

O-393-03

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION No. 474165
IN THE NAME OF OMEGA SA (OMEGA AG) (OMEGA LTD)**

**AND IN THE MATTER OF
AN APPLICATION FOR PARTIAL REVOCATION THEREOF
UNDER No. 80068
BY OMEGA ENGINEERING INC.**

**AND IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
BY THE PROPRIETOR
AGAINST THE DECISION OF MR. D. W. LANDAU
DATED 30 JANUARY 2003**

DECISION

Introduction

1. This is an appeal against a decision of Mr. D. W. Landau, Principal Hearing Officer, acting on behalf the Registrar, dated 30 January 2003, in which he partially revoked Registration No. 474165 for the trade mark OMEGA standing in the name of Omega SA (Omega AG) (Omega Ltd) (“Omega SA”) on grounds of non-use under section 46(1)(b) and (5) of the Trade Marks Act 1994 (“TMA”) with effect from 14 September 2001.
2. Registration No. 474165 was obtained on 8th March 1927 with a filing date of 23 October 1926. Under the registration as originally granted, OMEGA was registered in Class 14 for goods of precious metals and jewellery and imitations of such goods and jewellery. However, the registration was reclassified in 1995 as follows:

Class 5 Dental amalgams; anti-rheumatism rings, bracelets and anklets;
all made of precious metal

Class 9 Electrical contacts; crucibles; spectacles frames; all made from
precious metal

Class 14 Goods of precious metals and jewellery, and imitations of such
goods and jewellery

Class 16 Pens; penholders; pen cases and pencil cases; inkstands; all made from precious metal or coated therewith

3. On 14 September 2001, Omega Engineering Inc. (“Omega Engineering”) applied to revoke Registration No. 474165 for all the subject goods except wristwatches. Although the Statement of Grounds mentioned section 46(1)(a) and (b) of the TMA, the applicant alleged non-use by the proprietor except in relation to wristwatches “for at least the last five years in respect of any of the goods covered by the Registration”. Accordingly, the Hearing Officer presumed that the application was made under section 46(1)(b) and that since the applicant claimed no earlier date, partial revocation was sought from the date of the application namely, 14 September 2001. Omega Engineering does not dispute those findings by the Hearing Officer.
4. In his decision dated 30 January 2003, the Hearing Officer held:
 - (1) Registration No. 474165 should be revoked in respect of all the contested goods with effect from 14 September 2001.
 - (2) 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.

Since the applicant had been successful, Omega SA was ordered to pay Omega Engineering £1,600 towards the costs of the application.

5. On 27 February 2003, Omega SA filed notice of appeal to an Appointed Person under section 76 of the TMA. Omega SA does not dispute revocation in Classes 5, 9 and 16 (as was also the case before the Hearing Officer). However, Omega SA challenges the extent of the revocation within Class 14 requesting that:
 - “a) The application for revocation for non-use be further dismissed insofar as it related to ‘jewellery’ per se.
 - b) In the alternative, the application for revocation for non-use be further dismissed insofar as it related to ‘gold bracelets, gold clasps, earrings, necklaces, rings’”.
6. At paragraph 5 of the Grounds of Appeal, Omega SA announced an intention to seek leave to adduce further evidence, in particular:
 - “a) evidence relating to the use of the term ‘jewellery’ to describe the goods listed at 1.i) [sic 3.i)] above
 - b) evidence relating to translation of the term ‘joaillerie’”.
7. Paragraph 3.i) of the Grounds of Appeal particularises the first error the Hearing Officer is alleged to have made:

“Having been shown evidence of use of the mark in suit in relation to gold bracelets, gold clasps, earrings, necklaces, rings and the goods shown in the catalogue entitled ‘Haute de Gamme’ the Hearing Officer then erred in concluding that the Appellant had not shown use of the trade mark for ‘jewellery’ and in failing to include a description of goods that incorporated such goods in the final specification of the mark in suit.”

8. “Evidence relating to translation of the term ‘joaillerie’” concerns the second error the Hearing Officer is said to have made:

“The Hearing Officer erred in his view that the French word ‘joaillerie’ is normally used to describe a ‘jewellers shop’ and not for ‘jewellery’ (paragraph 42 of the Decision). The word ‘joaillerie’ is also used to describe ‘jewellery’.”

9. In the event, Omega SA did not make a formal application to adduce further evidence until 24 September 2003. The further evidence comprised the following:

- 1) Witness Statement of Petra Hlavacek dated 20 August 2003 exhibiting:

- PH1 Copy Hearing Officer’s decision
- PH2 Colour copy Haut de Gamme brochure
- PH3 Extract Illustrated Dictionary of Horology I + II
- PH4 Extracts Harrap French-English Dictionary (1997), Collins French Dictionary, second edition 2000, Collins Robert 1978 edition (reprinted 1985), Larousse Grand Dictionnaire (Volume 1, 1993) and Oxford Hachette French Dictionary, 2nd edition (1998)
- PH5 Extract WIPO International Classification of Goods and Services, 5th Edition, English – French

- 2) Witness Statement of Sophia Arenal dated 5 September 2003 exhibiting:

- SA1 Extract Webster’s 9th New Collegiate Dictionary (1988)
- SA2 Colour copy Chaumet brochures 1999, 2000, 2001, 2002
- SA3 Copy front and back covers Evening Standard Magazine 4 July 2003
- SA 4 Web page www.chanel.com (printed 7 July 2003)
- SA 5 Colour copy extracts Omega International Collection brochures 1999 – 2001
- SA 6 Colour copy Omega Bijoux brochure 2003
- SA 7 Colour copy photographs Goldsmith’s jewellers, Chancery Lane, June – July 2003
- SA 8 Colour copy photographs Andrew R. Ullmann Ltd, Hatton Garden, June 2003

SA 9 Copy colour photographs web pages www.chopard.com
undated

SA 10 Copy colour photographs web pages Piaget website
undated

SA 11 Copy letter Bromhead & Co. (Omega Engineering's
trade mark attorneys) to Office for Harmonization in the
Internal Market, 7 March 2003

3) Witness Statement of Ana Catherine de Costa dated 5 September 2003

4) Witness Statement of Sophia Arenal dated 24 September 2003
exhibiting:

SA-A1 Colour copy pages ? Omega Saga, Marco Richon, 1998

10. I heard the application to adduce further evidence as a preliminary issue to the hearing of the appeal at which Mr. Michael Edenborough of Counsel appeared for Omega SA and Mr. Christopher Morcom of Queen's Counsel represented Omega Engineering.

The Application to Introduce Further Evidence

11. The applicable principles were not in dispute. The *Ladd v. Marshall* [1954] 1 WLR 1489 at 1491 criteria are basic to the exercise of the discretion of an Appointed Person to admit fresh evidence on appeal but other factors such as those set out by Laddie J. in *Hunt-Wesson Inc's Trade Mark Application (SWISS MISS)* [1996] RPC 233 may be relevant (*LABEL ROUGE Trade Mark* [2003] FSR 13, *El Du Pont De Nemours & Co. v. ST Dupont* [2003] EWCA Civ 1368).

12. Mr. Edenborough's argument centred on the second of the *Ladd v. Marshall* criteria namely, the potential significance of the new evidence. In his submission, the interpretation given to the word "joaillerie", which appeared in Omega SA's Haut de Gamme brochure, coloured the Hearing Officer's view of the evidence. Since the Hearing Officer adopted that interpretation at the hearing, Omega SA could not have anticipated it and there was no delay in bringing forward the new evidence. Moreover, the credibility of the new evidence was not in doubt. I put to Mr. Edenborough that the new evidence addressed more than the meaning of "joaillerie". His response was that in essence the new evidence all went to the same point, which for reasons set out below I found unconvincing.

13. Mr. Morcom's main objections were overall delay and the fact that the new evidence could have been put to the Hearing Officer at the hearing. The points Omega SA seeks to address in the new evidence were always in the case and the evidence itself was accessible. The reasons put forward for the delay relate to the period around and after the filing of the appeal and concern the temporary indisposition of two individuals, one within the proprietor's legal department and one within its firm of trade mark attorneys.

14. I found it helpful to consider the evidence piece by piece, which is why it is listed at paragraph 9 above. At 9.1), exhibits PH1 and PH2 to the statement of Petra Hlavacek are already in the case. Exhibits PH3 to PH 5 comprise dictionary and other definitions from reference sources of which judicial notice can be taken. Ms. Hlavacek's statement does little more than introduce those sources. I see no reason why Omega SA should have anticipated that the Hearing Officer would prefer a different meaning of "joaillerie" to the one advanced on its behalf. I decided therefore to admit the evidence at 9.1) and, to be even-handed, a further extract from Collins' French-English Dictionary, 2nd Edition 1987 presented by Mr. Morcom.
15. At 9.2), exhibits SA 3, 4, 6, 7 and 8 to the first statement of Sophia Arenal are after the relevant 5-year period ending 14 September 2001. The same is true of the Chaumet 2002 brochure (SA 2). SA 9 and 10 are undated but it is a fair inference from Ms. Arenal's statement that the photographs are of the web pages as they stood in 2003. SA 5 adds little to the evidence that was before the Hearing Officer and was clearly available to put before him. The latter is also true of the Chaumet brochures 1999, 2000 and 2001. Moreover as is clear from my decision in the appeal, the brochures are of doubtful significance to the case. SA 11 concerns correspondence between Omega Engineering and OHIM relating to an entirely different matter. SA 1 adds yet another definition of "jewellery", which in view of my decision on 9.1) is redundant. I refused permission to admit the evidence at 9.2).
16. Ms. de Costa is a student for the BA (Honours) Degree in Jewellery Design at Central Saint Martins College of Art & Design, London. She has undertaken work experience with jewellery designers/companies. She offers her understanding of "jewellery" to include "hairpins, tiaras, earrings, cuffs, bracelets, watches, rings, chains, necklaces, pendants, brooches, cuff links, dress studs, body piercing jewellery ... anklets and toe rings". Again such evidence could have been obtained for the hearing and is of limited significance to the case. I did not allow the evidence at 9.3). Finally, the second statement of Sophia Arenal exhibits copy pages from a book about Omega SA (SA-A1). The pages are in French but Ms. Arenal translates into English those parts that she considers relevant. However these passages and their accompanying illustrations relate to exhibitions held at Goldsmiths' Hall in 1965 and 1970, that is, well before the period in suit.
17. To summarise my conclusions regarding Omega SA's request to introduce fresh evidence:
 - (a) The evidence at 9.1) was admitted;
 - (b) Permission was refused to introduce the evidence at 9.2) to 9.4) inclusive.

The Appeal

18. Again there was no argument as to the relevant law. The appeal is a review although the appeal tribunal has power to draw inferences of fact (CPR, r. 52.11(4), *El Du Pont De Nemours & Co v. ST Dupont* [2003] EWCA Civ

1368 per May L.J. at paras. 92 – 94). As to partial revocation for non-use within broad terms used in a specification, Counsel directed me to the following guidance of Aldous L.J. in *Thomson Holidays Ltd v. Norwegian Cruise Lines Ltd* [2003] RPC 586 at 597:

“Pumfrey J. [in *Decon Laboratories Ltd v. Fred Baker Scientific Ltd* [2001] RPC 293] was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. ...

Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. 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 the public would perceive the use. The court, when deciding whether there is confusion under s. 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.”

19. The Grounds of Appeal claim at paragraph 3 that the Hearing Officer erred in applying the above principles set out by Aldous L.J. in *Thomson Holidays*. In the first respect it is said that the Hearing Officer was shown evidence of use of OMEGA in relation to gold bracelets, gold clasps, earrings, necklaces, rings and the goods shown in Omega SA’s Haute de Gamme brochure but erred in deciding that Omega SA had not shown use for “jewellery” and in failing to list such goods in the revised specification. Moreover in a letter from Omega SA’s trade mark attorneys to the Treasury Solicitor dated 24 September 2003 it was asserted that:

“The registered proprietors have demonstrated that they have an interest in jewellery beyond jewelled watches, and that they ought therefore to have protection for such goods under this registration.”

20. At the hearing Mr. Edenborough did not pursue these contentions. In response to my express enquiries, he confirmed on behalf of his client that the evidence did not support use of OMEGA on earrings, necklaces and rings during the relevant period. Further, the copy invoices for cases and bracelets (including clasps) exhibited at PH3 to the Witness Statement of Peter Stierli, the Chief Finance Officer of Omega SA, dated 27 December 2001 related only to parts and fittings for watches and not to, for example, “gold bracelets” in their own right.

21. Instead, Mr. Edenborough argued in essence that Omega SA had shown use during the relevant period for watches including watches encrusted with precious stones. Particularly the latter sufficed to maintain a specification that included the term “jewellery” in Class 14. The Hearing Officer erred in concluding that the relevant buying public would not call such goods items of jewellery. Omega SA’s Haute de Gamme brochure dated 1999 and exhibited to Mr. Stierli’s statement at PS1 contained several pages displaying heavily be-jewelled watches under the heading “Joaillerie”. The Hearing Officer’s mistaken understanding that “joaillerie” meant “jeweller’s shop” and not “jewellery”, and that “bijoux” was the usual French term for “jewellery”, was instrumental in leading him to that conclusion.
22. Taking a step back from these definitional matters, I put it to the parties that the decisive issue was not whether be-jewelled watches could be classed as “jewellery” but what was a fair specification of goods having regard to the use made of OMEGA during the relevant period. It was incontrovertible first, that “jewellery” is a broad term encompassing several items and second, that Omega SA had shown use during the relevant period only in relation to watches and be-jewelled watches. I should mention that Omega SA’s use in the UK during the relevant period in relation to those goods is clearly substantiated by the evidence.
23. The Hearing Officer reduced the registration to:

“Wrist watches and parts and fittings therefor; all being made of precious metals or imitations of precious metals”.

Although the Hearing Officer considered whether the goods were “jewellery”, it not clear that he then proceeded to ask how the relevant buying public would describe Omega SA’s use (as opposed to distinguishing the goods from something else). I believe that in framing the revised specification the Hearing Officer might have been mindful of the fact that use on pocket watches had not been established during the relevant period. Moreover, Omega Engineering’s Statement of Grounds requested that the registration be revoked “to the extent that the goods extend beyond wrist watches”.

24. In my view, the relevant buying public would describe the use that Omega SA has made of OMEGA during the period in suit simply as use in relation to watches and not wrist watches. Further, Omega SA’s own use in the Haute de Gamme brochure and on invoices (for example, No. 90078537 (12.10.1998) p. 2, No. 90135762 (19.07.1999), p. 7) and the dictionary definitions (Illustrated Dictionary of Horology, Collins’ French-English Dictionary, 2nd Edition 1987) indicate that the public would describe the watches heavily encrusted with jewels as jewel- or jewellery watches.
25. Accordingly, I believe that a fair specification for Registration No. 474165 in view of the use made of it during the relevant period is:
- “Watches and jewel-watches and parts and fittings therefor; all being made of precious metals or imitations of precious metals”.

The specification will be limited to that effect as from 14 September 2001.

Costs

26. As Omega Engineering remained successful at the hearing below, I propose not to interfere with the costs order made by the Hearing Officer. Especially in view of the way Omega SA's case was stated, I believe that Omega Engineering is also entitled to a contribution towards the costs of this appeal. Omega SA requested a substantial bundle of evidence to be admitted on appeal but I only allowed a small fraction of that evidence to be introduced. Omega Engineering's costs on appeal should therefore include a sum towards its costs in relation to the preliminary request. I order Omega SA to pay Omega Engineering the sum of £1600 in respect of the application for revocation and I direct that a further sum of £900 be paid to Omega Engineering towards the cost of this preliminary application and appeal, to be paid on the same basis as indicated by Mr. Landau.

Professor Ruth Annand, 5 December 2003

Mr. Michael Edenborough instructed by Mewburn Ellis appeared as Counsel on behalf of Omega SA (Omega AG) (Omega Ltd)

Mr. Christopher Morcom QC instructed by Bromhead & Co appeared as Counsel on behalf of Omega Engineering Inc.