

O/1050/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 505036

TO REVOKE ON THE GROUNDS OF NON-USE
INTERNATIONAL REGISTRATION DESIGNATING THE UK
UNDER NO. WO000000749521 FOR THE MARK:



IN CLASS 14

OWNED BY
TISSOT SA

BACKGROUND AND PLEADINGS

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



International Registration designating the UK no. 749521

International registration date 4 December 2000

Date protection granted in the UK 12 July 2001

Registered for the following goods:

Class 14: Watches of all types and parts thereof; movements for clocks and watches and parts thereof.

(“the IR”).

2. On 27 June 2022, Samsung Electronics Co., Ltd. (“the applicant”) applied to partially revoke the IR. Save for “analogue watches”, the applicant seeks the revocation of all goods for which the IR is protected. The application was brought in 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 the date on which protection was granted in the UK, being 13 July 2001 to 12 July 2006, with revocation sought from 13 July 2006. Under its section 46(1)(b) ground, the applicant is alleging non-use of the IR 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 counterstatements wherein it defended all of the goods subject to the applications.

5. Both parties filed evidence in chief, with the proprietor also filing written submissions alongside its evidence. A hearing took place before me on 14 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 30 exhibits, being MKAH1 to MKAH30. 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.¹
8. 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

¹ MKAH1

behalf. Mr Stone's statement is accompanied by twelve exhibits, being DAS1 to DAS9.

9. 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.

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

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).² The outcome of the High Court proceedings was the granting of an injunction in favour of the Swatch Group.³ 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

² *Montres Breguet SA & Ors v Samsung Electronics Co. Ltd* [2022] EWHC 1127 (Ch)

³ The judgment of the High Court is presently subject to an appeal due to be heard on 5 and 6 December 2023

actions brought by the applicant against 19 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:⁴

“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.”

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 a range of marks owned by the Swatch Group then I must reach a similar conclusion here in relation to the IR at issue (particularly bearing in mind that said IR is not referred to in the finding made by Falk J, although I do note that it is associated with the ‘TISSOT’ mark that is referred to), i.e. that there has been genuine use of the same 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 revocation applications. 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 counterstatement, the proprietor clarified that it only sought to rely on use insofar as it covers the latter

⁴ A copy of the full judgment is exhibited at DAS3

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 assessments below, they may still have effect on these proceedings. 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 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 30 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 IR. 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 Tissot has made genuine use of the Mark between 27 June 2017 and 26 June 2022, in connection with the goods."⁵ The applicant argues that this statement is 'obviously incredible'⁶ 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.⁷ 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 in respect of the class 14 goods is that they be limited to just 'analogue watches'. During these proceedings, the applicant provided an alternative position, being a claim that the IR only survive in respect of 'watches other than smartwatches'. This issue first came to the

⁵See paragraph 18 of the witness statement of Ms Koenig and Mr Haller

⁶ 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.

⁷ 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.

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.

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 for 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 its specification in full)⁸ 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).

⁸ Save for any inclusion of 'clocks' as this point was confirmed as not being pursued by Mr Selmi at the hearing

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. 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.”

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

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v*

Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the

purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

26. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”⁹ 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”¹⁰ is not, therefore, genuine use.

27. 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

⁹ *Jumpman*, Case BL O/222/16

¹⁰ *Ibid.*

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.”

28. 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.”

29. As an international registration designating the UK, the relevant territory for the assessment of genuine use for the IR is the UK only.

30. 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.”

31. 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.”

32. 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 effect the overall evidential picture. While I am entitled to make inferences based on the evidence before me, the sheer volume of evidence coupled with the fact that the proprietor is a large company does not simply mean that I must make every inference in favour of the proprietor. Put simply, if I am not satisfied that such an inference is reasonable to make then I will not make it. On this point, I remind myself of the comments of Mr Daniel Alexander Q.C. in *Plymouth Life* (cited above and also referred to by the applicant at the hearing) that I will be justified in rejecting evidence if it is insufficiently solid. I do not consider this a necessarily controversial approach and I will proceed to assess genuine use in the way outlined in the case law.

33. Before moving to consider my assessment of genuine use, I first consider it necessary to assess the form of the IR used by the proprietor. In doing so, I remind myself that, at the hearing, Mr Stone made submissions in support of a claim that the proprietor had not used the IR as registered or in a form that is capable of being deemed an acceptable variant of the same.

Form of the IR

34. In its written skeleton argument filed prior to the hearing, the applicant reproduced a number of examples which it claims as being marks other than the IR as registered or acceptable variants of the same. I have reproduced some of these examples below.

(a) TISSOT T-TOUCH	(b) T-TOUCH EXPERT
(c) T-TOUCH SWISS EDITION	(d) T-TOUCH CONNECT
(e) 	(f) 
(g) 	(h) 
(i) 	
(j) 	

35. I note that additional examples were referred to in the applicant's skeleton argument but, at the hearing, Mr Selmi confirmed that these were not relied on. As a result, I have not reproduced these above. This concession did not apply to example (e) above, however, I note that one of the examples conceded was 'T-

RACE' and as example (e) is simply a stylised representation of the same, I do not consider it controversial to take the concession as applying to this example also. On this point, I note that the T-RACE mark appears in the invoices provided¹¹ but, as I will come to discuss further below, the proprietor does not actively seek to rely upon such use. In light of this, it is clear that the proprietor does not seek to rely on example (e) either and I will, therefore, say no more about it.

36. I turn now to consider the remaining examples. In doing so, I remind myself that, as per section 46(2) of the Act, a proprietor is entitled to rely on variant use of its mark, so long as that use does not alter the distinctive character of the mark. I also refer to the case of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, wherein Mr Phillip Johnson, sitting as the Appointed Person, stated that:

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

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

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

¹¹ See page 5 of MKAH12 for example.

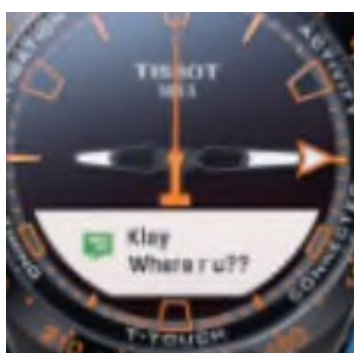
16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no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

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

37. In order to make the present assessment, I must consider in what does the distinctive character of the IR lie. The IR is made up of a number of elements, the first being a circular ‘button’ device in grey, within which sits a white letter ‘T’. Following this device is the word ‘TOUCH’, presented in a dark grey, fairly standard typeface. As set out in the case law cited above, where a mark consists of words and figurative elements, it is the words that are usually more distinctive. I see no reason why such a finding would not apply here. As such, I find that the distinctive character of the IR is dominated by the T TOUCH element. The device and stylistic elements will, in my view, only contribute to the distinctive character to a negligible degree. Turning to the above examples, I am of the view that, save for example (a) (which I will discuss further below), I can deal with them together. All of the examples shown differ from the IR by way of the alteration of the figurative and

stylistic elements. Further, the examples include additional elements such as, for example, the words 'EXPERT', 'CONNECT SOLAR' and 'the touch screen watch'. Regardless of the different/altered elements, I consider that the T TOUCH element remains the dominant element of the examples. On this point, I do not consider that the different/altered elements will be overlooked entirely, however, they will have very little impact in the minds of the consumer. I make this finding in line with the principles set out in the case law cited above which state that (1) the alteration or omission of non-distinct elements and (2) the addition of descriptive or suggestive words (such as 'EXPERT', 'CONNECT SOLAR' and 'the touch screen watch') are unlikely to change the distinctive character of the IR. As a result, I am satisfied that the examples shown are acceptable variants of the IR.

38. As set out above, I turn now to discuss example (a). I do so on the basis that it does not necessarily represent the position as reflected in the evidence. For example, the use of 'TISSOT T-TOUCH' in plain text is mostly done in third party press articles and where such use occurs, it is often accompanied by an image of the proprietor's watch which includes the word 'T-TOUCH' separate from the word 'TISSOT'. For example, I note that a print-out taken from the publication 'The Luxury Editor' includes reference to 'TISSOT'S T-TOUCH CONNECT SOLAR' watch.¹² However, the image of the watch, as set out below, clearly demonstrates use of 'T-TOUCH' solus, rather than accompanying another mark.



¹² See pages 4 and 5 of MKAH16

39. Further, where the proprietor has used word only representations of the IR, for example, in its invoice evidence¹³ (that I will discuss further below) it has done so by way of simply referring to 'T-TOUCH'. As a result, I find that where the proprietor's evidence does make reference to 'TISSOT T-TOUCH', it does so in conjunction with other acceptable variants of the mark which, as above, do not alter the distinctive character of the IR.

40. I will now proceed to consider whether there has been genuine use of the IR and, if so, I will consider what is a fair specification of the use shown.

Watches of all types and parts thereof.

41. In considering the above term, I am of the view that it can be broken down into two types of goods. The first being *watches of all types* and the second being *parts thereof*. Rather than assess the use of this term as a whole, I will break down my assessment to consider these types of goods separately, beginning with *watches of all types*.

Watches of all types.

42. Having reviewed the proprietor's evidence, the majority of it relates to the 'T-TOUCH CONNECT SOLAR'. On this point, I note that of the 'T-TOUCH' watches covered by the proprietor's invoice evidence,¹⁴ the overwhelming majority of them are the CONNECT SOLAR model (with the remaining watches being 'T-TOUCH EXPERT' or 'T-TOUCH SOLAR'). As a result, I consider that it is necessary to consider the categorisation of this product.

43. The applicant's position is that the T-TOUCH CONNECT SOLAR is either a smartwatch or a connected watch and is, therefore, proper to class 9. As a result, the applicant's position is that use of this product is of no relevance here as it is not proper to class 14. At the hearing, Mr Selmi took issue with this approach and

¹³ Page 1 of MKAH13, for example.

¹⁴ MKAH10 to MKAH15

argued that it was inconsistent as, in other proceedings within the set of 13 revocation proceedings between these parties, the applicant argued that the T-TOUCH CONNECT SOLAR was not a smartwatch. On this point, I appreciate that these proceedings are connected to the other proceedings on the basis that they involve the same parties, however, it is not the case that the parties must raise the same arguments across all proceedings so the issue of this alleged inconsistency is of no particular concern to me. I note that the parties made detailed submissions on the point of classification at the hearing. While I have no intention to repeat those submissions here, I confirm that I have taken them into account.

44. In respect of the issue of trade mark classification, I note that a watch with electronic functionality can be properly registered in class 14 if it is primarily a watch. Conversely, a wearable computer with multiple functions (one of which being time display functions) presented in the shape of a watch, is proper to class 9 because it is primarily a computer. Equally, it is entirely possible for use in relation to the same product or service to be capable of establishing use in relation to more than one term in a specification. Having reviewed the evidence in respect of the T-TOUCH CONNECT SOLAR, I am of the view that it is a watch that exhibits computerised functionality that can be considered as being those in line with a smartwatch¹⁵ (which would designate it as a class 9 good) but it also consists of a physical analogue watch face (which would put it in class 14).

45. In giving consideration to the present assessment, I have borne in mind the case of *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch) wherein the late Mr Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken

¹⁵ See MKAH5 which is a 2021 user manual for the T-TOUCH CONNECT SOLAR, which discusses the computerised functions of the product. In addition, the reference to it being a smartwatch is consistent in third party publications, which can be found at MKAH18

into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In the present case, I am of the view that 'watches of all types' is sufficiently clear to the point that the reliance upon the appropriate class is not relevant.

46. While the above case law and the arguments of the parties are noted, I do not consider that the assessment before me is particularly complicated. I say this because the T-TOUCH CONNECT SOLAR is a product capable of being described by the average consumer as a watch in the ordinary sense of the word but also as a smartwatch. This is on the basis that the product clearly exhibits functions of a smartwatch but also is, put simply, a watch that tells the time. In the present case, I consider that the average consumer would describe by equally significant proportions of the consumer base the T-TOUCH CONNECT SOLAR as either a watch, a smartwatch, or a good that falls within both categories. As an analogy, I note that clocks are goods proper to class 9 and radios are goods proper to class 14. If a mark was registered for only one of those goods (be that in class 9 or 14) and was put to proof of use of the same, would the use of a 'clock radio' be sufficient? Clearly it would and I am of the view that a similar outcome applies here. As a result, I am of the view that use of the T-TOUCH CONNECT SOLAR is sufficient to demonstrate use of both a smartwatch in class 9 and a watch in class 14. I will, therefore, proceed to consider the entirety of the use before me.

47. As I have already discussed above, the proprietor has filed sample invoices in respect of sales of T-TOUCH watches in the UK between 2017 and 2022.¹⁶ In addition, the proprietor has provided a breakdown of the invoices which confirms that the invoices represent the wholesale of £42,786.92 worth of watches.¹⁷ Having reviewed the invoices, I note that they include a wide range of watches that cannot be said to fall within the proprietor's T-TOUCH range of watches. For example, I note that they refer to T-RACE, BRIDGEPORT, CLASS DREAM and CARSON watches, amongst others. Having said that, I can confirm that, upon my own calculation of the invoices, the total figures provided in the breakdown do not

¹⁶ MKAH10 to MKAH15

¹⁷ See paragraph 11 of the witness statement of Ms Koenig and Mr Haller

include those alternative watch ranges meaning that the proprietor does not seek to rely on such use. As a result, I am satisfied that the invoices and accompanying breakdowns are reflective of goods sold under the T-TOUCH branding. While that may be the case, I do have some issue with the proprietor's evidence. This is because the proprietor's evidence includes a product reference page for the T-TOUCH watches covered by these invoices.¹⁸ However, having reviewed the invoices in conjunction with this product page, I cannot see how the product reference numbers match up. Further, some of these invoices clearly relate to T-TOUCH CONNECT SOLAR watches which, based on the evidence before me, are not the watches presented in the product page. While this is somewhat confusing, I do not consider that it takes away from the fact that the invoices cover T-TOUCH watches.

48. Taking the invoice evidence into account, it is clear that the above figures provided are very low in comparison to what is likely to be a very large market. On this point, I note that the evidence sets out that these figures are representative of just a fraction of the proprietor's total sales. I appreciate that this may be the case, however, it is a very vague statement and I have nothing sufficiently solid before me to assist me in determining an accurate level of turnover. Having said that, I note additional evidence has been provided of press coverage in the UK. For example, the proprietor has provided evidence taken from UK-based publications such as the Telegraph, OracleTime and Luxury Editor.¹⁹ There is evidence before me regarding the print circulation of the Telegraph newspaper in December 2019²⁰ but I'm not convinced that it necessarily applies to the article before me. I say this because the Telegraph article is an online article taken from the Luxury section of the Telegraph's website and there is nothing to suggest that this article ever made it to a print version of the newspaper. Having said that, I do appreciate that the Telegraph's website is likely to have attracted a reasonable amount of visitors. The proprietor has also provided print-outs from Wired Magazine, Spears and Brummel from 2020²¹ which all make reference to the TISSOT T-TOUCH CONNECT

¹⁸ MKAH30

¹⁹ MKAH16

²⁰ MKAH17

²¹ MKAH18

SOLAR watch. Circulation figures for these publications are provided and I note that these publications shown attracted circulations of 48,087 (for the November 2020 issue of Wired Magazine specifically), 24,000 (being an average circulation figure for Spears, with a readership of 62,000) and 20,000 (being a figure taken from a 2021 report from Brummell).²²

49. While I have my issues with the vague nature of the turnover figures, I am satisfied that, upon taking all of the above into account, the proprietor has genuinely used the IR for watches. As above, the applicant's case is that the specification should be limited to either "analogue watches" or "watches other than connected watches or smartwatches". In respect of the limitation to analogue watches, I am of the view that I can deal with this swiftly. This is because the proprietor's T-TOUCH range of watches are not simply analogue watches. Instead, the evidence before me demonstrates a type of watch that incorporates both an analogue and a digital face. For illustrative purposes, I have reproduced example images of the T-TOUCH range of watches below.



50. Clearly these are not just analogue watches and I hereby dismiss the argument that the IR be limited to just 'analogue watches'. I move now to consider the alternative argument that the specification should be limited to 'watches other than connected watches and smartwatches'. In the present case, I see no reason why the average consumer would not describe the goods at issue as connected or

²² MKAH19

smart watches on the basis that the T-TOUCH CONNECT SOLAR clearly exhibits smart and connected functions. In making this finding, 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).²³ 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, who stated at the hearing that such a term is, in any event, 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'.

Parts of watches [of all types].

51. The proprietor's evidence makes reference to the fact that it offers a number of authorised service centres in the UK. A print-out of the TISSOT website is shown that shows the results of a search for service centres in the UK.²⁴ I note that while the website states there are 61 results, only 3 are shown and I note that one of these is a Swatch Group service centre and the other two are third party service centres. Another page from the TISSOT website has been provided and I note that this makes reference to the services offered and the type of warranties that are available to customers.²⁵ Firstly, both of these website print-outs are undated so it is not entirely clear as to whether this evidence reflects the position during the relevant period. Secondly, the evidence relates to the TISSOT branding, not T-TOUCH so it cannot, therefore, be said to apply to use of the IR.

52. While the issue with the above evidence is noted, the proprietor has filed invoice evidence covering sales of watch parts in the UK between 2018 and 2021.²⁶ A range of goods covered by these invoices relate to watch straps and watch bracelets. My primary view is that watch straps when sold as standalone goods are

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

²⁴ MKAH24

²⁵ MKAH25

²⁶ MKAH23

not 'parts of watches' but are, instead, accessories for watches. As such, this evidence is of no assistance to the proprietor in its claim to use the IR on the above term. Even ignoring this, the evidence in support of watch straps does not relate to the IR. For example, the proprietor's evidence includes a range of images of watch straps and I note that none of these are branded as 'T-TOUCH'.²⁷ I appreciate that the proprietor has argued that some of these straps can be used on T-TOUCH watches, however, the straps are not branded as such. On this point, I note that the proprietor's evidence includes a print-out showing two watch straps that are compatible with a T-TOUCH watch.²⁸ This is noted but, again, the straps are branded as TISSOT, not T-TOUCH.

53. As for the goods covered by the invoices that can be said to be watch parts, I note that they make very limited reference to the 'T-TOUCH' branding. In light of the evidence discussed above, these parts could reasonably be said to be branded as 'TISSOT' and, therefore, of no assistance here. Other issues with this evidence are (1) a number of goods shown are listed as being on 'back order', which could arguably be said to mean that those goods were never actually delivered to customers and (2) some of the reference numbers could be said to cover brands other than TISSOT or T-TOUCH.²⁹ In the present case, even if I were to ignore these issues and take the invoices at their best case, they cover the sale of just 26 watch parts to customers during the relevant period. Despite the claim that these invoices are just 'examples', they represent a miniscule level of use. If it was the case that evidence was available of a greater level of use, then I consider it reasonable that evidence of such should have been placed before me in these proceedings. Taking all of this into account, I am of the view that without anything further, the proprietor has failed to prove that it has genuinely used the IR on such goods.

²⁷ MKAH22

²⁸ See page 3 of MKAH22

²⁹ See, for example, reference to the letter 'T' for a majority of the goods but also the letters 'U' and 'L' (on pages 6 and 7 of MKAH23) and, given the nature of the invoices (being Swatch Group invoices), these could be said to relate to other brands owned by the Swatch Group.

*Movements for [...] watches and parts thereof.*³⁰

54. The bulk of the evidence in respect of the above term is, like the evidence discussed in the preceding assessment, aimed at the TISSOT branding rather than the T-TOUCH brand. For example, I note that the proprietor has provided catalogue evidence of its movements but all of these are branded as TISSOT.³¹ To emphasise this point, I have reproduced the following images of the proprietor's movements:



55. The same issue applies to the third party article from 'First Class Watches' that simply refers to TISSOT watches.³² None of this evidence is of any assistance to the present case whatsoever.

56. The only evidence before me that can be said to cover the T-TOUCH brand is a screenshot taken from eBay which shows the sale of a watch that has a quartz movement.³³ Not only is this print-out undated (save for a reference to last being updated on 1 June 2022, being just prior to the end of the relevant period), it is seemingly taken from a non-UK version of eBay³⁴ so has no relevance to the relevant market and, lastly, the nature of an eBay listing is such that it does not necessarily mean that the watch actually sold and, even if it did, it is a private sale from a third party seller, not use by the proprietor. Even ignoring these glaring issues, this is the sale of a watch. In no way does this demonstrate the provision of a movement as a standalone good. On this point, there is nothing before me to

³⁰ As set out above, the proprietor no longer seeks to defend this term where it relates to clocks.

³¹ MKAH28

³² MKAH26

³³ MKAH29

³⁴ I say this on the basis that the prices are listed in dollars but I note that the seller located in Brazil

suggest that the proprietor's movements (even if they were branded as 'T-TOUCH') are ever sold as standalone goods. In my view, the proprietor's evidence falls well short of proving use of the above term and, in light of the evidence before me, I fail to see any reason as to why it was provided in these proceedings.

57. Insofar as the above term can be said to cover parts for watches,³⁵ I make the same finding as I have in my assessment of watch parts above, namely that there is no use.

CONCLUSION

58. The outcome of this decision is that the IR is to be partially revoked for the following goods:

Class 14: Parts of watches of all types; movements for clocks and watches and parts thereof.

59. The IR is, however, permitted to retain protection in the UK for the following goods, being those for which I have found use:

Class 14: Watches of all types.

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 of the IR have an effective revocation date of 13 July 2006.

³⁵ This is on the basis that the term as registered is 'movements for watches and parts thereof' and I am of the view that it could be said that the 'parts thereof' aspect could equally cover 'parts for watches' as opposed to 'parts of movements for watches'.

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 6th day of November 2023

**A COOPER
For the Registrar**