

O-313-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2333864B  
BY OMEGA ENGINEERING, INC  
TO REGISTER THE TRADE MARK:**

**OMEGAMETER**

**IN CLASSES 9, 14 and 37**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 94625  
BY OMEGA SA (OMEGA AG) (OMEGA LTD)**

## **Trade Marks Act 1994**

**In the matter of application no 2333864B  
by Omega Engineering, Inc  
to register the trade mark:  
OMEGAMETER  
in classes 9, 14 and 37  
and the opposition thereto  
under no 94625  
by Omega SA (Omega AG) (Omega Ltd)**

1) This opposition relates solely to the class 14 specification, which now reads:

*semi-worked wire of precious metals industrially and/or scientifically employed for measuring or controlling temperature.*

Originally the opposition was based on a number of trade mark registrations and applications and a variety of grounds; by the time of the hearing the basis of the opposition had been honed down to one point of contention.

2) Omega Engineering, Inc, which I will refer to as Engineering, has accepted that there is a likelihood of confusion in relation to the class 14 element of its application and Community trade mark application no 7320229 of Omega SA (Omega AG) (Omega Ltd), which I will refer to as Swiss, for the trade mark OMEGA. (The current status of this application is registration pending.) Engineering seeks the rejection of the opposition upon the basis of a 1994 agreement between the parties (the agreement). Effectively Engineering is claiming that Swiss's opposition is estopped because of the agreement. Swiss does not consider that the current application is caught by the terms of the agreement and that the application should be refused in respect of the class 14 goods.

3) A hearing was held on 19 November 2008. Engineering was represented by Mr David Crouch of Bromhead Johnson. Swiss was represented by Mr Michael Edenborough of counsel, instructed by Mewburn Ellis LLP.

4) The operative parts of the agreement are reproduced below:

“WHEREAS

(A) Both parties hereto are desirous of terminating Opposition proceedings lodged by Omega Engineering Incorporated against a Hong Kong Trademark Application No 3221/86 in class 9 of OMEGA SA.

- (B) OMEGA ENGINEERING INCORPORATED has made a Hong Kong Trademark Application to register the mark "ΩE" under Application No 1115A/87 in class 9.
- (C) OMEGA SA intends to oppose Hong Kong Trademark Application No 1115A/87 in class 9.
- (D) OMEGA ENGINEERING INCORPORATED has made applications under Nos 12775 and 12776 in the Federal Republic of Germany to register as trademarks OMEGA SOFT and OMEGA in class 9 and class 42.
- (E) OMEGA SA intends to oppose German Trademark Application Nos 12775 and 12776.
- (F) Both parties hereto are desirous of coming to an arrangement for the avoidance of future interference Worldwide between their respective fields of commercial operation under their Rights in respect of Trademarks consisting of or including the word OMEGA and/or the Greek letter Ω or containing elements colourably resembling either of those two elements.

IT IS HEREBY AGREED as follows:

OMEGA ENGINEERING INCORPORATED shall forthwith withdraw its Opposition to Application No 3221/86 upon the signing of this Agreement by formal notification to the Hong Kong Registrar of Trademarks.

2 OMEGA SA shall upon the signing of this agreement amend the specification of goods in its application No 3221/86 to read:

*"Computer controlled apparatus for checking and controlling the measurement of time and distances for use in sporting events; electronic information display apparatus for use in sporting events and in public concourses; parts and fittings for the aforesaid goods; all included in Class 9".*

3 Each of the parties hereto will bear its own costs in the said Opposition proceedings.

4 Henceforth from the signing of this Agreement and effective in all countries of the World:-

a OMEGA ENGINEERING INCORPORATED undertakes not to use, register or apply to register any trade mark consisting of or containing the word OMEGA or the Greek letter Ω or any mark containing elements colourably resembling either of those two elements in respect of computer controlled measuring, timing and display apparatus, unless intended for science and industry.

b OMEGA SA undertakes not to use, register or apply to register any trade mark consisting of or containing the word OMEGA, or the Greek letter  $\Omega$  or any element colourably resembling either of those two elements, in respect of

*"Apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow"*

c OMEGA SA will not object to the use or registration by OMEGA ENGINEERING INCORPORATED of any trade mark consisting of or containing the word OMEGA or the Greek letter  $\Omega$  or any element colourably resembling either of those two elements in respect of apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow

5 OMEGA ENGINEERING INCORPORATED shall upon the signing of this Agreement amend the specification of goods in its application No 1115A/87 to read:

*"transducers, detectors, sensors; electrical instruments and apparatus for controlling, checking, indicating, displaying, measuring, monitoring, warning, data logging (all for use with variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow) and parts and fittings for all the aforesaid goods, computers, computer programs, computer interfacing instruments and apparatus; signal conditioning instruments and apparatus and signal amplifiers; thermocouples, thermocouple probes and thermopiles; electrical power supply units; electrical adaptors, connectors, terminals, feedthrough unions, bushings, sockets, wires and cable, all of the foregoing only for use in science and industry, and not including computer controlled apparatus for checking and controlling the measurement of time and distances for use in sporting events; electronic information display apparatus for use in sporting events & in public concourses and parts and fittings for the aforesaid goods."*

6 OMEGA ENGINEERING INCORPORATED further undertakes to use and/or register the mark "QE" the subject of application No 1115A/87 only in the form as applied for under the said application.

7 OMEGA ENGINEERING INCORPORATED shall upon the signing of this Agreement amend the specification of goods in its German applications Nos 12775 and 12776 so as to set forth that all of the goods covered are for scientific and/or industrial use.

8 Each of the parties hereto agrees that the above terms are to be binding upon themselves, their assigns (sic) and licensees and are to be communicated to

their Registered and Permitted Users, if any, and are to ensure to the benefit of the other party's assigns (sic), licensees and Registered and Permitted Users.

9 Each of the parties hereto agrees that for all intents and purposes, this agreement supersedes the former Agreement made by the parties hereto and dated 6<sup>th</sup> March 1992 by OMEGA ENGINEERING INCORPORATED and 22<sup>nd</sup> April 1992 by OMEGA SA."

5) The agreement had previously been considered by Pumfrey J, in an appeal against a decision of the registrar, in *Omega SA v. Omega Engineering Limited* [2002] EWHC 2620 (Ch). In that case the dispute centred around the definition of the term "variable parameter", not a matter that is in dispute in this case. However, I consider that in interpreting and applying the agreement, certain of the comments of Pumfrey J should be borne in mind:

"This contention of the opponents is, in my judgment, based upon a wrong construction of clause 4(a). It seems to me to be clear that if the proviso "unless intended for use in science and industry" is satisfied, then clause 4(a) ceases to have any application. Engineering can apply for what they please, provided that the specification is limited to goods for use in science and industry. The real question is whether, notwithstanding that Engineering can apply under 4(a), SA can oppose. That depends upon the construction of clause 4(c), to which I shall now turn.

As I have observed, clauses 4(b) and 4(c) are complementary. SA applies not to register in the defiant clause of goods and will not oppose registration by Engineering in that class -- class as defined in the agreement and not class in its technical sense under the classification. This is a true demarcation. It is to be noted that measurement of time is not referred to explicitly in clauses 4(b) or 4(c) at all. On the face of it, therefore, clause 4(c) does not prevent SA from opposing any application by Engineering which is not expressly prohibited contractually by clause 4(a). Can this have been what the parties intended?

As I have indicated, the agreement was entered into also to compromise the proceedings to which I have referred. Thus SA accepted the limitations of clause 2 and Engineering those of clause 5. Engineering's German applications were limited to scientific or industrial use, but unfortunately I do not know (because no information has been provided) whether that specification included time measuring apparatus. If apparatus of any kind for measurement of time or of elapsed time is to be covered by the prohibition of clause 4(c), it must be as an unidentified variable parameter such as "pressure, force, load, vibration, conductivity, liquid level, acidity, humidity, strain and flow".

What is immediately apparent is that these are all quantities which are measured by transducer. They are quantities which can be measured and controlled in response to their measured value. Time, on the other hand, although a parameter that varies, in the sense that it passes, is not such a quantity. Periods of time can, of course, be pre-set and, to that extent, familiar to anyone with an egg timer, time is a variable parameter. But it is not measured in the sense that the listed quantities are measured.

I do not think that time is a variable parameter within the contemplation of clause 4(c). I am reinforced in this view by two considerations. First, clause 4(c) permits SA to oppose any mark applied for by Engineering in respect of apparatus otherwise of the kind specified which is not for use industrially or scientifically. A prohibition in respect of time measuring apparatus, regardless of its intended application, obviously directly reflects the centre of gravity of SA's business. Thus, on the construction which I consider appropriate, the centre of SA's business, which is concerned with time measurement, is surrounded by a penumbra of goods otherwise than for use in the industrial and scientific context. It is convenient at this point to refer to the second substantive argument advanced by the Respondents by way of cross-appeal.....

.....Clause 4(a) gives SA the right to consider applications on a case by case basis. It does not oblige SA not to oppose.”

6) The parties have commented upon how the current specification has come about. The specification, as filed, was for:

*goods of precious metals, none being wristwatches or parts and fittings therefor; all for science and/or industry.*

The specification as published was for:

*wire of precious metals for science and/or industry.*

During the proceedings Engineering requested that the specification be amended to:

*apparatus in the form of semi-worked wire of precious metals industrially and/or scientifically employed for measuring or controlling temperature.*

The Trade Marks Registry (TMR) suggested that the goods should be included in the class 9 specification and the class 14 specification deleted. Engineering rejected this suggestion, advising that the goods are sold under this description. It stated that the goods are not thermistors but coils of precious metal wire. The TMR then advised engineering that the class 14 specification should read as it currently stands. Engineering responded that it preferred its proposed wording.

The TMR advised Engineering that the head of classification had been consulted and had advised that the proposed specification was not acceptable as the presence of the term “apparatus”, giving it its natural meaning of a contrivance of some description, meant that the proposed specification would not be appropriate to class 14. An ex parte hearing was held in relation to the specification issue. The position already advised by the TMR was maintained, this decision, as per section 34 of the Trade Marks Act 1994 (the Act) was final<sup>1</sup>. Subsequent to the ex parte hearing Engineering accepted that the class 14 specification should read:

*semi-worked wire of precious metals industrially and/or scientifically employed for measuring or controlling temperature.*

7) Engineering has filed evidence in relation to the meaning of “apparatus”. The definitions include the following:

“the equipment needed for a particular activity or purpose”;

“a collection of instruments, machines, tools, parts, or other equipment for a particular purpose”

“a machine having a specific function”;

“a set of materials or equipment designed for a particular use”;

“a group of anatomical or cytological parts functioning together”;

“an instrument or appliance designed for a specific operation”;

“[t]hings provided as means to some end”;

“[a] full collection or set of implements, or utensils, for a given duty, experimental or operative; any complex instrument or appliance, mechanical or chemical, for a specific action or operation; machinery; mechanism”;

“equipment designed to serve a specific function”;

It has also furnished various definitions of equipment:

“the items needed for a particular purpose”;

---

<sup>1</sup> 34. - (1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final.

“anything designed or provided for a particular use”;

“anything, kept, furnished or provided for a specific purpose”.

Pages downloaded from Wordsmyth and Bartelby.com record apparatus as being a synonym for equipment.

8) The law in relation to the interpretation of agreements is well established. In *Investors Compensation Scheme Ltd v West Bromwich Building Society* [1998] 1 WLR 896 Lord Hoffman stated:

“My Lords, I will say at once that I prefer the approach of the learned judge. But I think I should preface my explanation of my reasons with some general remarks about the principles by which contractual documents are nowadays construed. I do not think that the fundamental change which has overtaken this branch of the law, particularly as a result of the speeches of Lord Wilberforce in *Prenn v. Simmonds* [1971] 1 W.L.R. 1381, 1384-1386 and *Reardon Smith Line Ltd. v. Yngvar Hansen-Tangen* [1976] 1 W.L.R. 989, is always sufficiently appreciated. The result has been, subject to one important exception, to assimilate the way in which such documents are interpreted by judges to the common sense principles by which any serious utterance would be interpreted in ordinary life. Almost all the old intellectual baggage of "legal" interpretation has been discarded. The principles may be summarised as follows:

(1) Interpretation is the ascertainment of the meaning which the document would convey to a reasonable person having all the background knowledge which would reasonably have been available to the parties in the situation in which they were at the time of the contract.

(2) The background was famously referred to by Lord Wilberforce as the "matrix of fact," but this phrase is, if anything, an understated description of what the background may include. Subject to the requirement that it should have been reasonably available to the parties and to the exception to be mentioned next, it includes absolutely anything which would have affected the way in which the language of the document would have been understood by a reasonable man.

(3) The law excludes from the admissible background the previous negotiations of the parties and their declarations of subjective intent. They are admissible only in an action for rectification. The law makes this distinction for reasons of practical policy and, in this respect only, legal interpretation differs from the way we would interpret utterances in ordinary life. The boundaries of this exception are in some respects unclear. But this is not the occasion on which to explore them.

(4) The meaning which a document (or any other utterance) would convey to a reasonable man is not the same thing as the meaning of its words. The meaning of words is a matter of dictionaries and grammars; the meaning of the document is what the parties using those words against the relevant background would reasonably have been understood to mean. The background may not merely enable the reasonable man to choose between the possible meanings of words which are ambiguous but even (as occasionally happens in ordinary life) to conclude that the parties must, for whatever reason, have used the wrong words or syntax. (see *Mannai Investments Co. Ltd. v. Eagle Star Life Assurance Co. Ltd.* [1997] 2 W.L.R. 945

(5) The "rule" that words should be given their "natural and ordinary meaning" reflects the common sense proposition that we do not easily accept that people have made linguistic mistakes, particularly in formal documents. On the other hand, if one would nevertheless conclude from the background that something must have gone wrong with the language, the law does not require judges to attribute to the parties an intention which they plainly could not have had. Lord Diplock made this point more vigorously when he said in *The Antaios Compania Neviera S.A. v. Salen Rederierna A.B.* 19851 A.C. 191, 201:

". . . if detailed semantic and syntactical analysis of words in a commercial contract is going to lead to a conclusion that flouts business commonsense, it must be made to yield to business commonsense."

In *Bank of Credit and Commerce International SA (in liquidation) v Ali* [2001] UKHL/8, [2001] 1 All ER 961 Lord Bingham of Cornhill stated (at paragraph 8):

"In construing this provision, as any other contractual provision, the object of the court is to give effect to what the parties intended. To ascertain the intention of the parties the court reads the terms of the contract as a whole, giving the words used their natural and ordinary meaning in the context of the agreement, the parties' relationship and all the relevant facts surrounding the transaction so far as known to the parties. To ascertain the parties' intentions the court does not of course inquire into the parties' subjective states of mind but makes an objective judgment based on the materials supplied."

Lord Hoffmann stated (at paragraph 37):

"What would a reasonable person have understood the parties to mean by using the language of the document against all the background which would reasonably have been available to them at the time?"

In *Roche Products Limited, Roche Diagnostics GmbH v Kent Pharmaceuticals Limited* [2006] EWCA Civ 1775 Neuberger LJ stated

“At least in English law, it is well established that, in the context of commercial contracts, although an expression will normally be given its ordinary English meaning, it has to be construed in its verbal and commercial context. Further, where it is demonstrated by satisfactory evidence that an expression is understood to have a special meaning by virtue of what has been called the "custom of the trade", then effect will be given to the custom of the trade, unless it is inconsistent with the express terms of the contract - see for instance *Smith Hogg Co. -v- Louis Bamberger & Sons* [1929] 1 KB 150 and the cases cited therein. In *Yangtze Insurance Association -v- Indemnity Mutual Marine Assurance Co* [1908] 2 KB 504 at 509, Farwell LJ said this:

"The general rule of construction is that words used in documents must receive their primary signification, unless the context of the instrument read as a whole, or surrounding contemporaneous circumstances, shew that the secondary meaning expresses the real intention of the parties, or unless the words are used in connection with some place, trade or the like, in which they have acquired the secondary meaning as their customary meaning *quoad hoc*".

28. Thus, when interpreting a contract, an English court is prepared to recognise that a particular expression, which may have a different or more limited meaning to an ordinary speaker of English, can nonetheless come to have a different or wider meaning in a particular trade. By parallel reasoning, it seems to me that the court should, in principle, be prepared to recognise that a mark may have a different or wider meaning, in a particular trade, from that which would be derived from the reason (whether in law or otherwise) for the affixing of the mark. Despite the strict approach to the meaning of "consent" in the context of Article 7, I doubt that what the ECJ said in the *Zino Davidoff* case would rule out the possibility of such an argument on the part of Kent succeeding, at least in principle, in the present case."

9) Mr Edenborough argued that this opposition was not caught by the agreement. He submitted that the agreement was drawn up to settle a conflict between the parties, that conflict involved a particular trade mark and related to class 9 goods. Mr Edenborough submitted that the agreement related to apparatus for certain purposes, all of which falls within class 9. He submitted that clause 4(c) uses apparatus in the context of how it would be understood as per the Nice classification system. Mr Edenborough stated that there was a conflict to resolve, it was a conflict relating to a class 9 problem; the apparatus for measuring variable parameters, such a temperature, is in class 9. He stated that

there was no separate definition of 'apparatus'. It is defined by reference to the goods that formed the subject matter of the conflict. Mr Edenborough concluded that the word apparatus in clause 4(c) does not have the wider wording that Engineering has proposed in its skeleton argument, a meaning that means that it could encompass non-finished goods that fall outside class 9. Mr Edenborough submitted that it was clear that the class 14 goods of the application are not apparatus as per the Nice classification and so on the one side there is the class 14 application for goods that are not apparatus and on other clause 4(c) which is referring to class 9 goods that are apparatus. It was his view that no reasonable interpretation of clause 4(c) could be extended to encompass goods that are not apparatus in class 14. Mr Edenborough submitted that there is another way to reach this same conclusion. The agreement was to resolve a conflict with respect to goods centred around class 9 because class 9 is where Engineering's interests lie whereas class 14 is where Swiss's interests lie.

10) Mr Crouch submitted that Mr Edenborough's submission that the agreement was restricted, in respect of Engineering, to class 9 goods was an unreasonable interpretation of the agreement. He saw no reason to assume that because the recitals refer to class 9 goods that the interpretation of clause 4(c) should be limited to class 9 goods. Mr Crouch stated that it is incorrect to state that Engineering has never been concerned with class 14 goods. He considered that the issue hinges around how the word 'apparatus' is to be interpreted. Mr Crouch noted that an attempt was made to refer to the class 14 goods as apparatus and that perhaps, in hindsight, that was not a good idea. Mr Crouch argued that if the position of the registrar is adopted, that a simple piece of wire cannot be defined as apparatus this does not mean that apparatus in clause 4(c) should be restricted to contrivances; instead it should be seen as encompassing a whole collection of items, one of which could be a simple thing such as semi-worked wire. As an example Mr Crouch referred to the Nice classification in class 11 where there is a broad generic heading for apparatus for heating, nevertheless, hot water bottles are classified in class 11. One would not normally refer to a hot water bottle as apparatus because it does not have the complexity of a contrivance, as per the interpretation of the registrar. Mr Crouch went on to say:

"There is an argument, say, if you were asked to put climbing equipment into the back of a van, you would include a lot of items, one of which might be a simple piece of rope. If you were questioned whether or not that piece of rope was apparatus or equipment in this case, in this argument, you might say, "No, it is not equipment." Therefore you might be questioned, "Why did you put it in the van?" Collectively, in terms of crampons, pulleys, harnesses, a piece of rope would very definitely fall within the understanding, the simple straightforward common sense understanding, of the word "equipment"."

Mr Crouch submitted that equipment is very closely related to apparatus (and, of course, the evidence of Engineering shows that one is a synonym for the other) He went on to say:

“It may be that on a kitchen table would be spread before you ammeters, complicated connection devices, chips of one kind or another, and simple pieces of wire. You would collectively refer to that as apparatus. To try and exclude the bit of wire just because, according to Mr. Alan Pike, you could not fairly call that apparatus, is not reasonable. It is not looking at it from a common sense point of view.”

Mr Crouch submitted that the goods are in class 14, that is not something which Engineering has arranged. The product is a simple extrusion and is semi-worked. However, Mr Crouch submitted that the goods fall within the common sense understanding of the word apparatus; any other interpretation would unduly restrict the scope of clause 4(c). Mr Crouch submitted that it is clear that in clause 4(c) the key matter is the purpose to which the equipment is put to, in this case it is for controlling parameters such as temperature, pressure and the like. As the goods are simple lengths of wire or coiled on a simple drum they are in class 14.

11) Mr Crouch finished his submissions by referring to the definitions of apparatus that Engineering had furnished in evidence.

12) The submissions of the parties have concentrated upon the meaning of apparatus and the relevance, or otherwise, of the class into which the goods of the applications fall. Mr Edenborough seemed to consider that the agreement cast a moat around class 14 which Engineering is not permitted to cross. The Nice classification is to some extent an arbitrary system which divides all the products and services of the world into 45 classes for administrative purposes. There are, of course, parameters set as to what goes into the classes, although those parameters can change and goods and services can and do shift classes. The position re the classification of goods and services is made clear in rule 2(4) of Commission Regulation 2868/95 of December 13, 1995:

“(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

(Of course, the above regulation relates to Community trade marks but the principle is the same in the United Kingdom.)

13) I am unconvinced that the Nice classification is a key to the interpretation of clause 4(c) in the context of this opposition.

14) The parties have argued as to the meaning of apparatus both within and without the context of the agreement. I consider that there is something to be said for Mr Crouch's submission that although the term 'apparatus' could not be applied to the semi-worked wire of itself, semi-worked wire could be included in a range of goods that would be termed as apparatus. There is no definition of apparatus in the agreement and there is no indication that it should be interpreted as per the Nice classification system. In addition, I can see nothing that suggests that the Nice classification defines apparatus in a particular way. The registrar, in this case, has simply decided that the use of the term apparatus in relation to the goods in question would bring them into class 9; he has not defined the term apparatus. I do not consider that the term apparatus in the context of the agreement, or specifications in general, can be considered to have a meaning that is a "custom of the trade". (I note that the registrar used to cavil at the term 'equipment' and require that the term 'apparatus and instruments' should be substituted for it.)

15) There is nothing to suggest that "something must have gone wrong with the language".

16) The specification is for:

*semi-worked wire of precious metals industrially and/or scientifically employed for measuring or controlling temperature.*

The goods covered by clause 4(c) are:

*apparatus industrially and/or scientifically employed for measuring or controlling variable parameters such as temperature, pressure, force, load, vibration, electrical conductivity, liquid level, acidity, humidity, strain and flow.*

Bearing in mind Lord Hoffman's fourth principle I consider that the goods covered by clause 4(c) are those which can have no other purpose than that outlined in the clause, they cannot be used for some other end. If this is not the case the agreement effectively loses all meaning. The goods of the application are semi-worked goods, they are unfinished. I specifically referred to the nature of the goods at the hearing:

"THE HEARING OFFICER: Mr. Crouch, there is only one query I really have that I want to ask you. Looking at the specification, effectively this is semi-worked wire and precious metals. Then it seems to me that the rest of that specification is a definition of the channel of trade rather than the actual product.

MR. CROUCH: It would certainly go through a different channel of trade to, say, jewellery or clocks. Indeed, I would say that, yes.

THE HEARING OFFICER: After semi-worked wire and precious metal, as it is semi-worked and it is wire, it does not actually in the end, of itself, define how it would be used or could be used. It could be used for anything. All this does is identify that these will go through a channel of trade which is industrially and scientifically employed for measuring or controlling temperature.

MR. CROUCH: Yes.

THE HEARING OFFICER: What I am trying to say there is that it is not actually a definition of the goods but a definition of the market.

MR. CROUCH: I think it does impose a restriction on the goods in that, as you say, they would go through a channel and they would be duly marked for that purpose, although I agree that they could be taken by a jeweller and used, because they are semi-worked wire, for a different purpose. That is not how they would be sold, yes, indeed, and would be put through different trade channels."

It seems to me that this is the key to the problem. The nature of the goods, owing to their intrinsic nature, is not defined, the markets to which they are sold is defined; this does not actually affect the nature of the goods. Engineering could sell the *semi-worked wire of precious metals* but there is nothing in the nature of the goods that means that it will be *industrially and/or scientifically employed for measuring or controlling temperature*. Indeed once sold there is nothing that Engineering can do in relation to the use of the goods. So, in the worst case scenario for Swiss, the purchaser of the goods could use them in watches, clocks or jewellery. **Consequently, I do not think that the goods of the application are on a par in any way with the goods described in clause 4(c) and so Swiss was not debarred from opposing the registration of the trade mark in class 14.**

**17) Subject to the completion of the registration process for Community trade mark registration no 7320229 the application is to be refused under section 5(2)(b) of the Trade Marks Act 1994 in respect of the class 14 goods of the application.**

### **Costs**

18) Mr Edenborough submitted that Swiss should have an award of costs off the scale as they were put to proof of use when owing to Swiss's two Community trade mark applications this was clearly a redundant exercise. One is left to wonder why then Swiss included all of the other trade marks upon which it earlier relied. Engineering could hardly second guess that Swiss would rely on its Community trade mark applications only. The evidence which Swiss filed was for the greatest part gleaned from other proceedings between the parties and did not for the most part show use in the five year period up to the date of publication, 9

June 2006. Swiss was also labouring under the misapprehension also that because of previous revocation actions involving the parties there was effectively issue estoppel in relation to proof of use owing to some overlap on the margins of the periods concerned. Consequently, I see no reason for compensating Swiss for this evidence in any shape or form. If Swiss had maintained reliance upon the other registrations I would not have compensated it for the evidence, owing to its nature. (It is to be noted at the same time that Engineering did not assist matters by fundamentally changing the basis of the defence; it did not originally rely upon the agreement as its defence.)

19) Omega SA (Omega AG) (Omega Ltd) having been successful is entitled to a contribution towards its costs. I order costs upon the following basis:

Opposition fee:	£200
Statement of case:	£300
Considering counterstatement:	£200
Preparation and attendance at hearing:	£500
Total:	£1,200

**I order Omega Engineering, Inc to pay Omega SA (Omega AG) (Omega Ltd) the sum of £1,200 in the event that Community trade mark no 7320229 is registered.**

**20) This decision is provisional, being subject to the registration of the Community trade mark. Swiss should inform me of any change of status of Community trade mark no 7320229 within one month of the change of status. A supplementary decision will then be issued, appeal dates will run from the date of the issue of the supplementary decision.**

***Conduct of advocates***

21) I am grateful to Mr Crouch and Mr Edenborough for the sensible and helpful approach that they took to the issues before me, honing the matters down to the key elements whilst putting forward clear and cogent arguments for their respective positions. The hearing represented a demonstration of economy of process at its best.

**Dated this     day of November 2008**

**David Landau  
For the Registrar  
the Comptroller-General**