

**O/1052/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 505049**

**TO REVOKE ON THE GROUNDS OF NON-USE  
REGISTRATION NO. UK00913496013 FOR THE MARK:**

**HAMILTON**

**IN CLASSES 9 AND 14**

**OWNED BY**

**HAMILTON INTERNATIONAL AG (HAMILTON INTERNATIONAL SA)  
(HAMILTON INTERNATIONAL LTD)**

## BACKGROUND AND PLEADINGS

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

HAMILTON

Registration no. 913496013<sup>1</sup>

Filing date 25 November 2014; registration date 5 May 2015

Registered for the following goods:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; compact discs; DVDs and other digital recording media; devices for converting compressed sound files (MP3); calculating machines and equipment for the processing of information; software; computer games software for mobile devices; computer and digital music players; electronic game software for mobile phones, computers and digital music players; computers; laptops; palmtops; mobile computers; personal computers; computers worn on the wrist; tablet computers; mobile radios; mobile telephones; mobile computers; mobile telecommunications apparatus and terminals; mobile data apparatus and receivers; wearable mobile phones; digital music players; mobile phones and advanced mobile phones with extended functionality (smartphones); telecommunications apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images, including cell phones and mobile phones with advanced extended features (smartphones); smartphones in the shape of a watch; electronic handheld devices for accessing the Internet and

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<sup>1</sup> The proprietor’s mark is a comparable trade mark based on a pre-existing EUTM (being EUTM no 13496013). 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.

sending, receiving, recording and storing short messages, e-mails, phone calls, faxes, images, sounds, music, text and other digital data, and for video conferencing; handheld electronic devices for receiving, storing and the wireless transmission of data or messages; electronic handheld devices to monitor and organize personal information; electronic handheld devices for universal search [GPS] and display of maps and navigation information; electronic handheld devices for detecting, storing, tracking, monitoring and transmission of data on the activity of the user, namely position, route, distance, heart rate; covers for computers, mobile phones and laptops; optical apparatus and instruments including eyeglasses, sunglasses, lenses, spectacle cases, cases for sunglasses and magnifiers; batteries for computers and electronic equipment; batteries and batteries for watches and chronological instruments.

Class 14: Precious metals and their alloys and goods made of these materials or plated therewith included in this class, namely figurines, trophies; jewellery, namely rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, jewelry boxes, cases; precious stones; semi-precious stones (gemstones); horological and chronometric instruments, namely watches, watches that communicate data to smartphones, watchbands that communicate data to smartphones, chronographs, clocks, watch bracelets, clocks, alarm clocks and parts and fittings for the aforesaid goods, namely needles, anchors, rockers, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, watch movements, watch springs, watch glasses, cases for watchmaking.

2. On 27 June 2022, Samsung Electronics Co., Ltd. (“the applicant”) applied to partially revoke the proprietor’s mark. The applicant seeks the revocation of all goods, save for “analogue watches” in class 14. The application is 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 registration of the mark, being 6 May 2015 to 5 May 2020, with revocation sought from 6 May 2020. Under its section 46(1)(b) ground, the applicant is alleging non-use of the mark for the period of 27 June 2017 to 26 June 2022, with revocation sought from 27 June 2022, being the date of the application at issue.
4. The proprietor filed a counterstatement wherein it defended all of the class 14 goods subject to the application. However, in respect of the class 9 goods, it only sought to defend some. Those that were undefended are as follows:

“Magnetic data carriers; recording discs; compact discs; devices for converting compressed sound files (MP3); computer games software for mobile devices; computer and digital music players; electronic game software for mobile phones and digital music players; laptops; palmtops; mobile computers; tablet computers; mobile radios; mobile telephones; mobile computers; mobile; wearable mobile phones; digital music players; mobile phones and advanced mobile phones with extended functionality (smartphones); apparatus for recording, transmission or reproduction of sound or images, including cell phones and mobile phones with advanced extended features (smartphones); electronic handheld devices for accessing the Internet and sending, receiving, recording and storing faxes, and for video conferencing.”

5. Both parties filed evidence in chief with the proprietor also filing written submissions alongside its evidence. A hearing took place before me on 15 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 14 November 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 34 exhibits, being MKAH1 to MKAH34. The evidence explains that both Ms Koenig and Mr Haller are authorised signatories of the proprietor and confirms that proprietor belongs to the Swatch Group. A list of the companies within what is referred to as the Swatch Group is provided in the evidence, of which the proprietor is one.<sup>2</sup>
8. I note that the proprietor's evidence consists of exhibits in a foreign language. Translations of the same are included in the evidence and, in support of the accuracy of the same, witness statements have been provided by Mr Garrett Higgins, Mr Samuel Miller (both of which are dated 22 December 2022) and Mr Craig Thomas Smith (which is dated 11 January 2023). All of these individuals are translators at Transperfect Legal Solutions and their evidence relates to translations to English from Italian, Spanish and French, respectively. I do not intend to summarise each statement but note that they confirm (1) what parts of Ms Koenig and Mr Haller's evidence has been translated and (2) the witnesses' belief that the translations are accurate.

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<sup>2</sup> MKAH1

9. The applicant's evidence came in the form of the witness statement of Mr David Stone dated 13 March 2023. As set out above, Mr Stone is the applicant's legal representative and is, therefore, duly authorised to give evidence on the applicant's behalf. Mr Stone's statement is accompanied by nine exhibits, being DAS1 to DAS9.

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

## **PRELIMINARY ISSUES**

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

### High Court proceedings and the related revocation proceedings

12. Throughout these proceedings, there has been reference by both parties to proceedings in the High Court of England and Wales between the applicant and several companies within the Swatch Group (the proprietor being one of them).<sup>3</sup> The outcome of the High Court proceedings was the granting of an injunction in favour of the Swatch Group.<sup>4</sup> The applicant claims that during those proceedings, the Swatch Group confirmed that it had not used its marks for 'smartwatches' and that it became apparent that there was no use for other goods contained in the specifications of other marks owned by companies within the Swatch Group. As a result, the applicant claims that the injunction is based on overly broad specifications of the Swatch Group's marks, for which there is no use.

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

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

Consequently, the applicant now seeks the present revocation action against the proprietor's marks. In addition to these proceedings, there are 12 other revocation actions brought by the applicant against 19 different trade marks owned by various companies within the Swatch Group.

13. During the hearing, the parties took me to the transcript of the cross-examination of Mr Sylvain Dolla, being the Chief Executive Officer of Tissot SA (being a company that sits within the Swatch Group) and a Member of the Extended Group Management Board for the Swatch Group. The applicant sought to point out that, during the cross-examination of Mr Dolla in the High Court, he confirmed that Tissot and the Swatch Group generally made a decision not to enter the smartwatch market and that the Swatch Group had never sold a smartwatch. Further, Mr Dolla confirmed that the Swatch Group decided to keep away from the smartwatch market as it is understood as a commodity.<sup>5</sup> In response to this point, the proprietor sought to argue that Mr Dolla was an employee of Tissot SA and not the proprietor in the present case, to which the applicant argued that Mr Dolla is also a member of the Extended Group Management Board so his comments can be taken to apply to all members of the Swatch Group. In any event, I do not consider that the comments of Mr Dolla in the High Court, despite being under oath, are relevant to the assessment I must make at present. While they are noted, my present assessment is based on the evidence before me and if that evidence is satisfactory in demonstrating use of a smartwatch, then that is sufficient to warrant a finding of genuine use of the same. If not, then no such protection will be granted. Mr Dolla's comments, therefore, have no effect on the assessment before me and I will say no more about them.

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

14. Throughout these proceedings, there has also been mention of the judgment of Falk J in the High Court proceedings wherein she stated at paragraph 175 that:<sup>6</sup>

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<sup>5</sup> A copy of the transcript of the cross-examination of Mr Dolla is exhibited at DAS5

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

“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 a range of marks owned by the Swatch Group then I must reach a similar conclusion here in relation to the mark at issue (even though said mark is not referred to above), 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

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

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



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

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 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 later relevant period, the proprietor’s failure to file any evidence in relation to the earlier relevant period means that the revocation will take effect from the earliest sought revocation date. So while I will make no reference to the earlier period in my assessment below, it may still have effect on these proceedings.<sup>7</sup> For ease of reference going forward, I will only refer to the one relevant period, being 27 June 2017 to 26 June 2022.

#### The proprietor’s evidence

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

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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.

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

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

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

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<sup>8</sup>See paragraph 22 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.

<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.

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

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 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).

### EUIPO Decision

24. I note that in its evidence, the proprietor filed a copy of an EUIPO decision dated 3 December 2020 (being before the UK's exit from the EU).<sup>11</sup> This decision held that the proprietor had genuinely used its HAMILTON mark in connection with "goods in precious metals and their alloys or coated therewith, not included in other classes, namely watches; jewellery, namely watches; jewellery, namely watches;

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<sup>11</sup> MKAH9

horological and chronometric instruments, namely watches; watches.” This decision is noted but, for the avoidance of doubt, it is not binding on me so is, therefore, of no assistance in these proceedings. Instead, my decision will be based upon the evidence before me and the relevant assessments, which I will reproduce below.

## **DECISION**

25. 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 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.

(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”.

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

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

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

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

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

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

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

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

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

27. 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.”

28. 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].”

29. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>12</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>13</sup> is not, therefore, genuine use.

30. 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

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<sup>12</sup> *Jumpman*, Case BL O/222/16

<sup>13</sup> *Ibid.*

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.”

31. 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.”

32. The proprietor’s mark is a comparable mark based on an earlier EUTM. This means that use of the mark in the EU prior to (and including) IP Completion Day (being 31 December 2020) is relevant to the present assessment.<sup>14</sup> By virtue of being a Member State prior to this date, the UK still formed part of the relevant territory of the EU. From 1 January 2021 onwards, however, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis*

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<sup>14</sup> See paragraph 4 of Tribunal Practice Notice 2/2020

*Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union noted that:

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

And

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

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

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

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

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

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

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

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

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

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

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.

### Class 9

37. I have mentioned above that the proprietor only sought to defend some of its class 9 goods. In addition to this, I note that the proprietor's skeleton argument that was filed prior to the hearing only sought to defend the following goods:

“Calculating machines and equipment for the processing of information; computers worn on the wrist; electronic handheld devices for universal search [GPS] and display of maps and navigation information.”

38. Mr Selmi confirmed at the hearing that the above goods were all that the proprietor now sought to defend. I will proceed to consider the goods, starting with “computers worn on the wrist.”

#### *Computers worn on the wrist.*

39. At the hearing, Mr Selmi took me to the following examples of watches that the proprietor claims to have advanced functionalities. These are the Jazzmaster Face 2 Face<sup>15</sup> and the Khaki Flight Timer.<sup>16</sup> For illustrative purposes, I have reproduced images of those watches below:



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<sup>15</sup> Page 1 of MKAH22

<sup>16</sup> Page 2 of MKAH22



40. The proprietor's position is that the above watches are computers worn on the wrist because they exhibit functions such as a pulsometer, tachymeter and telemeter (in respect of the Jazzmaster) and a pilot's logbook, two digital time zones, an alarm, a chronograph, a flight time recorder, ISA temperature and a perpetual calendar (in respect of the Khaki Flight Timer). In support of the functionality of the latter watch, the proprietor has also provided a user's manual.<sup>17</sup>

41. While I appreciate that these watches have some form of functionality above and beyond ordinary analogue or digital watches, I do not consider that they are 'computers worn on the wrist'. Use of these goods is, therefore, of no assistance to the proprietor's attempt to prove genuine use. Even if these watches could be said to fall within the above term, the evidence before me is insufficient to prove genuine use. I appreciate that there is a wider level of use associated with the proprietor's watches at large (which I will discuss in my class 14 assessment below). However, having reviewed the proprietor's evidence, namely the invoices provided,<sup>18</sup> I can only identify three sales of the 'Jazzmaster Face 2 Face'<sup>19</sup> watch and just one sale of the 'Khaki Flight Timer'.<sup>20</sup> On this point, I note that the invoices cover additional watches referred to as 'JM' which is seemingly short for 'Jazzmaster'. However, there is nothing to indicate they relate to the 'Face 2 Face' model as opposed to other models such as 'JM Thinline' or 'JM Lady', for example.<sup>21</sup> A similar issue applies to the 'Khaki' range of watches in that there is a range of references to 'Khaki' watches but nothing to suggest that they are the 'Flight Timer' watch as opposed to other models such as 'Khaki Field King' or 'Khaki Aviation'.<sup>22</sup> On the topic of the invoices, I note that they include a total of 174 individual invoice pages condensed onto just 87 pages. If it was the case that there was a wider level of use associated with these watches then I consider it reasonable to suggest that the proprietor should have directed me to specific examples of use.

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<sup>17</sup> MKAH23

<sup>18</sup> MKAH7 and 8

<sup>19</sup> See pages 65 and 85 of MKAH8

<sup>20</sup> See page 57 of MKAH8

<sup>21</sup> See page 6 of MKAH8 which makes reference to these types of watches

<sup>22</sup> See page 7 of MKAH8 which makes reference to these types of watches

42. Taking all of the above into account, my primary position is that the watches shown cannot be said to fall within the category of “Computers worn on the wrist”; they are, clearly, primarily watches (i.e. clocks worn on the wrist to tell the time) notwithstanding their additional functionality, rather than computers. If I am wrong on this point, then my secondary finding is that the evidence before me is far from sufficient to demonstrate genuine use. Whilst the invoice evidence is referred to by the proprietor as only reflective of a fraction of the proprietor’s total use, I have nothing sufficiently solid upon which to pin any accurate determination of any actual level of use. As set out above, the burden for proving use falls squarely on the proprietor. As such, it is reasonable to expect more sufficiently solid evidence to have been provided in support of the proprietor’s claims and without anything further, I do not consider it reasonable to infer that the use was at a level sufficient enough to be deemed genuine. As a result, I find that the proprietor has failed to demonstrate genuine use for the above term.

*Calculating machines and equipment for the processing of information; electronic handheld devices for universal search [GPS] and display of maps and navigation information.*

43. At the hearing, Mr Selmi put forward detailed submissions in respect of the above terms. I do not intend to reproduce these here but remind myself that the proprietor seeks to retain the above terms on the basis of the watches discussed in the preceding assessment. Even taking into account Mr Selmi’s arguments on this point, I fail to see how such an argument is sustainable. A watch is not a calculating machine or equipment for the processing of information and neither is it an electronic handheld device (regardless of whether the functions and buttons are manipulated by hand). As was the case above, even ignoring these issues, the evidence of use of these watches is just five examples of sales and is far from sufficient to determine a genuine level of use. As such, the proprietor has failed to demonstrate genuine use of the above terms.

## Class 14

44. While the proprietor initially defended all of its class 14 goods, I note that the skeleton argument filed prior to the hearing did not make reference to all of those goods. At the hearing, it was confirmed by Mr Selmi that only the following goods are defended:

“Jewellery, namely bracelets; precious stones; semi-precious stones (gemstones); horological and chronometric instruments, namely watches, chronographs, watch bracelets, alarm clocks and parts and fittings for the aforesaid goods, namely needles, watch cases, watch straps, watch dials, watch chains, watch movements, watch springs, watch glasses, cases for watchmaking.”

45. As such, the remaining undefended goods will be revoked accordingly and I will only consider the above set of goods.

*Horological and chronometric instruments, namely watches, chronographs, watch bracelets, alarm clocks and parts and fittings for the aforesaid goods, namely needles, watch cases, watch straps, watch dials, watch chains, watch movements, watch springs, watch glasses, cases for watchmaking.*

46. Given the broad nature of the above term, I consider it necessary to break it down to an appropriate grouping of goods and assess them in turn. In doing so, I will focus on the terms succeeding the word ‘namely’ only. I do so on the basis that the inclusion of ‘namely’ means that the term is limited to only those goods following such wording. For example, the term does not cover any and all types of horological or chronometric instruments but, instead, covers only watches, chronographs, watch bracelets and alarm clocks. While each assessment will determine whether there is use of the goods in question or not, I will, at the conclusion of my assessment and for the avoidance of doubt, return to confirm the actual fair specification of this term.

## *Watches.*

47. In support of a claim that it has used its mark on the above goods, the proprietor has provided a number of invoices that demonstrate the volume of trade conducted in the UK for HAMILTON branded watches between 28 November 2017 and 13 May 2020.<sup>23</sup> The invoices are to three different retailers in the UK, one of which was the recipient of three different shipments between 9 April 2019 and 13 May 2020. In total, these invoices cover the sale of £14,964.00 worth of watches in the UK. The proprietor sets out that this figure should not be taken to represent the total volume of sales but just a fraction of them. In addition, invoices from sales in the EU have also been provided and I note that these are dated between June 2017 and December 2020.<sup>24</sup> While this was a time when the UK was part of the EU, I note that no UK invoices are provided amongst this evidence. There are 147 pages worth of invoices and, helpfully, the proprietor has provided a breakdown of these invoices which sets out that they cover the sales of £422,738.22 worth of watches. As was the case with the UK invoices, the proprietor's position is that these invoices should only be taken to cover a fraction of the proprietor's sales in the EU. As a last point in respect of the EU invoices, I note that they are addressed to Swatch Group entities and I note that the applicant's position is that these invoices are internal so, as per *Ansul* (cited above), are of no assistance in the case of genuine use. While they may be addressed to Swatch Group companies, I am satisfied that they are parts of the distribution arm of the group and constitute distribution invoices. Therefore, I consider that they should be treated in the ordinary way, i.e. as if they were shipped to third party retailers. In such circumstances, it is ordinary for distribution invoices to be used to support a claim of use. Therefore, I consider it reasonable to infer from the invoices that they were meant for onward sale to consumers in the EU and I have nothing before me to suggest otherwise.

48. In addition to the above, evidence has been provided regarding sponsorship activity and advertising efforts. In respect of the first point, I note that evidence is

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<sup>23</sup> MKAH7

<sup>24</sup> MKAH8

before me regarding sponsorship of the Red Bull Air Race World Championship for three seasons between 2017 and 2019.<sup>25</sup> The evidence sets out that during the proprietor's sponsorship of this event, it was held in countries in the EU such as France, Germany, Portugal, Austria and Hungary. In respect of the latter point, I note that the evidence includes advertisements in various print publications in the UK throughout the relevant period.<sup>26</sup> This includes evidence of advertisements in a range of magazines such as Esquire, Wired and GQ. Evidence has also been provided of the circulation figures of Esquire magazine in the UK and I note that, from July to December 2017, it averaged a circulation of 62,677 per issue.<sup>27</sup> Even without evidence in support of the circulation of GQ or Wired, I am content to conclude that they are nationwide magazines which are likely to attract widespread circulation numbers per issue.

49. On balance of the evidence discussed above, I am satisfied that the proprietor's evidence is sufficient to demonstrate genuine use of watches. In respect of a fair specification, I do not consider it necessary to consider whether the term may survive in respect of other types of 'horological' or 'chronometric' instruments as the term is limited to just watches (on the basis that the wording 'namely' serves to limit the term to only those types of goods that succeed it). While that may be the case, I remind myself that, as set out above, the applicant's position is that the proprietor's mark should be limited to "analogue watches" or "watches other than connected watches or smartwatches". Therefore, the issue I must now consider is the fair specification of the above term.

50. 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

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<sup>25</sup> See MKAH25 and 26

<sup>26</sup> MKAH28

<sup>27</sup> MKAH29

reason why the average consumer would look to make such a distinction in their description of the same. As a result, I reject the applicant's pleaded case that these goods should be limited to 'analogue watches'.

51. 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'.

52. In light of the above, I find that the proprietor should be permitted to maintain its mark for 'horological and chronometric instruments, namely watches'. Before moving on, I wish to discuss the fact that, in respect of the fair specification point, submissions were put before me regarding the effect of the Nice Classification. Throughout these proceedings, Mr Selmi made reference to the case of *Pathway*<sup>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 and precise in describing the goods at issue. As a result, I see no reason why the Nice Classification would be relevant and I

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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)

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.

### *Chronographs.*

53. It is my understanding that a chronograph is an accurate instrument for recording small intervals of time or any timepieces designed for maximum accuracy.<sup>30</sup> This can include a type of watch that, as well as being able to tell time, has a stopwatch type mechanisms within the face or dial. At the hearing, Mr Selmi took me to a number of examples of watches that would also be considered ‘chronographs’. I note that this evidence includes print-outs from the proprietor’s own website dated from within the relevant period and obtained via the internet archive facility, the Wayback Machine.<sup>31</sup> The watches that are described as ‘chronographs’ are the ‘American Classic Intramatic Auto Chronograph’ and the ‘Chrono-Matric 50.’<sup>32</sup> I note that the ‘American Classic Intramatic Auto Chronograph’ is also referred to in a print-out taken from the website of Berry’s Jewellers.<sup>33</sup> It is also featured in a list taken from Esquire Online dated 14 February 2022 as part of its article regarding “the 24 best chronographs under £10,000.”<sup>34</sup>

54. In respect of these goods, at the hearing, Mr Selmi states that because the Esquire article mentioned in the preceding paragraph states that “when you ask someone to imagine a chronograph, you get pretty close to [the American Classic Intramatic]” then that is enough to prove use on chronographs. I appreciate that the press coverage is clearly of some assistance but the supporting evidence (outside of that already discussed above) in respect of this product is non-existent. For example, I

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<sup>30</sup> <https://www.collinsdictionary.com/dictionary/english/chronograph>

<sup>31</sup> MKAH15

<sup>32</sup> See pages 5 and 6 of MKAH15, respectively.

<sup>33</sup> See page 4 of MKAH16

<sup>34</sup> See page 9 of MKAH28

have reviewed the EU invoices provided by the proprietor and note that there are no entries that can be said to cover this chronograph. I note that, similar to the issue with the assessment of the class 9 goods above, there are several references to 'American Classic' watches in the EU invoices but they make reference to other models such as the 'Khaki X-Wind'<sup>35</sup> and the 'Correa Intra-Matic'.<sup>36</sup> As for the UK invoices, I note that only one sale is shown that covers a good referred to as 'INTRAMATIC D AC40'. I accept that this is likely to cover the chronograph discussed above (on the basis that AC could reasonably be said to stand for 'Auto Chrono'). However, this is evidence of just one sale in the relevant territories during the relevant period.

55. I appreciate that I have found use for watches in the preceding assessment and that a chronograph may be considered a type of watch. However, this does not mean that I must automatically find use for 'chronographs'. In light of the limited evidence before me, I am of the view that it is reasonable to expect the proprietor to file sufficiently sold evidence in support of the same. Without such, I am not willing to make a finding that the proprietor has shown genuine use in respect of the above goods.

#### *Watch bracelets.*

56. I have some question as to the validity of the above term as a watch bracelet is neither a horological or chronometric instrument. In any event, I do not consider this to be of any particular consequence here as the proprietor's skeleton argument simply sets out at paragraph 24 that it aims to address 'watch bracelets' when dealing with the remaining class 14 specification. On this point, I note the presence of more appropriate terms (being "watch straps" or "jewellery, namely bracelets") that cover identical goods as those described above. It is my view that it is appropriate to consider these goods under those terms instead, which I will do so further below.

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<sup>35</sup> See page 11 of MKAH8

<sup>36</sup> See page 6 of MKAH8



*Alarm clocks.*

57. The proprietor's position in respect of the above goods is that its watches exhibit enhanced functionalities such as alarms meaning that use of those goods constitute use of the above term. I do not consider this to be the case. While I do not doubt that the proprietor's watches may include alarms, their primary function remains as a watch and I disagree that this is sufficient to prove use for alarm clocks. In any event, I note that the proprietor refers to its 'Khaki Flight Timer' watch in claiming use of this term and, as I have discussed above, the evidence in respect of this is very limited so would not be of any real assistance to prove genuine use of the above term. As a result, I find that the proprietor has failed to prove genuine use of the above term.

*Parts and fittings for the aforesaid goods [being horological and chronometric instruments], namely needles, [...] watch dials, [...] watch movements, watch springs [and] watch glasses.*

58. In support of use of the parts and fittings aspect of its specification, the proprietor confirms that it provides its customers with a two year warranty and offers watch repair services via a network of dealers throughout the UK. In support of such a claim, a screenshot from the proprietor's website is provided which shows a range of service centres.<sup>37</sup> While this print-out shows a range of third party centres, the narrative evidence sets out that these are service centres through which the proprietor operates and I have no reason to doubt such a claim. While this evidence relates to the provision of services, it is my view that it can also extend to the provision of replacement parts and fittings in that it is likely that an entity providing the services would also be responsible for providing parts and fittings used in the course of the services. On this point, I note that in support of the provision of such parts and fittings, the proprietor has filed a range of invoices which cover the provision of replacement parts in the UK during the relevant period.<sup>38</sup> I note that these invoices are internal invoices and, for the same reasons set out above when

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<sup>37</sup> MKAH33

<sup>38</sup> MKAH34

discussing internal invoices above, I am content to accept them as demonstrative of the eventual provision of these goods to end consumers. Further, in support of this finding I note that the invoices cover repeat shipments to the same address thereby implying that the goods shipped were eventually provided to end consumers.

59. Having reviewed these invoices, I note that they cover a wide range of watch parts and fittings. While that may be the case, the proprietor's term does not cover any and all types of watch parts but, instead, is limited to needles, dials, movements, springs and glasses. Therefore, any reliance upon goods outside of these are of no assistance here. Taking that into account, I note that there are no goods in these invoices that can be said to be used of needles or springs. In respect of the latter point, I note that there are many entries in relation to 'spring bars' but it is my understanding that these do not cover actual springs in the way described by the above term. As such, the only goods covered by the invoices that can be said to fall within the above term are dial kits (which, in my view, will plainly include watch dials), movements and crystals (being a type of glass used in watches). While no information is provided as to exactly how many of these goods are covered in the invoices, I note that their inclusion in the invoices are repeated and consistent over the entirety of the relevant period. Lastly, I note that the evidence sets out that these invoices are not representative of the entire use for such goods but are part of a larger collection of the same.

60. Taking all of the evidence into account, I am of the view that the level of use shown in respect of these goods is low. Having said that, I remind myself that use need not be quantitatively significant in order for it to be deemed genuine. In the present case, I am of the view that the evidence before me could have benefitted from some clarity in respect of the actual level of sales rather than the proprietor simply relying on 'sample' invoices to demonstrate use. However, on balance of the actual evidence before me, I am satisfied that the proprietor has made a genuine attempt to create or preserve a market share in the watch parts covered by the invoices. As such, I am of the view that the proprietor has genuinely used its mark in relation

to dials, movements and glass. However, as the evidence relates to parts and fittings for watches only, the term is to be limited accordingly.

*Parts and fittings for the aforesaid goods [being horological and chronometric instruments], namely watch straps [and] watch chains.*

61. In respect of the above goods, the proprietor relies on the same evidence as set out in the preceding paragraph. This includes the reference to service centres and the range of invoices that cover the provision of 'parts' and 'fittings' for watches. One entry consistent across these invoices is a 'bracelet/strap' and I am of the view that regardless of whether the product is classified as a 'watch bracelet' or 'watch strap', it is a good that may fall within the above term, being a fitting for a watch. Over the 60 pages of invoices, I note that the presence of these goods is repeated and consistent throughout the relevant period. While I do not consider that the use before me is at a significant level, I remind myself that, as per the case law cited above, use need not be quantitatively significant in order for it to be deemed genuine. In the present case, I am of the view that such a level of consistent use is demonstrative of a genuine attempt to create and preserve a market share for these goods. As such, I find that there is genuine use for watch straps.

62. Having reviewed the invoices, I note that there is nothing before me regarding 'watch chains'. On this point, I remind myself that the invoices before me make reference to 'watch bracelets' and while these are noted, I do not consider that a watch bracelet is the same as a watch chain.<sup>39</sup> Therefore, the reference to watch bracelets in the preceding paragraph is, in my view, of no assistance here. As a result, I find that the proprietor has failed to file evidence sufficient to prove genuine use for 'watch chains'. Lastly, and for the avoidance of doubt, I wish to discuss the fact that there is evidence before me in respect of bracelets as items of jewellery. Based on the nature of this evidence (that I will discuss in further detail below), these goods are not parts or fittings for horological and chronometric instruments and are, therefore, of no assistance in respect of the above term.

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<sup>39</sup> I note that I have no evidence before me to demonstrate what a watch chain actually is and whether it is something worn on the wrist (as a bracelet is) or not.

*Parts and fittings for the aforesaid goods [being horological and chronometric instruments], namely watch cases [and] cases for watchmaking.*

63. On the plain reading of the above term, I am of the view that it covers internal and/or external casings of an actual watch itself. I say this because the above term is limited to parts and fittings and, in my view, a watch case (such as a watch box or presentation case, for example) is not a part or a fitting for a watch. As a result, I am of the view that the invoice evidence of watch parts as discussed in the preceding assessments is of assistance here. This is on the basis that the invoices cover a range of goods that can be said to be types of 'case' parts or fittings. These goods are those labelled 'case middle part', 'case back gasket' and 'case tube'. Following the same findings in the preceding assessments, I am of the view that the repeated and consistent appearance of these goods in the invoices is such that it is demonstrative of a genuine attempt by the proprietor to create or preserve a market share in respect of the above goods.

64. Taking all of the preceding findings into account, I conclude that the term of "horological and chronometric instruments, namely watches, chronographs, watch bracelets, alarm clocks and parts and fittings for the aforesaid goods, namely needles, watch cases, watch straps, watch dials, watch chains, watch movements, watch springs, watch glasses, cases for watchmaking" is to be limited to the following:

*"Horological and chronometric instruments, namely watches and parts and fittings for the aforesaid goods, namely watch cases, watch straps, watch dials, watch movements, watch glasses and cases for watchmaking."*

65. In respect of the present term, I note that the proprietor has failed to provide genuine use for "parts and fittings for watches, namely needles, watch chains, watch springs." These goods will, therefore, be revoked accordingly. For the avoidance of doubt, all of the parts and fittings covered by the present term will still be revoked insofar as they relate to the other 'horological and chronometric

instruments' that the proprietor has either failed to defend or failed to provide proof of use for. This will be reflected in the conclusion of my decision.

*Precious stones; semi-precious stones (gemstones).*

66. In respect of the above goods, the proprietor's position is that it sells watches that contain precious stones. Mr Selmi took me to examples of such at the hearing (and reproduced images of the same in his skeleton argument). While I appreciate that these watches do incorporate such materials, they are of no assistance here. This is on the basis that the above terms do not cover goods incorporating precious or semi-precious stones but are the actual raw materials themselves. Simply put, there is nothing before me to suggest that the proprietor trades in or sells precious or semi-precious stones as standalone goods. As such, I find that the proprietor has failed to demonstrate genuine use in respect of the above goods.

*Jewellery, namely bracelets.*

67. The only evidence before me in respect of use of the above term is the presence of a print-out from the proprietor's website for a bracelet<sup>40</sup> and an invoice covering just one sale of the same to a customer in Italy in December 2020.<sup>41</sup> I note that the print-out is undated but the narrative evidence claims that it is from within the relevant period. I note that the applicant takes issue with this but, on the face of it, I have no reason to disbelieve the narrative evidence that it is from within the relevant period. That being said, the evidence before me relates to just one sale and while I note that this is referred to in the narrative evidence as just an example invoice, I am of the view that it falls far short of being sufficient to prove genuine use. On this point, I am of the view that it is reasonable to expect that if evidence of a higher volume of sales was known to the proprietor, then it would have been relatively easy for it to have provided evidence of the same. Without such, I find that the proprietor has failed to prove genuine use for the above goods.

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<sup>40</sup> MKAH31.

<sup>41</sup> See MKAH32 which, I note includes the same reference number as that shown in MKAH31

68. For the avoidance of doubt, I have given consideration to whether the 'bracelet' evidence I have discussed in my assessment of watch fittings above is of any assistance here. Firstly, the reference number of the bracelet discussed in the preceding paragraph does not match any of the reference numbers in the parts/fittings invoices so I have no reason to believe that the invoices cover such goods. Secondly, I do not consider that a watch strap/watch bracelet is an item of jewellery. Instead, it is a fitting or accessory for a watch so would not, in any event, be of any assistance here.

## **CONCLUSION**

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

Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; compact discs; DVDs and other digital recording media; devices for converting compressed sound files (MP3); calculating machines and equipment for the processing of information; software; computer games software for mobile devices; computer and digital music players; electronic game software for mobile phones, computers and digital music players; computers; laptops; palmtops; mobile computers; personal computers; computers worn on the wrist, tablet computers; mobile radios; mobile telephones; mobile computers; mobile telecommunications apparatus and terminals; mobile data apparatus and receivers; wearable mobile phones; digital music players; mobile phones and advanced mobile phones with extended functionality (smartphones); telecommunications apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images, including cell phones and mobile phones with advanced extended features (smartphones); smartphones in the shape of a watch; electronic handheld devices for accessing the Internet and

sending, receiving, recording and storing short messages, e-mails, phone calls, faxes, images, sounds, music, text and other digital data, and for video conferencing; handheld electronic devices for receiving, storing and the wireless transmission of data or messages; electronic handheld devices to monitor and organize personal information; electronic handheld devices for universal search [GPS] and display of maps and navigation information; electronic handheld devices for detecting, storing, tracking, monitoring and transmission of data on the activity of the user, namely position, route, distance, heart rate; covers for computers, mobile phones and laptops; optical apparatus and instruments including eyeglasses, sunglasses, lenses, spectacle cases, cases for sunglasses and magnifiers; batteries for computers and electronic equipment; batteries and batteries for watches and chronological instruments.

Class 14: Precious metals and their alloys and goods made of these materials or plated therewith included in this class, namely figurines, trophies; jewellery, namely rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, jewelry boxes, cases; precious stones; semi-precious stones (gemstones); horological and chronometric instruments, namely watches that communicate data to smartphones, watchbands that communicate data to smartphones and parts and fittings for the aforesaid goods, namely needles, anchors, rockers, barrels, clockworks; parts and fittings for watches, namely needles, anchors, rockers, barrels, clockworks, watch chains and watch springs.

70. The mark may, however, remain registered for those goods for which I have found there to be genuine use. Those goods are as follows:

Class 14: Horological and chronometric instruments, namely watches and parts and fittings for the aforesaid goods, namely watch cases, watch straps, watch dials, watch movements, watch glasses and cases for watchmaking.

71. 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) ground. Instead, it chose to rely on the provision set out in section 46(3) of the Act. This means that where the mark is to be revoked, it is to be done so from the earliest date sought. Therefore, the revoked goods under the proprietor's mark have an effective revocation date of 6 May 2020.

## **COSTS**

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

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



## **APPEAL PERIOD**

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

**Dated this 6<sup>th</sup> day of November 2023**

**A COOPER**

**For the Registrar**