

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 474165
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD)**

**AND THE APPLICATION FOR PARTIAL REVOCATION THEREOF
UNDER NO 80068
BY OMEGA ENGINEERING, INC**

TRADE MARKS ACT 1994

In the matter of registration no 474165

of the trade mark:

OMEGA

in the name of Omega SA (Omega AG) (Omega Ltd)

**and the application for partial revocation thereof
under no 80068**

by Omega Engineering, Inc

BACKGROUND

1) On 14 September 2001 Omega Engineering, Inc (referred to as US from herein) filed an application for the partial revocation of trade mark registration no 474165 standing in the name of Omega SA (Omega AG) (Omega Ltd) (referred to as Swiss from herein). The trade mark was registered on 8 March 1927. It is currently registered for the following goods:

dental amalgams; anti-rheumatism rings, bracelets and anklets; all made of precious metal

electrical contacts; crucibles; spectacles frames; all made from precious metal

goods of precious metals and jewellery, and imitations of such goods and jewellery

pens; penholders; pen cases and pencil cases; inkstands; all made from precious metal or coated therewith

The goods are in classes 5, 9, 14 and 16 respectively of the International Classification of Goods and Services.

2) US states that the registration has not been used by Swiss for at least five years for the goods encompassed by the specification with the exception of wristwatches. US states that to the extent that the aforesaid goods extend beyond wrist watches the registration should be revoked under section 46(1) (a) of the Trade Marks Act 1994 (the Act) or in the alternative under section 46(1)(b) of the Act.

3) On 2 January 2002 Swiss filed a counterstatement. Swiss states that the trade mark was originally registered for *goods of precious metals and jewellery, and imitations of such goods and jewellery*. It includes a copy of the registration certificate. Swiss states that in 1995 the registration was re-classified into a number of different classes. It states that in the last five years the trade mark has only been used in relation to the class 14 goods originally claimed. Swiss furnish evidence to show use of the trade mark.

4) Swiss states that it accepts that the trade mark should be revoked in relation to the goods in classes 5, 9 and 16 but maintains that the whole of the class 14 specification

should remain upon the register. Swiss requests that no award of costs is made in these proceedings.

5) Both sides filed evidence.

6) The matter came to be heard on 22 January 2003 when US was represented by Mr Christopher Morcom QC, instructed by Bromhead & Co, and Swiss was represented by Ms Sofia Arenal of Mewburn Ellis.

Swiss's evidence

Witness statement of Peter Stierli

7) Mr Stierli is the vice president and chief finance officer of Swiss. He states that the trade mark OMEGA has been used (either alone or with the Greek letter O) in relation to goods of precious metals and jewellery, and imitations of such goods and jewellery in the United Kingdom during the last five years including in relation to clocks and watches. He exhibits brochures from 1996, 1997 and 1999. Mr Stierli states that the brochures all relate to products available under the OMEGA trade mark in the United Kingdom in those years. He states that many of the products are made from or coated with precious metals and/or encrusted with jewels.

8) Mr Stierli refers to the first page of the brochure entitled "Collection Haute de Gamme":

"Jewellery has always played a role in OMEGA's history as evidenced by the numerous prestigious gold medals and Grand Prix awards received by the brand for its creations: the Diamonds International Award, the City of Geneva Award and the Golden Rose of Baden Baden.

All are in recognition of the superior talent and experience of OMEGA's master jewellers. First, the most beautiful precious gems – diamonds, sapphires and rubies – are selected. Then each gem is hand-cut according to rigorous aesthetic and quality standards. Finally comes the delicate stage of mounting the precious stones on the jewel in the most harmonious fashion possible with the lustrous gold."

9) The goods shown in the catalogues are wrist watches and leather straps. Certain of the wrist watches shown are in precious metals and/or contain jewels.

10) Mr Stierli exhibits copies of details of the official retailers in the United Kingdom for the goods of Swiss sold under the trade mark OMEGA.

11) Mr Stierli exhibits copies of invoices which he states relate to sales in the United Kingdom of clocks, watches, jewellery, bracelets and cases made of precious metals, particularly gold. He states that several company names are mentioned on the invoices

though all bear the trade mark OMEGA. These, he states, are The Swatch Group (UK) Limited, SMH (UK) Limited, SMH Europa (Great Britain part) and The Swatch Group (Europa) UK. He states that all of these companies are or were at the relevant time part of the group of companies headed by The Swatch Group Limited. He states that Swiss is within this group and that use of the OMEGA trade mark by other companies within the group is with its consent.

12) A set of invoices is headed "Invoices for Clocks". All of them are from Swiss to The Swatch Group (UK) Limited. The invoices come from 1998, 1999 and 2000. The invoices do not state what trade mark appears upon the clock. The clocks are described as "CONST" or "MOTHER CLOCK CENTRALINO". All but one of the clocks is described as CONST, it is indicated that these clocks are of aluminium. In all, the invoices are for forty one clocks.

13) There are bundles of invoices headed "Gold Watches" for various years. As US have not attacked the registration in relation to wristwatches, and there is no indication that these goods are other than wristwatches, I do not see any need to comment further upon these invoices.

14) There are then bundles of invoices headed "Invoices for Cases and Bracelets" for the years 1996, 1998, 1999, 2000 and 2001. In fact the bundle headed for 1996 also includes invoices from 1997. The invoices are for such goods as gold bracelets, gold crowns, screws, gold cases, gold push pieces, gold links, steel bracelets, steel cases, bezels, seals, gold clasps. They, as far as I can see, represent parts and fittings for watches, some of which are of gold.

US's evidence

First witness statement of David John Crouch

15) Mr Crouch is a trade mark attorney at Bromhead & Co. Mr Crouch exhibits an agreement from 1994 between Swiss and US.

16) From the recitals to the 1994 Agreement it seems that a worldwide Agreement resulted specifically from proceedings entered into or threatened in Hong Kong and Germany. It contains provisions (paragraphs 1 to 3 and 5 to 7) which set out amendments to the specifications of US and Swiss designed to resolve the disputes in those countries. Sandwiched between the market specific provisions is paragraph 4, this sets out the basis for a worldwide settlement. It reads as follows:

"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 trademark consisting of or containing the word OMEGA or the Greek letter O 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 or industry.

b. OMEGA SA undertakes not to use, register or apply to register any trademark consisting of or containing the word OMEGA or the Greek letter O 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 trademark consisting of or containing the word OMEGA or the Greek letter O 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."

Witness statement of Peter W Peterson

17) Mr Peterson is an attorney-at-law in the United States of America. He states that in proceedings between US and Swiss in the United States of America he conducted a pre-trial discovery deposition of Christiane Sauser Rupp, on 27 June 2001. Ms Sauser Rupp appeared as a witness for Swiss under rule 30(b)(6) of the US Federal Rules of Civil Procedure. Mr Peterson states that her testimony was the testimony of Swiss rather than testimony of her personal knowledge. Mr Peterson exhibits pages 1 to 13 and 54 to 61 from the transcript of Ms Sauser Rupp's testimony, this transcript runs to some 213 pages.

18) A good part of the exhibit is background about Ms Sauser Rupp and the relationship between Swiss and the Swatch Group. In Ms Sauser Rupp's deposition she comments on goods sold under the OMEGA trade mark by Swiss. She states that Swiss sells watches under the name OMEGA and the Greek letter O. She also states that some gift items have been sold under OMEGA, such as earrings, necklaces and rings. She also comments that some leather goods have been sold under the trade mark OMEGA as well as umbrellas, cups and equipment relating to golf, as Swiss sponsors golf tournaments. She also advises that chocolate is sold under OMEGA. Ms Sauser Rupp states that these goods are mainly for the promotion of OMEGA watches. Ms Sauser Rupp states that Swiss sells mainly wristwatches under OMEGA. She states that Swiss no longer sells pocket watches.

19) Ms Sauser Rupp states that only Omega Electronics would be licensed to sell timers under OMEGA but that at the time of her deposition they were not so doing. She states:

"They have some timing devices which can well include a timer, but not independent timer, a simple device like that."

Ms Sauser Rupp states that repair of OMEGA goods is conducted under the trade mark OMEGA.

20) Ms Sauser Rupp is asked about the products of Omega Electronics. She states that they sell all types of products relating to the timing of sports events. They also sell passenger information displays and big displays screens for stadiums and other premises. She states that one of these displays is in a restaurant in the United Kingdom. Ms Sauser Rupp states that a radio frequency identification system has also been developed. She advises that radio frequency identification systems will be used for access control. Ms Sauser Rupp states that various sporting timing devices and systems are sold and “camera or photo finish camera”. She states that in her time with the Swatch Group no timing devices have been sold under the OMEGA trade mark for science or industry.

Further evidence of Swiss

Witness statement of Christiane Sauser Rupp

21) Ms Sauser Rupp is legal counsel at the legal department of The Swatch Group Limited. She states that the legal department of The Swatch Group is responsible for legal matters concerning Swiss.

22) Ms Sauser Rupp confirms that she was deposed as per the evidence of Mr Peterson. She states that the proceedings concerned an action brought in July 2000 by Swiss against US, Omega Press Inc and Omega Scientific Inc for cyber squatting. Ms Sauser Rupp states that she “understands” that the latter two companies are related to US. She states that the action followed the registration by Omega Press Inc and Omega Scientific Inc of the domain names “omegawatch.com” and “omegatime.com”. She states that her comments were made in the context of proceedings in the United States of America rather than in the context of a revocation action in the United Kingdom.

23) Ms Sauser Rupp states that it is clear from her deposition that she is a legal advisor and that she has no direct involvement in the running of Swiss or Omega Electronics SA. She states that although she has a general overview of the activities of each company she does not have extensive first hand knowledge of the range of the products and services or other detailed aspects of their businesses. She states that in page 12 of her deposition, which has been exhibited by Mr Peterson, asked whether she knew of the history of Omega Electronics SA she answered, “No, I don’t know it very well”. At page 13 she was able to confirm that the offices of Omega Electronics SA are in Bienne but she could not confirm the exact address. At page 14 she confirmed that she did not handle any matters for Omega Electronics SA, Ms Sauser Rupp exhibits the relevant page. In pages 166 and 167 of the deposition she stated:

“As I told you, I am not responsible of Omega Electronics and I cannot give you an answer which will be final. I knew that Omega Electronics goes... sells it products through some of our subsidiaries. For example, in England we have

Swatch Group, U.K., which has an Omega Electronics Division which sells that kind of products. I know that in some other countries they work with independent distributors.”

24) Ms Sauser Rupp states that on page 57 of her deposition, which has been exhibited by Mr Peterson, there is the following:

“Q. Are you family with the products that Omega Electronics sells under the Omega mark?

A. Well, within this particular litigation I spoke with Omega Electronics to have an idea of what their products were.”

25) Ms Sauser Rupp states that while the statements made in her deposition were made in good faith and to the best of her knowledge she does not have a highly detailed knowledge of the products and services of Omega Electronics SA/Omega SA. She states that her comments under deposition cannot fairly be taken to comprise an exhaustive list of the products and services of these companies. She states that an omission that now occurs to her is that Swiss sells clocks, although she knows that it does. Ms Sauser Rupp exhibits copies of invoices relating to the sales of clocks in the United Kingdom by Swiss. The invoices are all from Swiss to SMH (UK) Limited. The items recorded upon them are variously described as constellation clocks, double face golf clocks and golf clocks. The invoices emanate from 1996 and 1997.

26) Ms Sauser Rupp states that owing to his experience Mr Stierli has a much more detailed overview of the activities of Swiss than she could have.

27) Ms Sauser Rupp states that she does not see what the relevance of the 1994 agreement, exhibited by Mr Crouch, is in the context of this case.

Further evidence of US

Further witness statement of David John Crouch

28) Mr Crouch exhibits a further witness statement by Mr Peter W Peterson.

Further witness statement of Peter W Peterson

29) Mr Peterson states that he represented US in litigation against Swiss. He states that one case involved an action brought by Swiss against US on 27 September 2000, Civil Action No 3000 CV 1848 JBA. Mr Peterson states that in the course of discovery in this litigation he served Swiss with a notice of deposition of Swiss pursuant to Fed R Civ P 30(b)(6). He exhibits a copy of the notice of deposition. In this case Swiss was the plaintiff. Included in the notice is the following:

“The deposition shall include the following topics:

1. Plaintiff’s Internet web site(s).

2. Plaintiff's domain names.
3. The 1992 and 1994 Agreements and the negotiations leading to the 1992 and 1994 Agreements.
4. All trademarks owned by plaintiff, in any country, including but not limited to those containing the term OMEGA or the Greek letter O.
5. All products and services sold by plaintiff under any trademark, in any country, consisting of or containing the word OMEGA or the Greek letter O."

30) Mr Peterson goes on to comment on the nature and effect of depositions made under the Federal Rules of Civil Procedure and in particular the effect of rule 30(b)(6). Mr Peterson states:

"In the latter instance, under Rule 30(b)(6), the organisation named in the deposition notice "shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify... The persons so designated shall testify as to matters known or reasonably available to the organisation." The answers given by the Rule 30(b)(6) witness are binding on the organisation. "To satisfy Rule 30(b)(6), the corporate deponent has an affirmative duty to make available 'such number of persons as will' be able 'to give complete, knowledge and binding answers' on its behalf." *Reilly v. NatWest Markets Group, Inc.*, 181 F. 3d 253, 268 (2d Cir. 1999), *cert. denied*, 120 S.Ct. 940 (2000) (internal citations omitted)."

31) Mr Peterson goes on to comment on the deposition of Ms Sauser Rupp, which has already been referred to by both sides. Mr Peterson states that pages 134-137 were designated by Swiss as being "confidential" under a protective order entered by Judge Arterton.

32) Mr Peterson comments on Ms Sauser Rupp's position in the proceedings. He comments on the topics listed in the rule 30(b)(6) notice (these are referred to in paragraph 34 above) and that Ms Sauser Rupp was prepared to answer questions on these topics. Mr Peterson comments that the term plaintiff as defined in the notice relates not only to Swiss but also to any parent or affiliate to Swiss, such as Swatch Group and Omega Electronics.

33) Mr Peterson refers to the evidence of Ms Sauser Rupp which I have commented upon in paragraphs 23, 24 and 25 above.

34) Mr Peterson states that Swiss's counsel was given an opportunity to cross-examine Ms Sauser Rupp on the matters raised during Mr Peterson's questioning. He exhibits the pages of the transcript relating to the cross-examination by Swiss's counsel of Ms Sauser Rupp and notes that she did not modify any of her answers to the questions about goods sold or licensed by Swiss under the OMEGA trade marks.

Decision

35) The grounds for revocation are under sections 46(1) (a) and (b) of the Act. Section 46 of the Act reads as follows:

“(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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(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 existed at an earlier date, that date.”

36) Consideration has to be taken, also, of section 100 of the Act which states:

“100. 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.”

37) Consequent upon section 100 the onus is upon the registered proprietor to prove that he has made genuine use of the trade mark in suit, or that there are proper reasons for non-use.

38) Ms Arenal submitted that there was evidence of use of the trade mark in relation to pocket watches. This evidence was based upon part of the evidence relating to the history of the OMEGA trade mark. There is no evidence that in the last five years there has been any use of the trade mark for pocket watches. Indeed, the evidence appears to contradict this. In Ms Sauser Rupp’s deposition:

“Q. But in general you are talking about a wristwatch or a pocket watch?

A. Oh, mainly wristwatches

Q. Any other type of watch other than a wristwatch?

A. No. I speak now, in 2001. Because Omega has a long history, you know, more than 150 years; so, during their history they had all kinds of not only wristwatches but also pocket watches. But at the moment their business is wristwatches.

Q. They don’t sell pocket watches anymore?

A. No.

Q. Do you know when they stopped selling pocket watches?

A. No.

Q. Was it 10 years ago, 20 years ago, longer, shorter.

A. I cannot tell.

Ms Sauser Rupp was giving evidence in a different context and the nature of her evidence would have been influenced by that context. However, in this case she was giving clear and definite responses to questions. She was not being asked to give an exhaustive list of the products of Swiss but directly asked if it made pocket watches currently. She stated no. I do not consider that the context affects that no.

39) There is quite simply no evidence to show use of the trade mark in relation to pocket watches in the five years prior to the filing of the application for revocation.

40) There is a set of invoices for clocks and Ms Sauser Rupp refers to clocks in her statement. For these clocks to have any relevance it would be necessary for them to fall within the parameters of the specification. They would have to be made of precious metal or be items of jewellery or imitations thereof. The evidence is against this. In all but one of the invoices the clocks are described as CONST and it is indicated that these clocks are of aluminium. Aluminium is certainly not a precious metal. There is no evidence to indicate that the clocks that have been sold would fit within the parameters of the specification. In *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/01* the Court of First Instance at paragraph 47 held:

“In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned”

Certain of the findings of the Court in the above case relate specifically to the effects of rule 22 of Commission Regulation (EC) No 2868/95 and so do not have a direct bearing on these proceedings. However, paragraph 47 is not about the specific application of rule 22 but about the general basis of showing use. For clocks, within the parameters of the specification, there is no solid and objective evidence of use.

41) The evidence of Swiss shows use of the trade mark in relation to wristwatches and parts and fittings of wristwatches. Ms Arenal argued that the goods could be wristwatches and items of jewellery. In my view, on the evidence, the case boils down to whether the use of the trade mark upon wristwatches and parts and fittings therefor can be considered to be use on the goods in the specification. US have not attacked the specification in so far as it encompasses wristwatches. There is no doubt, in my mind, that Swiss has shown use on wristwatches made of precious metal. Whether there is clear use for wristwatches in imitations of precious metals was disputed by Mr Morcom. It is unlikely, in my view, that a business would specifically advertise or promote its goods as being made in an imitation of a precious metal. It would simply rely on the look of the product. From my reading of the evidence it appears that Swiss sell wristwatches made of 18 karat gold and also in gold colour. Watches are often made of gold. Taking into account the nature of the product, someone seeing a gold coloured watch, and not being the owner, will not be aware if it is imitation or real. So when it is not of gold it is, de

facto, an imitation of gold. I consider, therefore, that Swiss have shown use of its trade mark for wristwatches and parts and fittings therefor made of both precious metals and imitations of precious metals.

42) This leaves the issue of jewellery. Ms Arenal's argument was that the wristwatches could be both wristwatches and items of jewellery and indeed could be primarily items of jewellery. A good deal of her submission related to the catalogue entitled "Haut de Gamme" The catalogue shows wristwatches heavily encrusted with jewels and made of precious metals. It also regularly refers to the collection of watches as a new jewellery collection. That the catalogue makes this reference does not greatly influence my view of the position. The catalogue is for the English speaking world, not solely for the United Kingdom. It is quite possible, therefore, that it reflects non United Kingdom English usage. Although I note that parts of the catalogue also refer to joaillerie. Ms Arenal referred to this as being the French for jewellery. It is my understanding that bijoux is the normal word in French for jewellery and joaillerie is normally used for a jeweller's shop. That something is sold in a jeweller's shop does not make it jewellery eg tankards and christening mugs. Be that as it may, it is also the case, in my view, that publicity material often twists and abuses the English language; it is there to puff a product not to be a repository of standard English usage. I do not intend to adopt the logic of the Bellman and accept something as being true because it is repeated three times, especially in publicity material aimed at the worldwide English speaking audience.

43) Ms Arenal submitted that there are different types of watches; those which are primarily functional and those which are primarily decorative. I am not quite so certain that there is such a clear demarcation. It seems to me that virtually all watches invariably have two inextricably linked qualities, their purpose and their look.

44) Collins English Dictionary (5th Ed 2000) gives the following definitions for jewellery and watch respectively:

"U.S.; jewelry; n. 1. objects that are worn for personal adornment, such as bracelets, rings, necklaces, etc., considered collectively. 2. the art or business of a jeweller.

a small portable timepiece, usually worn strapped to the wrist (a wristwatch) or in a waistcoat pocket."

These definitions do not support the case of Ms Arenal but neither are they necessarily damning to it.

45) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark

Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828 stated:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

It is necessary to remember that this is not an issue of semantics but the reality in the trade. I need to give words their normal meaning within their context and looking at how the public would describe the goods in question.

46) I have had some difficulty with coming to a conclusion. The arguments of Ms Arenal are, at least superficially, attractive. Sometimes a reductionist approach can clarify an issue and I believe that this is the case here. The goods shown are worn around the wrist, have straps, if of precious metal, and are used to tell the times. What would the average person call an object with a strap, worn around the wrist and used for the telling the time? I think he/she would call it a wristwatch. I do not think that he/she would call it an item of jewellery. I am strengthened in my view by the overall impression of the evidence. It shows a manufacture of expensive watches, it all points to a watch manufacturer.

47) I have concluded that Swiss has not shown use of the trade mark for jewellery.

48) Any amended specification must be within the parameters of the specification. It cannot be an effect of revocation that a proprietor ends up with protection for goods that were not covered before. Taking this into account the registration will be reduced to read:

wrist watches and parts and fittings therefor; all being made of precious metals or imitations of precious metals

49) Mr Morcom argued that the registration should be revoked from five years after its registration. For the sake of convenience I will quote section 46(6) again:

“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 existed at an earlier date, that date.”

The registration has been attacked under section 46(1)(a) and (b). The grounds for revocation state that the registration “has not been used by the Proprietor of the mark for at least five years”. Even though the grounds quote 46(1)(a) I consider that the clear import of this wording is that the trade mark has not been used for five years at the date of the filing of the application for revocation. The counterstatement of Swiss specifically referred to use in the previous five years. Taking these matters into account I believe it is not surprising that Swiss concentrated upon the five year period prior to the filing of the application. I do not consider that it should be penalised for not dealing with the period from the date of registration, 8 March 1927. It would also seem rather unrealistic to expect a proprietor to have records from over seventy years before. In such circumstances I cannot be satisfied that the registration should be revoked from a date earlier than the date of the application.

50) It is my decision, therefore, that the registration should be revoked in respect of all the contested goods with effect from 14 September 2001. The specification will, be limited to:

wrist watches and parts and fittings therefor; all being made of precious metals or imitations of precious metals

with effect from 14 September 2001.

51) US having been successful is entitled to a contribution towards its costs. This is one of four revocation actions between the parties. US have filed the same evidence in each of the proceedings. Part of the evidence of Swiss is also very similar in each of the proceedings. I take this repetition of evidence into account in deciding the award of costs. I order Omega SA (Omega AG) (Omega Ltd) to pay Omega Engineering, Inc the sum of £1600. 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 30TH day of January 2003

**D.W.Landau
For the Registrar
the Comptroller-General**