

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 1477193  
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD)**

**AND THE APPLICATION FOR PARTIAL REVOCATION THEREOF  
UNDER NO 80066  
BY OMEGA ENGINEERING, INC**

**TRADE MARKS ACT 1994**

**In the matter of registration no 1477193  
of the trade mark:**



**in the name of Omega SA (Omega AG) (Omega Ltd)  
and the application for partial revocation thereof  
under no 80066  
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 1477193 standing in the name of Omega SA (Omega AG) (Omega Ltd) (referred to as Swiss from herein). The trade mark was registered on 10 March 1995. It is currently registered for the following goods:

*nautical, surveying, weighing, measuring, signalling, checking (supervision) and life-saving instruments and apparatus; teaching instruments and apparatus (other than material); all included in Class 9; but not including calculating machines or instruments and apparatus, all for measuring, signalling and checking (supervision) of heat and temperature for scientific or industrial use*

The goods are in class 9 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 sports timing equipment. US states that to the extent that the aforesaid goods extend beyond sports timing equipment 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 has been used extensively in the United Kingdom, including the period 1996 to 2001, in relation to equipment which includes measuring, signalling and checking apparatus and that it has also been used for research/teaching apparatus. Swiss deny that the registration should be partially revoked. Swiss furnish evidence to show use of the trade mark. Swiss seeks an award of costs.

4) Both sides filed evidence. 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 Timothy Edwin Colman**

5) Mr Colman is the brand director of Omega Electronics (OE) in the United Kingdom. Mr Colman states that OE was established in order to sell electronic and timing equipment under various OMEGA trade marks in the United Kingdom. He states that from the mid 1970s until 1984 OE traded under the name SSIH equipment and was a division of SSIH (UK) Limited. SSIH (UK) Limited was a wholly owned subsidiary of SSIH and later SMH group. Mr Colman states that around 1984 OE's name changed to Omega Electronic Equipment Limited. He states that the company continued to sell sports timing equipment and public display systems bearing OMEGA trade marks. Mr Colman states that around 1988 the name changed again to Omega Electronics Limited and in 1993 it was fully integrated into SMH (UK) Limited as a division. SMH (UK) Limited has since become Swatch Group (UK) Limited. Mr Colman states that the Swatch Group Limited, based in Switzerland, is the parent company of a worldwide group of companies including OE, Swatch Group (UK) Limited and Swiss. He states that OE has remained a division and uses various OMEGA trade marks including the trade mark the subject of this revocation action (the trade mark) with the consent of Swiss, as do other companies within the group, including Omega Electronics SA.

6) Mr Colman states that he is the person primarily responsible for selling products under the trade mark in the United Kingdom. He states that this equipment is a complex electronic system, one component of which is a specialised photo-finish camera. Mr Colman states that it is used mainly in horse racing, greyhound racing, cycling (track and road) and athletics but has also been used for research and teaching purposes, for example by universities to record and analyse the way people move.

7) Mr Colman states that every United Kingdom horse race is now timed and recorded using a system sold under the trade mark. Mr Colman states that these systems were sold to RaceTech. (He does not explain what RaceTech is.)

8) Mr Colman states that approximately sixty systems were sold under the trade mark in the United Kingdom between 1996 and 2001. The value of each system ranges from between £10,000 and £15,000. Mr Colman states that the trade mark is used for a family of products and systems and that one of the members of this family is known as HAWK EYE. He states that in the product literature OE sometimes abbreviate the trade mark to OSV, sometimes followed by a suffix such as pro or colour, and sometimes the reference is simply to HAWK EYE. Mr Colman states that all the products/systems bear the trade mark.

9) Mr Colman states that he exhibits copies of invoices from Omega Electronics SA relating to United Kingdom sales of products under the trade mark between 1996 and 2001. Mr Colman states that OE buys from Omega Electronics SA and then sells on to United Kingdom customers.

10) All the invoices are from Omega Electronics SA to Omega Electronics Ltd. There are thirty two invoices and two credit notes. The earliest invoice is from 1 April 1996 and the latest from 12 December 2000. Certain of the invoices relate to repairs carried out by Omega Electronic SA. One credit note refers to a HAWK EYE camera, the other to an OSV Pro Camera. Eleven invoices refer to HAWK EYE. Ten invoices refer to OSV. Two invoices refer to SCAN'O'VISION HAWK EYE. Seven refer to SCAN'O'VISION, sometimes in combination with OSV. One invoice refers to OSV HAWK EYE. The goods identified with reference to the above trade marks are cameras, printed circuits, control racks, camera cables and bridges.

11) Mr Colman exhibits seven invoices from OE to customers in the United Kingdom from between 1996 and 2001. All of the invoices are made out to Racetech. The final invoice is for 28 September 2001 which is after the date of the application for revocation. The details of the invoices are as follows:

- 26 September 1996 for 1 Colour OSV 3 photofinish system including 4 axis support for £23,500 including VAT.
- 31 July 1998 for 1 Colour Scan-O-Vision, complete with circuit boards, power supply, cables, 4-axis support for £14,387.29p including VAT and packing and delivery.
- 30 March 1999 for 4 x Scan-O-Vision colour photofinish systems comprising: camera, pro controllers, software V.2.15, 4-axis de luxe support, covers, computer cards, power box, cabling and installation manuals for £53,232.20 including VAT.
- 16 November 1999 for 4 x Scan-O-Vision Pro colour photofinish systems comprising: camera, pro controllers, software V.2.12, 4-axis de luxe support, covers, computer cards, power box, cabling and installation manuals for £53,232.20p including VAT.
- 20 December 1999 for 6 x Scan-O-Vision colour photofinish systems comprising: camera, pro controllers, software V.2.25, 4-axis de luxe support, covers, computer cards, power box, cabling and installation manuals for £79,848.30p including VAT.
- 25 July 2001 for 2 x 3355.706 OPSV PRO DL with four axis deluxe head for £20,485.89p including VAT.
- 28 September 2001 for 8 x OSV Pro systems for £106,464.40p including VAT.

12) Mr Colman states that in recent years he has been involved in the preparation of publicity and information leaflets for products sold under the trade mark. He exhibits brochures used in the United Kingdom from 1995. He states that the approximate date for each item has been written in the top right-hand corner.

13) The first item is dated 2001 and headed "Photofinish Technical Information". The item deals with photofinish cameras and their accompanying sensors. There is no use shown of the trade mark as registered. The closest use to the trade mark are references to OMEGA Scan'O'Vision. A further item from 2001 relates to a wind gauge which advises that:

“With the *Scan’O’Vision* connection, the OMEGA *Alizé* wind gauge is directly connected to the *Scan’O’Vision* Software; so the measurements will automatically be inserted in the photofinish results”.

14) A leaflet from 2000 relates to the SCAN’O’VISION BRIDGE which is described as “a box incorporating the power supply for the camera, all the electronics, the connections to the track (start, intermediate and finish) and the camera connection.” The leaflet shows use of SCAN’O’VISION BRIDGE rather than the trade mark as registered. The closest use to the trade mark appears on a picture of the box. This shows SCAN’O’VISION BRIDGE with the BRIDGE element written in a different script. To the right of this can be seen O above OMEGA, underneath this there appears further writing but it is not clearly legible.

15) A leaflet dated 1999-2001 is for the SCAN’O’VISION PRO. This relates to a camera and the SCAN’O’VISION BRIDGE interface. The leaflet does not show the trade mark as registered. Shown on the goods, a camera, SCAN’O’VISION is on the top right hand side of the camera and at the bottom left is O above OMEGA over a line of oblongs in two sizes underneath which is the word ELECTRONICS. These are separated by a large stylised PRO and a grid of squares. The top of the leaflet shows O above OMEGA over a line of oblongs in two sizes, underneath which is the word ELECTRONICS, underneath which is written SCAN’O’VISION PRO, the PRO being in a stylised format.

16) A leaflet dated 1998-2001 is headed “Time Keeping System for Track Cycling Fixed Cabling”. There is no use of the trade mark as registered. Various trade marks are shown eg OMEGA and HAWK EYE. SCAN’O’VISION appears once, without the other elements of the trade mark, under a picture of a personal computer upon which cyclists can be seen. Over the picture of the computer is written the words CONTROL ROOM.

17) A leaflet dated 1995/1996 which does not show the trade mark as registered. O is above OMEGA over a line of oblongs in two sizes underneath which is the word ELECTRONICS, this is at some distance from SCAN’O’VISION. The rear of the leaflet is headed “Technical Data Sheet SCAN’O’VISION.

18) Finally there is a leaflet dated 1995-1999 which is for SCAN’O’VISION HAWK EYE (HAWK EYE being stylised and including a device element). Most of the leaflet refers to HAWK EYE rather than SCAN’O’VISION.

## **US’s evidence**

### **First witness statement of David John Crouch**

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

20) 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 US's and Swiss's specifications 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."

### **Second witness statement of David John Crouch**

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

### **Witness statement of Peter W Peterson**

22) 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, the transcript runs to some 213 pages.

23) 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 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, also 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.

24) 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.

25) 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**

26) 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.

27) 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.

28) 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 its 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."

29) 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 familiar 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."

30) 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.

31) Ms Sauser Rupp states that owing to his experience Mr Colman has a much more detailed overview of the activities of OE in the United Kingdom than she could have.

32) 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**

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

### **Further witness statement of Peter W Peterson**

34) 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.”

35) 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).”

36) 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.

37) 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.

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

39) 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 her of answers to the questions about goods sold or licensed by Swiss under the OMEGA trade marks.

## **DECISION**

### **Preliminary Issues**

40) At the hearing Ms Arenal stated that Swiss would be willing to accept the following specification for its registration:

*apparatus and instruments for measuring, checking, recording, timing, printing and/or signalling; parts and fittings therefor; all being for use in sport; but not including calculating machines or instruments and apparatus, all for measuring, signalling and checking (supervision) of heat and temperature for scientific or industrial use*

41) Mr Morcom stated that the evidence filed by Swiss showed that the trade mark had not been used on any products and so the registration should be refused in its entirety. This matter was first raised in the skeleton argument of Mr Morcom:

“Although as already indicated, the application did not seek revocation in respect of “sports timing equipment”, the applicant seeks permission to amend the application to request complete revocation. It is submitted that no use has been proved of the mark as registered or in a form permitted by section 46(2).”

42) I see a fundamental flaw in Mr Morcom's argument. Swiss furnished evidence in relation to the scope of the claim for revocation. It is then subjected to a further attack on the basis that it has not shown use on the goods which were not under attack. It could hardly be expected to. It seems to me that Mr Morcom's argument is based on his conclusion, from the evidence supplied, that Swiss has never actually used the trade mark as registered. This might or might not be the case. However, it was not the issue upon which Swiss was challenged and so not the basis of Swiss's defence. Consequently, I do not consider it appropriate to allow an amendment to US's statement of case to allow it to attack all the goods of the registration. (A secondary consideration in my decision is that

this was raised for the first time the day before the hearing. If US wished to amend its grounds it could have done so far earlier. The final evidence of Swiss was received on 23 August 2002.)

### **Grounds of revocation**

43) 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.”

44) 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.”

45) 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.

**Use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered**

46) Ms Arenal accepted that there was no evidence to show use of the trade mark as registered. She identified use of OMEGA Scan ‘O’ Vision Color and Omega Scan ‘o’ Vision Hawk Eye as use of the trade mark in a form differing in elements which do not alter the distinctive character of the trade mark. This issue was dealt with by the Court of Appeal in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2002] EWCA Civ 1534. Lord Walker of Gestingthorpe held the following:

“41. The word “elements” can be used, and often is used, to refer to the basics of a matter. However it can hardly have that meaning in section 46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In section 46(2)

‘elements’ must have a weaker sense (of ‘features’ or even, as Mr Bloch came close to submitting, ‘details’).

43. I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?
44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorably line of poetry:

“Bare ruin’d choirs, where late the sweet birds sang”

is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich association (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? – Registrar or ordinary consumer?’ is a direct conflict. It is for the Registrar, through the hearing officer’s specialised experience and judgement, to analyse the “visual, aural and conceptual” qualities of a mark and make a “global appreciation” of its likely impact on the average consumer, who

“normally perceives a mark as a whole and does not proceed to analyse its various details.”

The quotations are from paragraph 26 of the judgement of the Court of Justice in Lloyd Schuhfabrik v Klijsen Handel [1999] CR 1 – 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

47) Ms Arenal argued that O would be universally seen as the Greek letter omega, consequently its absence does not have any effect on the distinctive character of the mark. I am not convinced by the assertion that it would be seen universally as this. There is no evidence to this effect. O could be simply seen as a device. O is at the top of the trade mark, it is in a bigger type face than the word “SCAN’O’VISION”. I see it as being a dominant element of the trade mark and having a definite impact upon the

consumer. I have found nothing in the evidence to show either use of the trade mark as registered or in a form differing in elements which do not alter the distinctive character of the trade mark.

48) In the original *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* appeal [2002] RPC 38, Mr Thorley QC, sitting as a deputy judge, stated:

“On the other hand, where a proprietor wishes to alter his mark or believes that his mark has become sufficiently distinctive in a different form to be registrable in that form, it is right that he should register it in that form and allow the former unused registration to lapse.”

In this case Swiss has not shown use in the form registered. It has shown use in a very different manner. It has not, as far as I am aware, registered the trade mark in the form or forms that it is used. It must take the consequences for this.

**49) I find that Swiss has not shown use of the trade mark as registered or in a form differing in elements which do not alter the distinctive character of the trade mark.**

50) Even if I had not come to the conclusion in paragraph 49 above I do not consider that the outcome would have been any better for Swiss. The use that has been shown, if not in relation to the trade mark, is for photo-finish systems for sporting activities. (In coming to that conclusion I follow the findings of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828 in which he stated that in the case of a partial revocation “the 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 perceive the use”.) 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.”

I give the words in the specification their natural meaning, but within the context that they appear in a specification derived from the International Classification of Goods and Services. In this context I cannot see that the specification covers photo-finish systems for sporting activities. So the goods which the evidence shows would not save Swiss even if the trade mark had been used.

## Conclusion

51) US filed a copy of an agreement between it and Swiss and a copy of part of the transcript of the deposition of Ms Sauser Rupp. From the submissions of Mr Morcom it would appear that one of the reasons for the filing of this evidence was to put the nature of the business of Swiss into a clear context and to show the limits of that business. In this case I do not think that anything turns upon this evidence. Ms Sauser Rupp's evidence has to be put into the context of the proceedings in which it was given. These were not non-use proceedings, if they had been it is very likely Swiss could have used a different representative(s). It cannot be reasonably expected, in my view, that Ms Sauser Rupp would have an encyclopaedic knowledge of all the goods of Swiss. She had the necessary knowledge for the context of the proceedings, very different proceedings relating to very different issues.

52) Mr Morcom argued that the registration should be revoked from 10 March 2001, 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 the period 1996 to 2001. Taking these matters into account I believe it 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, 10 March 1995. In such circumstances I cannot be satisfied that the registration should be revoked from a date earlier than the date of the application.

53) I cannot revoke the registration in respect of sports timing equipment. However, such goods are not specifically mentioned in the specification. A partial revocation has to be made within the context of the specification as it exists. Mr Morcom suggested that if the trade mark was not to be revoked in its entirety that the following specification would be appropriate:

*sports timing equipment; all included in Class 9; but not including calculating machines or instruments and apparatus, all for measuring, signalling and checking (supervision) of heat and temperature for scientific or industrial use*

I am of the view that *measuring apparatus and instruments* in the original specification encompasses the above goods.

54) It could be argued that the second part of the exclusion clause could be removed as it is effectively redundant in relation to the new specification. However, there is a “history” between the two sides and the exclusion would appear to be as a result of that “history”. Although technically the exclusion should be removed I do not propose so to do. It does no harm in its presence but could do harm in its absence in relation to the conflicts between the two sides.

55) Taking these matters into account I consider it appropriate to adopt the specification proposed by Mr Morcom.

**54) 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:**

*sports timing equipment; all included in Class 9; but not including calculating machines or instruments and apparatus, all for measuring, signalling and checking (supervision) of heat and temperature for scientific or industrial use*

**with effect from 14 September 2001.**

**55) 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 30<sup>TH</sup> day of January 2003**

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