

O-303-10

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER
2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 465986
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD) AND AN
APPLICATION TO EXTEND PROTECTION TO THE UK FOR THE
TRADE MARK**



IN CLASS 9

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 71749 BY OMEGA ENGINEERING INC**

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF International Registration No. 465986
in the name of Omega SA (Omega AG)(Omega Ltd) and an application to
extend protection to the UK for the mark**



in Class 9

and

**IN THE MATTER OF Opposition thereto under No. 71749
by Omega Engineering Inc**

BACKGROUND

1) On 6 November 2003 the UK was notified by the World Intellectual Property Organization (WIPO) of international registration 465986 (having a registration date of 25th November 1981), in respect of which it had been subsequently designated under the relevant provisions of the Madrid Protocol (the “Protocol”). The relevant mark (“the designation”) is shown above and is in respect of a list of goods in Class 9. The designation stands in the name of Omega SA (Omega AG) (Omega Ltd) (“Swiss”) of Rue Stampfli 96, Bienne, Switzerland CH-2503.

2) The designation was accepted and advertised for opposition purposes on 25 April 2008. On 25 July 2008, Omega Engineering, Inc (“Engineering”) of One Omega Drive, Stamford, Connecticut 06907-0047, United States of America filed notice of opposition. The opposition was based solely on the provisions of section 5(2) (b) of the Trade Marks Act 1994 (“the Act”). Engineering relied upon four earlier marks.

3) Swiss subsequently filed a counterstatement denying Engineering’s claims and requesting that it provide proof of use in respect of all the goods claimed for the one mark that is registered, namely UK registration 1557184. The other earlier marks, all Community Trade Marks (CTMs), were subject to opposition proceedings before the Office for Harmonization in the Internal Market (OHIM).

4) Both sides filed evidence and requested a contribution to their costs. The matter came to be heard on 27 October 2009 when Swiss was represented by Mr Michael Edenborough of Counsel, instructed by Mewburn Ellis LLP and Engineering was represented by Mr David Crouch of Bromhead Johnson.

5) When submitting its skeleton arguments for the hearing, Engineering brought to my attention to the fact that the CTM 174458 OMEGA, one of its earlier marks relied upon and subject to opposition proceedings before the OHIM, had been divided. The divided CTM had been accorded the number 8376311, and is proceeding to registration in respect of detailed lists of goods and services including a list of Class 9 goods that it argued were substantially identical or similar to Swiss' goods.

6) This CTM once registered, would become an earlier mark not subject to the proof of use requirements. At such time as it completed its registration procedures, it would become a significant earlier right in these proceedings. In light of this, I wrote to the parties after the hearing informing them of my intention to delay issuing the decision until this CTM has been finally determined. It completed its registration procedure on 16 April 2010 and Swiss were subsequently invited to provide any submissions it wished to make in respect of this registered earlier mark. In reply, Swiss informed the Registry that it was taking steps to cancel the UK designation, the object of these proceedings. WIPO issued a notification dated 7 July 2010, confirming that the UK designation 465986 had been cancelled.

COSTS

7) In light of these developments, the proceedings are now without object and there is no substantive point to decide. The only outstanding issue is in respect of costs and I invited submissions on this point. Only Swiss responded, submitting that, if costs are awarded at all, the award should be on the normal scale.

8) Whilst the proceedings are now without object, I bear in mind that Engineering incurred costs in filing its statement of case and filing evidence as well as in respect of instructing counsel at the subsequent hearing. Taking all these factors into account, I find that Engineering is entitled to a contribution towards its costs.

9) However, the lateness of the cancellation of the subject designation appears to be as a result of the timeframe in play in respect of the proceedings before the OHIM and not as a result any wilful delay on the part of Swiss. As such, and as Swiss submit, it is appropriate to award costs on the normal scale. With this in mind, I award costs on the following basis:

Preparing statement of case & considering other side's statement	£450
Preparing evidence & considering other side's evidence	£1100
Preparing for, and attending hearing	£900
TOTAL	£2450

10) I order Omega SA (Omega AG) (Omega Ltd) to pay Omega Engineering, Inc. the sum of £2450. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24 day of August 2010

**Mark Bryant
For the Registrar,
the Comptroller-General**