there to be a reputation in the

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<sup>4</sup> *Montres Breguet SA & Ors v Samsung Electronics Co. Ltd* [2022] EWHC 1127 (Ch)

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

<sup>6</sup> A copy of the full judgment is exhibited at DAS3

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

### Relevant periods

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

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

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”

17. So long as I am satisfied as to use and provided that said use commenced or resumed prior to the period of three months before the application dates of the present proceedings, I agree with the proprietor's position in that the earlier relevant periods are of no real consequence to the genuine use assessment I must make. That being said, it follows that if there is no use in respect of the latter



relevant periods, the proprietor's failure to file any evidence in relation to the earlier relevant periods means that the revocations will take effect from the earliest sought revocation dates. So while I will make no reference to the earlier periods in my assessments below, they may still have effect on these proceedings.<sup>7</sup> 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 for the first mark and 8 July 2017 to 7 July 2022 for the second.

### The proprietor's evidence

18. Prior to the hearing, the applicant filed a skeleton argument that contained detailed and extensive criticisms of the proprietor's evidence. Having reviewed and considered the issues raised by the applicant, I note that the majority of them relate to criticisms of the evidence insofar as they fail to demonstrate genuine use. While Mr Stone did not seek to raise all of these issues at the hearing, Mr Selmi set out that it was not appropriate for the applicant to raise these issues at such a late stage in the proceedings (being the skeleton argument stage) without formally challenging the evidence. While this point is noted, it is not necessary that the applicant raises such issues in evidence or request to cross-examine witnesses. On the contrary, it is common in proceedings before the Tribunal for an opposing party to raise issues with the sufficiency of the other side's evidence at the hearing stage or via written submissions in lieu. Further, I remind myself that the onus is on the party bearing the burden of proving use to file its best case as evidence in chief. Having said that, I do appreciate that where the party challenging the evidence appears to have avoided criticising the accuracy or sufficiency of it during the written procedure, only to unveil an extensive attack on its accuracy and sufficiency after the evidence rounds have closed, there is potential for unfairness. In the present case, I appreciate that the applicant's critique of the proprietor's evidence is extensive and was not unveiled until mere days before the hearing. However, in respect of the former point, I remind myself that the evidence filed in these proceedings was voluminous and spread over 61 exhibits. In such

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<sup>7</sup> On this point, I note that revocation of the undefended goods in the Class 9 mark will take effect from the earlier date.

circumstances, it is not unsurprising for any criticisms of the same to also be extensive. In respect of the latter point, I note Mr Selmi's issues with the applicant's approach but note that he did not seek to make an application to allow for the proprietor to file evidence in response to the criticisms made. While I will say no more about this issue, I wish to point out, for the avoidance of doubt, that while I will give consideration to the applicant's criticisms, the conclusions I will reach in this decision will be based on my own assessment of the evidence before me.

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

20. The second issue raised relates to the evidence at large being discredited by the false statement by Ms Koenig and Mr Haller that "it is clear from the above that Blancpain has made genuine use of the Mark for the goods on its specification during the period in question."<sup>8</sup> The applicant argues that this statement is 'obviously incredible'<sup>9</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

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<sup>8</sup>See paragraph 34 of the witness statement of Ms Koenig and Mr Haller

<sup>9</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.

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>10</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

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

22. I note that in its skeleton argument prior to the hearing and also via oral submissions from Mr Stone at the hearing, the applicant sought to introduce a

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<sup>10</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.

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

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

## **DECISION**

24. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

25. Given that the proprietor’s 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”.

26. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

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

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the



goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

28. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>11</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>12</sup> is not, therefore, genuine use.

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

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<sup>11</sup> Jumpman, Case BL O/222/16

<sup>12</sup> *Ibid.*

“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 the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

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

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

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

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

for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

31. The proprietor’s 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.<sup>13</sup> By virtue of being a Member State prior to this date, the UK still forms part of the relevant territory of the EU. From 1 January 2021 onwards, however, the relevant territory is the UK only. In relation to the period during which use in the EU is relevant, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union noted that:

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

And

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

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<sup>13</sup> See paragraph 4 of Tribunal Practice Notice 2/2020

mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

32. 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.”

33. 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."

34. Before proceeding to consider the relevant assessment, I wish to discuss the volume of the proprietor's evidence. By my count, the proprietor's evidence in chief (excluding the translated evidence and cover pages for the exhibits) is 291 pages in length. While this falls within the guidelines of the Tribunal, being 300 pages for evidence in chief as set out in Tribunal Practice Notice 1/2015 ("the TPN"), I note that there is a significant amount of evidence wherein several pages of documents are laid out on one page. While not an exhaustive list of examples where this practice has taken place, I refer to Exhibit MKAH4 which is made up of 69 invoices over 35 pages,<sup>14</sup> Exhibit MKAH2 which is all presented as just one page but is

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<sup>14</sup> The same approach has been taken for the majority of the invoice evidence provided

clearly multiple pages from websites condensed onto one elongated page<sup>15</sup> and Exhibit MKAH14 which consists of 19 pages of a magazine condensed to just 10 pages.<sup>16</sup> 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.

35. 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

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<sup>15</sup> I note that these pages, when printed into the hearing bundle, were illegible so it is only possible to view them in an electronic format.

<sup>16</sup> As was the case with the invoices, this approach has been taken for the majority of the press coverage evidence provided also.

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.

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

### The proprietor's first mark

#### *Horological and chronometric instruments.*

37. 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 wholesale invoices showing the sale of BLANCPAIN goods to some of its corporate customers in the UK between 2017 and 2022.<sup>17</sup> In addition, it has provided sample invoices of sales made by the proprietor's London boutique store between 2018 and 2022.<sup>18</sup> The narrative evidence sets out that the invoices cover a range of timepieces such as its 'Fifty Fathoms', 'Villeret', 'Air Command Flyback Chronograph' collections and also its women's collection models. I note that examples of these timepieces are shown via catalogue evidence.<sup>19</sup> Having reviewed the invoices, there is nothing to suggest that they cover anything other than the aforementioned timepieces. The proprietor has calculated the total sales figures for the invoices and I note that the wholesale invoices amount to £742,179.00 and the boutique invoices amount to £264,040.00. The proprietor

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<sup>17</sup> MKAH4

<sup>18</sup> MKAH6

<sup>19</sup> MKAH7



confirms that this turnover is taken from sample invoices only and should not be taken to represent the total sales in the UK. In addition to these invoices, the proprietor has also provided evidence pointing to its retail presence in the UK (via physical and online retailers),<sup>20</sup> its press coverage<sup>21</sup> and its advertising and marketing efforts.<sup>22</sup> I do not intend to go over this in any detail but note that while the proprietor has not provided figures as to its marketing expenditure, the narrative evidence confirmed that it is significant.

38. The total turnover provided by these invoices amounts to an approximately sales level of £1,006,219 worth of watches in the UK during the relevant period.<sup>23</sup> When considering this against the likely size of the relevant market, I am of the view that they represent a low level of sales. I appreciate the proprietor's position that the invoices do not reflect the entirety of the business but I have been given no information as to the true scale. I note that I have been provided with a reference to the invoices covering only a 'small fraction' of sales but I have nothing to determine what a fraction is being referred to. Having said that, I am satisfied that, upon taking all of the evidence into account, the proprietor has demonstrated 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

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<sup>20</sup> See MKAH9, 10 and 11

<sup>21</sup> See, for example, MKAH19 and 21 which includes excerpts from *The Economist* and *Time* magazine, respectively

<sup>22</sup> See, for example, MKAH7, 14 and 15

<sup>23</sup> I say approximate on the basis that some invoices are wholesale and may not be reflective of the final sale price of those goods.

chronometric apparatus and instruments”. In response, the applicant referred to the case of *Roger Maier and Another v ASOS*<sup>24</sup> 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.

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>25</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>26</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

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<sup>24</sup> [2015] EWCA Civ 220

<sup>25</sup> HAMILTON & INCHES, Case BL O/090/17

<sup>26</sup> While services are specifically referred to in the *Titanic Spa* case, the question applies equally to goods, as is the case here

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.

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. In light of the above, the issue now before me is what specification is appropriate. The applicant’s case is that the specification should be limited to either “analogue watches” or “watches other than connected watches or smartwatches”. During the hearing, Mr Selmi set out that the average consumer would not categorise the goods in such an artificial way. In respect of the term ‘analogue watches’, I agree with Mr Selmi and I see no reason why the average consumer would, upon being confronted with a series of watches, seek to describe them using the precise type of watch that they are. Even if it were the case that an undertaking only sold analogue watches (or digital ones, for that matter), I see no reason why the average consumer would look to make such a distinction in their description of the same.<sup>27</sup> As a result, I reject the applicant’s pleaded case that these goods should be limited to ‘analogue watches’.

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<sup>27</sup> 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.

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>28</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. At the hearing, Mr Selmi made reference to the case of *Pathway*<sup>29</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

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<sup>28</sup> Additional references to other goods were mentioned but, for illustrative purposes, I have only mentioned one example.

<sup>29</sup> *Pathway IP SARL v Easygroup Ltd* [2018] EWHC 3608 (Ch)

and precise in describing the goods at issue. As a result, I see no reason why the Nice Classification would be relevant and 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 stones.*

47. I appreciate that the proprietor sells goods that incorporate precious stones.<sup>30</sup> However, the above term does not cover goods made of or incorporating precious stones but, instead, covers the actual precious stones themselves. As the applicant has put forward, there is no evidence to suggest that the proprietor operates in the diamond trade, for example. As such, there is nothing before me to suggest that the proprietor has used its mark on the sale of precious stones and, without such, I am not willing to find that it has made a genuine attempt to create or preserve a market share in the same. Therefore, I find that no evidence of genuine use has been provided for "precious stones".

*Jewellery, costume jewellery.*

48. The proprietor's position is that in addition to what it refers to as "uncontroversial items" such as ladies' watches, it also sells other items of jewellery such as cufflinks made of 18ct white and red gold.<sup>31</sup> Firstly, while I appreciate that there may be a degree of similarity between watches and jewellery, 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

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<sup>30</sup> See, for example, page 5 of MKAH24, which shows a watch that incorporates diamonds in its bezel.

<sup>31</sup> While not expressly pleaded, I note that invoices provided at MKAH44 include leather key chains. For the avoidance of doubt, I do not consider that a leather keychain is an item of jewellery so, even if it were relied upon, it would be of no assistance.

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.

49. As set out above, the proprietor claims to also sell cufflinks. The supporting evidence on this point comes in the form of images from the proprietor’s website dated 29 October 2020 showing two cufflinks.<sup>32</sup> Additionally, there is one invoice dated 14 December 2021 that shows the sale of one set of cufflinks for a total of £3,200.<sup>33</sup> The recipient of the product is completely redacted but the narrative evidence states that it was from the sale of the product at the London boutique store. Further, I note that London is mentioned on the invoice itself. This represents the totality of the proprietor’s jewellery evidence. It is my view that this evidence is vanishingly small and, without anything further, I am unwilling to make an inference that it is sufficient to demonstrate that the use of the same is at a level sufficient enough for it to be deemed genuine within the meaning of the case law. I appreciate that the proprietor may operate a successful business in relation to watches, however in the circumstances, I consider it is reasonable to expect that if the proprietor had genuinely used its mark on these goods then it should have been able to provide sufficiently solid evidence to demonstrate as such. Without such evidence, and in light of my findings in the preceding paragraph, I find that there is no genuine use for “jewellery”. For the avoidance of doubt and for the same reasons given throughout the present assessment, I find that there is also no genuine use for “costumer jewellery”.<sup>34</sup>

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<sup>32</sup> MKAH35

<sup>33</sup> MKAH34

<sup>34</sup> I note that the applicant put forward an argument as to the definition of costume jewellery but, in light of the lack of evidence, I do not consider it necessary to address this any further.

*Precious metals and their alloys and goods in precious metals, not included in other classes.*

50. The proprietor's case in respect of the above goods is that some of its watches contain precious metals and precious metal alloys. While I appreciate that the proprietor has filed evidence that its watches are made of precious metals and their alloys, it is of no assistance to the proprietor in respect of "precious metals and their alloys". This is on the basis that I do not consider that use of watches in precious metals or their alloys is sufficient use of "precious metals and their alloys". 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" must fail. On this point, I also note that the proprietor claims that one of its models of watches comes in 'Sedna Gold', being a proprietary combination of gold, copper and palladium. While this is noted, the evidence simply suggests that one of its goods are made from this material and not that the proprietor sells this product in its raw form under the BLANCPAIN branding.

51. While the above finding is noted, the same cannot be said for "goods in precious metals, not included in other classes" as use of watches in these materials would satisfy use of the same. As I have set out above, I accept that the proprietor's watches are made of such materials. However, I do not consider that an assessment of use for such goods is necessary. The reason for this is twofold. Firstly, the proprietor has only provided evidence of genuine use for watches meaning that any such retainment of the above term would be limited to "watches in precious metals." Secondly, I have found genuine use for "watches" and as that term is not limited to the materials with which those goods may be made, it can reasonably be said to cover watches made in precious metals. 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".

## The proprietor's second mark

52. As set out above, the proprietor sought to defend only some of the class 9 goods for which revocation is sought. In its skeleton argument, the proprietor only referred to a limited set of those defended class 9 goods and, at the hearing, Mr Selmi confirmed that the proprietor was happy to drop its defence in relation to all class 9 goods save for the following:

“Other digital recording media; software; apparatus for recording, transmission and reproduction of sound or images; telecommunication apparatus and instruments; calculating machines and data processing equipment software; covers for portable and mobile telephones; optical apparatus and instruments particularly magnifying glasses.”

53. As such, I will proceed to consider the above goods only. For the avoidance of doubt, all of those class 9 goods not referred to above will be revoked.

### *Other digital recording media.*

54. In relying on use of the above term, the proprietor claims to have genuinely used its mark on branded USB sticks. Images of these USB sticks are provided in the evidence and I note that those include BLANCPAIN branding.<sup>35</sup> In addition to this, there are two invoices that show the shipment of USB sticks.<sup>36</sup> Both invoices are addressed to Swatch Group companies in the UK. The first invoice covers the shipment of 15 USB sticks and the order is described as being ‘Boutique Blancpain’ and the second covers the shipment of 50 USB sticks with the order being described as ‘NHM Event’. In respect of the latter description, Mr Stone submitted at the hearing that ‘NHM’ stood for ‘Natural History Museum’ and that the goods were shipped so that they would eventually be given away by the proprietor at said event. On the point of the meaning of NHM, I do not accept that this should be taken to mean ‘Natural History Museum’ and I note that I have no evidence before

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<sup>35</sup> MKAH45

<sup>36</sup> Pages 9 and 11 of MKAH44



me to suggest that this is what it means. Having said that, I accept that the presence of 'Event' in the order description indicates that the goods are for an event, regardless of what that event is. As such, I agree with the applicant's position in that there is nothing before me to suggest that the invoice represents sales to end consumers and, without anything further, I am not willing to find as such. This is particularly the case given that the invoices are internal. On this point, I appreciate that invoices to internal distribution arms of a company may be capable of representing sales to end users, however in the present circumstances, the reference to the goods being ordered for an event indicates to me that they are for promotional purposes.<sup>37</sup> As a result, the shipment of goods containing the description 'NHM Event' are no assistance to the proprietor. As for the invoice regarding the order 'Boutique Blancpain', I accept that this description can reasonably be said to be in relation to goods ultimately sold at the London boutique and I have no reason to believe otherwise.

55. In light of what I have said above, the evidence before me is in relation to the sale of 15 USB sticks in the UK during the relevant period. The nature of USB sticks is such that they are relatively inexpensive goods. Further, it is my understanding that the market for these goods is such that it attracts frequent sales at a high volume. As such, I consider that the sale of 15 USB sticks across the relevant territory during the relevant period is vanishingly small. While the proprietor may be a successful watch brand, this does not mean that I should automatically infer that any use for goods such as USB sticks should be found to be genuine. Without anything further, I find that the proprietor has failed to demonstrate genuine use for the above goods.

#### *Software.*

56. The proprietor's position in respect of the above term is that it produces mobile phone applications. In support of this the proprietor refers to the Blancpain GT Series mobile application from 2017, of which a screenshot of the home page is

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<sup>37</sup> On this point, see paragraphs 20 to 21 of *Silberquelle* (cited above) which sets out that the provision of promotional items are not distributed in any way with the aim of penetrating the market for goods in the same class.

provided.<sup>38</sup> Further, the proprietor has filed evidence of a screenshot taken from the Google Play store showing the availability of an application called 'Blancpain Library'. Dealing with this evidence in turn, I appreciate that the proprietor's branding is emblazoned on the GT Series mobile application, however, I do not consider that it is of any assistance. This is on the basis that the evidence sets out that the GT Series is an organised racing event that the proprietor simply sponsors and I have nothing before me to suggest that it actually produces and distributes the application itself. Further, no download figures have been provided for this application so even if I were satisfied that it was something that was produced and distributed by the proprietor, the evidence is insufficiently solid to demonstrate that the proprietor has genuinely used its mark on such goods during the relevant period. Turning to the Blancpain Library app, I do not consider that this is of any assistance either. This is on the basis that the screenshot appears to have been taken from the US version of the Google Play store so it is not clear whether this application was available to UK or EU consumers. Further, the download figures set out that there had been '100+' downloads at the time of the screenshot being taken (it is not clear when this was). This is a very vague reference to download figures and could, at the very least, be said to cover just over 100. Alternatively, it could cover far in excess of 100. Either way, the evidence is clearly insufficiently solid and without anything to guide me on more accurate download figures, I am unable to determine an accurate level of use. Given that the burden to prove use is on the proprietor, I am unwilling to infer that the downloads (even if they could be said to relate to the relevant territory) are at a level sufficient to find genuine use of the above term.

57. Taking all of the above into account, I find that the proprietor has failed to demonstrate that it has genuinely used its mark in relation to any goods that can be said to fall within the above term.

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<sup>38</sup> MKAH52

*Apparatus for recording, transmission and reproduction of sound or images; telecommunication apparatus and instruments; calculating machines and data processing equipment software.*

58. The proprietor's position in respect of the above terms is that it operates as the official timekeeper for GT Racing<sup>39</sup> and that this is sufficient to prove use of the same. On this point, I note that the evidence includes print-outs showing results from a GT Series race in 2017 that includes the BLANCPAIN branding.<sup>40</sup> Further, there is a print-out dated 15 September 2018 taken from the GT Series website that, again, shows the BLANCPAIN branding. At the hearing, Mr Selmi set out that the provision of this service involves a complicated array of timekeeping equipment. I note that the supporting explanation of this service in the narrative evidence sets out that the time measurements for these races are taken via sensors placed along the racetrack (such as photocells for immediate timing) and that the system is operated via transponders, auxiliary cameras and, since 2018, a GPS system.<sup>41</sup> It is confirmed that all of these devices work together to gather information that is communicated instantly to the proprietor's computers.

59. While I do not doubt that the timekeeping services offered to GT Racing by the proprietor involve a complicated set up of devices, it is my view that the evidence, at best, demonstrates the provision of a service and not the actual provision of any goods. There is no evidence to suggest that the customer (being GT Racing) actually purchases and retains the goods used in the course of providing this service. Just because those services may include setting up the devices discussed in the preceding paragraph, this is not the actual provision of those goods in line with the commercial *raison d'être* of the mark. Taking all of the above into account, I am not convinced that the evidence that Mr Selmi took me to points towards use of any goods that can be said to fall within the above term. At best, this evidence

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<sup>39</sup> See paragraph 27 and 31 of the witness statement of Ms Koenig and Mr Haller.

<sup>40</sup> MKAH6

<sup>41</sup> While I accept that the entire system of data acquisition and the monitoring of the performance is entirely managed by the proprietor, the evidence confirms that some race tracks provide their own sensors and photocells. On this point, see both paragraph 31 of the witness statement of Ms Koenig and Mr Haller and MKAH51

can only be said to point towards the provision of timekeeping services. The proprietor has, therefore, failed to provide genuine use for the above terms.

*Covers for portable and mobile telephones.*

60. The evidence includes an example of an image of one of the proprietor's mobile phone cases.<sup>42</sup> In addition, invoice evidence is provided that shows the shipment of iPhone cases to a Swatch Group subsidiary in London between 2017 and 2019.<sup>43</sup> I note that the invoices show 80 iPhone covers which are described as being for an NHM Event. For reasons already discussed above, these are of no assistance. In addition, there are 7 iPhone cases that are described as being for the Basel Fair and a Zurich Event. Following the same reasoning discussed when considering the NHM Event, these are of no assistance. Not including the aforementioned invoices reserved for events or fairs, the invoices cover a total of 139 iPhone covers. The applicant's argument in respect of this evidence is that the invoices are internal invoices and are, therefore, of no assistance. While I agree that the fact that they are internal is an issue in respect of those goods reserved for events, I see no reason why the same outcome applies to all goods. I say this because unless I have reason to believe otherwise, it is entirely possible that the goods are shipped for eventual sale to end consumers at the London boutique, for example. Therefore, I am of the view that the invoices can still represent sales to end consumers and I will treat them as such.

61. While I appreciate that the level of sales shown for the above goods is at a higher level than the other class 9 goods covered by the proprietor's second mark, I still do not consider that it is sufficient to demonstrate genuine use for the above term. I make this finding on the basis that the level of sales is still very low in comparison to the EU and UK markets for mobile phone covers. While I have set out above that use need not be quantitatively significant in order for it to be genuine, the use is at such a minuscule level that it does not justify such a finding. This is particularly the case given that (1) there is no additional supporting evidence and (2) the nature

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<sup>42</sup> MKAH45

<sup>43</sup> MKAH43 and MKAH44

of the goods at issue is such that they are likely to be inexpensive goods that attract high volumes of sales. Without anything further, I am unwilling to find that the sale of just 139 phone cases is sufficient to satisfy the requirements for genuine use of the same.

*Optical apparatus and instruments particularly magnifying glasses.*

62. The proprietor's evidence includes an image of a BLANCPAIN branded watchmaker microscope.<sup>44</sup> In addition, the proprietor has provided a range of invoices that include the shipment of 'microscopes'.<sup>45</sup> Having reviewed the invoices, I note that they cover the shipment of microscopes to a Swatch Group company in London. In total, the invoices cover the shipment of 42 microscopes (I note that there are an additional 10 microscopes that included the order description NHM Event and, following the same reasons set out at paragraph 54, these are of no assistance). Even if it could be said that all of these microscopes were sold to end consumers (and not shipped to retailers for the purpose of employees using them, be that for the purpose of demonstrating the intricacies of the watch to the customer or to diagnose issues with existing customer's watches), they represent a vanishingly small level of sales. It is my view that the sale of just 42 microscopes across the relevant territory throughout the relevant period is far from sufficient to demonstrate genuine use of the same. While I appreciate that the proprietor operates a successful watch brand, I am not willing to infer that simply because it sells microscopes, the sales associated with them must be at a level to be deemed genuine. In my view the evidence is insufficiently solid to prove otherwise and, without anything further, I find that the proprietor has failed to prove genuine use of the above term.

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<sup>44</sup> MKAH45

<sup>45</sup> MKAH44

## CONCLUSION

63. The outcome of this decision is the proprietor's second mark is to be revoked in full but its first mark is only to be partially revoked. The revoked goods under both marks are as follows:

### *The proprietor's first mark*

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

### *The proprietor's second mark*

Class 9: Apparatus for recording, transmission and reproduction of sound or images; electronic payment processing apparatus, apparatus for processing cashless payment transactions; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; apparatus used for playing compressed sound files (MP3 files); calculating machines and data processing equipment, software; 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, mobile computers, personal computers, wrist computers, smartwatches, electronic tablets and computerized and mobile devices, digital personal stereos, mobile telephones and new-generation mobile telephones with greater functionality (smartphones); telecommunication apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images, particularly mobile telephones and new-generation mobile telephones with greater functionality (smartphones); hand-held electronic

apparatus for accessing the Internet and sending, receiving, recording and storing short messages, electronic messages, telephone calls, faxes, video conferences, images, sound, music, text and other digital data; handheld electronic apparatus for wireless reception, storage and transmission of data or messages; handheld electronic apparatus for monitoring or organizing personal information; handheld electronic apparatus for global positioning [GPS] and displaying maps and transport information; handheld electronic devices for detection, storage, monitoring, surveillance and transmission of data relating to user activity, namely position, itinerary, distance traveled, heart rate; covers for computers, portable and mobile telephones; optical apparatus and instruments particularly spectacles, sunglasses, magnifying glasses, smart glasses; cases for spectacles, sunglasses and magnifying glasses; batteries for electronic apparatus and computers, batteries for timepieces and chronometric instruments.

64. The proprietor's first mark may remain registered for the following goods, being those that I have determined as being reflective of a fair specification:

Class 14: Watches.

65. As I have set out above, the proprietor did not seek to file any evidence in respect of the earlier relevant periods in respect of the 46(1)(a) grounds. Instead, it chose to rely on the provision set out in section 46(3) of the Act. This means that where the marks are to be revoked, they are to be done so from the earliest dates sought. Therefore, the revoked goods under the proprietor's first mark have an effective revocation date of 7 May 2010 and those under the proprietor's second mark have an effective revocation date of 29 June 2017.

## **COSTS**

66. 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.

67. 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**

68. 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**