

O-307-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 16028
BY OMEGA ENGINEERING INC.
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK No 771474



IN THE NAME OF OMEGA SA (OMEGA AG)(OMEGA LTD)

BACKGROUND

1) International Trade Mark No 771474 for the device below is protected from the International Classification date of 1 May 2001:



2) It is protected for the following specification of goods in Class 14: “Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes; jewellery, precious stones; timepieces and chronometric instruments.”


3) By an application dated 1 August 2002 Omega Engineering Inc. applied for a declaration of invalidity in respect of this registration. The grounds are in summary:

a) The applicant is the proprietor of the following trade marks:

Mark	Number	Effective date	Classes
OMEGA.CO.UK	UK 2226666	21.03.00 pending	9, 14, 16, 35, 37, 40 & 41
OMEGA	CTM 1567684	21.03.00 pending	9, 14, 16, 35, 37, 40, 41 & 42
ΩMEGA	CTM 2180834	17.04.01 pending	9, 14, 16 & 35

b) The applicant claims to have made substantial use of these trade marks in the UK and elsewhere in relation to the goods covered by the applications and to have gained a reputation in the UK. It is stated that the mark OMEGA has been used in the UK since 1974 in relation to thermocouples made from precious metals.

c) It is claimed that Trade Mark 771474 is similar to the applicant’s marks and is protected for identical or similar goods. Therefore, the mark in suit should be declared invalid under Section 5(2)(b) and 5(4)(a).

4) The registered proprietor filed a counterstatement denying the above grounds, and also claims prior rights in trade marks consisting of or containing the Greek letter  and/or the word OMEGA in Class 14. The registered proprietor also points out that it is opposing the applications that the applicant is relying upon in this invalidity action.

5) Both sides ask for an award of costs in their favour.

6) Both sides filed evidence in these proceedings and the matter came to be heard on 25 August 2004 when the applicant was represented by Mr Crouch of Messrs Bromhead Johnson. The registered proprietor was represented by Ms Arenal of Messrs Mewburn Ellis.

APPLICANT'S EVIDENCE


7) The applicant filed a witness statement, dated 19 December 2002, by David John Crouch its Trade Mark Attorney. He states that "The Applicant manufactures and sells throughout the European Union a very wide range of equipment for the industrial and scientific fields".

8) Mr Crouch also provides four exhibits which consist of two witness statements (including exhibits) made by Mr Crouch dated 24 and 29 October 2002; and two witness statements (including exhibits) made by Mr Michael Wood dated 22 and 27 November 2002. All four statements were originally filed in relation to opposition number 70763.

9) I shall first summarise the two statements of Mr Crouch, the applicant's Trade Mark Attorney. He provides various exhibits which include:

- Pages from publications dated 1995 showing use of a device consisting of the Greek letter for "omega" with a letter "E" grafted onto the right hand side. Also used is the name "Omega Engineering Inc." and "Omega". The publications offer spools of wire made of various metals and alloys including copper, iron, platinum, nickel, tungsten, nickel/chromium all of which carry both signs. They also offer computer boards and interfaces, solenoid valve timers and solid state timers. The goods are priced in dollars. One included addresses of overseas offices including premises in the UK.
- Print outs from a website dated February and March 2001 which show use of a device consisting of the Greek letter for "omega" with a letter "E" grafted onto the right hand side. Also used is the name "Omega Engineering Inc." and "Omega". Some of the print outs are from the UK website. The sites offer probes, wire, measuring apparatus and instruments, controllers, solenoid valve timers, computer boards, timers and counters. There are also print outs from UK, French and Dutch websites dated October 2002 which again show use of the name "Omega" and offer probes, wire, measuring apparatus and instruments. The wire offered includes platinum versions.
- A copy of an agreement dated 1994 between the two parties which at clause 4 states:

"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  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 ■ 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 ■ 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.”

- Copies of pages from a transcript of a pre-trial deposition by Christiane Sauser Rupp of the firm Omega SA taken on 27 June 2001 in U.S. proceedings. Ms Rupp comments on clause 4 stating that in her time with Omega SA they had never sold timing devices for science or industry. She states that they are prevented by the agreement from selling computer controlled timing apparatus. She states that her company accepts that the agreement allows Omega Engineering Inc. to sell a “timing device which is ancillary to a product which has another purpose”. In response to the question “But would you agree that it was Omega Engineering was permitted to use register or apply to register the Omega marks in respect of computer-controlled measuring, timing and display apparatus intended for scientific or industry?” she answered “yes, if I read that, yes.”

10) Mr Wood is the Sales and Applications Manager of Omega Engineering Limited. In his two statements he states that Omega Engineering Limited is a wholly owned subsidiary of Omega Engineering Inc. His company acts as the UK distributor for products such as chronometric and horological products, period timers, and timers used to measure and/or control other variable parameters all for science and industry. He provides extracts from publications which show products which carry the OMEGA name and the Greek letter. The pages provided are not dated and show products such as an industrial timer which Mr Woods states has been sold in the UK since 1992, and industrial timers, solid state timers, solenoid valve timers and computer counter/timer interface boards which he states have been sold in the UK since 1995.

11) Mr Wood states that his company sells pure platinum, gold and rhodium thermocouple wire, complete thermocouple assemblies made of such metals, gold and silver plated switch contacts and gold plated connector pins all bearing the OMEGA name and also the device mark. He provides copies of packaging and pages from the website also showing use of the marks.

12) Mr Wood states that the turnover in respect of platinum and also gold wire bearing these marks in the UK has been as follows:

Year	Platinum sales £	Inches of platinum wire sold	Gold sales £	Inches of gold wire sold
1997	2000	n/a	160	132
1998	660	n/a	220	144
1999	1860	n/a	41	20
2000	10260	20000	165	120
2001	13300	17000	350	240

REGISTERED PROPRIETOR'S EVIDENCE

13) The registered proprietor filed three witness statements. The first, dated 29 January 2003, is by Peter Stierli the Vice President and Chief Finance Officer of the registered proprietor company. He states that he has a good knowledge of English.

14) Mr Stierli states that his company has used the Greek letter and word OMEGA in the UK in relation to jewellery, clocks and watches. He provides combined turnover figures for the UK and the Republic of Ireland stating that the majority of sales are achieved in the UK. These figures relate to goods in Class 14, the majority of it relating to watches/jewellery watches.

Year	Turnover in £
1996	9,757,253
1997	8,765,668
1998	9,567,131
1999	10,136,660
2000	16,825,377

15) Mr Stierli states that his company has used both the symbol or Greek letter for the word OMEGA as well as and in combination with the word itself. He provides a number of exhibits which I summarise as follows:

- PS1 various brochures dated 1996 – 2001 used in the UK showing use of the letter and word OMEGA on watches.
- PS2: a list of retail outlets throughout the UK.
- PS3: copies of invoices between 1996 – 1997 relating to clocks; between 1996-1999 relating to watches and jewel studded watches and between 1996-2000 relating to gold watch bracelets, gold cases and steel bracelets.
- PS4: photographs of clocks sold by the registered proprietor which are similar to those sold in the UK.
- PS5: an international registration for the Greek letter Omega dated 2 May 1895 in relation to, inter alia, watch movements and watch cases.

- PS8: a magazine circulated across Europe including the UK which shows examples of the registered proprietor's watches from 1900 to 2000 which have the symbol or word OMEGA (sometimes both) on them. This magazine also shows jewel studded watches and decorated gold watch cases.

16) The second witness statement, dated 30 January 2003, is by Sofia Arenal the registered proprietor's Trade Mark Attorney. She provides a number of brochures which show the Greek letter and/or the word OMEGA used on watches. She points out that a number of these watches are bejewelled and can form part of a piece of jewellery.

17) Ms Arenal states that the International Classification of goods and services produced by the World Intellectual Property Organisation states that Class 14 does not include "certain goods in precious metals (classified according to their function or purpose)". The extract referred to is supplied at exhibit SA10, and also gives examples of goods made of precious metals which do not fall within Class 14 which includes "electric contacts (Cl.9)".

18) The third statement, dated 26 February 2003, is by Roger Grimshaw, the registered proprietor's Trade Mark Attorney. He provides, at exhibit RSG1, a copy of a judgement of the High Court in a dispute between the two parties where the judge gave an opinion on the meaning of Clause 4 of the agreement referred to in the applicant's evidence. I do not intend to summarise the findings here but will refer to them as necessary in my decision.

19) That concludes my review of the evidence. I now turn to the decision.

DECISION

20) The request for the declaration of invalidity is made under the provisions of Section 47(2) of the Act. These state:

"47.(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,"

21) I first consider the position under section 5(2)(b) which reads:

"5.-(2) A trade mark shall not be registered if because -

- (a)....
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

22) An “earlier trade mark” is defined in section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

23) At the hearing the applicant stated that its strongest case is under CTM 2180834. Although this mark is still pending, if it proceeds to registration it would be regarded as an “earlier trade mark”.

24) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG*;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*

25) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the protected mark and the applicant's application on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

26) For ease of reference the registered proprietor's specification and the relevant part of the applicant's CTM 2180834 are reproduced below:

Registered proprietor's specification	Applicant's specification
Class 14: Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes; jewellery, precious stones; timepieces and chronometric instruments.	Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; timers; period timers; all the foregoing being for science or industry.



27) At the hearing Mr Crouch, for the applicant, stated that he was not opposing the following parts of the registered proprietor's specification: "jewellery, precious stones; timepieces and chronometric instruments".

28) Clearly, the remaining part of the registered proprietor's specification overlaps with the applicant's specification, a point which was conceded by Ms Arenal at the hearing. The goods are either identical, or at worst similar.

29) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods for which it is registered, and any other relevant factors. In making my

global assessment I shall consider the goods as similar as this provides the applicant with the weakest possible case.

30) I shall now consider the marks of the two parties, which are reproduced below for ease of reference:

Registered Proprietor's mark	Applicant's mark
	

31) At the hearing Ms Arenal contended that the marks of the two parties were not similar. She explained her views on the differences between the two parties marks, although these comments relate more to the two opposition cases heard at the same time:

“On the other hand, you have a word which has most of the letters of the word OMEGA except in the middle of it there is the currency symbol for one of the most widely traded and used currencies in the world, which is the Euro symbol. Of course, we are operating here in the European Union and although you cannot pay for many things in shops in Euros in the UK, I would say that every person in the UK recognises that symbol as the Euro. It is comparable with putting the US dollar sign in the middle instead of saying “S”. People notice that. It is not a negligible difference.

The reason the other side have included it in their mark is that they are trying to be clever. They are trying to reinforce their links with Europe. They are trying to make you think, “Yes, this is a European mark because we are taking your currency symbol and we are putting it right in the middle of us.” It is like saying, “For Omega Engineering, Europe is at our heart.” It is in the middle of their mark. That is a completely different message from the classic Greek symbolism of the word OMEGA with the letter OMEGA. Conceptually, they are not similar; they are different. Theirs is a play on words and ours is a clear Greek classic message.”

32) I accept that the average consumer, being “reasonably well informed and reasonably circumspect and observant”, will notice the use of the Euro symbol in the middle of the applicant’s mark. However, the applicant’s mark will be seen as an OMEGA mark as this is the dominant and distinctive element of the mark. The applicant’s products are designed and intended for scientific and industrial use and I have no doubt that the average consumer of the applicant’s products would identify the registered proprietor’s mark as the Greek letter “Omega”. However, I have to consider the general public as the average consumer for the applicant’s goods. In my opinion they will recognise the applicant’s mark as the Greek letter OMEGA and as such would regard the marks as similar.

33) I must also take into account the reputation of both parties. The registered proprietor I accept had, at the relevant date, a reputation for watches and timing

apparatus for sport. From the evidence filed the applicant cannot claim to have any significant reputation, and cannot enjoy any enhanced level of protection.

34) Taking all of the above factors into account I have no hesitation in finding that there is a likelihood of confusion. The ground of invalidity under section 5(2)(b) of the Trade Marks Act 1994 succeeds in relation to “Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes”. As grounds for refusal exist only in respect of these goods the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a form TM21 restricting the specification as follows:

Class 14: “Jewellery, precious stones; timepieces and chronometric instruments.”

35) If the applicants do not file a form TM21 restricting the specification as set out above the application will be refused in its entirety.

36) Earlier in this decision I found that the applicant does not have a reputation in relation to the goods in Class 14. Thus, the applicant does not get to first base in a passing off action. The invalidity action under section 5(4)(a) must fail.

37) The invalidity action based on the applicant’s CTM application 2180834 has succeeded under Section 5(2)(b). Although Section 6(1) states that pending applications qualify as earlier trade marks, the proviso in sub-section (2) says that if the earlier mark is not yet registered its status as an earlier mark is subject to it being registered. My decision under section 5(2)(b) is therefore stayed pending the registration, or otherwise of the earlier mark cited in the grounds of invalidity. Accordingly, I direct that this decision will not take effect until one month following the resolution of Community Trade Mark Application number 2180834.

38) As the applicant was successful it is entitled to a contribution towards its costs. I have taken into account the fact that this case was one of three where the evidence was effectively identical and a single hearing took place. I order the registered proprietor to pay the applicant the sum of £1450. This sum 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 7th day of October 2004

George W Salthouse
For the Registrar,
the Comptroller-General