

O-186-14

**TRADE MARKS ACT 1994**

**In the matters of trade mark application No. 2567290  
for the trade mark OMEGA in Classes 6, 9, 17 and 37  
in the name of Omega Red Group Limited**

**and**

**Application No. 2567470  
for the following series of five trade marks:**



**in Classes 6, 9, 17 and 37  
in the name of Omega Red Group Limited**

**and**

**and two oppositions thereto consolidated under No. 102045  
by Omega SA (Omega AG) (Omega Ltd)**

## **TRADE MARKS ACT 1994**

**IN THE MATTERS OF Trade Mark Application No. 2567290  
for the trade mark OMEGA in Classes 6, 9, 17 and 37  
in the name of Omega Red Group Limited**

and

**IN THE MATTERS OF Trade Mark Application No. 2567470  
for a series of five figurative trade marks containing the word OMEGA  
in Classes 6, 9, 17 and 37 in the name of Omega Red Group Limited**

and

**CONSOLIDATED OPPOSITION THERETO under No. 102045  
by Omega SA (Omega AG) (Omega Ltd)**

### **Background**

1. On 17th December 2010 Omega Red Group Limited applied to register the mark OMEGA (No. 2567290), and the following series of marks (No. 2567470) as follows:



2. The applications were submitted with the following specification:

#### **Class 6**

Fasteners, clamps, fixings, and couplings all made of metal; metal building materials; non-electric cables and wires of common metal; ironmongery, items of metal hardware; pipes and tubes of metal; parts and fittings for all the aforesaid goods.

#### **Class 9**

Lightning conductors; lightning arresters; lightning protection installations, parts and fittings therefor; apparatus and instruments for lightning protection; apparatus and instruments for protecting electrical and electronic apparatus and instruments against lightning; electric controls for lightning protection installations, parts and fittings therefor; fasteners, clamps, fixings, wires, cables, tape, straps and connectors, all for use in lightning protection installations and earthing systems; earthing systems, parts and fittings therefor; earthing conductors; earth rods; earth bars; earthing clamps and electrically conductive metal components for use as earthing; apparatus and instruments for earthing protection; surge protection apparatus.

## **Class 17**

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials; insulating materials; electrical insulators; high tension insulators; fasteners, clamps, clips, fixings, straps and housings all made from plastic; all of the aforesaid goods being for use in lightning protection installations and earthing systems.

## **Class 37**

Building construction, maintenance and installation services; constructing, erecting, installing, testing and repairing lightning conductors; installing, testing and repairing electric controls for lightning protection installations; maintenance, testing and repair of lightning protection apparatus; constructing, installing, testing and repairing earthing systems; advice and consultancy in relation to all the aforesaid services.

3. As a result of the decision of the Registrar's Hearing Officer issued on 27th July 2011 in respect of another opposition to Application 2567290 by Omega Engineering, Inc (No. 102089), the goods in Class 9 of that application were reduced to the following:

“Lightning conductors and lightning arresters; lightning protection installations; apparatus and instruments for lightning protection; apparatus and instruments for protecting electrical and electronic apparatus and instruments against lightning; earthing systems; earthing conductors; earth rods; earth bars; earthing clamps and electrically conductive metal components for use as earthing; apparatus and instruments for earthing protection; surge protection apparatus”.

4. The corresponding specification in application No. 2567470 was not affected by this decision.





5. On 21st June 2011, Omega SA, (Omega AG) (Omega Ltd), hereinafter referred to as “SA”, filed notice of opposition to both applications although only directed against the goods and services in class 9 in 37 of the applications. These actions were allocated Nos. 102080 and 102045, later being consolidated under the latter. The grounds of opposition in summary are:

**Under Section 5(2)(b)** in that international registrations designating the EU Nos. 997036 and 992381, and UK registration Nos. 699057 are similar marks to those covered by the applications and specify identical or similar goods.

**Under Section 5(3)** in that 699057, 992381 and UK registrations Nos. 283841 and 283842 have a reputation in the UK for all specified goods and services, and are identical or similar to the applicant's marks and registration of the latter would take unfair advantage of, be detrimental to, the distinctive character or reputation of 699057, 992381, 283841 and 283842; and

**Under Section 5(4)(a)** in that the law of passing off protects an earlier unregistered trade mark: Ω OMEGA.

6. Details of the earlier mark relied upon are as follows:

<b>Number</b>	<b>Mark</b>	<b>Specification</b>
283841	OMEGA	Watches and parts of watches, but not including watch cases sold separately
283842	 OMEGA	Watches and parts of watches, but not including watch cases sold separately
699057	 OMEGA	Measuring and signalling apparatus and instruments, all for use in sport; but not including calculating machines nor instruments and apparatus for measuring, signalling and checking (supervision) of heat and temperature for scientific and industrial use.
992381	 OMEGA	Maintenance and repair of jewellery products, of horological products and of chronometric instruments; installation of apparatus and instruments for sports timekeeping; maintenance and repair of apparatus and instruments for sports timekeeping.
997036	 OMEGA	Photofinish apparatus, photocell apparatus, electronic apparatus incorporating a time display, transponders, acoustic start apparatus, horns, loudspeakers, lap counters, shot counters, countdown timers, starting timers, starting guns, electronic starting gates, electronic starting blocs, electronic starting platforms, electronic touchpads, flashes, goal lamps, wind meters, scoreboards, displays, data processing apparatus, software, all the aforesaid goods intended for the field of sports.

7. The applicant denies all the grounds, providing their reasoning in the counterstatements received on 19th December 2012, requesting that the opponent provides proof that their earlier marks have a reputation and are “famous” as claimed. Only the opponent filed evidence, with further submissions, and neither party requested to be heard. This decision follows a careful consideration of all the submitted papers.

### **The Evidence**

8. Turning to the first of the two Witness Statements from Petra Hlavacek, who confirms that she works in the legal department of The Swatch Group Ltd, being responsible for all

legal matters (including intellectual property) of her company and its affiliated companies, including Omega Electronics SA, Swiss Timing Ltd. and SA. She has held this position since June 2000.

9. The first Witness Statement is dated 13 March 2013, Ms Hlavacek confirming that the information contained comes from her own knowledge, and also from the records of Omega SA, Omega Electronics SA and of Swiss Timing Ltd. Ms. Hlavacek describes herself as “French and German bilingual”, but is also fluent in English. She adds that SA has “... given first to Omega Electronics SA, and since 2006 to Swiss Timing Ltd. a non written license to use the OMEGA trade marks for specific products or services”.

10. Ms Hlavacek gives an outline of the history of the OMEGA brand, and the business that developed the name. More detail is provided in Exhibit PH1 which consists of a copy of a brochure called “Omega Past and Present” dating from 1985. The business has a long history in chronology (over 150 years), with SA having used the OMEGA trade marks in the United Kingdom since 1948 in relation to horological and chronometric apparatus and instruments such as clocks, watches, chronographs and chronometers.

11. Ms. Hlavacek points out that sports measuring, signaling and timing equipment has been sold by SA, then by Swiss Timing Ltd, in the UK under the OMEGA trade marks on a continuous basis for over 30 years. She highlights that Exhibit PH1 mentions the brands connection with NASA; the Ω OMEGA SPEEDMASTER chronographs being used by NASA astronauts, including those on the moon landing in 1969. The latter was commemorated in 2009 by the launch of a 40th anniversary limited edition Ω OMEGA SPEEDMASTER watch (see Exhibit PH2).

12. More brand history is set out in Exhibits PH3 consisting of a copy of a publication dating from 1993 entitled “Ω OMEGA The History of a Great Brand”, and PH4 being a copy of a book written by Marco Richon in 1988 called “Ω OMEGA Saga”. The latter is in French but Ms. Hlavacek provides a translation of the following points:

1912 – it was decided that the face of every one of SA’s watches sold in the UK would bear the name OMEGA;

1917 – The British Air Force chose Omega to equip its combat units;

1921 – Creation of Omega Watch Company of England Limited to sell OMEGA products in the UK;

1925 – Omega Watch Company of England Limited moved to Holborn Viaduct in London;

1939 – 1945. All the navigational watches used by the RAF during the second World War were made in Switzerland, and about half of these were OMEGA watches;

1952 – Omega was named once again as the official supplier to the British Armed Forces;

1983 – Omega SA’s UK operations moved to Eastleigh, near Southampton;

1993 – Omega SA was responsible for the official timekeeping for the start of the prestigious Whitbread Round the World Race;

1997 – Pierce Brosnan launched a new watch in Omega SA's range at the Goodwood Festival of Speed (20 - 23 June).

13. Ms. Hlavacek refers to the wide range of horological and chronometric instruments sold under the OMEGA trade marks, including ladies' and men's watches, sport watches, chronographs and divers' watches. Reference is also made to measuring and signaling equipment used in sports: for example for timing the speed and performance of sports people, particularly athletes in competitions, notably the Olympic games. Ms Hlavacek refers to the variety items set out in Exhibit PH5, which comprises a watch catalogue dating from 2003, and chapter 2 of the book by Marco Richon mentioned above which gives further brand history. Ms Hlavacek says that although in French, the pictures "...clearly show high profile use of the OMEGA trade marks by Omega SA as well as its licensees for a wide range of timing activities". Ms Hlavacek highlights the following use:

Chronographs dated 1913 (page 79);

Football stadium clock from the range launched in 1928 (page 80);

Stopwatches (page 81);

Poster from the 1932 Olympics (page 82);

Sports timing equipment from the 1940s (page 87);

The Pope receiving an OMEGA SEAMASTER watch in 1956 (page 94);

Display board from the 1964 Winter Olympics (page 100);

English advertisement for the OMEGA CHRONOSTOP in 1966 (page 102);

Sports timing activities at the 1968 Olympics in Mexico (page 104);

Sports timing equipment in 1978 (page 116);

Video matrix display board in 1982 (page 121);

Ω OMEGA SCAN'O'VISION sports timing equipment in 1990 (page 125);

Divers' watches (pages 135-140); and

14. Ms Hlavacek adds that there is a list of important events timed using SA's products and services under the OMEGA trade shown on pages 132 and 133 covering the period 1932-1998. She adds that the trade mark "Ω" appears next to every page number.

15. Ms. Hlavacek goes on to emphasise the range of goods and services with which the OMEGA brand is associated, and the very significant nature of its reputation. Particular mention is made of SA having provided sports measuring and signaling equipment and services, notably in relation to time-keeping for the Olympic games in 1932, and for over 20 Olympic games, since, including the London Olympics in 1948. This involvement is set

out in detail in Exhibits PH7, a brochure headed “Significant Moments” which provides history about SA’s business and trade mark involvement, and PH8 which consist of a publication called “Ω OMEGA 50 years of Olympic timing”. Ms Hlavacek says that these exhibits illustrate that the OMEGA trade marks feature prominently on the products themselves, and show their high visibility at events where SA provides sports time keeping equipment and services.

16. Under the heading “Other Public Events and Venues” Ms Hlavacek gives more details of use of the OMEGA trade mark in relation to “sports measuring and signaling products and services” at other major sporting events and stadiums around the UK. For example, the 18th Commonwealth games, held in Scotland in 1986. It is also stated that by the year 2000, scoreboards, aquatics timing and scoring systems, photo finish systems and athletic timing systems bearing the OMEGA trade marks had been installed at over 200 UK locations, including in public swimming pools in Darlington and Leeds (1982), London and Ipswich (1983) in London and Everton (1985), Edinburgh and Macclesfield (1986), Stockport (1991) and Haslemere in 1998. Details can be found on Page 6 of Appendix 2 to the Witness Statement by Timothy Edwin Colman provided as Exhibit PH9, the Annex consisting of a copy of a publication from Omega Electronics called “The Last Word in Sports Timing”. This gives details of OMEGA products and venues where various types have been installed. Ms Hlavacek makes particular reference to public information systems and display boards under the OMEGA brand installed in major transport hubs in the UK, including Liverpool Street, Watford and Milton Keynes railway stations, at Gatwick Airport and in a restaurant, Smiths of Smithfield, which indicates when tables are available.

17. Exhibit PH10 is a copy of an SA newsletter of November 1992 referring to tennis tournaments in the UK in the early 1990s. Exhibit PH11 contains colour pictures of various measuring and signaling products used as part of SA’s services under the OMEGA trade marks taken from catalogues, with the dates and event mostly indicated. Included are a starting gun apparatus, various pieces of measuring and timing equipment, public information systems and display boards. The relevance to the UK market is not always obvious although Ms Hlavacek says that with the exception of the Alpine skiing starting gate, this is the same equipment as has been used in the UK.

18. Exhibit PH12 contains three brochures dating “from around 2000” that show information display systems under the OMEGA trade marks. The systems seem to be based outside the UK; Ms Hlavacek confirms that at least one was installed in Leipzig; but also says that the installations included the UK.

19. Ms Hlavacek goes on to refer to her company’s connection with jewellery, stating that SA has, for many decades used and registered its OMEGA trade marks in relation to such goods. Evidence for this is provided in Exhibit PH13, which contains copies of pages from chapter 4 of the book OMEGA Saga. Ms Hlavacek says that although in French, the pictures clearly show the jewellery and are in many cases dated. “Events” in the UK are mentioned, in particular:

Jewellery exhibition in London (1965) called “Meteorites and Jewels” held in London in 1965 (p. 260);

Jewellery exhibition held in May 1970, noted as having been visited by Princess Anne (page 270);

20. Ms Hlavacek says that around 2002, SA launched its jewellery collection entitled "Omega Bijoux". She says that this was heavily promoted throughout the European Community, including the UK, Exhibit PH14 being a catalogue of the collection which includes rings, necklaces, earrings and bracelets. Ms Hlavacek highlights that as well as bearing the  $\Omega$  trade mark, some items are also made in this shape, in particular, the necklace illustrated on page 25, and other pieces within the "Symbole" collection. Exhibit 15 gives details of some of the related UK press coverage of the promotion.

21. Exhibit PH16 consists of printouts from SA's website which Ms Hlavacek says shows examples of SA's jewellery range as at January 2012. Apart from the pictures of various products there is little information provided.

22. Ms Hlavacek says that SA also sells jewellery under its trade marks through a network of boutiques and retailers across the UK, including: Fannies the Jewellers, Aberdeen; the Omega boutique in the Bull Ring shopping centre, Birmingham; FJ Zelly Limited, Bishop's Stortford; Waltons the Jeweller, Chester; Laing the Jeweller in Glasgow; the Omega boutique in Argyle Arcade, Glasgow; the Omega boutique at Heathrow airport terminal 1; the Omega boutique at the Bluewater shopping centre, Kent; Omega boutiques in Old Bond Street, Westfield shopping centre, Regent Street, Harrods and other locations in London; the Omega boutique at the Trafford Centre, Manchester; TB Mitchel, Perth; Harrington and Hallworth, Wilmslow; Parkhouse, Cardiff; and Berry's Jewellers Ltd, Leeds.

23. Ms Hlavacek also mentions the OMEGA brand being used in connection with fine leather goods and fragrances, Exhibit PH17 being provided as evidence. The exhibit consists of details said to be taken from SA's website in January 2012, Apart from the date and pictures of various products there is little detail given in the exhibit. However, Ms Hlavacek confirms that the products are sold in the UK, for example, in the Omega boutiques in Birmingham, Glasgow, Heathrow airport, the Bluewater shopping centre, Old Bond Street, Westfield shopping centre, Regent Street in Harrods in London and the Trafford centre in Manchester.

24. The final part of the Witness Statement sets out SA's promotional activities for its watches, which Ms Hlavacek says are advertised in many national publications in the UK, listing The Times, the Sunday Times magazine, the Sunday Telegraph, International Watch Magazine, Chronos, Business Age, Elle, The Economist, Newsweek and Time. Exhibit PH18 contains examples editorials and advertisements from the 1990s.

25. It is also mentioned that SA uses high profile individuals to advertise and promote its products, notably from the sports, acting and fashion industries, particularly mentioned are Anna Kournikova and Martina Hingis. Ms Hlavacek says that these sportsmen and women promote products outside the sporting field: "the OMEGA trade marks are certainly not a 'one product brand' ". Other individuals said to have acted, or currently acting as ambassadors for the OMEGA trade marks include Cindy Crawford, Sir Peter Blake, Michael Schumacher, Ernie Els, Pierce Brosnan, George Clooney, Nicole Kidman, Daniel Craig, Buzz Aldrin, Eugene A. Cernan, Michael Phelps, Greg Norman, Sergio Garcia and Michelle Wie. Ms Hlavacek makes reference to Pierce Brosnan having worn an OMEGA branded watch when acting in the James Bond films, and to Daniel Craig having worn an OMEGA SEAMASTER Planet Ocean chronometer in the role in Skyfall. Exhibit PH20 consists of a website extract showing the current ambassadors.

26. The next Witness Statement dated 15 March 2013 comes from Sofia Arenal, a partner in Mewburn Ellis LLP. Ms Arenal states that within her company she is primarily



responsible for cases involving Omega SA, and through involvement in numerous proceedings has reviewed a large amount of evidence relating to SA's business and use of trade marks.

27. Ms. Arenal refers to SA being the owner of a family of trade marks consisting of or incorporating the word OMEGA and/or the device  $\Omega$ , the most widely known and registered being the  $\Omega$ , OMEGA and  $\Omega$ , OMEGA. She states that in the trade mark  $\Omega$  OMEGA the  $\Omega$  is centred over the letter E, but is represented as shown in the Witness Statement for typographical reasons. Ms Arenal refers to SA's other trade marks including OMEGA CONSTELLATION, OMEGA CERAGOLD, OMEGA SPEEDMASTER MARK II and  $\Omega$  OMEGA SCAN 'O' VISION.

28. Ms Arenal refers to there being numerous decisions of the UKIPO, the CTM office and the courts recognising SA's reputation in its OMEGA trade marks, notably  $\Omega$ , OMEGA and  $\Omega$  OMEGA. By way of example Ms Arenal provides a copy (Exhibit SA1) of OHIM opposition decision No. B561490 of 29 May 2009 against an application to register  $\Omega$ .COM in the name of Omega Engineering, Inc., Particular reference is made to the following extract on pages 15 to 16:

“Having assessed the evidence produced by the opponent, the Office finds that it convincingly demonstrates that the opponent's trade mark  $\Omega$  OMEGA possesses an enhanced distinctiveness and reputation in connection with precision time-pieces, in particular watches (also professional watches) and sports timing equipment as a result of its intensive use and promotional activities in many European Union Member States.... The evidence produced is sufficient to show that the trade mark "OMEGA", has been massively promoted... and that a significant part of the relevant public knows and recognises the opponent's mark "OMEGA" in relation to the above mentioned goods. The Office notes that the enhanced distinctiveness and reputation of the opponent's trade mark "OMEGA" in respect of the above goods is acknowledged also by the applicant”.

29. Ms Arenal says that the same conclusion was reached by the OHIM in the following successful oppositions against Omega Engineering, namely opposition number B553372 against application 2225126 ( $\Omega$ .NET); opposition number B629172 against application 2229169 ( $\Omega$ ), opposition number B542102 against application 2226454 ( $\Omega$ .ORG) and opposition number B548257 against application 2226462 ( $\Omega$ ). As Exhibit SA2 Ms Arenal provides a copy of the front page of these decisions along with the page(s) containing the relevant paragraph which Ms Arenal has marked for ease of reference.

30. Ms Arenal says that a similar conclusion was reached in the UK tribunal decision in an opposition to application 2179158 for the trade mark OMEGAMETER under number BL 0/013/02, a copy of which is shown as Exhibit SA3. In paragraph 33 the hearing officer stated:

“I accept, therefore, that the opponents enjoyed a significant reputation under their mark in relation to watches and time-keeping systems for sporting events at the material date in these proceedings.”

31. Ms Arenal mentions that before the Hearing Officer was the Witness Statement of Mr Colman included as an exhibit to the witness statement of Petra Hlavacek. On appeal to the High Court the opposition against OMEGAMETER was upheld by the late Justice Pumfrey, which, as can be seen from the copy of the decision shown as Exhibit

SA4, quoted the hearing officer's paragraph 33 summary at page 1. Ms. Arenal goes on to mention the decision of the Appointed Person in SA's successful partial invalidation action against UK registration 1557184 (OMEGA), a copy of which is shown as Exhibit SA5, highlighting in particular paragraph 17 which says:

"The Hearing Officer held that 699057 Ω OMEGA is possessed of high inherent distinctive character in relation to the goods in respect of which it is registered. He further held that at the date of [the registered proprietor's] application for the mark in suit, 16 December 1993 [Omega SA] had a reputation in relation to both watches and sophisticated timing devices for sporting purposes... Indeed, Rimer J. confirms [Omega SA's] reputation at [2004] EWHC 2315 (Ch)".

32. In conclusion Ms Arenal mentions the reference by the Appointed Person to the judgment of Rimer J in *Omega Engineering Ltd. v Omega SA* of 2 August 2004, a copy of which is shown as Exhibit SA6. In this the Appointed Person says at paragraph 3:

"Omega is a Swiss company which has long been associated with the sale of watches and whose trade includes the provision of timekeeping equipment for use in sporting events and the development of public information and display systems for use in railways stations, airports and so on".

33. The next Witness Statement is dated 25 April 2013, and comes from Simon Andrew James, a Brand Manager at Swiss Timing, a division of Swatch Group (UK) Ltd, and is authorised to make his statement on behalf of SA. Mr James confirms that he is the same Simon Andrew James who made the Witness Statement on 3 July 2008 in relation to the opposition made by OMEGA SA against application number 2459957 in the name of March Ventures Limited, and reaffirms its contents. This Witness Statement is shown as Exhibit SAJ-A1, although not accompanied by a complete set of exhibits. Mr. James refers to the following:

SAJ1 (2007 catalogue, noting pages 14-16 are blank);  
SAJ11 (customer order day books);  
SAJ12 (picture featuring Ellen MacArthur);  
SAJ13 (picture from Crystal Palace Athletics Grand Prix);  
SAJ14 (picture from athletics meet, Glasgow); and  
SAJ15 (selection of invoices).

34. Mr James particularly quotes the following statement included as paragraph 19 of his earlier statement:

"As can be seen from the exhibits to this witness statement, athletics competitions would use the following Ω OMEGA branded equipment for measuring and signaling, although please note this is not an exhaustive list: timing computer, photo finish cameras, photo cells, field display boards, false start systems, starting blocks, scoreboards, wind gauges and wind gauge displays and lap counters. Swimming competitions would use, inter alia, the following Ω OMEGA equipment: starting blocks, touch pads, wiring harnesses, buttons, acoustic starts, scoreboards, the Ω OMEGA Ares aquatic interface, a power supply and data switches."

35. Mr James confirms that this remains an accurate overview of the sports measuring and signaling apparatus and instruments sold in the UK under the Ω OMEGA and OMEGA trade marks during the period 2006 to 2011. Mr. James also refers to the earlier statement

where the a lower estimated value of  $\Omega$  OMEGA branded sports measuring and signaling products for the period 2003 to 2007 is given as £2.2M, providing a further “rough” estimate for the period between 2006 and 2011 of £6.6M. He breaks this down as follows although does not give the source:

2006 over £0.6 million  
2007 over £1.2 million  
2008 over £1.4 million  
2009 over £1.2 million  
2010 over £1 million  
2011 over £1.2 million

36. Mr James says that in recent years, invoices issued by his company appear under the name Swiss Timing”, Exhibit SAJ-A3 being a selection of those issued during 2007 to 2011. All relate to the sale of sports measuring and signaling apparatus and instruments branded with the  $\Omega$  OMEGA or OMEGA trade marks. Mr James notes that some date from later in 2011, and whilst not relevant to proving use in relation to specific registrations in the current proceedings, demonstrate continued use and investment in the  $\Omega$  OMEGA and OMEGA brands. The relevant items are identified by the manuscript insertion of the word OMEGA inside a box.

37. Mr. James goes on to link some of the product codes on the invoices to pictures of the products in the 2007 Catalogue provided as Exhibit SAJ-A2, mentioning in particular Stock reference 2872-003. From Exhibit SAJ-A4 (a copy of page 6 of the swimming section and page 6 of the track and field section of the 2007 Catalogue) it can be seen that this code refers to a “coiled cable” known as the OMEGA OIT3. Mr James cross references this with:

Invoice 0649 dated 7 June 2007 to SASA East District in Musselburgh, Scotland;  
Invoice 0880 dated 31 December 2007 to Pellikaan Const in London, and  
Invoice 2545 dated 29 November 2007 to Eric Wright Cons. in Preston.

38. Exhibit SAJ-A5 consists of a copy of page1 of the swimming section of the 2007 Catalogue which Mr James cross-references with the following invoices listing products bearing a code beginning 3330:

Invoices 0880 dated 31/12/07 and 1218 of 30/10/08 to Barr and Wray in Glasgow;  
Invoice 0906 dated 29/1/08 to 1SG Jackson Ltd in Ipswich;  
Invoice 1258 dated 27/11/08 to Carllion Reg Building of Wolverhampton;  
Invoice 1407 dated 27/3/09 to Spie Matthew Hall of London;  
Invoice 2543 dated 29/11/11 to City of Edinburgh Council.

39. The products concerned consist of an OMEGA ARES with aquatics interface” described as being the “heart of the timing system”, an OMEGA ARES single power supply, and an OMEGA ARES Data Switcher.

40. Exhibit SAJ-A6 consists of copies of pages 4 and 5 of the swimming section of the 2007 Catalogue which Mr James cross-references with the following invoices listing products bearing codes beginning with 0880:

Invoices 0880 dated 31 December 2007 to Wirral MBC of Birkenhead;  
Invoice 0951 dated 19 March 2008 to Wirral MBC of Birkenhead;  
Invoice 1258 dated 27 November 2008 to Carllion Reg Building of Wolverhampton;

Invoice 2545 dated 29 November 2008 to Eric Wright Cons. in Preston.

Invoice 2543 dated 29 November 2011 to City of Edinburgh Council

I cannot find an Invoice 2799 said to have been issued to McGill Electrical Ltd of Dundee.

41. Mr James next refers to invoice 0880 of 31 December 2007 and in particular to the inclusion of product codes 3400.903 and 3400-991 which he says can be seen on pages 2 and 4 of the multisport scoreboards section of the 2007 catalogue shown as Exhibit SAJ-A7. Mr James highlights that the trade marks  $\Omega$  OMEGA and OMEGA can be seen on many products in this section, citing by way of example:

Page 1: Art 3400.900 OMEGA Multisport controller, where the mark  $\Omega$  OMEGA is shown in white in the bottom right hand corner of the product photograph.

Page 1: Art 3400.602 OMEGA SATURN basic system type 602, shows the mark  $\Omega$  OMEGA in white in the centre of the product photograph (SATURN and SATURN ATHINA are sub-brands);

Pages 2, 3 and 5: The trade mark  $\Omega$  OMEGA is also shown in white approximately in the centre of the products pictured on the right hand side of each page:

Page 8: The trade mark  $\Omega$  OMEGA can be seen in black on a white background on pictures of football displays with references Art 3412.913 and Art 3412.914.

42. Exhibit SAJ-A8 consists of copies of “marked-up” invoices to Aspire Defence Services dating from March and July 2012, relating to the sale of an “OCP5 Touchpad Set 190”90 8 lanes” and Touchpad Trolley Universal Castors”. Acknowledging that these date from outside of the relevant period, Mr James nonetheless says that they demonstrate continued use of the  $\Omega$  OMEGA and OMEGA trade marks. Exhibit SAJ-A9 contains pictures from an athletics meet in Gateshead in 2010, and the European Synchronised Swimming Championship in Sheffield in 2011, both showing prominent use of the trade mark  $\Omega$  OMEGA.

43. Mr. James claims that, alongside  $\Omega$  OMEGA and OMEGA branded sports measuring and signaling apparatus and instruments installed throughout the UK in the period 2006-2011, his company also provided training and advice by telephone, site visits or via correspondence. He states that the value of these installation, maintenance, repair, training and advisory services during this period was approximately £300K per annum, including parts and equipment.

44. Mr James goes on to mention that his company has a number of annual contracts with various leisure centres, schools and high-profile sporting venues in the UK for maintenance and support services in relation to  $\Omega$  OMEGA and OMEGA branded equipment. He mentions in particular the National Cycling Centre Premiership rugby venues. Details of these can be found in the invoices provided as Exhibit SAJ-A10. These date from March 2006 through to November 2012 and refer to contracts as described by Mr James. Mr James acknowledges that there is no mention of  $\Omega$  OMEGA and OMEGA, saying that this is because they appear on separate invoices issued for the parts to be used in the repair service.

45. Mr James goes on to mention Exhibit SAJ-A11 which contains example invoices issued in May and June 2006 in relation to contacts for maintenance of Ω OMEGA and/or OMEGA branded equipment at council-run sports and leisure centres, and a British Government services company Serco. The relevant bodies include Gwynedd Council, Southampton Council, Newport City Council and Lisburn Council. The contacts with Serco is in relation to leisure and sports centres across the UK, in particular, Aquavale Leisure Centre in Aylesbury, Grand Central Pools in Stockport, Watermeadows Leisure Centre in Mansfield and Manchester Aquatics Centre which was purpose-built for the 2002 Commonwealth Games, and since 2005 has been the aquatics venue for the Paralympic World Cup.

46. Exhibit SAJ-A12 consists of a selection of invoices to DC Leisure and to Parkwood Leisure, the earliest dating from July 2008, relating to contracts with privately owned leisure management companies and leisure and fitness chains around the UK.

47. Exhibit SAJ-A13 provides copies of further invoices relating to maintenance and service contracts for schools in relation to sports equipment. The examples cited are Guildford High School, Girls Education Co Ltd for Wycombe Abbey School, Abingdon School and International Schools Ltd for ACS Cobham. These date from 19 August 2010, 17 May 2011, 3 November 2011 and 29 March 2011, respectively. Exhibit SAJ-A14 contains further invoices relating to some of the maintenance and service contracts for Ω OMEGA and OMEGA branded equipment for high-profile sporting venues across the UK as follows:

Invoice no. 0396 dated 30 December 2006 to Warrington Wolves FC for the Halliwell Jones Stadium

Invoice no. 0066 dated 7 March 2006 to the Velodrome Trust for The National Cycling Centre which Mr James says is regularly used by several Olympic athletes as well as members of the general public.

Invoice no. 2831 dated 10 August 2012 to Premiership Rugby Ltd for 12 Premiership rugby venues.

That concludes my summary of Mr James' Witness Statement.

48. The final Witness Statement is dated 13 May 2013 and is a second statement from Petra Hlavacek. Ms. Hlavacek states that the purpose of this second witness statement is to provide further information in relation to sales of jewellery and watches, and the provision of repair services in the UK. Ms Hlavacek provides "approximate gross sales figures" for jewellery sold under the trade marks OMEGA and/or Ω OMEGA in the UK:

Year	Gross Sales Figures (GBP).
2006	245,000.00
2007	89,000.00
2008	71,000.00
2009	92,000.00
2010	101,000.00
2011	82,000.00

49. Ms Hlavacek next provides “approximate gross sales figures” for watches sold under the trade marks OMEGA and/or Ω OMEGA in the UK:

Year	Gross Sales Figure (GBP)
2006	22,300,000.00
2007	26,300,000.00
2008	28,200,000.00
2009	35,600,000.00
2010	39,500,000.00
2011	46,900,000.00

50. Ms Hlavacek then provides “approximate gross sales figures” for repair services of watch and jewellery under the trade marks OMEGA and/or Ω OMEGA in the UK:

Year	Sales Figures (GBP)
2006	1,700,000.00
2007	2,500,000.00
2008	2,700,000.00
2009	3,100,000.00
2010	3,800,000.00
2011	4,500,000.00

51. Samples invoices for jewellery are provided as Exhibit PH21 and for watches as Exhibit PH22, in both cases for the years 2004 to 2011. Ms. Hlavacek states that the range of jewellery shown in the invoices includes cufflinks, bracelets, earrings, medallions, necklaces, chains, pendants and rings. She states that in the watch invoices the products are identified as Watch CO 95 ON METAL which indicates the CONSTELLATION sub-brand, Watch CO CARRE LADIES, Watch SE Div 300 M Gents, the SE indicates the SEAMASTER sub-brand. Ms Hlavacek confirms that all watch products bear the Ω OMEGA, and/or OMEGA trade marks. Exhibit PH23 is introduced as a “current list of sales points of SA in the UK, which Ms Hlavacek says is representative of the number, identity and location of sales points during the period 2006 to 2011.

## Decision

52. The opposition is founded under Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Act. Addressing the ground under Section 5(2)(b), which reads as follows:

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

(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.”

53. An earlier trade mark is defined in section 6 of the Act, 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 or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

### **Proof of use**

54. One of the earlier trade marks relied upon by the opponents under this ground had been registered for five years at the time of the publication of the opposed trade mark application. Consequently it is subject to the proof of use requirement as per Section 6A of the Trade Marks Act 1994. Specifics as to the use claimed are set out by the opponents in paragraph 8 of their revised statement of case, which is challenged by the applicants in their Counterstatement. The earlier mark in question is as follows:

**Mark:**           Ω  
                  OMEGA

**Goods:**       Measuring and signalling apparatus and instruments, all for use in sport; but not including calculating machines nor instruments and apparatus for measuring, signalling and checking (supervision) of heat and temperature for scientific and industrial use.

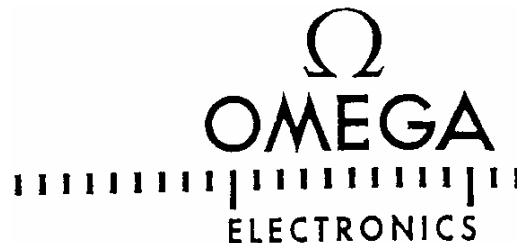
55. What is required is use in relation to “Measuring and signalling apparatus and instruments”. Apart from the requirement that these be for use in “sport” it does not matter what is measured or the form of the signalling.

56. Before going into the use it is useful to recap on some of the history of this particular registration. This had been subject of an application for revocation (BL O/027/03), in which the Registrar’s Hearing Officer had found there to be use of the mark but only in respect of part of the goods for which it was registered. The original specification was therefore restricted to its current form with effect from 14 September 2001. In his decision the Hearing Officer accepted that the evidence had “shown use of the trade mark in relation to goods that measure things other than time eg distance” and also “equipment that can be used for signalling ie equipment for judges to communicate with each other”, adding that the proprietor had “supplied a wide range of equipment for sporting use in a wide variety of sports.” Although relating to use outside of the relevant period here, it does show that my findings below are consistent with the previous assessment.

57. The evidence provided by the opponents is largely historical being aimed at establishing long standing use. Nevertheless, there is evidence, primarily that exhibited by Mr James, that establishes recent and relevant use of the mark in question in relation to goods for measuring and signaling. By way of example: Exhibit SAJ-A2, a 2007 catalogue of Swiss Timing products lists the Omega Ares which is described as “The heart of the timing system...”, the Ω OMEGA mark being clearly visible on the right of the apparatus

face panel. This apparatus comes with a collection of accessories, including the “StartTime II acoustic start device consisting of an “Integral single speaker and flash...amplifies verbal commands and transmits start signals...” and the “Omega FLASH start”, a “Visual signal for hearing impaired athletes...”

58. The 2007 catalogue exhibited also lists the Omega Saturn described as “Basic multisport scoreboard with game time, scores and period with “3 time-out indicators...” To me this describes apparatus with both “timing” and “signaling” functionality. The Saturn has the Ω OMEGA mark visible in the centre of the apparatus face panel. Evidence of the sale and/or maintenance (indicating sales have taken place) of these products can be found in the invoices provided as exhibits by Mr James. Many of these invoices also show Ω OMEGA, albeit in the form:



59. There are many more “measuring” and “signaling” goods listed in the 2007 catalogue, such as the Montreal Shot clock, OMEGA PICCOLO and OMEGA CALYPSO scoreboards, the 9mm Starting system gun, the EDM (Electronic Distance Measurement) system, MISTRAL – Integrated wind gauge, BOREAS - Concentration clock and wind measurement, Marathon clock, CHRONOS timer, TRACKER – Start semaphores/Lap counters, to name just a few. All show the Ω OMEGA mark. Invoices relating to sales, and/or post sale maintenance, training etc can again be found in the invoices headed as above. Whilst I have no information on the size of the market for such goods, the figures provided show a significant commercial activity. I therefore have little difficulty in coming to the conclusion that use in relation to the measuring and signaling apparatus listed in the specification of goods is established.

### **Section 5(2)(b) – case law**

60. The standard authorities are those as set out in the decision of Mr Geoffrey Hobbs QC in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), which are (by reference to the CJEU cases mentioned) as indicated below.

### **The CJEU cases**

61. The cases are *Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

### **The principles**



“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer and nature of the purchasing decision**

62. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services, and then to determine the manner in which these goods will be selected by the average consumer in the course of trade.

63. Goods of the like of lightning conductors, lightning arrestors and lightning protectors are not commonly (if ever) purchased by the public at large. I am aware that for certain activities such as caravanning, a lightning rod may be used to earth the vehicle in which case the average consumer will be the caravanning public and the purchase being by self-selection in a store, or visual/oral by telephone or the internet. Otherwise, the consumer will generally be those engaged in the specification of electricity supply systems and civil engineering and construction projects, such as architects and design engineer who will be well informed, observant and circumspect. The determination of the product or solution selected will be on a case-by-case basis to suit the circumstances; the more complex the requirement, the greater the attention, and may involve a bespoke solution. So for a telecommunications mast in an area prone to lightning or a predominantly metal and glass skyscraper there will be more attention to detail than for the spire for a local church. The construction and engineering contractors that complete the installation will also have varying degrees of specialism, but nonetheless will pay a high level of attention to ensure the components match the specification and that the installation is correct. The varying degrees of specialism in the product range will also affect the level of attention. The selection of a sophisticated device used on high-voltage power lines and telecoms systems to protect equipment from lightning and switching surges will demand greater attention than a lightning rod device that diverts lightning surges to ground will. However, even at the more basic end of the market there will still be a reasonably high level of attention to the selection process.

64. In the case of “earthing” and “surge protection”, the range of potential consumer will be greater. Earthing and surge protection can be a highly technical part of industries such as the electricity generation and distribution industry, telecommunications, and civil engineering and construction. In such applications the consumer will apply the same high degree of attention as the lighting products above. Earthing is used to protect against an electric shock by providing a protective conductor for a fault current to flow to earth through protective devices such as a circuit-breakers, fuses or residual current devices that will switch off the electricity supply to the circuit that has the fault. Such goods will be found in many homes, and even when installed by a specialist tradesperson will still generally be known and purchased by the DIY savvy public at large. As electronic apparatus such as personal computers, televisions and washing machines used around the house have become more technical and sophisticated the consumer has become more aware of the issues of surge protection, and will buy such goods to plug vulnerable devices into.

65. The “public” consumer of the applicant’s goods and services are more likely to be subject to the effects of imperfect recollection than the skilled professional. That said, as these will not be an everyday purchase, they will take particular care to ensure the correct product is purchased, which will often be guided by an original component that they are replacing.

66. The position from the perspective of the opponent’s goods and services is more informed as the evidence gives a picture of the consumer of sports measuring, signaling and timekeeping apparatus, and the supplementary services that they provide in their installation, maintenance and repair. These general terms will encompass the more specific types of sports equipment such as the “photofinish apparatus”, “lap counters”, “starting guns” etc, listed in the specification of earlier mark number 997036 so will be provided to the same consumer in the same way.

67. The evidence shows the sports measuring and signaling products and services to have been provided to major sporting events, such as the Olympics and Commonwealth games,

and to venues such as stadiums, public swimming pools, major transport hubs such as railway stations, airports, and in one case to a restaurant to indicate the availability of tables.

68. For events such as the Olympic and Commonwealth Games, the identification and acquisition of products and services for competition venues, stadiums and training halls will be handled by organizing committees composed of representatives of public authorities and leading figures from within and outside of the sporting world. These committees will be well informed and advised on available technology, and have the benefit of previous equipment and service usage to guide them. Given the scale of the event and purchasing requirements, presumably made by tender, each step will be thoroughly scrutinized. Decisions are likely to include the involvement of engineering and construction specialists who will be equally well informed, observant and circumspect, with the determination of the product being a joint decision on direction from the committee and/or with advice from the specialist. Each will be selected on a case-by-case basis to suit the circumstances; the more complex the requirement, the greater the attention.

69. In the case of venues, be they sporting or transport, the consumer who will make the purchasing decision is likely to be a suitably qualified technical and/or procurement specialist, who will have knowledge, and make informed decisions with a high degree of care. For major purchases the decision may again be by a tendering process, particularly for public venues, which will involve a good deal of definition and review. For services such as maintenance or repair, or the purchase of spare parts or accessories, the decision is most likely to be guided and supplied on the same basis by the supplier of the primary equipment.

70. The maintenance and repair of jewellery, horological products and chronometric instruments covers a wide spectrum of activities, ranging from the services of the local high street jeweller who will clean or repair damage, replace batteries, etc, through to laboratories that will carry out highly sophisticated repairs and recalibration to precision timing equipment. As a consequence, the consumer of such services will be similarly diverse, from members of the public who will have an idea of what they need but guided by the knowledge of the retailer, through to highly qualified specialist in science, industry and activities where highly accurate time keeping and time measuring is necessary.

### **Comparison of the respective goods**

71. In assessing the similarity of the respective goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the goods in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the judgment:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature and their method of use and whether they are in competition with each other or are complementary.’

72. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited* (The “Treat” case) [1996] R.P.C. 281, such as the nature of the users and the channels of trade. I also have regard to *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

73. As mentioned earlier, the specification of goods in Class 9 of application 2567290 has been reduced but is otherwise wholly encompassed by the specification of 2567470. I therefore propose to do my analysis based on the Class 9 specification for application 2567470, for if the goods here are found not to be similar, then it will follow that the goods of application 2567290 will not be.

**2567470 Class 9**

Lightning conductors; lightning arresters; lightning protection installations, parts and fittings therefor; apparatus and instruments for lightning protection; apparatus and instruments for protecting electrical and electronic apparatus and instruments against lightning; electric controls for lightning protection installations, parts and fittings therefor; fasteners, clamps, fixings, wires, cables, tape, straps and connectors, all for use in lightning protection installations and earthing systems; earthing systems, parts and fittings therefor; earthing conductors; earth rods; earth bars; earthing clamps and electrically conductive metal components for use as earthing; apparatus and instruments for earthing protection; surge protection apparatus.

**Class 37**

Building construction, maintenance and installation services; constructing, erecting, installing, testing and repairing lightning conductors; installing, testing and repairing electric controls for lightning protection installations; maintenance, testing and repair of lightning protection apparatus; constructing, installing, testing and repairing earthing systems; advice and consultancy in relation to all the aforesaid services.

against:

- 699057 Measuring and signalling apparatus and instruments, all for use in sport; but not including calculating machines nor instruments and apparatus for measuring, signalling and checking (supervision) of heat and temperature for scientific and industrial use.
- 992381 Maintenance and repair of jewellery products, of horological products and of chronometric instruments; installation of apparatus and instruments for sports timekeeping; maintenance and repair of apparatus and instruments for sports timekeeping.
- 997036 Photofinish apparatus, photocell apparatus, electronic apparatus incorporating a time display, transponders, acoustic start apparatus, horns, loudspeakers, lap counters, shot counters, countdown timers, starting timers, starting guns, electronic starting gates, electronic starting blocs, electronic starting platforms, electronic touchpads, flashes, goal lamps, wind meters, scoreboards, displays, data processing apparatus, software, all the aforesaid goods intended for the field of sports.

74. All of the goods in the specification in Class 9 of application no. 2567470 are for lightning conducting, lightning arresting, lightning protection, earthing or surge protection. It is not clear what makes up such products and conceivably their nature may be the similar to some of the apparatus and instruments covered by the opponent's earlier marks. At the fullest extent of their meaning it is possible that the opponent's goods and services are capable of describing goods for the same use and purpose as those of the applicants, particularly as a part or fitting, instruments that "measure" a lightning strike, or "signal" that one had taken place. However, that these goods in the earlier marks are all limited to being "for use in sport" removes this potential for similarity between the specifications of the earlier marks and Class 9 of the opposed mark. I have no evidence but I do not see that they will have much, if any overlap in the channels of trade, be that manufacture or sale, nor are they in competition, or complementary within the meaning given in *Sanco SA v OHIM* (Case T-249/11).

75. This leaves the question of the specification for Class 37 of the application. This covers "building construction" along with "maintenance and installation services for buildings", and "construction, erection, installation, testing and repair of goods of the type found in the Class 9 specification. It also lists advice and consultancy in relation to the services. Again, it seems self-evident to me that when considered in the context of the criteria to be used in determining similarity, these services are quite different to goods for measuring and signaling, services for the maintenance and repair of jewellery, time measuring and timekeeping apparatus and instruments, and the apparatus used to manage sporting activities and competitions.

76. It is with little difficulty that I arrive at the determination the respective goods and services are dissimilar.

### **Comparison of trade marks**

77. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives marks as a whole and does not pause to analyse their various details. In addition, they rarely have the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective marks.

### **Distinctive and dominant elements**

78. Distinctive character of a mark can be appraised only, first, by reference to the goods and services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* paragraphs 22 and 23.

79. The opponent's marks consist of the word OMEGA, and the same word with the symbol  $\Omega$  placed above. These are not elements of the opponent's invention; they are the

word and symbol that represent a letter from the Greek alphabet. That aside, the word OMEGA (and the OMEGA symbol) have no descriptive, laudatory or other meaning in relation to the goods or services for which it is registered, and is wholly and strongly distinctive in such use. Although being placed above would usually give the  $\Omega$  symbol a degree of dominance, this is diminished by the fact that it is well known as the representation of the word OMEGA, and only serves to reinforce that the opponent's marks are OMEGA, and that this word is the dominant and distinctive within the marks.

80. For application No. 2567290 the applicant's mark consist of the word OMEGA in capital letters. In their counterstatement they concede that this is identical and or virtually identical to the opponent's marks so I need say no more about this. Application No. 2567470 is for a series of five versions of a circular device with what to me seems to be a representation of a "flash" of electricity or lightening. Three are represented in red and white, grey and white and black and white, each with the word OMEGA in white lettering running horizontally through the middle. The remaining two have either a red or black square containing a white circle with the "flash" represented in the same colour as the square and with the word OMEGA in black. Just as with the opponent's mark, the word OMEGA has no linkage with any characteristic of the goods and services for which registration is sought; it is entirely distinctive. The device element occupies a significant portion of the mark and contrary to the opponent's submission, it is my view that they consist of more than matter wholly lacking any distinctive contribution. A "flash" of lightening or representing electricity has a descriptive connection with the goods and services, but being somewhat stylized and in combination with the circle creates a figurative element that cannot be said to make no distinctive contribution. That said, the word OMEGA is clear and visible and if the mark was being referred to or recalled to mind it is likely to be by this word. Whilst the figurative elements provide some separation, OMEGA is the dominant and distinctive part of the marks.

### **Reputation and enhanced distinctiveness**

81. The evidence shows the opponent's OMEGA trade mark has been in use in the UK since 1948 in relation to horological and chronometric apparatus and instruments such as clocks, watches, chronographs and chronometers. Advertising has been widespread through the medium of nationally circulated publications in the UK, including The Times, the Sunday Times magazine, the Sunday Telegraph, International Watch Magazine, Chronos, Business Age, Elle, The Economist, Newsweek and Time, albeit being examples from some years previously. More recent evidence shows the use of high profile individuals to advertise and promote these products, notably from the sports, acting and fashion industries, including through the use of brand "ambassadors. In relation to sports measuring, signaling and timing equipment the evidence links back for "over 30 years" and shows a connection with prestigious sporting events such as the Olympic and Commonwealth games, and many sports venues throughout the country. Alongside this sits the use of the OMEGA trade mark in relation to public information systems and display boards installed in major transport hubs in the UK, including railway stations and airports

82. The opponents also have a long-standing connection with jewellery, Exhibit PH13 containing pictures of such goods, and mention of jewellery exhibitions in London in 1965 and 1970. There is also evidence of the launch of a jewellery collection around 2002 entitled "Omega Bijoux" that is said to have been heavily promoted throughout the European Community, including the UK, Exhibit PH14 being a catalogue of the collection. In this can be seen rings, necklaces, earrings and bracelets being sold under the  $\Omega$  trade mark, with some items also made in this shape. Some of the related UK press coverage of

the promotion is provided as Exhibit PH15. Exhibit PH16 giving an extract from the opponent's website shows further examples of the jewellery range said to as at January 2012. The use shown is after the relevant date and apart from showing that jewellery is also sold under the trade mark through a network of third party traders and "Omega boutiques" in various parts of the UK, there is little supporting detail.

83. There is also mention of the OMEGA brand being used in connection with fine leather goods and fragrances. The supporting evidence essentially consists of an extract from the opponent's website in dating from January 2012 which is after the relevant date. There is little further detail beyond the statement that such goods are sold at the Omega boutiques and by various third-party traders.

84. The "lower estimated" value of  $\Omega$  OMEGA branded sports measuring and signaling products for the period 2003 to 2007 is given as £2.2M, with further "rough" estimates for the period between 2006 and 2011 of £6.6M. No mention is made of value of the non - sports measuring/signaling products. Gross sales figures" for jewellery sold under the trade marks OMEGA and/or  $\Omega$  OMEGA in the UK for 2006 – 2011 range from a base of £71,000 in 2008 to a peak of £245,000 in 2006. The more recent years have ranged between £82,000 and £101,000. The biggest part of the opponent's business is by far in respect of watches, with "approximate gross sales figures" ranging from £22.3 million in 2006, rising year on year to £46.9 million. Figures for repair watch and jewellery repair services under the range from £1.7 million in 2006 rising year on year to £4.5 million in 2011.

85. Putting all of the above into context it seems reasonably clear to me that at the material date in these proceedings, the opponents had established a very significant reputation in respect of watches, and that this should be taken as adding to the distinctive character of the mark in respect of such goods. Although much lower in terms of sales, this will have washed over into the repair of watches. Although seemingly low when compared to the figures for watches, the next in terms of significance for the opponents business is the "measuring and signaling products". For these goods the sales figures have not been separated into sporting and non-sporting use, but to my mind if there is a reputation for such goods that is likely to enhance the distinctive character of the mark it must be in the sports side of this business. This is not just on the strength of sales, but also by virtue of its exposure at the most prestigious of sporting events, and at sporting venues. Bringing up the reputational rear is the jewellery side of the business which by the probable size of the market for such goods is does not even scratch what you would anticipate to be the trade of a single high street trader. I have nothing by which to gauge any reputation for leather goods and/or fragrances.

86. My conclusions (not surprisingly) accords with the findings in the OHIM opposition decision No. B561490 of 29 May and UK tribunal decisions in opposition number BL 0/013/02 to which I have been referred.

87. The opponents also assert that the applicant's choice of the colours red and white is significant, stating that the opponents have used these in its branding for OMEGA marks over many years. They extend this argument to the black and white versions on the assertion that this "...it is commonly acknowledged to give protection for any colour combination". In relation to such arguments I am mindful of the judgment of the Court of Justice of the European Union ("CJEU") in Case C-252/12, Specsavers International Healthcare Limited and Others v Asda Stores Limited which indicates that:

"Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.

Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision."

88. Although concerning Community Trade Marks and proceedings under Community Trade Mark Regulation 207/2009, it is applicable, by analogy, to the interpretation of the corresponding provisions of the Trade Mark Directive and national law implementing those provisions.

89. I also bear in mind Case C-533/06 O2 Holdings Limited and O2 (UK) Limited v Hutchison 3G UK Limited, the relevant paragraph 66 saying:

"Article 4(1)(b) of Directive 89/104, however, concerns the application for registration of a mark. Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered."

90. This means that colour should be taken into account where the earlier mark has been registered in black and white and has been used to the extent and consistency that the colour(s) form part of the distinctive character of the earlier mark. Otherwise, colour should be regarded as irrelevant.

91. I have to say that the examples cited to show a link between the colours red and white and the opponent's marks is tenuous to say the least. For example, the use of red in the cover of the watch catalogue that is part of Exhibit PH5 and the advertisement in Exhibit PH13 is purely incidental. The same can be said about the red casing or background of a product with the OMEGA shown in white, or as shown in Exhibit PH14, the opponents OMEGA mark in red on a white page or gold on red in respect of the cover. At the extreme is the claim to the colours because text such as "find a store" and "significant moments" being represented in red, and "products being represented within red boxes". Accordingly, I do not see that the argument based on "colour" has any substance.

### **Visual comparison**

92. The opponent's marks consist of the word OMEGA presented in upper case, which is different to the applicants who use the word with the initial letter "O" in uppercase and the following letters in lower case. The opponent's mark also includes the omega symbol



above the same word, but to my mind that is going to have little visual impact. That cannot be said of the figurative elements of the applicant's marks which include a "circle" of various colours, and containing the "flash", and/or "square" background. The word in this mark is centrally placed in the circle and does not escape the eye. Compared as totalities the degree of visual similarity with the opponent's marks may reside in a relatively small, but certainly not insignificant element of the applicant's marks –the word OMEGA - such that this results in the marks as a whole being visually similar to a reasonable degree.

### **Aural similarity**

93. It is well established that where marks consists of a combination of a word and device, it is by the words that the average consumer is most likely to refer to the mark. As all marks contain the word OMEGA, albeit represented in different styles, this must inevitably result in aural identity.

### **Conceptual similarity**

94. If it the average consumer of the goods and services in question does not know that OMEGA is a letter from the Greek alphabet then the respective marks will be treated as invented words and the conceptual position will be neutral. However, to me it seems unlikely that the meaning of OMEGA would not be known to the average consumer which can only lead to the conclusion that the competing marks must be regarded as being identical in concept.

### **Likelihood of confusion**

95. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater or lesser degree of similarity between the respective goods and services. It is also necessary to take account of the distinctive character of the opponent's earlier trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons and must instead rely upon the imperfect picture of the respective trade marks that the consumer will have retained in their mind.

96. Earlier in this decision I concluded that: (i) The competing trade marks are visually similar and aurally and conceptually identical in their dominant distinctive element, (ii) The inherent distinctive character of the opponent's earlier trade mark is strong and enhanced by a significant reputation for watches and their repair, and measuring and signaling products for sports. (iii) there is potential for overlap in respect of the average consumer, the level varying according to the goods and services, but that as the applicant's consumer base being knowledgeable professionals such as engineers, creates a significantly reduced potential for imperfect recollection. (iv) The selection of the goods and services would be by visual means, such as from product catalogues or by written specification, particularly where the requirement was bespoke, and always with a high degree of attention by particularly well informed decision makers. (v) The goods and services at issue are significantly dissimilar. Balancing all of this I come the conclusion that even factoring in the similarities, there is no likelihood of confusion.

## Conclusion

97. The opposition based upon section 5(2)(b) of the Act fails.

98. This brings me to the ground under Section 5(3). Under this ground the opponents rely on registration Nos. 699057, 992381, 283841 and 283842. They assert that they have a reputation in the UK for all associated goods and services which are identical or similar to those of the applications, and that registration of the latter would take unfair advantage of, be detrimental to, the distinctive character and/or reputation.

99. The principles to be applied when determining an objection under this ground were summarised by the Hearing Officer, Allan James, in BL O-179-11 as follows:

“(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors Corp v Yplon SA* [2000] RPC 572 (CJEU), paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel Corporation Inc v CPM United Kingdom Ltd* (Intel) [2009] RPC 15 (CJEU), paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon AG v Fitnessworld Trading Ltd*. [2004] ETMR 10 (CJEU), paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; Intel, paragraph 42.

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; Intel, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; Intel, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the

earlier mark is registered, or a serious likelihood that this will happen in future; Intel, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal SA and others v Bellure NV and others* (L'Oreal) C-487/07 (CJEU), paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; L'Oreal, paragraph 41."

100. The above guidance encompasses the points on "linkage" considered in the Spa-Finder (T-67/04) and Citti (T-181/05) cases to which the opponents refer me.

101. I see the position in respect of the opponent's reputation in their OMEGA trade marks amongst the relevant consuming public for the goods or services as follows. The extent of the reputation varies in scale, from very significant in respect of watches and their repair, significant for the "measuring and signaling products for sporting use, and minimal in respect of jewellery. This assessment is based on the evidence provided, taking account of factors such as the nature and degree of exposure to the relevant public, and scale of the business. It seems logical to me that the level of awareness of the trade marks by the relevant public should be commensurate with this use, but what is not so clear is whether, and if so, to what extent, any reputation may extend beyond the consumers for the goods and services for which it is registered?

102. In respect of watches and the associated repair services the consumer is potentially everyone, so there is no question of consumer extension to answer. The position with respect to the specialised goods such as the measuring and signalling equipment is less clear; would the brand of the timing equipment being used in a competition be noticed? It is also not clear how aware the public may be of the opponent's jewellery business, but as an avenue of trade traditionally associated with watches will add little in extending any reputation. So in essence, the established use and reputation is centred on time and timekeeping and likely to extend little beyond this.

103. Whether the public confronted with the applicant's mark would make a link with the opponent's mark may be influenced by the answers to certain questions, some of which I do not have, for example, the extent to which OMEGA may be used as a trade mark by 3<sup>rd</sup> parties. I am also mindful that the form in which the Opponents have used their marks has varied little over the years. Additionally, the type of goods and services for which these marks have been used have remained centred on time-keeping, time-measuring and jewellery. This should be considered in the context of their being an additional distinctive element, the circle and flash, in the applicant's mark, and the distance between the respective goods and services. Notwithstanding this, it seems to me that the applicant's mark has become known to an extent that there is significant chance that it will be called to mind when encountering the marks applied for, particularly given that the core element of both is an identical and distinctive word. Here I have regard to the PULSAR case

(R1769/2011-1) from which the opponents refer me to the statement "...the stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it within the meaning of Article 8(5) CTMR". That is fine so far as it goes, but is just one factor in the required assessment.

104. If I were to take the contrary position that a link will be established, would this create the types of injury set out in Section 5(3), or there is a serious likelihood that such an injury will occur in the future? The Opponent's written submissions describe the potential injury as "The likely benefit to the applicant and detriment to the opponent..." which they set out in the context of "misrepresentation" for the ground under Section 5(4). They put this as:

"Anyone purchasing the applicant's products, whether it be a lightning conductor for a school, sports centre, home, industrial unit etc., would undoubtedly be familiar with the opponent's famous OMEGA trade marks, either as a user of these products and services, or perhaps as one of the many millions of people who watch the Olympic games and other international sports events on television or are simply aware of the famous OMEGA watch brands. They would undoubtedly perceive the applicants OMEGA marks as being connected with the opponent, either by directly originating from them, or under some kind of commercial agreement such as a licence or joint venture."

105. I have already set out why I consider the respective goods and services to be clearly different. Any potential overlap between the relevant consumers for these goods and services is very limited. To this I would add that these consumers are, to a significant extent, well informed, knowledgeable and less prone to make uninformed judgments. Collectively I would say that the relevant public is unlikely to believe that the goods and services marketed under the later mark come from the owner of the earlier mark, or one that is economically connected.

106. And specifically:

- a) As a result of the reputation in the opponent's OMEGA trade marks and the fact that the mark applied for is extremely similar, use of the marks applied for would both take unfair advantage of and be detrimental to the distinctive character and reputation of the earlier marks.
- b) Such use would take unfair advantage by effectively "riding on the coat tails" of the reputation which the opponent has carefully generated and nurtured over the many decades, in relation to a wide range of products and services. This would allow the applicant's marks to benefit from the positive connotations associated with the earlier marks, for example, precision, reliability, endurance, safety and quality.
- c) Use of the applicant's marks would be detrimental to the distinctive character and repute of the earlier marks, by lessening their distinctiveness in the market place and on the trade mark register. Particularly in view of the London 2012 Olympic games, for which preparations were very much underway at the time of filing of the opposed applications, this use could imply some kind of sponsorship or association or other connection with the opponent, for example in relation to technical equipment and building construction maintenance and installation services connected either with the

Olympic village, or for visitors coming to London, and the UK in general, in order to participate in or spectate at the Olympic games. The applicant's claimed building, construction, maintenance and installation services are broad enough to include construction, maintenance and installation services relating to sports centres, swimming pools, athletics tracks, race tracks, tennis courts and other sporting facilities. The opponent's products and services are particularly relevant to such venues.

- d) The dilution of the opponent's OMEGA marks would also negatively impact on their sponsorship and promotion of sporting and cultural events and of high profile individuals including sports people and actors."

107. A type of detriment referred to by the opponent is that use of the marks applied for would be detrimental to "...the distinctive character and repute ... of the earlier marks, by lessening their distinctiveness in the market place and on the trade mark register", although the given examples seem to me to go more to "unfair advantage". Putting more flesh on the above summary of L'Oreal this ground was described as follows:

"39 As regards detriment to the distinctive character of the mark, also referred to as 'dilution', 'whittling away' or 'blurring', such detriment is caused when that mark's ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, Intel Corporation, paragraph 29).

108. Looking first at the assertion that use of the applicant's marks would be detrimental to the distinctive character and repute of the earlier marks. Being on the register does not affect any reputation of a trade mark, nor does the presence of a mark on the register cause another mark to lose distinctive value or reputation just because others are added, and I do not intend to say any more on this.

109. In relation to the market place, the opponent makes specific mention of the preparations for the London 2012 Olympics that were ongoing at the time the applications were filed asserting that linkage with the marks applied for could be taken to imply some kind of sponsorship or association or other connection with the opponent. By way of example they refer to the services in Class 37 of the applications stating that the building, construction, maintenance and installation services listed are broad enough to include such services provided in relation to sports centres, swimming pools, athletics tracks, race tracks, tennis courts and other sporting facilities where the opponent's products and services are particularly in evidence. It cannot be disputed that the Class 37 of the application notionally includes such services provided in respect of the types of venues mentioned. However, it is not at all clear why the fact that the opponent also provides quite distinct goods and services at such venues should create any suggestion of sponsorship or association; the opponents do not and have never provided any building construction, building maintenance or building installation services or anything close. That they argue this in relation to arenas for sporting activities only serves to illustrate that the opponents are associated with a particular activity.

110. The opponent further argues that the potential for their sponsorship or endorsement of the applicant's services in Class 37 to be implied will result from a connection being

drawn with the Olympic village, by visitors coming to London and the UK in order to participate in or watch at the Olympics. The first point is that these are not the consumer of the applicant's services. To my mind, few, if any would pay any regard to who built the venue, installed facilities or is the maintenance contractor, such that it seems unlikely that they would even be aware if the applicants had even had any involvement.

111. The opponent asserts that the dilution of their OMEGA marks would negatively impact on their sponsorship and promotion of sporting and cultural events and of high profile individuals including sports people and actors. For this, and the other reasons I have mentioned, I do not consider that the ability of the earlier marks to identify its goods and services would be weakened by the use of the applied for marks, or that they would be any less attractive.

112. The next type of detriment that the opponent's allege is "riding on the coat tails" of their reputation, or in other words, taking unfair advantage. Here L'Oreal says:

"41 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation."

113. The opponent says that its reputation has been carefully generated and nurtured over the many decades; I see no reason to dispute this. Where the opponent and I do part company is where it says that this has been "...in relation to a wide range of products and services". As I have already mentioned, most of the use has been in relation to goods such as watches, followed by sports timing/measurement and jewellery, all areas that are connected or overlap in some way. Specifically, they assert that the applicant's marks would benefit from "positive connotations" associated with the earlier marks, such as "precision, reliability, endurance, safety and quality."

114. Here I am mindful of the decision of Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753:

"136 I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage

to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention.

- 137 The question of unfair advantage has to be considered in the round, using a global assessment as indicated in *Intel* in paragraph 79 of the Court's judgment. As Advocate General Sharpston said at paragraph 65 of her Opinion in *Intel*, unfair advantage is the more likely to be found if the mark is more distinctive and if the goods or services are more similar. The Board of Appeal in *Mango* also said that unfair advantage is the more likely where there is greater similarity of goods as well as where the mark is more distinctive, but that was a case where the mark was identical, and strongly distinctive, and the goods were not the same but they were in an associated or overlapping field. The Court in *L'Oréal v Bellure* also referred to the importance of the strength of the reputation of the mark, and the strength of the reminder, reiterating what had been said in *Intel*. Here, although the relevant goods are very similar (even identical if one is considering the category stand mixers), the mark is distinctive, but not strongly so, nor is the reminder strong. That is therefore another pointer away from unfair advantage. At paragraph 66 of her Opinion in *Intel* Advocate General Sharpston referred to the question whether the association of the earlier mark would enhance the performance of the later sign in the use made of it. That is another way of putting the proposition that the alleged infringer must draw some advantage from the use of a similar mark or sign. In *L'Oréal v Bellure* the third party's advantage had been established; here it is very much in issue.
- 138 It seems to me that, on the evidence and on the judge's findings as regards that evidence, *Whirlpool* is unable to show that *Kenwood* has in fact drawn, or is likely to draw, any commercial advantage from the perceived similarity. None of Mrs Watson, the survey witnesses, or the demonstrators enables *Whirlpool* to show clearly that *Kenwood* had obtained any such advantage, or were likely to do so. Relevant average consumers would be aware both of the *KitchenAid Artisan* and of the new entrant to the market. The two are similar in certain respects, but above all because both are stand mixers designed to a high standard of style, so as to be attractive products on the kitchen work surface, rather than functional items to be hidden away when not in use. Accordingly, looking at the question of unfair advantage generally, it seems to me that the judge was right to reject the case made on that footing for two reasons: there was no advantage to *Kenwood*, and if, to the contrary, there were, it was not an unfair advantage."

115. Distinct from *Whirlpool*, the applicant is not a newcomer to a specialist market in which the opponent has a monopoly. The markets are clearly well separated and there is no evidence that the opponent is the only trader in its field. The dominant distinctive element (the word *OMEGA*) of the respective marks is identical and in respect of the associated goods and services is strongly distinctive, but there is other significant (non-negligible) matter in both marks. On the evidence the distinctiveness of the opponent's mark is strengthened by a significant reputation for watches, sports timing/measuring apparatus and instruments, and associated repair and maintenance services, but far less

so beyond this. In no case would any of the goods and services for which the opponent's marks have a reputation be considered similar or to be in an associated or overlapping field to the goods and services of the application.

116. There is no evidence of an intention to take advantage of the opponent's reputation and no basis from which to infer that this was the applicant's intention, although I accept that unfairness can be demonstrated by something other than intention. Even if the opponent could show that the applicant has obtained an advantage, there must be an "added factor" of that advantage being categorised as unfair.

117. That calling to mind the opponent's marks would enhance the performance of the applicant's mark is not established. It is possible to infer from the evidence that the opponent's reputation in the OMEGA marks includes attributes such as "precision", "reliability" and "quality", for if that were not the case it seems unlikely that they would have such a longstanding relationship with the Olympics and other high-profile events. However, qualities such as "endurance" and particularly "safety" have less to do with the opponent's use of OMEGA and seem to have been included in an attempt to draw a link with desirable aspects in the applicant's goods. I am strengthened in this view by the lack of any mention of such qualities in the opponent's evidence. Accordingly, looking at the question of unfair advantage generally, it seems to me that I reject that there would be advantage to the applicant through image transfer, and even if there was, it would not be an unfair advantage.

## **Conclusion**

118. The opposition based upon section 5(3) of the Act also fails.

## **Section 5(4)(a) – Passing Off**

119. As mentioned in their written submissions, the opponent's case under this ground is identical to that previously set out for the ground under Section 5(3). As I have previously set this out in full I do not propose to do so again here.

120. An allegation under Section 5(4)(a) constitutes a ground of opposition where the use of the mark in question is liable to be prevented:

“(a) by virtue of any rule of law (in particular, the law of passing-off) protecting an unregistered trade mark or other sign used in the course of trade..”

121. The elements of passing-off, often referred to as the classic trinity were summarised in *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver setting the position as follows:

“The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the



plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

122. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom."

123. To qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature (See *Hart v Relentless Records* [2002] EWHC 1984), but being a small player does not prevent the law of passing-off from being relied upon (See *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49).

124. The test for misrepresentation was explained in *Reckitt & Colman Products Ltd v Borden Inc* as follows:

"Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff"

125. In terms of misrepresentation, I must be satisfied that the goods and services offered under the applicant's mark would be taken (or likely to be taken) by a substantial number of the opponent's present and potential customers to be their responsibility, or that there is some form of economic connection between the opponent and the applicant. Although an intention to misrepresent would be a highly relevant factor, it is not a prerequisite. Misrepresentation can be found in innocent circumstances.

126. Although there is no requirement in passing-off for goods/services to be similar, or for there to be a common field of activity, it is nevertheless a highly relevant factor, as can be seen from the judgment in *Harrods Ltd v Harroddian School* [1996] RPC 697, where Millett LJ stated:

"The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration."

and

"The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything."

and

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

127. In relation to damage, although a direct loss of sales is often the most obvious form of damage to consider, damage can arise in other ways. In *Maslyukov v Diageo Distilling Ltd* [2010] EWHC 443 (Ch) Arnold J stated:

“85 Secondly, counsel submitted that the hearing officer had wrongly failed to recognise that damage resulting from Diegeo’s loss of control over the marks, including erosion of distinctiveness of the marks, was sufficient damage to sustain a passing off action, as shown by the following passage from McAlpine at [20] which the hearing officer himself quoted at para.128 of the decision:

“When it comes to considering damage, the law is not so naïve as to confine the damage to directly provable losses of sales, or ‘direct sale for sale substitution’.

The law recognises that damage from wrongful association can be wider than that. Thus in *Ewing v Buttercup Margarine Ltd* (1917) 34 R.P.C. 232 Warrington L.J. said:

‘To induce the belief that my business is a branch of another man’s business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me.’ In so saying, he was not limiting the kinds of potential damage to those listed by him. Rather, he was indicating that the subtleties of the effect of passing off extend into effects that are more subtle than merely sales lost to a passing off competitor.

In *Associated Newspapers Ltd v Express Newspapers* [2003] F.S.R. 909 at 929 Laddie J. cited this passage, referred to other cases and went on to say:

‘In all these cases [that is to say, the *Clock Ltd* case referred to above and *Harrods v Harrodian School* [1996] R.P.C. 679 ], direct sale for sale substitution is unlikely or impossible. Nevertheless the damage to the claimant can be substantial and invidious since the defendant’s activities may remove from the claimant his ability to control and develop as he wishes the reputation in his mark. Thus, for a long time, the common law has protected a trader from the risk of false association as it has against the risk of more conventional goods for goods confusion.’

The same judge expressed himself more picturesquely, but equally helpfully, in *Irvine v Talksport Ltd* [2002] 1 W.L.R. 2355 at 2366. Having pointed out the more familiar, and easier, case of a defendant selling inferior goods in substitution for the claimant’s and the consequential damage, he went on to say:

‘But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the claimant’s. In such a case, although the defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus Fortnum and Mason is no more entitled to use the name FW Woolworth than FW Woolworth is entitled to use the name Fortnum and Mason ...’ ‘The law will vindicate the claimant’s exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity.’ (at 2368)

In *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75 at 88, Peter Gibson L.J. acknowledged that:

‘Erosion of the distinctiveness of the name champagne in this country is a form of damage to the goodwill of the business of the champagne houses.’

The same view was expressed by Sir Thomas Bingham MR at 93.”

128. In *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

*“Damage*

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant’s unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

### **The relevant date**

129. Matters must be judged at a particular point in time. In *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 the GC stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has

acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

130. The relevant date at which to assess whether the use of the applicant’s mark was liable to be prevented under the law of passing-off is therefore 17th December 2010. I note that it may have been necessary to consider the position at an earlier date if the applicants had actively pursued its claim to 20 years concurrent use, but as they have not provided any evidence this is not an issue here.

131. At several points in this decision I have considered the opponent’s use of their earlier marks in the context of whether, and to what extent this may have established a reputation. It was an easy conclusion to reach that at the material date the opponents had collectively made very significant use of their marks in respect of watches and their repair, measuring and signaling products, most significantly for sporting, but also non-sporting use, and to a lesser extent, jewellery and its repair. In respect of the “leather goods” and “fragrances” the only information I have is that said to have been taken from the opponent’s website in January 2012, and confirmation that the products shown are sold in the UK in Omega boutiques in various locations. Although lacking any real detail, this nevertheless suggests that there has been use beyond the trivial, and it seems logical to me that this use will have created goodwill.

132. So having found there to be goodwill, the next question is one of misrepresentation. As mentioned above, the question is whether a substantial number of the opponent’s present or potential customers would take goods and services offered under the applicant’s mark to be those of the opponents, or that there is some connection between with the opponent and the applicant.

133. As I have already said, the respective goods and services are not similar, and as hard as the opponent has strained to bring them into a common or connected field of activity, the plain fact is that they are nowhere near. That both may be provided in relation to a sports venue or other building where both have supplied goods or services does not make this so. On the facts before me I see no reason why the public would make a relevant connection, let alone one that would lead them to suppose that the opponent’s have made themselves responsible for the quality of the defendant’s goods or services. This being the case, it must follow that there can be no damage of the sort envisaged in the case law,

### **Conclusion under Section 5(4)(a)**

134. The claim under passing off fails.

### **Overall outcome**

135. The opponent has failed under Section 5(2)(b), Section 5(3) and also section 5(4)(a).

### **COSTS**

136. The applicant having been successful is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. With this in mind I award costs on the following basis:

137. The opponent filed two oppositions, attacking on three grounds. This was supported by a reasonably significant amount of evidence, albeit quite repetitive and only one

consolidated set for both proceedings. The applicant filed two essentially identical counterstatements with no evidence or submissions being filed by it. I therefore consider that an award as follows to be appropriate:

£600 in respect of the work undertaken in considering the opponent's statements of case (including the revised version),

£400 for the work in preparing the counterstatements

£1500 for the work in considering the opponent's evidence.

**Total: £2,500**

138. I order that the opponent shall pay the applicant the sum of £2,500. 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 April 2014**

**Mike Foley  
For the Registrar  
The Comptroller-General**