



Neutral Citation Number: [2022] EWHC 1127 (Ch)

Case No: IL-2019-000011

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)

Rolls Building, Royal Courts of Justice
Fetter Lane, London, EC4A 1NL

Date: 20/05/2022

Before:

MRS JUSTICE FALK

Between:

- (1) MONTRES BREGUET S.A.
(2) BLANCPAIN S.A.
(3) MONTRES JAQUET DROZ S.A.
(4) OMEGA S.A.
(5) COMPAGNIE DES MONTRES LONGINES,
FRANCILLON S.A.
(6) TISSOT S.A.
(7) MIDO S.A.
(8) HAMILTON INTERNATIONAL S.A.
(9) SWATCH S.A.
(companies incorporated in the Swiss Confederation)
(10) GLASHÜTTER UHRENBETRIEB GmbH
(a company incorporated in Germany)

Claimants

- and -

- (1) SAMSUNG ELECTRONICS CO. LTD
(a company incorporated in South Korea)
(2) SAMSUNG ELECTRONICS (UK) LIMITED

Defendants

Simon Malynicz QC, Geoffrey Pritchard and Daniel Selmi (instructed by **Wilmer Cutler Pickering Hale and Dorr LLP**) for the **Claimants**
Daniel Alexander QC and Ashton Chantrielle (instructed by **Allen & Overy LLP**) for the **Defendants**

Hearing dates: 18, 21, 22 & 25 March 2022

JUDGMENT APPROVED

Covid-19 Protocol: This judgment was handed down by the judge remotely by circulation to the parties' representatives by email and release to the National Archives. The date and time for hand-down is deemed to be 10.30 am Friday 20 May 2022.

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Mrs Justice Falk:

INTRODUCTION

1. This is my decision following a liability trial of a claim for trade mark infringement brought by the claimant watch makers against the Samsung Electronics group. The claim relates to digital watch faces (watch face applications, or “apps”) that could be downloaded to Samsung’s smartwatches from the Samsung Galaxy App store (the “SGA store”).
2. The Claimants are all members of the Swatch group of watch makers. I shall refer to the Claimants collectively as “Swatch”, and the group of which they are members as the “Swatch group”. All of them are incorporated and based in Switzerland, with the exception of the Tenth Claimant which is incorporated in Germany. Each has a distinct brand and associated trade marks, ranging from Swatch in the “basic range” (with prices below CHF 200), Tissot, Mido and Hamilton in the “middle range” (between CHF 300 to 1,000), Longines in the “high range” (CHF 1,000 to 5,000), Omega in the “luxury range” (CHF 3,000 to 10,000) and Breguet, Blancpain, Glashütte Original and Jaquet Droz in the most exclusive “prestige range”, with some prices of those watches running into hundreds of thousands of Swiss francs, or even more. Members of the Swatch group also own other brands, namely Harry Winston, Union, Rado, Certina, Balmain and Flik Flak.
3. The First Defendant, Samsung Electronics Co. Ltd (“Samsung”), is incorporated in South Korea and is the parent entity of the well-known technology group. The claim against the Second Defendant, a UK subsidiary, was stayed, so Samsung is the only active defendant.
4. Swatch claim that between October 2015 and February 2019 a total of 23 of their trade marks were infringed by 30 watch face apps being made available in the SGA store, and that those apps were admitted by Samsung to have been downloaded around 160,000 times in the UK and EU. Although each of the apps was developed by a third party (the “app developers”), Swatch maintain that Samsung was intimately involved in, and controlled, the whole process by which the apps were made available. Their primary case is that Samsung is liable as a primary tortfeasor, alternatively that it is a joint tortfeasor. An alternative claim for passing off, covering a further six apps as well, was not pursued at the trial, and claims for infringement of two additional trade marks with international registrations were also not pursued.
5. Samsung denies liability. Its defences include that it has not used the marks, that the signs on the apps were not used in a way that indicated that there was any connection with Swatch, and that the conditions for joint liability were not established. Further, it relied on Article 14 of Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 (the “e-Commerce Directive”).
6. It will be necessary to refer at various points in this judgment to the appearance of trade marks or signs on watch faces. There was no dispute that the conventional location of a trade mark on a watch, whether in word or figurative form or both, is generally the centre of the upper portion of the dial. For convenience, I will use

the term “Dial Branding” to refer to the appearance of the mark or sign on the watch face.

7. I would like to thank Counsel and other members of the respective legal teams for their assistance and co-operation, including in providing further written submissions in response to questions from the court arising out of the pleadings in respect of individual apps, and in agreeing the contents of Appendices 1 and 2 to this judgment. I do need to add, however, that because of the way in which the case was presented the court was required to do a significant amount of work to produce those Appendices, despite their content being uncontroversial. I would recommend that, in future, greater consideration is given in advance to what would best assist the court to determine the issues in the case, which in this case included disputes about each app.

THE EVIDENCE

Documentary evidence

8. Apart from some evidence of the alleged infringements, documentary evidence provided by Swatch principally comprised documents provided under a Civil Evidence Act notice evidencing the background and history of the individual Claimants, material on the luxury watch market and the Swatch group’s place in it, Samsung smartwatch promotional material, and video extracts from Samsung developer conferences in 2018 and 2020.
9. Samsung’s documentary evidence included material relating to the smartwatch, Samsung’s review process, terms and conditions for app developers, download and sales data and, under a Civil Evidence Act notice, evidence in respect of Apple’s app review process, Apple and Google’s infringement report processes, Samsung’s infringement report process, potentially infringing apps shown on the Apple app store and Google Play, and the full version of the watch designer tool presentation at the 2018 Samsung developer conference.

The witness evidence

10. I heard oral evidence from three witnesses for each party. There was no expert evidence. Swatch’s witnesses were Carole Aubert, Peter Steiger and Sylvain Dolla. Samsung’s witnesses were Loi Le, Younggu Kim and Taegu Lee. Mr Le gave evidence through a Vietnamese interpreter and Mr Kim and Mr Lee through a Korean interpreter. All witnesses gave evidence in person, other than Mr Le who gave evidence by videolink from Hanoi. There were no issues with the credibility of any of the witnesses.

Carole Aubert

11. Ms Aubert is an in-house counsel at the Swatch group, where she is largely concerned with brand protection and has particular responsibility for online infringement. Before joining the group in July 2018 she worked for the Federation of the Swiss Watch Industry for 13 years as head of its internet unit, overseeing

online enforcement on behalf of members. She also worked during part of that period as a partner in a law firm.

12. Ms Aubert's written evidence assisted in providing some context and background to the Swatch group's approach to brand protection and this claim. I found her oral evidence in cross-examination to be somewhat general and of less assistance to the issues in the case. To some extent this was a reflection of her role in the group, although she appeared also to be less familiar with the details of the litigation than might have been expected.
13. One theme of Ms Aubert's cross-examination was the fact that Swatch had neither chosen to sue the app developers, nor had it taken legal action against other watch face app providers, including a relatively well known one called Svartling. A point was also taken about an apparent delay between Samsung providing evidence identifying an apparently infringing app in the Apple store and Swatch taking steps to get it taken down.
14. These points do not affect the question whether Samsung is liable. Fundamentally, it is up to the Swatch group to determine what if any legal action it should take and against whom, as opposed to relying solely on "notice and take down" procedures (see [70] below). It is understandable that the group takes a selective approach. As Ms Aubert said in her written evidence, its resources are not infinite. It is clear from Ms Aubert's evidence that Swatch's decision to bring proceedings against Samsung was at least partly prompted by a perception that Samsung was "not operating at industry standard" in taking proactive steps to prevent infringement.
15. As regards app developers, I accept Ms Aubert's evidence that Swatch's experience has been that the level of detail that had been provided by Samsung about them was unlikely to make attempting to track down and pursue them practicable. I also note that Samsung has taken no action against the app developers either, despite the fact that it could be expected to have more detail, including banking information, and has also had a direct legal relationship with them under the terms and conditions it entered into with them (discussed further below).
16. Further, as I understood Ms Aubert's evidence, whilst the Swatch group does make a significant number of requests for allegedly infringing matter to be removed from the internet, it is quite cautious in its approach, such that its requests are generally accepted. I also understood her to draw distinctions between the level of concern Swatch would have about apparently infringing material appearing on (say) a phone, as opposed to their concern about such material appearing on a smartwatch. I would further point out that, as discussed below, Samsung markets its smartwatch for its watch-like qualities, which include a round dial. There are some differences in that respect from (for example) the Apple smartwatch.

Peter Steiger

17. Mr Steiger has had a number of roles in the Swatch group since joining it 32 years ago, in particular in the areas of finance and logistics. He is currently the group's

Chief Controlling Officer and is a member of its Executive Group Management Board. He also has specific control of some of the group's country organisations, including the UK.

18. Mr Steiger's evidence reflected his long experience at the group and the knowledge he has gained. He emphasised the importance of the branding and the "Swissness" of the group's watches. He also explained his understanding of the perspective of customers acquiring watches in the luxury or prestige ranges, who would either be watch enthusiasts or purchasing as a gift, and were looking for a brand that they could trust and with a reputation that would reflect well on them.

Sylvain Dolla

19. Mr Dolla has worked with the Swatch group for 17 years, and was appointed CEO of Tissot in June 2020, having previously been CEO of Hamilton. He is also a member of the Extended Group Management Board of the group's holding company. As CEO of Tissot he is responsible for brand strategy for the Tissot brand.
20. Mr Dolla's evidence was confident and impressive. He gave a clear explanation of brand values including, in particular, the fact that consumers were looking for something timeless, with which they could develop an emotional connection. A deliberate decision had been made not to enter the smartwatch market, in the sense generally understood of a limited life product. Tissot had introduced its own "connected" watch with some functions (the Tissot T-Touch Connect), which was very important to the brand, but had chosen to do so by developing its own operating system, intended to operate on a long term basis on a "beautiful watch", and to run for months without conventional recharging (by using solar power). The group had declined approaches that major technology companies had made seeking collaboration.
21. Mr Dolla's concern about the impact of the watch faces complained about appearing on Samsung smartwatches was very evident.

Loi Le

22. Mr Le has worked at Samsung since 2012, at the Samsung Vietnam Mobile R&D Center ("SVMC") in Hanoi. He is now a senior software engineer, and his main responsibility is to manage the Samsung Galaxy App validation process. His team, currently comprising 14 people, is responsible for the content review of the apps uploaded to the SGA store by app developers. He reports to the App Review Team in Korea, managed by Younggu Kim.
23. Mr Le's responses were straightforward, clear and informative about his team and their working practices. He also candidly accepted that it was a mistake to have allowed the apps in dispute through the review process, and explained that at the time his team had little knowledge of luxury brands.

Younggu Kim

24. Mr Kim is a senior professional at Samsung in South Korea, whose role includes managing the app review process for the SGA store and overseeing training in respect of it. His background is in electronic engineering. As already indicated he is responsible for the App Review Team at the SVMC. He has been involved in app review work since 2011, well before the SVMC team was established in 2016.
25. Mr Kim’s evidence about Samsung’s approach to content review, and in particular the intellectual property aspects and how its processes have developed, was, like Mr Le’s, helpful and informative. His evidence also made it clear that the apps in dispute would have been rejected if the SVMC team had known about the Swatch brands.

Taegu Lee

26. Mr Lee is a principal professional at Samsung, based in South Korea. His role is specific to smartwatch apps, overseeing how they are uploaded to the SGA store and having responsibility for Samsung’s policies relating to smartwatch apps in that store, including benchmarking against competitors such as Apple and Xiaomi. He has worked in content management since 2010.
27. Mr Lee’s evidence in cross-examination was in some respects a little less straightforward than that of Mr Le and Mr Kim. He did candidly accept that a smartwatch is a watch, but maintained his written evidence that the difference between an analogue watch face and a watch face app on a smartwatch was easily perceived, despite agreeing with Samsung’s 2020 marketing material for its Galaxy watch referred to at [45] below. He also suggested that it was rare for the “always on” feature (see below) to show a brand name, despite a substantial proportion of the apps in dispute doing so (a fact that he accepted). As discussed below, I also had some difficulty with his evidence – which I consider in any event to be an expression of opinion – that most consumers would identify that apps were sold by third parties before deciding to download them.

GENERAL PRINCIPLES: ARTICLE 9

28. Article 9 of the EU Trade Mark Regulation ((EU) 2017/1001) (the “EUTM Regulation”) provides as follows:

“1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

- (a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;
- (b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
- (c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.

3. The following, in particular, may be prohibited under paragraph 2:

- (a) affixing the sign to the goods or to the packaging of those goods;
- (b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder; ...
- (e) using the sign ... in advertising ...”

29. For the purposes of these proceedings it was not suggested that there was any material difference between the wording of Article 9(2), which applies to EU marks, and its equivalent in domestic legislation, s 10(1)-(3) of the Trade Marks Act 1994 (“TMA 1994”)¹.

30. It is uncontroversial that, to establish “double identity” infringement under Article 9(2)(a) (equivalent to s 10(1) TMA 1994), six conditions must be satisfied: (i) there must be use of a sign by a third party within the relevant territory; (ii) the use must be in the course of trade; (iii) the use must be without the consent of the proprietor of the trade mark; (iv) the use must be of a sign which is identical to the trade mark; (v) the use must be in relation to goods or services which are identical to those for which the trade mark is registered; and

¹ TMA 1994 was enacted to give effect to Directive 89/104/EC, now Directive (EU) 2015/2436. There is one UK trade mark in issue (Tissot Navigator UK141), where Swatch claims that an identical sign was used in respect of similar goods, in breach of s 10(2) and (3) TMA 1994. The remainder of the marks now in issue were registered as EU marks. Upon withdrawal from the EU, each EUTM was “cloned” into an equivalent UK right, called the “comparable trade mark (EU)”: *Easygroup Limited v Beauty Perfectionists Limited* [2021] EWHC 3385 at [16]. Nothing material turns on this for present purposes.

- (vi) the use must be such as to affect or be liable to affect the functions of the trade mark.
31. To establish infringement under Article 9(2)(b) (equivalent to s 10(2) TMA 1994), six conditions must also be satisfied. The first three are the same as under Article 9(2)(a) ((i) to (iii) above). The remaining three are: (iv) the use must be of a sign which is at least similar to the trade mark; (v) the use must be in relation to goods or services which are at least similar to those for which the trade mark is registered; and (vi) the use must give rise to a likelihood of confusion on the part of the public.
 32. Infringement under Article 9(2)(c) (equivalent to s 10(3) TMA 1994) requires nine conditions to be satisfied: (i) the trade mark must have a reputation in the relevant territory (the EU for EU registered marks, and the UK for UK registered marks); (ii) there must be use of a sign by a third party within the relevant territory; (iii) the use must be in the course of trade; (iv) it must be without the consent of the proprietor of the trade mark; (v) it must be of a sign which is at least similar to the trade mark; (vi) it must be in relation to goods or services; (vii) it must give rise to a “link” between the sign and the trade mark in the mind of the average consumer; (viii) it must give rise to one of three types of injury, that is to say, (a) detriment to the distinctive character of the trade mark, (b) detriment to the repute of the trade mark, or (c) unfair advantage being taken of the distinctive character or repute of the trade mark; and (ix) it must be without due cause.
 33. It was not disputed that the relevant dates for assessment of the infringement claims were between October 2015 and February 2019, when Swatch contends that the uses complained of commenced (*Levi Strauss & Co v Casucci SpA* (C-145/05) [2006] ETMR 71 at [17]-[20]).

THE MARKS AND SIGNS IN ISSUE

The trade marks in issue

34. Details of the 23 trade marks in issue are set out in Appendix 1 to this judgment, including the goods that they are most relevantly registered for and on which Swatch relied.

The watch face apps in issue, and Swatch’s claim

35. Details of the 30 apps in issue are set out in Appendix 2. By way of explanation:
 - a) The numbering of the apps in the first column is the court’s own, for ease of identification.
 - b) The numbering in the second column is taken from Appendix 1 to the Amended Particulars of Claim (the “APoC”). That Appendix is in five parts. Part 5 relates to passing off and is no longer pursued. The allegations set out in Parts 1 to 4 are arranged as follows:
 - i) Part 1: identical marks and identical goods.

- ii) Part 2: identical marks and similar goods.
 - iii) Part 3: similar marks and identical or similar goods.
 - iv) Part 4: UK and international marks.
- c) The first part of each numerical reference set out in the second column denotes the relevant part of Appendix 1 to the APoC, and the second its location within that part. For example, 1.4 denotes the fourth entry in Part 1.
- d) As can be seen, several apps appear in more than one part, primarily Parts 1 and 2. With one exception, Part 1 is confined to alleged infringements of marks registered under class 9 of the Nice Classification (typically listed as “smartwatches”, “computers worn on the wrist”, or similar), and Part 2 is confined to alleged infringements of marks registered under 14 (typically listed as “watches” or, more generally, “horological and chronometric instruments”, or similar).
- e) The exception is app number 14, which is alleged to infringe Hamilton EU103 (entry 19 in Appendix 1). This appears in Part 1 by reference to its registration under both class 9 and (in respect of its registration for “watches that communicate data to smartphones”) class 14, and in Part 2 by reference to its registration under class 14 for watches.
- f) Swatch’s allegations in respect of each app are set out in the fourth column of Appendix 2. For ease of reference, where allegations in respect of an app appear in more than one Part of Appendix 1 to the APoC the relevant location is shown in parenthesis after the allegation.
- g) The claim under Part 4 is now pursued only in respect of one UK mark, Tissot Navigator UK141, which is alleged to be infringed by app number 7.
36. As already mentioned, the apps were made available in the SGA store at various times between October 2015 and February 2019. A number were available for free and others required a modest payment. Samsung admitted that during that period the 30 apps now in dispute were downloaded 157,715 times in total by end users in the EU. With the additional six apps the subject of the original claim, Samsung’s figure for total downloads is 163,769. Swatch accepts Samsung’s figures for the purposes of determining liability only. Not surprisingly, apps available for free were generally downloaded in greater numbers.
37. The Swatch group began monitoring the SGA store in December 2018, when it became aware that potentially infringing apps were available in it. Swatch first made contact with Samsung’s Swiss subsidiary in that connection by a letter dated 21 December 2018, which demanded that the apps, together with any other infringing apps, be taken down and sought disclosure of app developers’ details and details of downloads. The letter referred to trade mark infringement but also made additional allegations, including in respect of copyright in design features. By 9 January 2019 all the apps identified by Swatch had been taken down.

38. Swatch issued proceedings in February 2019. The claim identified some additional apps not referred to in the correspondence. These were then also promptly taken down by Samsung.

SAMSUNG SMARTWATCHES

Samsung smartwatches: function and design

39. Mr Lee described a smartwatch as a wearable electronic device with a digital interface that provides operational controls through software apps. Smartwatches tell users the time but also come with a number of additional features not provided by traditional watches, such as the ability to make calls, listen to music, read messages or emails, make payments and track health and activity levels. Mr Lee said that Samsung smartwatches function “more like a wearable computer or mobile phone than like a traditional watch”, and said that they were predominantly purchased for their ability to do things other than display the time. The fact that smartwatches are purchased not simply to tell the time was supported by documentary evidence and is in any event obvious.
40. The face of a smartwatch consists of a digital display which, unless an “always on” feature is enabled, is switched on when prompted, whether by motion or tapping the screen. When switched on the default screen is a watch face which tells the time, although features such as incoming calls may be displayed instead. If an “always on” feature is available and enabled then a watch face will be displayed continually, although to preserve battery life and avoid screen damage the version of the watch face shown will generally be a simpler version as compared to the one displayed while the smartwatch is in active use, using around 15% of the number of pixels. If that feature is not enabled the watch face will change to a blank screen after a set number of seconds, the default being 15 seconds.
41. Samsung smartwatches allow significant flexibility for the consumer to configure the software on their smartwatch as they choose, including by accessing the SGA store to download apps.
42. At least during the relevant period, a Samsung smartwatch did not connect directly to the internet. Instead, it relied on a wireless connection to a smartphone with which it was linked (although not necessarily a Samsung model of a smartphone). In order to create the connection the end user would have to download the Samsung Wear app to the phone.
43. Samsung first launched a smartwatch in 2013. From 2018 Samsung’s smartwatch models have been called the “Galaxy Watch”. Models launched before then were called the “Samsung Gear” or “Galaxy Gear”.

44. Since 2015 smartwatches produced by Samsung have been round in shape, like a conventional watch, and with a bezel² that also has the appearance of that for a watch. They are held on to the wrist by a strap, again like a conventional watch.
45. Samsung's smartwatches are, and were at relevant times, specifically marketed by it for their watch-like qualities. For example, I saw marketing material from 2020 describing the Samsung Galaxy watch as "truly watch-like", with "ticking sounds and hourly schemes to provide a realistic watch-like feel", and with a "rich watch face design created with depth and lighting effect". The advertisement adds that, in addition to the preloaded styles, "about 60,000 styles can be downloaded from the Galaxy Apps"³. Earlier marketing material included: an undated video promoting the Samsung Gear S3 design, describing it as a "true watch" and depicting a watchmaker, work bench and tools; a webpage from 2016 advertising the launch of that product as redefining the smartwatch experience by injecting "real watch" value with designs "firmly grounded in timeless watch aesthetics", emphasising Samsung's "drive to add new value to the smartwatch experience by creating pieces that are watches, first and foremost" and referring to the innovation of an "Always on Display" which "greatly adds to the device's 'real watch' aesthetic"; and a 2019 webpage advertising the Samsung Galaxy watch as having "the feel of a real watch" and describing it as having a "round face, watch hand shadowing and ticking sound [to] give it the feel of a real watch".
46. Samsung's business model involves producing and marketing the hardware (in this case the smartwatches) pre-installed with a comparatively small number of apps designed by Samsung so that the hardware functions. This will include around 20 watch faces that the consumer can choose from. Samsung also offers some further apps that it has developed, including watch face apps, in the SGA store. However, a substantial majority of apps available in the SGA store are developed and provided by third-party app developers. Mr Lee described this as typical of businesses operating in the electronics industry. He also gave evidence that, based on the available figures, only 26% of UK Samsung smartwatch users had made active use of the SGA store, with those who did downloading an average of 4.6 watch face apps each. Further, about 15% of watch face apps are made available for free, frequently becoming paid for apps if they gain popularity.
47. Samsung smartwatches are generally in use for a relatively short period. The average replacement cycle for a Samsung smartwatch in the UK is about 27 months.

The SGA store

48. The SGA store was established and is managed by Samsung, specifically for Samsung devices. It is an online platform through which both Samsung and third-

² The surround of a watch face that holds, or appears to hold, it in place.

³ The SGA store. Mr Lee's evidence was that there were about 96,000 watch apps available in January 2020, being around 10% of the total number of apps in the SGA store. There was also evidence that around 88% of the watch apps available in the SGA store for the Samsung Gear watch were watch face apps. Mr Lee also explained that there were now around 110,000 watch apps in the SGA store.

party app developers can make available apps to consumers who have Samsung products, including but not limited to Samsung smartwatches.

49. The SGA store comprises both “back-end” and “front-end” servers. The back-end comprises a developer portal where app developers can upload apps and an administration site where Samsung reviews apps before they are made available. The front-end is the part that is available to consumers.
50. Also available to developers via the back-end portal is the “Galaxy Watch Studio tool”. That tool provides user-friendly instructions on how to create Samsung smartwatch watch face apps that work on Samsung’s Linux-based “Tizen” operating system, for uploading to the SGA store.
51. Once an app has been designed and uploaded to the SGA store, it is automatically submitted to Samsung’s app review process, which must be passed before it is made available to consumers as a “for sale” version on the front-end server. The review process is discussed further below.
52. In order to access the SGA store consumers must set up an SGA store account with Samsung, which involves providing a name, email address, country of residence and phone number (plus optional payment details, although those can be provided when a purchase is made). Watch face apps available in the SGA store can only be viewed or downloaded by consumers with a Samsung smartwatch, which must also be connected to a smartphone (see above). Once connected, watch face apps may be viewed and downloaded to the smartwatch by using either the phone or the smartwatch. The process for accessing the SGA store and obtaining apps is discussed further below.
53. The SGA store has a search function, although Ms Aubert’s evidence was that it was restricted to the app name and that Swatch did not find it helpful in identifying potentially infringing apps. Ms Aubert also criticised the fact that the contents of the store could not be viewed from a desktop browser and that there was no system of alerts when new apps were added containing keywords corresponding to previous searches. Rather, Swatch had to buy Samsung’s product and then try to investigate using a phone and smartwatch, conducting manual searches without the benefit of any alerts and also with no means to search using picture recognition. Further, the apps available could differ between countries, and it was necessary to specify a country when setting up the required Samsung account, potentially requiring multiple accounts to allow comprehensive searching.
54. I accept this evidence. I also note and accept Mr Lee’s evidence that consumers may search for other features apart from keywords, such as styles and colours, and by using a drop-down menu (none of which would be particularly useful for Swatch), and his explanation that search results will not necessarily be comprehensive because unpopular apps may be excluded. I further note that Swatch commissioned a report from a third party, the Mintz Group, which confirmed the existence of some difficulties in searching the SGA store, including an inability to search all watch faces at once rather than within specified categories, and common misspellings.

Samsung's arrangements with app developers

55. During the period in issue, any third party who wished to upload an app to the SGA store was first required to obtain an account by registering with Samsung's SGA Seller Portal by providing their name, email address, country of residence and bank account, and agreeing to Samsung's terms and conditions. The terms and conditions included, among other things:
- a) a requirement to submit to Samsung any app that the third party wished to distribute through the SGA store, which Samsung would evaluate to determine whether it "complies with the certification requirements";
 - b) statements that there was no obligation on Samsung to distribute any app, and that it would not distribute any app "unless and until [it] has been certified to Samsung's satisfaction", Samsung having "sole discretion" to determine the device or devices on which any app was made available and make all decisions regarding placement or promotion. Samsung also reserved the right to remove any app "for any reason", with the examples provided including any assertion of intellectual property right infringement and customer complaints about content or quality;
 - c) provision for revenue sharing, with Samsung being entitled to 30% of revenue raised (or 20% if the app developer was a "Galaxy Apps Partner"), with the price being set by the app developer so long as it fell within price points specified by Samsung;
 - d) a licence to Samsung in respect of any app, including (for all EU territories other than Slovenia, and for a number of non-EU territories) a right for Samsung to grant licences to buyers, or (in other territories) to act as the app developer's agent in marketing and distributing the app;
 - e) a number of representations and warranties, including that any app was the app developer's original work and did not "violate any Samsung or third-party intellectual property rights", and that it did not otherwise contain unauthorised, hidden or inappropriate content (such as depicting explicit sexual activity or promoting misuse of drugs, intolerance or gambling), together with an indemnity in favour of Samsung in the event of breach;
 - f) a further express provision that the developer would not use any trade mark in a way that was likely or intended to cause confusion about the owner or authorised user; and
 - g) a right on Samsung's part to terminate the agreement at any time, and a further reference to Samsung's policy of terminating the accounts of "repetitive infringers" of intellectual property laws.
56. These terms and conditions were applicable in respect of all apps uploaded to the SGA store, including but not limited to watch face apps.
57. As already mentioned, Samsung has organised developer conferences, which are available online. Their aim clearly includes the provision of guidance about

developing apps for the SGA store, with a view to ensuring that a good range of high quality apps is available.

The app review process

58. Each third-party app uploaded to the SGA Store is, and was at relevant times, subject to both a technical and a content review prior to being made available to consumers. The technical review is limited to checks for viruses and to ensure the app's functionality and compatibility with Samsung's operating system. The content review was historically conducted by a team based in Poland, but in 2016 a new team led by Mr Le was set up as part of the SVMC, and that team has since carried out all content review globally (covering apps for smartphones and tablets as well as watch apps), other than for apps released to the Chinese market.
59. Mr Le's team comprises around 14 individuals, all of whom are local Vietnamese and were generally recruited as new graduates. Most of the team, including Mr Le, are software engineers by background. My impression is that none of them have international or European market experience, and that while all have some level of English they are not fluent English speakers. Mr Le accepted that they would have had little knowledge of luxury brands when they were recruited. Mr Le's own knowledge of famous watch brands at the time appears to have been limited to what he had picked up from sports-related advertising.
60. As an indication of scale, in 2020 Mr Le's team reviewed 319,000 apps, including 89,000 smartwatch apps. From January 2018 to March 2019, each member of Mr Le's team reviewed 85 apps per day on average, working a 44 hour week. I note that that works out at a little over six minutes an app. Team members are assigned a number of apps each day and are expected to complete their review within three days. They are instructed to spend about 5-10 minutes reviewing each app against Samsung's internal content review guide (the "CRG", discussed below), using their own knowledge and judgment and referring to the internet (although see [69] below on the last of these points). Mr Le's evidence was that 5-10 minutes was sufficient for experienced reviewers.
61. Mr Le's team base their review on metadata, app names, tags, descriptions and screenshots provided by the app developer. They do not ordinarily actually review the apps as they would appear on a device. There is an ability to escalate borderline cases to be determined by the App Review Team in Korea, but based on Mr Le's evidence this facility is rarely used.
62. Once an app has passed the review process it will go live in the SGA store within about two hours, unless the app developer had manually chosen to distribute it at a later date. The app developer would also determine the price (within permitted parameters) or whether the app was to be available for free.
63. The content review process has undergone an evolution since the commencement of these proceedings. Prior to February 2019 it was limited to a manual and visual review of app content conducted by Mr Le's team with reference to the CRG. From February 2019 onwards an additional stage of automated "pre-review" was added to the process in the form of Samsung's Validation Automation System

(“VAS”). VAS has not been used to scan existing apps. It applies only when new apps are reviewed prior to being made available.

64. VAS is a computerised process that automatically cross checks a proposed app’s meta tags (source code information), title, app description and the developer’s name against a list of keywords, with the aim of identifying content that could be infringing or prohibited. As of February 2022 the database of keywords checked for by VAS comprised approximately 4,000 pre-defined trade marks, brands and phrases. It includes watch brands such as those owned by Swatch. However, VAS will only check for exact matches. Any app with a word or phrase that matches the keywords is flagged for manual review, in addition to the manual content review which continues to apply to all apps. Mr Kim gave evidence that Samsung has not received further claims of trade mark infringement since VAS was introduced, although Ms Aubert disagreed with this and pointed to an additional list of potentially infringing apps sent to Samsung in December 2020.
65. In addition to VAS, Samsung has also introduced a “Closed-Seller” model for watch face app developers, such that only pre-approved sellers, who have signed a specific pledge not to infringe intellectual property rights, can register to sell apps. It has also introduced an automated visual comparison of watch face app displays against conventional watch faces, although the recognition rate is quite low. Since 2021 app developers have also been required to submit any “brand phrase” (which I take to mean any Dial Branding, see [6] above) in the app description, which VAS can then review.

The CRG

66. In considering whether an app should be admitted to the SGA, Mr Le’s team are expected to rely on the CRG.
67. The version of the CRG produced in evidence is 40 pages in length. It has four sections: 1) performance, which includes functionality and usability; 2) restricted content, which covers inappropriate material such as content that is sexually explicit, violent or drug-related; 3) legal; and 4) culture or market, which covers matters specific to certain countries.
68. The legal section covers 14 pages, of which most is devoted to intellectual property. It is notable that there is a detailed section covering the circumstances and context in which references to Samsung’s own protected marks and phrases are permitted, with a table of screenshots providing examples as well as relatively detailed guidance. The section devoted to third-party rights holders (referred to as “copyright owners”) contains much less detailed guidance. It provides pictorial examples of a number of well known sports club logos, cartoon characters, games brands and “copyrighted brands”, and describes the process for reporting infringing content. No watch brands are included and there is no specific guidance on apps for smartwatches. The substantive guidance amounts to little more than the following:

“Apps should not use protected materials by protection laws including but not limited to copyright, trademark or patent without permission.

...

For well known contents, e.g. popular car brands, IT related brands, (Microsoft, Google, Apple, etc) songs, art works, it is required to check if it is used with proper permission.

First, reviewer should check that legal statement of the brand. Major companies have legal statement in their web site so we can check if there's any issue to use brand name or logo and content that infringes the right of likeness is not allowed.

...

Content that uses another entity's intellectual property without permission, including but not limited to: software, music, art, and other copyrighted, trademarked or patented materials is not allowed.”

69. It can be seen from this that there was no clear instruction to do an internet search of any kind, at least in respect of what the reviewer did not regard as “well known contents”, and certainly no instruction to check any trade mark database.

Notice and take down process

70. Like other online marketplaces the SGA store operates a “notice and take down” process, whereby anyone can notify Samsung that a particular app infringes intellectual property rights. Samsung will investigate (suspending sales of the app while it does so) and, if appropriate, will remove the app from the store. There was no substantive dispute about the effectiveness of this process at trial.

Accessing apps from the SGA store

Access from the smartwatch

71. Samsung smartwatch owners are first introduced to the SGA store during the set-up phase, with a “welcome” screen. By clicking on the icon the user is taken to a screen entitled “Legal information”, containing terms and conditions which the user must accept in order to proceed, and commencing with the words “All content made available to you by the Samsung Galaxy Store is subject to the terms and conditions set forth below”.
72. Once accepted, the user is presented with a range of icons on the watch face, one of which is the SGA store. On accessing the store different options are presented, one of which is “Watch Faces”. Within this users can scroll between different watch face apps, or make searches. During this process they will see the name of the app, a rating, a small icon previewing its design and an “install” button allowing for installation directly from that screen. No information about the seller of the app is provided at any stage of the process just described, and Samsung’s own apps and third-party apps are not distinguished. However, by clicking on the app name rather than pressing “install” at this stage a new screen will be shown which additionally includes a previously unseen name below the app name. That

name is the name of the app developer, although that fact is not specified anywhere on the screen.⁴

Access from the smartphone

73. Users may also search for watch face apps via their smartphones, if connected to a Samsung smartwatch. The phone version of the SGA store app allows users to select from different categories of apps, one of which is dedicated to watches and displays only watch apps. Again, they can scroll or search. In this case the details that will be displayed with the app include the name of the app developer as well as the other details shown on the watch, although again without specifying what the name represents. However, it is fair to say that, because more than one app can be previewed at once on a phone, the variety of different names, and the fact that on some of them Samsung's own name might appear instead of a third-party name, does more to flag up that the name may relate to the source of the app. Clicking on the app name brings up a further screen which again contains the app developer's name under the app name. It also separately contains "Seller info", but that appears not to repeat the app developer's name and to relate instead to version number and file size.

INFRINGEMENT

74. This section of the judgment considers the following elements of the tests for infringement under Article 9(2) of the EUTM Regulation and applies them to the facts:
- a) the concept of the average consumer;
 - b) use;
 - c) identity and similarity of marks and signs;
 - d) identity and similarity of goods and services;
 - e) use "in relation to" goods or services;
 - f) function and descriptive use;
 - g) likelihood of confusion; and
 - h) Article 9(2)(c): unfair advantage etc.

The average consumer

75. A number of aspects of trade mark infringement are assessed by reference to the notional average consumer. Broadly, that concept is relevant to any assessment required of the perception of the mark or sign. This will include the question

⁴ It is understood from correspondence between the parties that older versions of Samsung's systems did not allow for the first alternative of direct installation, as opposed to the screen that includes the app developer's name. Samsung did not rely on that point as a distinguishing factor at trial.

whether the sign and mark are identical or similar, whether there is a likelihood of confusion or a link, and what the sign or mark relates to or signifies (such as whether a sign is purely descriptive).

76. There was no dispute about the principles to apply. In brief summary, the relevant matter should 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 rely on the imperfect picture he has kept in his mind, and whose attention varies according to the category of goods or services in question...”

(per Kitchin LJ, *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24; [2012] FSR 19 at [52(b)]).

77. In *London Taxi Corporation Ltd v Frazer-Nash Research Ltd* [2017] EWCA Civ 1729, [2018] FSR 7 at [34], Floyd LJ (with whom Kitchin LJ agreed) referred to the purpose of a trade mark as being, broadly, to operate as a guarantee of origin, and said that the term average consumer “includes any class of consumer to whom the guarantee of origin is directed and who would be likely to rely on it, for example in making a decision to buy or use the goods...”. That passage was cited by Arnold J in *Sky plc & Ors v SkyKick UK Ltd & Anor* [2018] EWHC 155, [2018] RPC 5, [2018] ETMR 23 (“*Skykick*”) at [274], where he went on to make the point at [275] that the average consumer must both be familiar with the trade mark and exposed to, and likely to rely on, the sign.
78. The level of attention and care displayed by the average consumer is also likely to vary depending on the nature of the goods or services and how they are acquired: Case C-342/97 *Lloyd Schuhfabrik Meyer v Kliysen Handel* [1999] ETMR 690 at [26]. For example, the average consumer is likely to pay a higher degree of attention in relation to expensive purchases, as opposed to acquisitions of inexpensive goods that are purchased regularly.
79. Further, the concept of average consumer does not involve a statistical test or averaging of the class. In particular, infringement may be found “if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court” (per Kitchin LJ in *Comic Enterprises v Twentieth Century Fox* [2016] EWCA Civ 41; [2016] FSR 30 (“*Comic Enterprises*”) at [34]). As Kitchin LJ also explained, the assessment must take into account the distinctiveness of the trade mark. There will be a greater likelihood of confusion where the trade mark has a highly distinctive character.
80. Samsung submitted that the average consumer in this case is a member of the general public seeking to purchase an app for use on a Samsung smartwatch that they already possess, and that they would be familiar with app stores, including that many of the apps are developed by third parties.

81. I agree with Samsung that, when considering the offering of apps in the SGA store, the average consumer is a member of the general public seeking to acquire an app, and given that the apps were only available to those with a Samsung smartwatch, the average consumer must be in that category of person, and will be viewing the app either on their Samsung smartwatch or on a phone connected to their smartwatch. However, I am not persuaded that such a consumer will necessarily be particularly familiar with app stores, or have any clear understanding that the majority of apps available in the SGA store (in particular, watch face apps specifically designed for Samsung smartwatches) will originate from third parties unconnected with Samsung, and not from Samsung or, as discussed further below, from Swatch.
82. Further, in this case the concept of average consumer is also relevant in respect of the apps in their downloaded form. In that context, I agree with Swatch that the relevant average consumer is the general public, being persons who acquire watches and/or smartwatches. As explained by Birss J in *Thomas Pink Limited v Victoria's Secret UK Limited* [2014] EWHC 2631 (Ch); [2014] ETMR 57; [2014] FSR 40 (“*Thomas Pink*”) at [118iii)], the average consumer also represents consumers at all levels of the market, ranging from low end to luxury.
83. In both cases, the average consumer must be assumed to be familiar with the relevant Swatch marks and exposed to, and likely to rely, on the sign (*Skykick*, above).

Use

Use in an online environment: the principles

84. What constitutes “use” in an online environment was considered by the CJEU in joined Cases C-236/08 to C-238/08 *Google France v Louis Vuitton Malletier* [2010] ECR I-0000; [2010] RPC 19 (“*Google France*”), Case C-324/09 *L’Oréal v eBay* [2011] RPC 27; [2011] ETMR 52 and more recently in Case C567/18 *Coty Germany v Amazon Services Europe* [2020] ETMR 37 (“*Coty*”).
85. *Google France* concerned Google’s “AdWords” service, which allows advertisers to identify keywords that, if entered by an internet user, will produce a prominently displayed “sponsored link” with a short commercial message, in return for a fee per click. In summary, the claims were brought on the grounds that the Claimants’ trade marks had been infringed by identical signs being used as keywords by competitors to promote their products.
86. The court concluded that, while the advertisers were using the relevant signs and could be liable if the internet user could not readily determine the origin of the goods, a service provider such as Google did not itself use them by storing the keywords and organising a display of advertisements. This was because “use” required, as a minimum, that an entity “uses the sign in its own commercial communications” (paragraph [56]). Google was simply allowing its clients to use the signs.
87. This approach was endorsed in *L’Oréal v eBay*. That was a reference from the High Court in proceedings brought by L’Oréal alleging trade mark infringement

in respect of goods sold on eBay's site that were either counterfeit, not intended for sale or not intended for sale in the EU (parallel imports). Among other things, eBay had used Google's AdWords service to advertise some of the products for sale on its site, creating sponsored links to the eBay site.

88. The court held that, whilst an operator of an online marketplace such as eBay could be restrained from advertising via a keyword identical to the mark in question where the origin of the goods could not readily be determined (paragraphs [84] to [97]), insofar as the signs were used in offers for sale displayed on the operator's own website it was not "using" them. The court said this:

"99... it is first necessary to point out that, where sales are made through online marketplaces, the service provided by the operator of the marketplace includes the display, for its customer-sellers, of offers for sale originating from the latter.

100. Next, when such offers relate to trade-marked goods, signs identical with or similar to trade marks will inevitably be displayed on the website of the operator of the online marketplace.

101. Although it is true that, in those circumstances, those signs are 'used' on that site, it is none the less not evident that it is the operator of the online marketplace that is 'using' them, within the meaning of Directive 89/104 and Regulation No 40/94.

102. If a sign identical with, or similar to, the proprietor's trade mark is to be 'used', within the meaning of Article 5 of Directive 89/104 and Article 9 of Regulation No 40/94, by a third party, that implies, at the very least, that that third party uses the sign in its own commercial communication. In so far as that third party provides a service consisting in enabling its customers to display on its website, in the course of their commercial activities such as their offers for sale, signs corresponding to trade marks, it does not itself use those signs within the meaning of that EU legislation (see, to that effect, *Google France and Google*, paragraphs 56 and 57).

103. As was stated, inter alia by the United Kingdom Government and the Commission at the hearing and by the Advocate General at points 119 and 120 of his Opinion, it follows that the use of signs identical with or similar to trade marks in offers for sale displayed on an online marketplace is made by the sellers who are customers of the operator of that marketplace and not by that operator itself."

89. *Coty* concerned a trade mark infringement claim brought by a perfumes distributor against Amazon in relation to its activities of storing infringing products and handing them to delivery companies on behalf of third parties. The court made the point at [37] that "use" involves "active behaviour and direct or indirect control of the act constituting the use". After commenting that only a third party with control of the act was able to stop it, the court said this (citations omitted):

"39. The Court has also repeatedly held that the use, by a third party, of a sign identical or similar to the proprietor's trade mark implies, at the very least, that that third party uses the sign in its own commercial

communication. A person may thus allow its clients to use signs which are identical or similar to trade marks without itself using those signs ...

40. Thus, the Court has held, as regards the operation of an e-commerce platform, that the use of signs identical or similar to trade marks in offers for sale displayed in an online marketplace is made by the sellers who are customers of the operator of that marketplace and not by that operator itself ...

41. It has also noted, as regards an undertaking whose main activity is filling cans with drinks produced by it or by third parties, that a service provider who merely fills, under an order from and on the instructions of a third party, cans already bearing signs similar to trade marks and therefore merely executes a technical part of the production process of the final product without having any interest in the external presentation of those cans and in particular in the signs thereon, is not itself ‘using’ those signs, but is only creating the technical conditions necessary for the third party to use them ...

42. Similarly, the Court has held that, although an economic operator who imports or sends to a warehouse-keeper, for the purposes of their being put on the market, goods bearing a trade mark of which it is not the proprietor may be regarded as ‘using’ a sign identical to that trade mark, that is not necessarily true of the warehouse-keeper who provides a storage service in relation to goods bearing another person’s trade mark ...

43. The fact of creating the technical conditions necessary for the use of a sign and being paid for that service does not mean that the party offering the service itself uses the sign ...”

90. At [44] and [45] the CJEU pointed out that Article 9(3)(b) of the EUTM Regulation and its predecessor specifically covered offering of goods, their being put on the market, or their being stocked “for those purposes”, and that it followed that it was necessary for the economic operator providing the storage itself to pursue the aim of offering the goods or putting them on the market. It added:

“46. Failing that, it cannot be concluded that the act constituting the use of the trade mark is carried out by that person, or that the sign is used in that person’s own commercial communication.”

91. The CJEU found that Amazon had not used the sign in its own commercial communication, because only the third party intended to offer them for sale or put them on the market (paragraph [47]). It therefore concluded that an entity storing goods for a third party without knowledge of infringement was not “stocking” them if it was not itself pursuing such an aim (paragraph [53]).

Samsung’s case on “use”

92. Samsung contends that it did not use the signs at all. It simply provided a vehicle, in the form of the SGA store, through which app developers provided apps.
93. Mr Alexander submitted that none of the individual acts carried out by Samsung amounted to use in a trade mark sense. Validating watch face apps for upload

(including undertaking the content review) did not amount to use at all, let alone use in relation to relevant goods or services. It was the app providers, not Samsung, who placed the apps in the SGA store by uploading them. Downloads of apps were procured by customers for their own personal use, and not by Samsung, and it was the customer who affixed the watch face by installing it, having acquired it from the app developer. He placed particular reliance on the Advocate General's opinion in *L'Oréal v eBay* at [119]-[120], which was referred to by the CJEU in that case at [103], to the effect that use and display of signs on the website of an electronic marketplace is not use by the operator, any more than their use in classified newspaper ads is use by the newspaper.

Swatch's case on "use"

94. Mr Malynicz sought to distinguish *Google France*, *L'Oréal v eBay* and *Coty* on the basis that there was both active behaviour and control by Samsung, and use in its own commercial communications. He relied on *Cosmetic Warriors Limited & Anor v Amazon.co.uk Ltd & Anor* [2014] EWHC 181 (Ch), [2014] FSR 31 ("*Lush*"), where John Baldwin QC (sitting as a High Court judge) found that Amazon had infringed Lush marks in circumstances where typing "Lush" into the search facility on the Amazon site resulted not only in the display of goods for sale by third parties where sales would be fulfilled by those third parties, but also products sold by Amazon or where it provided fulfilment services. The judge concluded that no distinction should be drawn between the three categories, because they were mixed up and Amazon's involvement in the transactions in the other categories was sufficient. The search engine was designed to maximise the sale of goods from the site, and Amazon was doing much more than enabling customers to display signs on its website (see paragraph [57]).

Discussion

95. I have reached the conclusion that Samsung did use the signs in the course of its trade for the purposes of Article 9 of the EUTM Regulation. I should emphasise that, in reaching that conclusion, I have taken all the evidence relevant to this issue into account. Many of the features referred to below (including but not limited to assistance designed to make it easier for app developers to create apps, and providing an environment under which apps could be uploaded, stored and downloaded by customers) would not, or would be unlikely to, amount to use if taken in isolation. But that would not be the right approach. Instead, it must be correct to consider Samsung's conduct as a whole.
96. An initial, and overarching, point relates to the Samsung smartwatches themselves and the way in which they are marketed, as "truly watch-like", and also by reference to the wide variety of watch face apps available in the SGA store (see [45] above).
97. Samsung therefore specifically advertises the availability of a wide range of watch face apps in the SGA store. It clearly regards that as a feature worth promoting, with a view to making its products appear more attractive. It has made a commercial choice to design only a limited number of watch face apps itself, and instead to allow and indeed encourage app developers to develop the vast majority.

98. Mr Lee's unchallenged witness evidence also showed that there are additional reasons why it is in Samsung's commercial interests to host third-party apps, and in particular free apps (even though by definition such apps raise no revenue directly either for the developer or for Samsung). As I understood his evidence, Samsung regards it as desirable that free apps are developed and made available that can allow or highlight the use of functions or interfaces that are unique to Samsung devices, and in particular new models of them. In return, app developers can benefit from increased sales of paid-for apps (because the SGA store is configured to enable users to see other apps from the same developer) and promotional opportunities provided by Samsung.
99. I accept this evidence, which to my mind clearly indicates a symbiotic relationship between app developers and Samsung, going well beyond revenue derived from the sale of apps and benefitting both parties. The revenue raised is comparatively trivial and is clearly not a material motivating factor for Samsung.
100. No doubt reflecting its commercial interest, Samsung provides material assistance to developers of watch face apps, in the form of the Galaxy Watch Studio tool. That user-friendly tool was used to create all but one of the apps in dispute (the exception having been developed using an open source platform). Further, Samsung hosts developer conferences to inspire and showcase the capabilities of apps built on Samsung devices, with presentations available online so that app developers who did not attend in person can view them. Samsung enters into licensing arrangements with all app developers before they are permitted to use any of its development material or upload apps to the SGA store (see [55] above).
101. It is also relevant that the SGA store is a store that Samsung operates that is dedicated to apps for Samsung products, and that it reviews all apps for both functionality and content before they are made available in the SGA store. Although customers may be able to download watch faces for Samsung smartwatches from other sites, I find that the average consumer would understand that, unlike watch face apps in the SGA store, watch face apps available from other sites are not "official" and would not be understood to carry any assurance from Samsung that they would work satisfactorily on its products. In contrast, apps available in the SGA store would be understood by the average consumer to be made available by Samsung through its own store, and indeed to carry an implicit assurance that Samsung is satisfied with them and ought to provide assistance in the event that they prove problematic. Indeed, Samsung has specifically marketed its smartwatches by reference to the availability of watch face apps in its store.
102. Further, in contrast to apps that obviously relate to goods or services provided by a third party and facilitate their provision (the Uber app was the example used at trial, but there are many others), watch face apps do not do so, and do not directly perform any such function. They are also grouped together in the SGA store with watch face apps designed by Samsung. They provide an optional alternative to the Samsung designed watch faces preloaded on the watch.
103. The function of watch face apps is not to provide third party goods or services, but to adorn the smartwatch, tell the time and allow interaction with other

functions. When in use the watch face app is the starting point for user interaction with the smartwatch. It is the interface that provides the “default” screen, but it is clearly not a simple wallpaper or background: it has an active role. Put another way, it can be perceived as a key part of both the cosmetic design and working mechanism of the smartwatch itself, rather than simply as an app that can conveniently be accessed through the watch.

104. Further, the apps in question were designed exclusively for, and operated only on, Samsung smartwatches.
105. Whilst the average consumer would understand that, say, the Uber app was provided by a third party and not by Samsung (not least because the app name will proclaim that, and it would also be understood that the Uber app is available on multiple devices), that is much less clear in respect of watch face apps that are quite obviously designed to fit on, and function as a key part of, a Samsung smartwatch, and where the apps are grouped in the SGA store with watch face apps designed by Samsung.
106. Another aspect of content review is the means it provides to Samsung to ensure that only content that it considers to be appropriate for use on its products is made available. This is also linked to customer perception. The average consumer is unlikely to blame eBay itself for shoddy goods acquired through its market place. But a poor quality watch face app designed for the Samsung smartwatch and acquired through the SGA store would, in my view, reflect negatively on Samsung in the mind of at least a significant proportion of average consumers. A clear aim of the content review is to limit the risk of that occurring, and rather to ensure that the apps that make it through the review are good quality apps that will enhance, rather than diminish, customers’ perceptions of Samsung’s products. I note that the CRG specifically refers to the fact that apps should be “valuable, entertaining, unique or informative” (and should otherwise be rejected) and that they should be “designed by considering aesthetic factors”.
107. I also do not accept Samsung’s arguments that app downloads were simply procured by customers for their own personal use, such that there was no use in the course of trade. As with the rest of the process, their provision to customers was orchestrated by Samsung (albeit that without the other elements this would clearly be insufficient to amount to use by Samsung). Samsung would also field customer complaints about them and provide a level of customer support. It would also share in any revenue raised. In any event, Article 9(3) of the EUTM Regulation is not prescriptive as to the form of use. Samsung’s activities could be described as offering or stocking the goods in the SGA store under Article 9(3)(b), or (by arranging and permitting their download) affixing signs, included in any Dial Branding, to the smartwatch under Article 9(3)(a).
108. Similarly, the fact that, once an app had passed Samsung’s review, the developer could control when it became available to consumers, and that it did so at a price that was (within limits) of the developer’s choosing, is insufficient to alter the conclusion that there was use by Samsung, for the reasons already given.
109. Overall, Samsung’s role goes well beyond, for example, the can filler referred to in *Coty* at [41], and it is far from being the equivalent of a warehouse-keeper who

provides storage services (*Coty* at [42]). It is not just providing the necessary technical environment to allow the apps to be uploaded, displayed in the SGA store and downloaded. It has a clear commercial interest in the watch face apps in the SGA store, their availability, presentation and use by consumers. As regards watch face apps, I do not consider that the SGA store is simply an online marketplace like eBay. Rather, Samsung's activities go beyond that, just as (albeit with very different facts) eBay's promotion of products for sale on its website via keyword advertising on Google went beyond the provision of an online market place that allowed customers to display offers for sale on the site.

110. In my view there was active behaviour by Samsung in relation to the apps and control by it of their availability, and Samsung was using the apps, and the signs contained in them, in its own commercial communications.

Identity and similarity of marks and signs

111. Appendix 3 to this judgment contains my findings in respect of identity and similarity in relation to the watch face designs and app names in dispute. This section sets the principles I have applied.
112. I note that Swatch conceded in its opening submissions that, where Samsung disputed a claim of identity, the case could be tried on the basis that the marks were highly similar rather than identical. I did not understand Samsung to object to this.
113. The test for identity of marks was helpfully discussed by Laddie J in *Compass Publishing v Compass Logistics* [2004] RPC 41 ("*Compass Publishing*") at [15]-[21], by reference to Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ETMR 83; [2003] FSR 34 ("*LTJ*") and the Court of Appeal decision in *Reed Executive Plc v Reed Business Information Ltd, Reed Elsevier (UK) Ltd* [2004] RPC 40 ("*Reed Executive*"). In summary, a strict approach is taken. Either all elements constituting the mark must be reproduced, without modification or addition, or any differences must be "so insignificant that they may go unnoticed by an average consumer" (*LTJ* at [54]). In *Compass Publishing* at [20] Laddie J pointed out the advantage of a double identity claim as avoiding the need to prove likelihood of confusion, and said that that advantage "is only to be secured in cases where the mark and sign are so close that one could be considered a counterfeit of the other", adding that small differences that ordinary members of the public would not notice save by a close comparison can be ignored.
114. In contrast, noticeable differences cannot be ignored. In *Compass Publishing* the difference between "Compass Logistics" and "Compass" could not be ignored, because "Logistics" would be perceived as part of a mark rather than as simply descriptive. It had trade mark impact (*Compass Publishing* at [41]). Similarly, in *Reed Executive* "Reed Business Information" was found not to be identical to "Reed" because the use of capitals conveyed that "Business Information" was part of the name rather than being merely descriptive and really adding nothing, in contrast to (say) "Palmolive Soap" as compared to "Palmolive" (paragraphs [37]-[40]). Further examples are provided by *Hasbro Inc v 123 Nahrungsmittel GmbH* [2011] EWHC 199 (Ch); [2011] ETMR 25; [2011] FSR 21 at [194], where Floyd J concluded that "PLAY DOUGH" could not fairly be excised from "THE

EDIBLE PLAY DOUGH”, “COLOURFUL EDIBLE PLAY DOUGH” and “PLAY DOUGH MIX”.

115. Therefore, the significance of deletions or additions must be taken into account. Alterations that are significant will prevent there being identity, provided they have trade mark impact.
116. However, another possibility is that the item objected to may comprise more than one separate sign: see for example *Samuel Smith Old Brewery (Tadcaster) v Lee (t/a Cropton Brewery)* [2011] EWHC 1879 (Ch); [2012] FSR 7 at [88]-[91]. Whether signs are separate will be determined through the eyes of the average consumer.
117. As regards similarity of marks and signs, in *JW Spear v Zynga* [2015] FSR 19 at [60] Floyd LJ summarised the approach to take as follows:

“(i) The court should assess the phonetic, visual and conceptual similarity of mark and sign and decide whether, overall, mark and sign would be perceived as having any similarity by the average consumer.

(ii) If no overall similarity at all would be perceived, the court would be justified in declining to go on and consider the likelihood of confusion applying the global appreciation test ...

(iii) Where the average consumer would perceive some overall similarity, however faint, the court must go on to conduct the global appreciation test for the likelihood of confusion, taking account where appropriate of any enhanced reputation or recognition of the mark.

(iv) In conducting the global appreciation test the court must take forward its assessment of the degree of similarity perceived by the average consumer between mark and sign.”

118. The assessment must therefore be based on the overall impression, normally based on the mark as a whole (see further the discussion of likelihood of confusion, below). I would add that phonetic, visual and conceptual similarity, are not always of equal weight (see the discussion in *Kerly’s Law of Trade Marks and Trade Names*, 16th ed. at 11-093). While I have considered each type of similarity, I consider that visual similarity generally has the most practical significance in this case. In particular, Dial Branding and app names are designed to be seen rather than heard, and the conceptual significance of a name such as Hamilton or Jaquet Droz is limited.

Identity and similarity of goods and services

119. Whether a sign is used in relation to identical goods or services will depend on the goods or services listed in the registration of the mark and relied on by the claimant in its pleaded case.
120. Where general terms are used to describe goods or services, they must be interpreted as including goods or services clearly covered by the literal meaning: Article 33(5) of the EUTM Regulation. Goods can be treated as identical where

one is a subset of the other: Case T-133/05 *Gérard Meric v Office for Harmonisation in the Internal Market* EU:T:2006:247 at [29]. However, trade mark specifications are concerned with use in trade, so when construing a word used in a trade mark specification the court is concerned with “how the product is, as a practical matter, regarded for the purposes of trade” (*British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) at p.289, per Jacob J).

121. Similarity is assessed by reference to all relevant factors, including the nature of the goods, their end users, their method of use and whether they are in competition with each other or are complementary: Case C-39/97 *Canon KK v Metro Goldwyn Mayer Inc* [1998] ECR I-5507; [1999] RPC 117 at [23]. Some guidance was provided by Jacob J in *British Sugar* at p.296, who said that the following factors were relevant:

“(a) The respective uses of the respective goods or services;
 (b) The respective users of the respective goods or services;
 (c) The physical nature of the goods or acts of service;
 (d) The respective trade channels through which the goods or services reach the market;
 (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
 (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

122. One element of similarity is complementarity of goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 (“*Boston Scientific*”) at [82] the Court of First Instance described goods as being complementary where:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

123. The fact that consumers regard a product as a complement of or accessory of another is insufficient, unless it was considered usual for the products to be sold under the same mark: *Rossi v OHMI-Sissi Rossi (SISSI ROSSI) (Intellectual property)* Case T-169/03 at [63], where aesthetic complementarity between shoes and handbags was held to be insufficient.
124. Complementarity was recently considered by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) (“*Axogen*”) in the context of medical equipment. She rejected the proposition that the plausible use of goods alongside each other was enough, and concluded at [38] that *Boston Scientific* was concerned with whether the average consumer may think that

responsibility for the goods and services lies with the same undertaking. I respectfully agree.

125. Swatch's marks are relevantly registered in class 9 or class 14. Its pleaded case relied on marks registered under class 9 as covering (depending on the mark) "computers worn on the wrist"⁵, "electronic apparatus incorporating a time display", "smartwatches" or "smartphones in the shape of a watch". Its pleaded case relied on marks registered under class 14 as covering (depending on the mark) "watches", "horological and chronometric instruments", "timepieces and chronometric instruments; smart watches with extended functionality and connected watches", or "watches that communicate data to smartphones". For marks registered in class 9 Swatch claims that there is identity of goods or services, and for marks registered in class 14 that there is similarity⁶.
126. Samsung conceded in closing submissions that smartwatches are a form of watch, albeit a "very specialised sub-category", but its case is that the relevant goods in this case are the apps, and not smartwatches or watches. Swatch had not registered any marks for apps for smartwatches or designs for smartwatch faces. Further, making an app available for download was a service and not a good. Swatch's pleaded case was that the relevant goods were smartwatches, not apps. There was therefore no identity of goods.
127. For Swatch, Mr Malynicz submitted that there was identity of goods between the apps and smartwatches on the basis that watch face apps are smartwatch faces, and because they are interactive they are smartwatches in digital form. In any event there was a high level of complementarity between apps and smartwatches.
128. As I understood Mr Malynicz's submissions in closing, he accepted that the app when on offer in store was not identical with a smartwatch (although there was a high level of complementarity) but once in operation on a smartwatch it was.
129. I have concluded that the apps are not identical goods to the "computers worn on the wrist", "electronic apparatus incorporating a time display", "smartwatches" or "smartphones in the shape of a watch" for which Swatch has registered marks and on which it relied in its pleaded case. Software was not specified in the registration of most of the marks in dispute and, even where it is specified, it was not pleaded. The description of goods pleaded are clearly tangible items that incorporate software or electronics. Software cannot properly be described as a subset of hardware and is not so regarded in practical terms.
130. However, I agree that the watch face apps in issue are similar goods to smartwatches, in particular on the basis of complementarity. They are obviously not only intended to be used together but are essential for each other's operation. The apps were specifically designed for the Samsung smartwatch and appeared in the "official" Samsung store. They would appear to the average consumer to

⁵ Or "wrist computers".

⁶ As already mentioned there is one exception, "Hamilton", EU013, claimed to be identical under both class 9 and class 14, though in that case the latter registration is for "watches [and] watches that communicate data to smartphones". The claim in respect of a further one, Longines Device EU298, is also made under both class 9 and class 14 on the basis of similar marks and identical or similar goods.

have a common commercial origin. Both could be obtained from Samsung, directly in the case of the apps in the SGA store, and either directly or indirectly via another retailer in the case of the smartwatch. As discussed further below, the display of the app provider's name in the app store was not sufficient to displace this, whether for smartwatch owners using the SGA store or for consumers otherwise aware of the app's origin in the SGA store. (See [154]-[155] below.)

131. This is very different to the example of wine glasses and wine referred to in *Axogen* at [40]-[41], where an average consumer would not assume a common source.
132. Further, smartwatches are, as Samsung conceded, a form of watch. They are effectively a subset and on that basis there is identity between smartwatches and watches. In any event smartwatches are at least highly similar to watches. Smartwatches and watches are both marketed to individual consumers (that is, end-users or those buying them as gifts). Further, whilst I saw market analysis suggesting that smartwatches and watches are not in "real competition" and are in separate "product categories", I nevertheless conclude that they must to an extent compete with each other, since most consumers would choose to wear one or the other and not both, at least at the same time. Importantly, both smartwatches and watches are worn on the wrist, and the function of telling the time may fairly be described as their default function. This is so even if they also perform other functions, and indeed might primarily be used to perform those other functions. They also have a broadly similar outward appearance.
133. It is worth noting here that it is not only smartwatches that may be used primarily for purposes other than telling the time (a feature that Samsung relied on). In current usage a conventional watch may well be used more as a form of jewellery or as a fashion statement, rather than to tell the time (for which, for example, a mobile phone could equally be used). Of course, the watch face apps were also intended to produce a form of fashion statement when in use.
134. I would also be prepared to accept that the disputed watch face apps have a level of similarity with watches. When in use, a watch face app will perform the same function as a watch, telling the time on a wrist. The apps in dispute appear to have similar features to conventional watch faces, in particular analogue or digital dials. They were designed, like other Samsung watch face apps, to look like conventional watch faces.
135. It would also be artificial to describe the offer of the app in the SGA store as the offer of a service of making a watch face app available. What was on offer in the store was the app, which once acquired would function as a watch.

Use "in relation to"

136. The signs have to be used "in relation to" the goods or services in question. This depends on how the average consumer would understand the marks to be used, taking into account the context: *Schütz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712 (Ch) at [79]-[85]. To take an example used by Briggs J in that case, no one would suggest that using Pirelli trade marks on tyres amounted to use in relation to a Ford car to which they were affixed.

137. In Case C-17/06 *Céline v Céline* [2007] ETMR 80 the CJEU explained at [20]-[23] that use in relation to goods or services is use for the purposes of distinguishing them, meaning distinguishing them as originating from a particular undertaking: Case C-62/97 *Bayerische Motorenwerke AG v Deenik* [1999] 1 CMLR 1099 at [38] (see also *Datacard Corporation v Eagle Technologies* [2011] RPC 17 (“*Datacard*”) at [250]). This can include a situation where a sign is not affixed to goods but a link is established between the sign and the goods, rather than (for example) a case where use of a shop name is limited to identifying the relevant business.
138. Mr Malynicz submitted that where the sign was used in the app name that was use in relation to smartwatch face apps and/or smartwatch faces. However, where Dial Branding was used on the watch face it was used to signify the origin of a watch or smartwatch (for example, as being a conventional Tissot watch, or a Tissot watch in smartwatch/digital form). Further, the preview of the watch face that was available before downloading the app was also use in relation to a watch or smartwatch.
139. Samsung maintained that there was no use in relation to smartwatches or watches. The apps produced decorations for smartwatches and were purchased by consumers for private enjoyment. They were software, and Samsung only provided the hardware and the service of offering software for downloading. The average consumer would understand that the additional software generally originated from third-party app developers, and in this case the name of the third-party app seller was provided. The average consumer would appreciate that the app seller had produced the app and that the app name simply described the design (like “William Morris” on fabric manufactured by John Lewis). Further, no one would understand the preview (which was very small) as indicating the origin of a smartwatch, but rather that it simply showed what the face would look like. Once downloaded, the app just provided an image of a watch face. It was comparable to wallpaper on a phone or laptop and did not denote the origin of a smartwatch. If there was use in relation to goods at all, it was use in relation to apps or smartwatch face design.
140. Samsung also maintained that any use was purely descriptive, so that there was no use “in relation to” goods or services at all, even apps. That, linked, issue is discussed in the following section.
141. In my view the average consumer would understand the use of a sign in an app name seen in the SGA store through a consumer’s phone or smartwatch to be use in relation to that app and, in particular, what it will represent once downloaded. To take an obvious example, an app with the name “Tissot Watch Face” would be understood to denote that the app will produce a Tissot watch face when downloaded to the smartwatch. It is use in relation to the software, by which I mean the app, including in particular the watch face that the app will produce once downloaded (which after all is the point of the app).
142. The same analysis must apply to any preview of the watch face that could be viewed on the consumer’s phone or smartwatch before downloading the app. It showed what the watch face would look like once the app is downloaded. I do not agree with Mr Malynicz’s submission to the contrary.

143. In reaching these conclusions I bear in mind that the app name and preview would only be seen in a context where it would be obvious to the average consumer that the smartwatch app was just that, an app for a smartwatch, rather than as denoting the origin of the smartwatch itself.
144. Once downloaded and used, the position is more complex. The smartwatch owner knows that he or she is wearing a smartwatch and using an app. In contrast, a third party seeing the watch face may not do so.
145. In my view the Dial Branding on a downloaded watch face, which appears in the location that would be expected on a conventional watch and on a product which Samsung markets for its watch-like qualities, is not used solely or even primarily to denote the origin of the app (although it does that as well for the consumer who is aware of what it is). Rather, the Dial Branding is intended to denote, or at least to appear to denote, the origin of the watch. Further, the smartwatch owner aims to achieve that effect, as does the provider of the app. I note that it is well established that the post-sale context is relevant: see for example *Thomas Pink* at [142]-[145]; *Arsenal v Reed* [2003] EWCA Civ 696; [2003] ETMR 73; [2003] RPC 39 at [57]; and *Datacard* at [277]-[289] (in the context of likelihood of confusion).
146. I therefore consider that signs that appear on watch faces produced by watch face apps are used in relation to smartwatches, which are at least highly similar to watches.

Function and descriptive use

147. Double identity infringement under Article 9(2)(a) requires the use to be liable to affect the functions of the mark: see for example Case C-487/07 *L'Oréal v Bellure* [2010] RPC 1; [2009] ETMR 55 at [58]. The primary function is the origin function, that is the ability of a trade mark to act as a badge or guarantee of origin. Others include investment and advertising.
148. A use of a sign for purely descriptive purposes is not “use” for infringement purposes because it does not affect any of the interests which the mark is intended to protect (see for example *L'Oréal v Bellure* at [61]). This point is obviously not limited to claims for double identity infringement, but it is convenient to consider the points together given the way in which Samsung put its case.
149. In relation to its claim for double identity infringement, Swatch relied on the origin function. The origin function is affected if the average consumer is not able, or not able without difficulty, to ascertain whether the goods or services in question originate from the trade mark owner or an undertaking economically connected to it, or instead from a third party (*Google France* at [84], discussed by Arnold J in *Datacard* at [263]-[264], and *L'Oréal v eBay* at [94]). In both *Google France* and *L'Oréal v eBay* the CJEU also pointed out that Article 6 of the e-Commerce Directive requires that the person on whose behalf a commercial communication which is part of an information society service is made must be clearly identifiable (*Google France* at [86]; *L'Oréal v eBay* at [95]).

Samsung's case on function/descriptive use

150. Mr Alexander submitted that the signs were not used to indicate that the apps originated from or had any connection with Swatch. The signs indicated the nature of the designs rather than the origin of the apps. There was no indication of anyone taking the use as being anything other than that the design was similar to one appearing on Swatch's watches. Where the sign was used in an app name it was clear that it was being used as such. Where it appeared on the watch face design it was just part of the design.

Discussion

151. There is significant overlap between these issues and the question of what goods or services the signs were used in relation to, and reference should be made to the discussion of that issue. As regards the points specifically raised by Samsung on function and descriptive use, I found them to be unconvincing.

152. The apps did not simply produce a depiction of a watch face, like a poster of a Ferrari showing the well-known logo on the car that Mr Alexander used as an example. When downloaded to a Samsung watch, the apps produced a watch face that looked like, and functioned as, a watch. The fact that the app might also allow other functions to be accessed cannot affect that. Any Dial Branding would not be understood by the average consumer as descriptive of the design of the app. Rather it was, and was clearly intended to be, perceived as branding. Similarly, where used in the app name it was not like a label on the poster in Mr Alexander's example stating "Ferrari". It was not the name of something that would be understood as, for example, a picture or other depiction of a watch face, but rather as something that was, and would function as, a watch face.

153. Similarly, I do not accept that the signs would not be understood by the average consumer as an indication of the origin of the app in question. Bearing in mind the apps' availability on the "official" Samsung site, the average consumer either viewing the app in the SGA store or aware of its origin in the SGA store would be likely to assume that there was some licencing or other economic arrangement with the watch maker that permitted use of the sign, just as with (say) the Uber app there would be an assumption that Uber had permitted the use of its name and app.

154. The fact that the third party developer's name appeared in the app details is insufficient to displace that assumption. That name was neither necessarily seen before the app was downloaded (see [72] above), nor was it made clear who the person named was intended to be. In particular it was not made clear that the person named was the app seller rather than, say, a designer or design house. I also find that a significant proportion of average consumers would view and download watch face apps directly from the smartwatch (being the obvious place to view them and determine what app or apps they wish to acquire) as described at [72] above, and would be unlikely to see the developer's name, or to appreciate its significance if they did. If they focused on a name at all, they would have been more likely to focus on the name of the app.

155. Combining this with the fact that the app being viewed was available on a Samsung site, I conclude that a reasonably observant user would not have been able to ascertain without difficulty that Samsung did not provide the app under an arrangement with Swatch, or that there was otherwise no economic link between the provider of the app and Swatch. The requirement for clear identification emphasised by the CJEU in *Google France* at [86] and *L'Oréal v eBay* at [95] was not met.

Likelihood of confusion

156. As with my findings on similarity of marks and signs, Appendix 3 to this judgment contains my findings in respect of likelihood of confusion in relation to the watch face designs and app names in dispute. The principles that I have applied are set out below.
157. In order to establish infringement under Article 9(2)(b) Swatch must demonstrate the existence of a likelihood of confusion. The relevant legal principles to apply were summarised by Kitchin LJ in *Comic Enterprises* (in the registration context) and set out as follows by Arnold LJ in the context of infringement in *Liverpool Gin v Sazerac* [2021] EWCA Civ 1207; [2021] ETMR 57 ("*Liverpool Gin*") at [8]-[9]:

"8. ... (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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.’

9. The same principles are applicable when considering infringement, although it is necessary for this purpose to consider the actual use of the sign complained of in the context in which the sign has been used: see Case C-533/06 *O2 Holdings Ltd v Hutchison 3G UK Ltd* [2008] ECR I-4231 at [64], and Case C-252/12 *Specsavers International Healthcare Ltd v Asda Stores Ltd* [EU:C:2013:497] at [45]. As Kitchin LJ (with whom Sir John Thomas PQBD and Black LJ agreed) put it in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 at [87]:

‘In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.’”

158. Arnold LJ went on at [10]-[12] to consider the two main kinds of confusion, namely direct confusion (where the sign is mistaken for the mark) and indirect confusion. He pointed out at [12] that indirect confusion is not limited to cases where there is no such mistake but there is a belief that the goods or services come from the same or an economically linked undertaking. He gave a further example, being a situation where consumers are led to believe that there has been co-branding, such that there is an economic link between the proprietor of the sign and the proprietor of the mark.
159. There is a particular aspect of this that is relevant in this case. Swatch are concerned not only about cases where a Samsung smartwatch might be confused with a watch made by Swatch (or a Swatch version of a smartwatch), but also about consumers potentially being led to believe that Swatch companies have entered into licensing arrangements with Samsung. The latter is relevant to smartwatch owners who may view apps in the SGA store and download them, but also to others who may see or be shown the apps in use and understand that they are apps on a Samsung product.

160. In *Liverpool Gin* at [13] Arnold LJ said that “there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion”. As previously remarked by James Mellor QC in *Cheeky Italian v Sutaria* (O/219/16) at [16], a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.
161. The marks the subject of the claim have all been used, and as discussed further below have acquired a reputation as, branding for watches. I have found that smartwatches are at least highly similar to watches (see [132] above). These are relevant factors in determining likelihood of confusion: see in particular paragraphs (g) and (h) of Kitchin LJ’s summary, and the relevance of context emphasised in *Liverpool Gin* at [9]. A further important point is that post-sale confusion can be relevant (*Datacard* at [277]-[289], referred to at [145] above).
162. In my view the context, including the post-sale context, is of particular importance in this case, in the following respects:
- a) An owner of a Samsung smartwatch who viewed the app in the SGA store would, as already discussed, understand that it was the “official” store and would be likely to assume that there was some licencing or other economic arrangement with the watch maker that permitted use of the sign. The fact that collaborations are known to exist between smartwatch providers and other brands – a collaboration between Apple and Hermes was referred to in the evidence as an example – supports this to an extent, but the most important point is the appearance of the apps in the SGA store, rather than elsewhere. The average consumer would not assume that a major organisation like Samsung was permitting signs to be used in its official store without permission. The appearance of the third party developer’s name in the app details is insufficient to displace this (see [154]-[155] above).
 - b) The same point would apply to the position of a smartwatch owner who had downloaded the app from the SGA store. The absence of an economic link with Swatch would not have been made sufficiently clear.
 - c) As far as other consumers are concerned, when downloaded to a Samsung watch any Dial Branding would appear to a significant proportion of (reasonably observant) average consumers as being shown on the face of a watch (as opposed to a smartwatch). Indeed, this is consistent with how Samsung marketed its smartwatches, as “truly watch-like” (see [45] above). That is the context in which signs appearing in Dial Branding would be used.
 - d) Other consumers might appreciate that they were seeing a smartwatch, and indeed might understand that it was a Samsung smartwatch, but there is no basis for concluding that they would have assumed that the app had nothing to do with Swatch. Rather, the natural assumption would be that the smartwatch was either produced by Swatch or there was a licencing or other economic arrangement in place in relation to the app. (In any event, the fact

that a significant proportion would consider that they were looking at a watch rather than a smartwatch is sufficient: see c) above and e) below.)

- e) The average consumer would be familiar with the fact that Dial Branding is used to denote the origin of a watch. The use of Dial Branding that was identical or similar to Swatch's marks on goods that either appear to be identical to Swatch's goods (because they appear to be watches) or at least to be highly similar to Swatch's goods (because they are known to be smartwatches, which are at least highly similar to watches) is highly relevant to establishing the likelihood of confusion. As noted at [145] above, the Dial Branding would have been intended to denote, or at least to appear to denote, the origin of the watch, and both the smartwatch owner and the provider of the app would have aimed to achieve that effect.

- 163. I also remind myself that evidence of actual confusion need not be established. The test is one of likelihood of confusion. It was submitted on behalf of Samsung that the absence of actual evidence of confusion in this case was material in demonstrating that there was no likelihood of confusion. I see that point in principle – indeed in *Compass Publishing* at [22] Laddie J stated that it is often a rule of thumb that where there is no actual confusion in the market-place there is no registered trade mark infringement – but it is not fatal. Instances of confusion might well not have come to Swatch's attention. Further, and importantly, Mr Alexander supported his submission on this point by reference to the argument that the average consumer would understand that online platforms provide apps from sources not commercially related to the app provider. In the context of the watch face apps in issue I have rejected that argument: see in particular [101]-[105] and [154]-[155] above.
- 164. The evidence relied on by Samsung in this connection included Facebook entries posted by two members of a group called Hamilton Watch Owners, where one posted a picture of their "Hamilton smart watch" and another responded "its not a Hamilton watch. Its a Samsung smart watch with a Hamilton face". As Ms Aubert pointed out, that was a group dedicated to Hamilton aficionados (and therefore not necessarily representative of the average consumer), but in any event the fact that the smartwatch was identified for what it is does not rule out indirect confusion, in the form of an economic arrangement between Hamilton and Samsung.
- 165. Further, I am not persuaded by Samsung's arguments that it would be very unlikely that a person who was not a Samsung smartwatch owner would see and/or be confused by any of the apps complained of, given that they would not be readily visible on someone else's wrist and/or that the smartwatch would not be displaying the watch face when they did see it. First, the watch face app would obviously be shown when checking the time, whether for the benefit of the smartwatch owner or for the benefit of anyone else. Secondly, given that the watch face app provides the interface, it would be the screen first seen when activating the smartwatch, including (at least on some models) by motion (such as lifting an arm or flicking the wrist to tell the time or use another function). Thirdly, users who had gone to the trouble of downloading an app with Dial Branding were in my view also likely to have wanted to show others what they

were, or purported to be, wearing, whether physically or via social media, and to have done so in fact.

Article 9(2)(c): unfair advantage etc

166. Swatch also seeks findings that the apps complained of breached Article 9(2)(c) on the basis that the use of the signs took unfair advantage of, or was detrimental to, the distinctive character or repute of the relevant marks. Swatch seeks those findings irrespective of any finding that there has been infringement under Article 9(2)(a) and (b), on the basis that it may be relevant to quantum, and also because in its view Article 9(2)(c) encapsulates the real mischief in this case⁷.
167. There was no submission at trial that the signs were used with “due cause”, so the only requirements to consider that are specific to Article 9(2)(c) are the reputation of the marks, link and injury.

Reputation and link

168. Arnold J provided guidance on the reputation requirement in *Skykick* at [307], as follows:

“Reputation of the trade mark. This is not a particularly onerous requirement. As the Court of Justice explained in Case C-375/97 General Motors Corp v Yplon SA [1999] ECR I-5421:

‘24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.’”

169. Whether use of the sign gives rise to a link to the trade mark in the mind of an average consumer depends on a global assessment of all relevant factors: Case C-252/07 *Intel v CPM* [2009] RPC 15 (“*Intel*”) at [41]. The fact that the sign would call the mark to mind is sufficient: *Skykick* at [309]. Obviously, the greater the

⁷ In pleading terms, the claim under Article 9(2)(c) does not cover marks relied on in Part 1 of Appendix 1 to the APoC, because Swatch relies on its reputation for watches rather than smartwatches. However, all the apps that appear in Part 1 also appear elsewhere.

similarity between the mark and the sign and between the relevant goods and services the more likely this is to occur. Other relevant factors include the strength of the reputation of the mark in the context of the goods or services for which it was registered, and its degree of distinctiveness (*Intel* at [42]-[58]). Provided a connection is made between the mark and the sign, it does not matter that a likelihood of confusion is not established: *Intel* at [66].

170. For EU trade marks (and their new UK comparables), reputation in respect of periods before 31 December 2020 is assessed by reference to the position of the corresponding EUTM in the European Union, including the UK: Article 54(5)(c) of the Withdrawal Agreement⁸ and paragraph 10 of Schedule 2A TMA 1994. The mark must be known by a significant part of the public in a substantial part of the EU, although this may comprise a single Member State: *Skykick* at [308].
171. I am satisfied that Swatch has provided sufficient evidence to establish a reputation in respect of each of the marks in issue in the relevant location (namely the EU for all marks other than Tissot Navigator UK141, and the UK for that mark). I reject Mr Alexander's submission that no such evidence has been provided, or that evidence needed to be provided that was specific to the EU. A significant amount of evidence was provided under a Civil Evidence Act notice covering, among other things, histories of the brands, brand rankings and market analysis, none of which was challenged by Samsung. Further, both Mr Steiger and Mr Dolla provided evidence of reputation which I accept. Mr Dolla's evidence focused on Tissot, but Mr Steiger's was more general and encompassed all Swatch brands. Whilst the estimated turnover figures provided in the materials were worldwide rather than for the EU or UK specifically, I am satisfied from the remainder of the evidence, including the witness evidence summarised in the following paragraphs, that sufficient evidence was provided to meet the reputation requirement, which as Arnold J remarked is not particularly onerous.
172. Mr Steiger's witness statement explained the significance of the Swiss-made heritage and the development of the Swatch brand as a turning point for the Swiss watch industry, following its reputation risking disappearance after the introduction of quartz watches such as Seiko. He set out details of each of the Swatch group brands and described their target markets. He emphasised the group's policy not to grant licences for its brands or undertake co-branding, to avoid the risk of dilution. He described the group's approach to control and management of its brands and the carefully-built images they project, including exclusivity in particular, as being at the core of its business model.
173. Mr Steiger also explained the group's approach to marketing, including that all the brands use advertising and PR events (including carefully selected sporting events for some brands, such as Omega for the Olympics), and that some of them use "brand ambassadors" or other methods such as an association with charitable activities. He gave some details of Swatch's very significant marketing budget at over CHF 1 billion, amounting to 11 to 12% of turnover. He also referred to visual merchandising at the point of sale, and described Swatch's significant distribution

⁸ Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community 2019/C 384 I/0.

network. He further explained that around 25% of the group's sales were in Europe, with a similar share of the marketing budget being devoted to Europe (of which around 10 to 12% was spent in the UK). Mr Steiger also explained that marketing in Europe was particularly important because of its association with luxury brands and the fact that Europe is a significant travel destination for travellers from elsewhere, with tourists making a significant proportion of purchases of luxury goods in Europe.

174. Mr Dolla's evidence emphasised the significance of brand image, describing this as the main foundation of Tissot's success, and the differentiation Tissot aims to achieve through an emphasis on "Swissness", craftsmanship and heritage. He explained how Tissot is promoted through sporting events, particularly those associated with technical innovation such as cycling, and Tissot's heavy investment in marketing, in particular in Europe.
175. Marks such as those associated with Omega, Longines, Tissot and Swatch are very well-known. Their reputation is obvious. As regards others, I would point out that there is no requirement that some threshold percentage of the public must know the mark. This is particularly relevant to the most exclusive prestige or "niche" marks. It is obviously not the case that the more exclusive the brand the less likely the relevant mark is to have established a reputation for Article 9(2)(c) purposes. Further, I would observe that the developers of apps using identical or similar signs to the marks clearly intended to imitate or at least to pay homage to the relevant marks, including exclusive marks such as Jaquet Droz. That rather demonstrates the existence of a reputation.
176. I am also satisfied that in respect of all signs which I have found to be identical or similar to the marks the necessary link would be established. I particularly bear in mind the context of the use of the signs, on the Dial Branding of watch faces produced by watch face apps and in the names of watch face apps, and the reputation and distinctiveness of the Swatch marks as watch brands. It is also clear that it would have been the app developers' intention to create a link.

Injury

177. Swatch relies on all forms of injury under Article 9(2)(c), namely detriment to the distinctive character of the marks ("blurring"), detriment to the repute of the marks ("tarnishing") and unfair advantage being taken of the distinctive character or repute of the marks ("free riding").
178. The existence of injury depends on an assessment of all relevant circumstances: *Intel* at [66]. Guidance about the different types of injury was provided by the CJEU in *L'Oréal v Bellure* at [39]-[41]:

"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*, para.29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

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.”

179. The onus is on the trade mark proprietor to establish either actual injury to the mark (being evidence of a change in the economic behaviour of the average consumer), or a serious risk or likelihood that injury will occur in the future: *Intel* at [38]-[39], [71] and [77]. Samsung maintained that no credible evidence had been provided to establish this, and that any reputation of the brands was unsullied.
180. The requirement for a change in economic behaviour was considered by Arnold J in *Jack Wills Ltd v House of Fraser (Stores) Ltd* [2014] EWHC 110 (Ch); [2014] FSR 39 at [81]-[83]. He explained that there was no requirement for evidence of a change in the economic behaviour of consumers of the *trade mark proprietor’s* goods or services, but there would still need to be some change in economic behaviour (or a serious likelihood of it), in that case a change in behaviour of the defendant’s consumers. Arnold J concluded at [83] that the correct way to approach the question was to proceed by analogy with the approach in the following passage of the CJEU’s judgment in *WOLF HEAD* (C-383/12):
- “42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.
43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”
181. I also bear in mind that, although it is not permissible for the court to speculate, it is legitimate to draw inferences from the facts: *Enterprise Holdings Inc v Europcar Group UK Ltd & Anr* [2015] EWHC 17 (Ch) [2015] FSR 22 at [222].

182. I am satisfied that the use of signs identical or similar to the marks in watch face apps (whether in Dial Branding, or in the app name or the preview of the watch face that could be seen prior to downloading the app) was *capable* of having a detrimental effect on the character or reputation of the marks and of amounting to unfair advantage for the purposes of Article 9(3).
183. For brands in the prestige, luxury and high ranges (see [2] above), the impact or at least potential impact on brand reputation resulting from use of signs identical or similar to the relevant marks seems to me to be obvious, and supported by the witness evidence of Mr Steiger and Mr Dolla. They are intended to be, and are marketed as, exclusive, beautifully crafted Swiss-made products, produced (in the case of prestige products) in limited numbers and with an emphasis on heritage and longevity. In contrast, the Samsung smartwatch is a commoditised gadget with a short life and, despite work on its aesthetics, in a wholly different league as a product. The damage can be regarded as a form of dilution or tarnishment.
184. For Swatch brands in the middle range, similar points apply. Those watches still cost significant sums. Tissot is marketed for its Swiss quality and reliability, Mido as a benchmark for Swiss-made fine watches at affordable prices, and Hamilton as producing watches combining “American spirit with true Swiss precision”. Further, a specific aspect of their reputation is that they are intended to be long-lived, and indeed “timeless”, in sharp contrast to the limited life of a smartwatch. The association of these brands with smartwatches could inevitably have an impact on their reputation, as Mr Steiger explained. It could taint their perceived value and exclusivity.
185. In the basic range, Swatch can obviously not be regarded as an exclusive product, and it is relatively inexpensive. However, it has been an extremely successful brand which has positioned its watches as fresh and innovative lifestyle and fashion accessories, again Swiss made and exclusive to Swatch. Use of an identical or similar sign on a product that does not conform to that description could have the effect of tarnishing the mark. Alternatively, it could have had a dilutive or blurring effect.
186. I am also satisfied that the use of signs identical or similar to the marks in watch face apps was capable of amounting to free-riding. Swatch has invested very significant sums in building and maintaining the reputation of its brands, and cultivating their “Swissness”. Samsung markets its smartwatch as “truly watch-like” and indeed has promoted it as a “true watch”, also pointing out the “always on display” feature as adding to the “real watch” aesthetic. It has even collaborated with a Swiss watch designer in working on its designs, and has publicised that fact. Slides from the 2018 Samsung Developer Conference (available online) feature apparently Swiss watch faces, including in one instance an Omega watch face. Although Samsung sought to dismiss the relevance of this on the basis that the presentation was intended to cover technical aspects of watch designer tools and that the presenter made a one-off mistake, this amounted to implicit encouragement to designers to use such features.
187. Samsung’s approach to promoting its smartwatch was not lost on consumers, as demonstrated by the fact that the watch face apps in dispute were admittedly downloaded around 160,000 times. The availability of images of “Swiss” watch

faces on Galaxy smartwatches, including some of the apps in question, on the internet and social media would clearly have been to Samsung's commercial benefit in encouraging sales of Samsung smartwatches. For example, in one thread on a Samsung forum there was a comment in 2018 by someone who said they loved Omega Speedmaster Moonphase watches, could not buy one at present but had created a replica face using the Galaxy design tool, which led to requests to share it. Another Instagram post in 2020 showed an Omega branded face on a Samsung smartwatch with a comment that "this would do for now" because they could not afford the real thing.

188. However, there is a separate question as to whether Swatch has proved the existence of some change in economic behaviour.
189. Mr Steiger fairly accepted in cross-examination that "one-time" infringements that were addressed immediately did not present major issues in terms of protecting brand reputation, but pointed out that some of the apps were downloaded a significant number of times, when compared to sales of watches of the brand in question. Taking Tissot as an example, its reputation was harmed by a smartwatch showing a copy of a Tissot watch face which was not of the same quality as a Tissot watch. Although Samsung criticised Mr Steiger's calculations as having an incorrect basis, the thrust of Mr Steiger's point remains. I would add that what to Samsung is tiny or immaterial is not necessarily so for Swatch.
190. Further, I disagree with Mr Alexander's submission that Mr Dolla's evidence expressing concern about consumers choosing to purchase £300 smartwatches instead of a £900 Tissot watch was inconsistent with the evidence that purchasers of Swiss made watches were making an aspirational purchase, buying into heritage and craftsmanship. First, I have already concluded that users who had gone to the trouble of downloading an app with Dial Branding were likely to want to have shown others what they were, or purported to be, wearing, whether physically or via social media. In cases where the smartwatch was recognised as a Samsung product, it is likely that this would have had a positive effect on the perceived attractiveness of a Samsung smartwatch to consumers who could afford that but felt that they could not, or could not yet, afford a desirable Swiss made watch. Secondly, and importantly, Mr Dolla expressed a second concern, namely that consumers would consider that there was an association or partnership between Tissot and Samsung, when there was not, to the detriment of Tissot's reputation. I agree that this is a valid concern.
191. However, whilst some of the apps were downloaded in large numbers, others were not. Further, Samsung has taken down all the apps and there is no suggestion that there is any risk of them reappearing in the SGA store. Although existing downloads have not been deleted, smartwatches to which they have been downloaded are in practice likely to be in use for a limited period: see [47] above. In these circumstances I do not consider that Swatch can demonstrate a serious risk or likelihood of future injury, if actual injury cannot be shown.
192. It is true that, when they were available, the apps are likely to have been viewed in the SGA store by persons who did not download them. However, no numbers are available in respect of that and it is reasonable to infer that there would have been a correlation between the number of downloads of a particular app and the

number of times it was viewed – or at least viewed in the detail required to appreciate the existence and nature of the relevant sign – in the SGA store.

193. I have concluded that injury did occur in respect of apps 7, 8 and 14 in Appendix 2, to the extent that they were downloaded and used. Apps 7 and 8, which were “Tissot” apps offered for free, made up the vast bulk of the downloads (67,444 and 75,175 respectively). App 14, a “Hamilton” app, was downloaded 12,569 times.
194. In contrast, other apps were each downloaded on far fewer occasions. The total for all those other apps was 2,527 downloads, with by far the largest number being the 1,147 downloads of app 10. Taking a pragmatic approach, and having regard to Mr Steiger’s evidence in particular, I have concluded that these numbers are too low to justify a conclusion that any injury occurred.
195. I should also clarify that in the light of Mr Steiger’s and Mr Dolla’s evidence my finding relates to the signs as they appeared on watch faces, rather than app names.

Joint tortfeasorship and Article 10(3)

196. In view of the conclusions reached it is not necessary to address Swatch’s alternative case that the app developers were primary infringers, whether under general principles or by virtue of carrying out “preparatory acts” under Article 10 of the EUTM Regulation, and that Samsung was liable as a joint tortfeasor.

E-COMMERCE DIRECTIVE DEFENCE

197. Samsung relies on Article 14 of the e-Commerce Directive (“Hosting”), which it says provides a complete defence.
198. The e-Commerce Directive, which was transposed into English law by the Electronic Commerce (EC Directive) Regulations 2002, SI 2002/2013, was as the name suggests intended to facilitate e-commerce. It was introduced at a relatively early stage of the development of modern internet commerce. Article 14 is part of a group of “safe harbour” provisions in Section 4 of Chapter II of the Directive, entitled “Liability of intermediary service providers”, the legal effect of which is not limited to intellectual property. The other provisions comprise exemptions in Article 12 relating to transmission (“Mere conduit”), Article 13 relating to temporary storage in transmission (“Caching”), and Article 15, which prohibits the imposition of any general monitoring obligation.

199. Article 14(1) provides as follows:

“Where an information society service is provided that consists of the storage of information provided by a recipient of the service, Member States shall ensure that the service provider is not liable for the information stored at the request of a recipient of the service, on condition that:

- (a) the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or
- (b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information....”

200. The corresponding provision of the UK regulations is regulation 19, which provides:

“Where an information society service is provided which consists of the storage of information provided by a recipient of the service, the service provider (if he otherwise would) shall not be liable for damages or for any other pecuniary remedy or for any criminal sanction as a result of that storage where—

- (a) the service provider—
 - (i) does not have actual knowledge of unlawful activity or information and, where a claim for damages is made, is not aware of facts or circumstances from which it would have been apparent to the service provider that the activity or information was unlawful; or
 - (ii) upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information ...”

201. It is also worth setting out certain of the recitals to the Directive:

“(41) This Directive strikes a balance between the different interests at stake and establishes principles upon which industry agreements and standards can be based.

(42) The exemptions from liability established in this Directive cover only cases where the activity of the information society service provider is limited to the technical process of operating and giving access to a communication network over which information made available by third parties is transmitted or temporarily stored, for the sole purpose of making the transmission more efficient; this activity is of a mere technical, automatic and passive nature, which implies that the information society service provider has neither knowledge of nor control over the information which is transmitted or stored.

(43) A service provider can benefit from the exemptions for ‘mere conduit’ and for ‘caching’ when he is in no way involved with the information transmitted; this requires among other things that he does not modify the information that he transmits; this requirement does not cover manipulations of a technical nature which take place in the course of the transmission as they do not alter the integrity of the information contained in the transmission.

(44) A service provider who deliberately collaborates with one of the recipients of his service in order to undertake illegal acts goes beyond the activities of ‘mere conduit’ or ‘caching’ and as a result cannot benefit from the liability exemptions established for these activities.

(45) The limitations of the liability of intermediary service providers established in this Directive do not affect the possibility of injunctions

of different kinds; such injunctions can in particular consist of orders by courts or administrative authorities requiring the termination or prevention of any infringement, including the removal of illegal information or the disabling of access to it.

(46) In order to benefit from a limitation of liability, the provider of an information society service, consisting of the storage of information, upon obtaining actual knowledge or awareness of illegal activities has to act expeditiously to remove or to disable access to the information concerned; the removal or disabling of access has to be undertaken in the observance of the principle of freedom of expression and of procedures established for this purpose at national level; this Directive does not affect Member States' possibility of establishing specific requirements which must be fulfilled expeditiously prior to the removal or disabling of information."

202. For the purposes of these proceedings, Swatch has accepted that Samsung is the provider of an information society service, and that the apps in question are information for the purposes of Article 14. It also did not contend at trial that Samsung failed to remove the offending apps expeditiously, although it was pointed out that no steps have been taken by Samsung to seek to ensure the removal of previous downloads of the apps. The remaining disputes related to whether what Samsung did went beyond the storage of information, and whether it had awareness of facts and circumstances for the purposes of Article 14(1)(a).

The European case law

203. Article 14 has been considered by the CJEU in *Google France, L'Oréal v eBay* and (since the UK's withdrawal from the EU) in Cases C-682/18 C-683/18, *Peterson v Google* ECLI:EU:C:2021:503.
204. As already discussed, in *Google France* the CJEU found that a provider does not "use" the signs by storing the relevant keywords, but it went on to consider Article 14. After commenting on the role of a provider such as Google in transmitting and holding information, it said this at [112] to [114]:

"112. In order for the storage by a referencing service provider to come within the scope of Article 14 of Directive 2000/31, it is further necessary that the conduct of that service provider should be limited to that of an 'intermediary service provider' within the meaning intended by the legislature in the context of Section 4 of that directive.

113. In that regard, it follows from recital 42 in the preamble to Directive 2000/31 that the exemptions from liability established in that directive cover only cases in which the activity of the information society service provider is 'of a mere technical, automatic and passive nature', which implies that that service provider 'has neither knowledge of nor control over the information which is transmitted or stored'.

114. Accordingly, in order to establish whether the liability of a referencing service provider may be limited under Article 14 of

Directive 2000/31, it is necessary to examine whether the role played by that service provider is neutral, in the sense that its conduct is merely technical, automatic and passive, pointing to a lack of knowledge or control of the data which it stores.”

205. The court went on to state that the fact that Google received payment, set payment terms or provided general information would not deprive it of protection, and that concordance between a keyword and search term did not suffice to create knowledge or control of the data. In contrast “the role played by Google in the drafting of the commercial message which accompanies the advertising link or in the establishment or selection of keywords is relevant” (paragraph [118]). It concluded that Article 14 must be interpreted as applying where a service provider “has not played an active role of such a kind as to give it knowledge of, or control over, the data stored”.
206. In *L’Oréal v eBay*, as already discussed, the CJEU also found that there was no “use” of signs by an online marketplace displaying them in offers for sale, but went on to consider Article 14. It said this about the scope of Article 14(1):

“110. With regard to the online marketplace at issue in the main proceedings, it is not disputed that eBay stores, that is to say, holds in its server’s memory, data supplied by its customers. That storage operation is carried out by eBay each time that a customer opens a selling account with it and provides it with data concerning its offers for sale. Furthermore, eBay normally receives remuneration inasmuch as it charges a percentage on transactions completed on the basis of those offers for sale.

111. However, the fact that the service provided by the operator of an online marketplace includes the storage of information transmitted to it by its customer-sellers is not in itself a sufficient ground for concluding that that service falls, in all situations, within the scope of Article 14(1) of Directive 2000/31. That provision must, in fact, be interpreted in the light not only of its wording but also of the context in which it occurs and the objectives pursued by the rules of which it is part (see, by analogy, Case C 298/07 *Bundesverband der Verbraucherzentralen und Verbraucherverbände* [2008] ECR I-7841, paragraph 15 and the case-law cited).

112. In that regard, the Court has already stated that, in order for an internet service provider to fall within the scope of Article 14 of Directive 2000/31, it is essential that the provider be an intermediary provider within the meaning intended by the legislature in the context of Section 4 of Chapter II of that directive (see *Google France and Google*, paragraph 112).

113. That is not the case where the service provider, instead of confining itself to providing that service neutrally by a merely technical and automatic processing of the data provided by its customers, plays an active role of such a kind as to give it knowledge

of, or control over, those data (*Google France and Google*, paragraphs 114 and 120).

114. It is clear from the documents before the Court and from the description at paragraphs 28 to 31 of this judgment that eBay processes the data entered by its customer-sellers. The sales in which the offers may result take place in accordance with terms set by eBay. In some cases, eBay also provides assistance intended to optimise or promote certain offers for sale.

115. As the United Kingdom Government has rightly observed, the mere fact that the operator of an online marketplace stores offers for sale on its server, sets the terms of its service, is remunerated for that service and provides general information to its customers cannot have the effect of denying it the exemptions from liability provided for by Directive 2000/31 (see, by analogy, *Google France and Google*, paragraph 116).

116. Where, by contrast, the operator has provided assistance which entails, in particular, optimising the presentation of the offers for sale in question or promoting those offers, it must be considered not to have taken a neutral position between the customer-seller concerned and potential buyers but to have played an active role of such a kind as to give it knowledge of, or control over, the data relating to those offers for sale. It cannot then rely, in the case of those data, on the exemption from liability referred to in Article 14(1) of Directive 2000/31.

117. It is for the referring court to examine whether eBay played a role such as that described in the preceding paragraph in relation to the offers for sale at issue in the case before it.”

207. The CJEU concluded at [123] that Article 14(1) applies to the operator of an online marketplace where that operator:

“... has not played an active role allowing it to have knowledge or control of the data stored. The operator play such a role when it provides assistance which entails, in particular, optimising the presentation of the offers for sale in question or promoting them.”

208. The CJEU also considered the knowledge related conditions in Article 14(1)(a) and (b), and said this:

“119. In situations in which that provider has confined itself to a merely technical and automatic processing of data and in which, as a consequence, the rule stated in Article 14(1) of Directive 2000/31 applies to it, it may none the less only be exempt, under paragraph 1, from any liability for unlawful data that it has stored on condition that it has not had ‘actual knowledge of illegal activity or information’ and, as regards claims for damages, has not been ‘aware of facts or circumstances from which the illegal activity or information is

apparent' or that, having obtained such knowledge or awareness, it has acted expeditiously to remove, or disable access to, the information.

120. As the case in the main proceedings may result in an order to pay damages, it is for the referring court to consider whether eBay has, in relation to the offers for sale at issue and to the extent that the latter have infringed L'Oréal's trade marks, been 'aware of facts or circumstances from which the illegal activity or information is apparent'. In the last-mentioned respect, it is sufficient, in order for the provider of an information society service to be denied entitlement to the exemption from liability provided for in Article 14 of Directive 2000/31, for it to have been aware of facts or circumstances on the basis of which a diligent economic operator should have identified the illegality in question and acted in accordance with Article 14(1)(b) of Directive 2000/31.

121. Moreover, if the rules set out in Article 14(1)(a) of Directive 2000/31 are not to be rendered redundant, they must be interpreted as covering every situation in which the provider concerned becomes aware, in one way or another, of such facts or circumstances.

122. The situations thus covered include, in particular, that in which the operator of an online marketplace uncovers, as the result of an investigation undertaken on its own initiative, an illegal activity or illegal information, as well as a situation in which the operator is notified of the existence of such an activity or such information. In the second case, although such a notification admittedly cannot automatically preclude the exemption from liability provided for in Article 14 of Directive 2000/31, given that notifications of allegedly illegal activities or information may turn out to be insufficiently precise or inadequately substantiated, the fact remains that such notification represents, as a general rule, a factor of which the national court must take account when determining, in the light of the information so transmitted to the operator, whether the latter was actually aware of facts or circumstances on the basis of which a diligent economic operator should have identified the illegality."

209. The court concluded as follows at [124]:

"124. Where the operator of the online marketplace has not played an active role within the meaning of the preceding paragraph and the service provided falls, as a consequence, within the scope of Article 14(1) of Directive 2000/31, the operator none the less cannot, in a case which may result in an order to pay damages, rely on the exemption from liability provided for in that provision if it was aware of facts or circumstances on the basis of which a diligent economic operator should have realised that the offers for sale in question were unlawful and, in the event of it being so aware, failed to act

expeditiously in accordance with Article 14(1)(b) of Directive 2000/31.”

210. *Peterson v Google* (which does not form part of EU retained law but to which the court may have regard⁹) concerned alleged breaches of copyright in respect of the YouTube platform and another platform operated by Cyando. It applied the principles set out in *Google France* and *L’Oréal v eBay*, making it clear at [107] and [108] that contribution that extended beyond “merely making the platform available” would not fall within Article 14. However, it noted that the platforms in question do not “create, select, view or monitor” content, and added that the fact that technological measures were implemented aimed at detecting content that may infringe copyright did not amount to playing an active role giving knowledge and control (paragraph [109]). Further, the court explained at [111]-[114] that “abstract knowledge” that protected content was being made available was insufficient to satisfy the condition in Article 14(1)(a). Rather, knowledge needed to relate to specific activities. There was no general obligation to monitor or search for information, and automatic indexing and the provision of recommendations based on users’ profiles and preferences were insufficient to amount to specific knowledge.

Samsung’s case on Article 14

211. Mr Alexander sought to distinguish earlier case law, and *L’Oréal v eBay* in particular, on the basis that this case concerns an app store, rather an online marketplace where it is possible for the operator to adopt a passive role. This is simply not possible with app stores and would be undesirable. It was inherent in an app store that there had to be reasonably close involvement between the operator of the platform and those developing apps for it. Apps were developed for a particular operating system and had to interact with specific software and hardware. Some level of assistance was essential to ensure that apps work properly and did not damage equipment or affect other software.
212. Mr Alexander submitted that there were strong public policy reasons to facilitate co-operation. It was clear from case C-298/07 *Bundesverband der Verbraucherzentralen und Verbraucherverbände* at [15] and [19] that the e-Commerce Directive was required to be interpreted in the light of its objectives, and that it had the aim of contributing to the development of information society services and maximising the opportunities afforded to e-commerce. The Commission had criticised practices making it harder for third party providers to produce and market apps in competition to those provided by the app store provider, and a similar point had been made by a House of Lords select committee. App store providers should not be dissuaded from providing assistance to create apps or from promoting apps of third parties. That context should be taken into account in interpreting Article 14.
213. Mr Alexander relied on the extensive recitals to the e-Commerce Directive, including recital (41), which makes clear that its aim is to strike a balance between different interests, and recitals (42) to (44) which he submitted suggested that the

⁹ S. 6(2) European Union (Withdrawal) Act 2018.

operative provisions applied to situations where the platform operator did not modify the content complained of (see [201] above).

214. Further, *L'Oréal v eBay* indicated that for Article 14(1)(a) to operate a specific alert was needed. Samsung had acted promptly once alerted to the possibility of an issue. It was not reasonable, in the context of the international nature of e-commerce, to expect Samsung to pick up every possible risk of confusion with specific Swiss watch brands, particularly niche ones. Swatch was well-placed to identify any issues itself and use the notice and take-down procedure.
215. In summary, the court should conclude that Article 14 should not be disapplied as a consequence of co-operation that was reasonably necessary to facilitate the creation and distribution of apps, or by an app store provider seeking to identify and filter out potential issues with apps, as long as it did not design the relevant app or make editorial changes to it. In addition, the court should find that if there was an adequate notice and take-down procedure it would not be “apparent” that an app was problematic for the purposes of Article 14(1)(a) if issues were not identified in advance.

Discussion

216. The protection conferred by Article 14 and regulation 19 is limited to activity that “consists of the storage of information”. Further, that concept has been interpreted in *Google France* and *L'Oréal v eBay*, which both form part of retained law, in a relatively restrictive manner, as being limited to conduct of a “technical, automatic and passive” nature, rather than an active role that would give the relevant person “knowledge of, or control over” the data. This approach reflects the wording of the recitals, in particular recital (42) (albeit that in terms that recital refers to transmission and caching). It is worth noting that the reference to knowledge and control here is separate from the knowledge-related condition in Article 14(1)(a).
217. Thus, steps such as optimising the presentation of, or promoting, offers by an online market place would preclude exemption (*L'Oréal v eBay* at [116] and [123]). Further, whilst there is no obligation to monitor, a failure to act expeditiously following awareness of facts or circumstances that would have alerted a diligent economic operator would also lead to a denial of protection (paragraph [124]).
218. Based on the approach taken in the existing case law, it is far from clear that what Samsung did in this case was limited to acts of a “mere technical, automatic and passive nature” such that it lacked knowledge of or control over the data. Rather, in addition to the functional and safety review, the SVMC performed a relatively detailed content review with reference to the CRG. As already discussed, only a relatively small part of that guide relates to third parties’ intellectual property rights. Further, in other respects Samsung also took active steps, including in relation to facilitating and encouraging the design of apps, and marketing its smartwatches by reference to the availability of watch face apps in the SGA store. The commercial benefit it derived from doing so was from sales of its products, rather than any form of charge for storage. It has also promoted some of the apps.

219. Further, a watch face app has relatively limited content. Each app relates to a different watch face (plus, potentially, a related “always on” version of that face). The evidence indicates that whilst a reviewer would not generally download the app on to a watch, they will look at the details, including the app name and screenshots of the watch face. Reviewers are able to, and do, reject apps that are not regarded as meeting Samsung’s policies. As a result, it can be inferred that Samsung, via the reviewer in question, would have obtained “knowledge” of signs that appeared on the watch faces and in the app name, even if it is the case that a gatekeeper role such as that adopted by the SVMC should not be regarded as amounting to “control” of data in the manner contemplated by the CJEU.
220. However, Samsung has a fair point that the case law does not consider app stores, and it is possible that the different factual context could have some impact on the approach to take to the “knowledge or control” test that the CJEU has applied, a test which is not reflected in the express terms of Article 14(1). I would add that the first part of Article 14(1) should also not be interpreted to deny practical effect to Article 14(1)(a) (see *L’Oréal v eBay* at [121] and [122] in particular).
221. I agree that Article 14 and regulation 19 should be interpreted in the light of the objectives of the legislation. I also accept that some level of interaction is required between an app store and third party app providers to ensure that apps can function properly and do not cause problems with equipment or other software. Further, I can see a strong argument that it would be unattractive to penalise operators solely by virtue of having additional review procedures in place that are designed to weed out inappropriate or illegal content. I note in particular that recital (10) to the e-Commerce Directive emphasises the principle of proportionality, and also refers to the need to ensure protection of objectives of general interest, including the protection of minors and human dignity.
222. In the light of these points I would prefer to base my conclusion on Article 14(1)(a), as interpreted in *L’Oréal v eBay*. I cannot accept Mr Alexander’s interpretation that the condition in Article 14(1)(a) is not met as long as an app store provider does not design the relevant app or make editorial changes to it. It is clear from *L’Oréal v eBay* that the test is one of whether a diligent economic operator should have identified the illegality by reference to facts or circumstances of which it is (actually) aware. The existence of notice and take-down procedures does not itself provide a defence.
223. I am satisfied that the content review process would have resulted in the reviewer, and through it Samsung, becoming aware of the app name and the appearance of the watch face, including any Dial Branding on it.
224. At the trial, emphasis was placed on behalf of Samsung on the modifications it has made to its procedures since Swatch made its claim (although, no doubt mindful of its case, there was also a more or less explicit complaint by Samsung that it should not have been required to make those improvements and that the Closed-Seller system in particular (see [65] above) could harm free access and competition). I accept Swatch’s case that Samsung’s procedures were inadequate before the claim was brought. The fact that Samsung has made changes since then rather underlines that conclusion, but is not necessary to it.

225. In the case of those apps that I have found did infringe Swatch’s marks, I have concluded that the awareness of the app name (where relevant) and/or the appearance of the watch face, and specifically any Dial Branding on it, that would have been gained during the content review process would have alerted a diligent economic operator to the infringement.

226. In particular:

- a) Samsung chose to confine the day to day work of content review to a relatively small team of individuals, all from the same territory and (it seems) with little or no international or European market experience or training in brand recognition. Compared to a total workforce of around 2000 at the SVMC alone and the scale of Samsung’s business more generally, a team of around 14 individuals, all local Vietnamese and mainly software engineers, appears under-resourced both in numerical and skills terms. Linked to this, the period of time effectively allowed to review each app (see [60] above) appears to me to be on the short side, at least for reviewers who are not very experienced.
- b) The CRG provided very little guidance about the protection of intellectual property rights of third parties. In contrast, the protection of Samsung’s own name and branding was dealt with in some detail.
- c) At the time, Mr Le’s team was given no active instruction to undertake any searches, whether on Google or another generic search engine, to check that the app name and any Dial Branding on the watch face did not infringe any mark. There was also no reference to the possibility of searching any trade mark database. The reference to checking the internet in the CRG relates only to “well known contents”, which in context at least appeared not to include watch brands (see [68] and [69] above). Indeed, there is no reference to watch brands at all in the CRG, despite the prevalence of watch face apps.
- d) In contrast, Mr Kim’s evidence was that after the dispute started Samsung did start to consult the (freely available) Global Brand Database of the World Intellectual Property Organisation (“WIPO”). He accepted that searches could be made quickly. He also explained that, although not reflected in the CRG, reviewers are now told to search Google or the WIPO database in cases of doubt. That is a material improvement, although I would add that I would expect a diligent operator to include in their review a search of a trade mark database such as WIPO wherever there appears to be a risk that the app name or Dial Branding on the watch face includes something that might be a trade mark (whether in word or figurative form), and that this should be reflected in clear written instructions to reviewers, as well as being covered in training.
- e) Bearing in mind among other things that a high proportion of the watch apps in the SGA are watch face apps (88% being the figure in evidence), and Samsung’s marketing approach for its smartwatches (which emphasises their realistic watch like qualities: see [45] above) I would also expect Samsung to ensure that the reviewing team have knowledge of a

good range of watch brands, so as to be reasonably well placed to pick up infringing apps, rather than being limited by individual personal experience or cultural awareness. I would also expect there to be clear, positive, encouragement to any less experienced local staff to check any doubtful cases with an experienced reviewer, without being penalised in respect of the number of apps that they are expected to review in a given period.




227. In my view this approach provides an appropriate balance between the different interests. In essence, having determined for its own (perfectly legitimate) reasons to undertake a content review, Samsung is required to behave as a diligent operator would in respect of the content of which it becomes aware in the process. The changes Samsung has made to its processes since the dispute started appear to go some way towards meeting that requirement, although as indicated above there appears to be a bit further to go with the review process.
228. I should also mention the fact that some of the apps were promoted as “Editor’s Picks” or similar. These were chosen by reference to numbers of downloads and recommendations from an advertising agency acting for Samsung. Promotion is an activity that the CJEU has said is outside Article 14(1), although Samsung maintains that the promotion was automatic, based on download frequency. Given my conclusion on Article 14(1)(a) I make no finding about whether this activity would otherwise have taken Samsung outside the protection of Article 14(1).
229. One final point I should mention is that Samsung made a number of complaints at trial about what it asserted was a lack of co-operation by Swatch in assisting in identifying and resolving issues, including failing to provide a list of trade marks, and its failure to monitor the SGA store before 2018. None of these matters appear to me to be strictly relevant to liability, and in particular to what steps Samsung itself should have been taking before 2019.

CONCLUSIONS

230. In conclusion Swatch has established infringement of its marks, under Article 9(2)(a) or (b) of the EUTM Regulation, in respect of apps 1 to 18, 20-22 and 26-30, as set out in more detail in Appendix 3. In respect of apps 1, 4, 12, 15, 16, 18, 20-22 and 26-28 the finding of infringement relates to the relevant sign on the watch face only, as opposed to any app name. In respect of apps 11, 13, 17, 29 and 30 it relates only to the sign in an app name. For other apps the conclusion relates to both.
231. I have concluded that use in app names (or in previews of the watch face) is not use in relation to smartwatches. Therefore, findings of double identity infringement under Article 9(2)(a) are limited to the use of signs on watch faces produced by watch face apps, which does constitute use in relation to smartwatches (or in relation to the “computers worn on the wrist”, “electronic apparatus incorporating a time display” or “smartphones in the shape of a watch” for which Swatch has registered marks and on which it relied in its pleaded case under Part 1 Appendix 1 of the APoC).

232. I have however concluded that watch face apps are similar goods to smartwatches and that they have some level of similarity with watches, such that infringement is established under Article 9(2)(b) where the other requirements are met, including likelihood of confusion.
233. Swatch has also established infringement under Article 9(2)(c) in respect of apps 7, 8 and 14, in respect of the relevant sign as it appeared on the face of the watch.
234. Samsung does not have a defence to the infringements under Article 14 of the e-Commerce Directive.

APPENDIX 1: THE TRADE MARKS IN ISSUE






First Claimant (“Breguet”)	
1.	WO(EM)1324675: word mark BREGUET (“Breguet EU675”), registered for class 9 goods including “ <i>smartwatches</i> ” ¹⁰ .
2.	EM003440881: word mark BREGUET (“Breguet EU881”), registered for class 14 goods including “ <i>horological and chronometric instruments</i> ” ¹¹ .
Second Claimant (“Blancpain”)	
3.	WO(EM)1328990: word mark BLANCPAIN (“Blancpain EU990”), registered for class 9 goods including “ <i>wrist computers, smartwatches</i> ” ¹² .
4.	EM003441722: word mark BLANCPAIN (“Blancpain EU722”), registered for class 14 goods including “ <i>horological and chronometric instruments</i> ”.
Third Claimant (“Jaquet Droz”)	
5.	WO(EM)1413802: word mark JAQUET DROZ (“Jaquet Droz EU802”), registered for class 9 goods including “ <i>smartwatches</i> ”.
6.	EM000509224: word mark JAQUET DROZ (“Jaquet Droz EU224”), registered for class 14 goods including “ <i>horological and chronometric instruments</i> ” (class 14).
Fourth Claimant (“Omega”)	
7.	WO(EM)1255609: figurative mark  OMEGA (“Omega & Device EU609”), registered for goods in class 14 including “ <i>timepieces and chronometric instruments</i> ” (class 14) and “ <i>smart watches with extended functionality and connected watches</i> ” (class 14).
8.	WO(EM)0771474: figurative mark  (“Omega Device EU474”), registered for goods in class 14 including “ <i>horological and chronometric instruments</i> ”.
9.	EM000226282: word mark DE VILLE (“De Ville EU282”), registered for goods in class 14 including “ <i>watches</i> ”.
10.	WO(EM)1268944: figurative mark  OMEGA GLOBEMASTER (“Omega Globemaster & Device WO944”), registered for goods in class 14 including “ <i>timepieces and chronometric instruments</i> ” and “ <i>smart watches with extended functionality and connected watches</i> ” ¹³ .
11.	EM000225615: word mark SPEEDMASTER (“Speedmaster EU615”), registered for goods in class 14 including “ <i>watches</i> ”.
Fifth Claimant (“Longines”)	

¹⁰ Goods listed are those relied on in pleaded case, except where otherwise indicated.






¹¹ Pleaded as “watches”, but that text does not appear in the registration.

¹² Pleaded as “computers worn on the wrist; electronic apparatus incorporating a time display”, but that text does not appear in the registration.

¹³ WO944 is pleaded simply as “watches”, with no reference to smart watches. “Watches” (as opposed to “smart watches”) does not appear in the registration.

12.	WO(EM)1341298: figurative mark  (“Longines Device EU298”), registered for goods in classes 9 and 14, including “ <i>smartwatches</i> ” (class 9) and “ <i>watches</i> ” (class 14).
13.	EM000226233: word mark LONGINES (“Longines EU233”), registered for goods in class 14, including “ <i>horological and chronometric instruments</i> ”.
Sixth Claimant (“Tissot”)	
14.	WO(EM)1256550: word mark TISSOT (“Tissot EU550”), registered for goods in class 9, including (translated from French) “ <i>wrist computers; electronic apparatus incorporating a time display</i> ”.
15.	EM000225698: figurative mark  (“Tissot Stylised EU698”), registered for goods in class 14, including “ <i>horological and chronometric instruments</i> ”.
16.	WO(EM)0749521: figurative mark  (“T Touch Stylised EU521”), registered for goods in class 14, including “ <i>watches</i> ”.
17.	UK00002552141: word mark TISSOT NAVIGATOR (“Tissot Navigator UK141”), registered for “ <i>horological and chronometric instruments</i> ” (class 14).
Seventh Claimant (“Mido”)	
18.	EM000103358: word mark MIDO (“Mido EU358”), registered for goods in class 14 including “ <i>horological and chronometric instruments</i> ”.
Eighth Claimant (“Hamilton”)	
19.	EM013496013: word mark HAMILTON (“Hamilton EU013”), registered for goods in classes 9 and 14, including “ <i>smartphones in the shape of a watch</i> ” (class 9) and “ <i>watches [and] watches that communicate data to smartphones</i> ” (class 14).
Ninth Claimant (“Swatch”)	
20.	WO(EM)1329569: word mark SWATCH (“Swatch EU569”), registered for goods in class 9, including “ <i>smartwatches</i> ”.
21.	EM000226019: word mark SWATCH (“Swatch EU019”) registered for goods in class 14 including “ <i>horological and chronometric instruments</i> ”.
Tenth Claimant (“Glashütte”)	
22.	EM013657994: figurative mark  (“Glashütte Original Device EU994”), registered for goods in classes 3, 9, 16, 18, 25, 35 and 37, including “ <i>computers worn on the wrist; electronic apparatus incorporating a time display</i> ” (class 9).
23.	EM004821773: figurative mark  (“Glashütte Original Device EU773”), registered for goods in class 14, including “ <i>watches</i> ”.




APPENDIX 2: THE APPS IN ISSUE

App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
1.	1.1, 2.1	 <p>App name: Glashaus-Panoma App seller: Ahoi Atlantic</p>	<p>The sign on the watch face is allegedly identical to  Glashütte Original Device EU994 (1.1)</p> <p>The sign on the watch face is allegedly identical to  Glashütte Original Device EU773 (2.1)</p>
2.	1.2, 2.2	 <p>App name: Tropical Birds by Jaquet Droz /¹⁶ Freedom Republic App seller: Alexei Bogomolov</p>	<p>The app name is allegedly identical to Jaquet Droz EU802 (1.2)</p> <p>The sign on the watch face is allegedly identical to Jaquet Droz EU802 (1.2)</p> <p>The app name is allegedly identical to Jaquet Droz EU224 (2.2)</p> <p>The sign on the watch face is allegedly identical to Jaquet Droz EU224 (2.2)</p>
3.	1.3, 2.3	 <p>App name: Breguet Face App seller: Alok Charma</p>	<p>The app name is allegedly identical to Breguet EU675 (1.3)</p> <p>The sign on the watch face is identical to Breguet EU675 (as admitted by the First Defendant in Annex 2 to the Amended Defence of the First Defendant) (1.3)</p> <p>The app name is allegedly identical to Breguet EU881 (2.3)</p>




¹⁴ As the Court was not provided with a unique ID in respect of the Apps, one is assigned in this table via sequential numbering in the order that each App first appears in Appendix 1 to the APoC. This approach was agreed with the parties following the trial.




¹⁵ References in parenthesis relate to location in APoC Appendix 1.




¹⁶ Where “/” appears in the app name, that signifies a separate line of text.







App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
			<p>The sign on the watch face is identical to Breguet EU881 (as admitted by the First Defendant in Annex 2 to the Amended Defence of the First Defendant) (2.3)</p>
4.	1.4, 2.4	 <p>App name: Graftic (rEwatch) / spiderock App seller: Andrea Vargiu</p>	<p>The sign on the watch face is allegedly identical to Swatch EU569 (1.4)</p> <p>The sign on the watch face is allegedly identical to Swatch EU019 (2.4)</p>
5.	1.5, 2.6	 <p>App name: Swatch Orange Black WF App seller: Erol Yenigun</p>	<p>The app name is allegedly identical to Swatch EU569 (1.5)</p> <p>The sign on the watch face is allegedly identical to Swatch EU569 (1.5)</p> <p>The app name is allegedly identical to Swatch EU019 (2.6)</p> <p>The sign on the watch face is allegedly identical to Swatch EU019 (2.6)</p>
6.	1.6, 2.7		<p>The app name is allegedly identical to Jaquet Droz EU802 (1.6)</p> <p>The sign on the watch face is allegedly identical to Jaquet Droz EU802 (1.6)</p> <p>The app name is allegedly identical to Jaquet Droz EU224 (2.7)</p> <p>The sign on the watch face is allegedly identical to Jaquet Droz EU224 (2.7)</p>




App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
		<p>App name: Thomasse clock Jaquet Droz <i>App seller: Gerard Thomasse</i></p>	
7.	1.7, 2.8, 4.2	 <p>App name: Tissot Navigator 3000 <i>App seller: German Gomez</i></p>	<p>The app name is allegedly identical to Tissot EU550 (1.7)</p> <p>The sign on the watch face is allegedly identical to Tissot EU550 (1.7)</p> <p>The app name is allegedly identical to TISSOT Tissot Stylised EU698 (2.8)</p> <p>The sign on the watch face is allegedly identical to TISSOT Tissot Stylised EU698 (2.8)</p> <p>The app name is allegedly identical to TISSOT NAVIGATOR UK141 (4.2)</p> <p>The sign on the watch face is allegedly identical to TISSOT NAVIGATOR UK141 (4.2)</p>
8.	1.8, 2.9	 <p>App name: Tissot Watch Face <i>App seller: Greg Holl</i></p>	<p>The app name is allegedly identical to Tissot EU550 (1.8)</p> <p>The sign on the watch face is allegedly identical to Tissot EU550 (1.8)</p> <p>The app name is allegedly identical to TISSOT Tissot Stylised EU698 (2.9)</p> <p>The sign on the watch face is allegedly identical to TISSOT Tissot Stylised EU698 (2.9)</p>





App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
9.	1.9, 2.11	 <p>App name: Swatch Gold / Kirillch's Watchface App seller: Krill Churnossov</p>	<p>The app name is allegedly identical to Swatch EU569 (1.9)</p> <p>The sign on the watch face is allegedly identical to Swatch EU569 (1.9)</p> <p>The app name is allegedly identical to Swatch EU019 (2.11)</p> <p>The sign on the watch face is allegedly identical to Swatch EU019 (2.11)</p>
10.	1.10, 2.13	 <p>App name: Swatch – Red Sunday App seller: Vitaljis Russanova</p>	<p>The app name is allegedly identical to Swatch EU569 (1.10)</p> <p>The sign on the watch face is allegedly identical to Swatch EU569 (1.10)</p> <p>The app name is allegedly identical to Swatch EU019 (2.13)</p> <p>The sign on the watch face is allegedly identical to Swatch EU019 (2.13)</p>
11.	1.11, 2.15	 <p>App name: SWatch App seller: Inhoon Ko</p>	<p>The app name is identical to Swatch EU569 (as admitted by the First Defendant in Annex 2 to the Amended Defence of the First Defendant) (1.11)</p> <p>The app name is identical to Swatch EU019 (as admitted by the First Defendant in Annex 2 to the Amended Defence of the First Defendant) (2.15)</p>







App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
12.	1.12, 2.16	 <p>App name: Moon Watch App seller: Yu Cao</p>	<p>The sign on the watch face is identical to <i>Glashütte ORIGINAL</i> Glashütte Original Device EU994 (as admitted by the First Defendant in Annex 2 to the Amended Defence of the First Defendant) (1.12)</p> <p>The sign on the watch face is identical to <i>Glashütte ORIGINAL</i> Glashütte Original Device EU773 (as admitted by the First Defendant in Annex 2 to the Amended Defence of the First Defendant) (2.16)</p>
13.	1.13, 2.17	 <p>App name: BFF: Blancpain Villeret Black analog watch face for gear S2,S3 / BFF-STORM App seller: Stormer</p>	<p>The app name is allegedly identical to Blancpain EU990 (1.13)</p> <p>The app name is allegedly identical to Blancpain EU772 (2.17)</p>
14.	1.14, 2.5	 <p>App name: Hamilton by BFX / Butterfly FX</p>	<p>The app name is allegedly identical to Hamilton EU013 (1.14, 2.5)</p> <p>The sign on the watch face is allegedly identical to Hamilton EU013 (1.14, 2.5)</p>







App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
		<p><i>App seller: Butterfly FX David Jurgensen</i></p>	
15.	2.10	 <p>App name: Gear Digital Tissot Replica Classic Chronometer Black AOD / AURORA <i>App seller: Hada Gutnova</i></p>	<p>The sign on the watch face is allegedly identical to  T Touch Stylised EU521</p>
16.	2.12	 <p>App name: Omega SKT <i>App seller: TM</i></p>	<p>The sign on the watch face is allegedly identical to Speedmaster EU615</p>

App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
17.	2.14, 3.16	 <p>App name: Aurora Longines 1973 / Chronometer Classic Black AOD / AURORA App seller: Butterfly FX David Jurgensen</p>	<p>The app name is allegedly identical to Longines EU233 (2.14)</p> <p>The sign on the watch face is allegedly similar to  Longines Device EU298 (3.16)</p>
18.	2.18	 <p>App name: Unknown App seller: Erol Yenigun</p>	<p>The figurative sign at the top of the watch face is allegedly identical to  Omega Device EU474</p> <p>The word sign, which is alleged to read DE VILLE, is allegedly identical to De Ville EU282</p>
19.	3.1		<p>The sign on the watch face is allegedly similar to  OMEGA Omega & Device EU609</p>



App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
		<p>App name: DXB Watch Alpha Moonwatch / DXB Watches Dubai <i>App seller: DXB Watches Dubai</i></p>	
20.	3.2, 3.12	 <p>App name: Boogaloo-Mega Studiomaster I / Boogaloo <i>App seller: Helmut Sinor</i></p>	<p>The app name is allegedly similar to Speedmaster EU615</p> <p>The sign on the watch face is allegedly similar to Speedmaster EU615 and Ω OMEGA Omega & Device EU609</p>
21.	3.3	 <p>App name: Boogaloo-Mega Racer I / Boogaloo <i>App seller: Helmut Sinor</i></p>	<p>The sign on the watch face is allegedly similar to Speedmaster EU615 and Ω OMEGA Omega & Device EU609</p>
22.	3.4, 3.11, 3.13		<p>The sign on the watch face is allegedly similar to Speedmaster EU615 and Ω OMEGA Omega & Device EU609</p>

App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
		<p>App name: Boogaloo-Mega Racer II / Boogaloo <i>App seller: Helmut Sinor</i></p>	
23.	3.5	 <p>App name: KT Akemo Globemaster – Analog / Swiss inspired Chronometer / Kammensek Timepieces <i>App seller: Kammensek Timepieces</i></p>	<p>The app name is allegedly similar to  Omega Globemaster & Device WO944</p> <p>The sign on the watch face is allegedly similar to  Omega Globemaster & Device WO944</p>
24.	3.6	 <p>App name: MRV Contact / MRV <i>App seller: Manuel Reina Varea</i></p>	<p>The sign on the watch face is allegedly similar to  TOUCH T Touch Stylised EU521</p>

App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
25.	3.7	 <p>App name: Nimo W16G / NIMO watches App seller: Mohammad Saberi</p>	The sign on the watch face is allegedly similar to  OMEGA Omega & Device EU609
26.	3.8	 <p>App name: RTWATCH6 App seller: Ratis Turss</p>	The sign on the watch face is allegedly similar to  TOUCH T Touch Stylised EU521
27.	3.9	 <p>App name: RTWATCH4 App seller: Ratis Turss</p>	The sign on the watch face is allegedly similar to  TOUCH T Touch Stylised EU521





App Number ¹⁴	APoC Appendix 1 Reference	Sign (allegedly infringing watch face app)	Relevant Trade Marks ¹⁵
28.	3.10	 <p>App name: RTWATCH5 App seller: Ratis Turss</p>	The sign on the watch face is allegedly similar to  TOUCH T Touch Stylised EU521
29.	3.14	 <p>App name: Mido Time / by Andi App seller: Andrey Antipin</p>	The app name is allegedly similar to Mido EU358
30.	3.15	 <p>App name: RM_OmegaClassic_Mens / SWFD App seller: Evgeny Trofimov</p>	The app name is allegedly similar to  OMEGA Omega & Device EU609 The sign on the watch face is allegedly similar to  OMEGA Omega & Device EU609

APPENDIX 3: CONCLUSIONS ON INDIVIDUAL MARKS AND SIGNS




App Number	Conclusions ¹⁷
1.	<p>The sign on the watch face is not identical to  Glashütte Original Device EU994 (1.1) or  Glashütte Original Device EU773 (2.1). The average consumer would notice the difference between Glashütte and Glashaus. However, there is a high degree of similarity (visual, but also aural and conceptual) and a likelihood of confusion.</p>
2.	<p>The app name is identical to Jaquet Droz EU802 (1.2) and Jaquet Droz EU224 (2.2). The addition of “Tropical Birds” just describes the product and “by Jaquez Droz” conveys trade mark origin. “Freedom Republic”, which appears on a separate line, would be perceived as a separate sign.</p> <p>The sign on the watch face is identical to Jaquet Droz EU802 (1.2) and Jaquet Droz EU224 (2.2). The relevant sign is Jaquet Droz. The “JD” would be perceived as a separate sign.</p>
3.	<p>The app name is identical to Breguet EU675 (1.3) and Breguet EU881 (2.3). The relevant sign is “Breguet” and the addition of “Face” is descriptive.</p> <p>The sign on the watch face is identical to Breguet EU675 (1.3) and Breguet EU881(2.3) (as admitted by the Defendants)</p>
4.	<p>The sign on the watch face is identical to Swatch EU569 (1.4) and Swatch EU019 (2.4). The sign is “Swatch”. “Swiss” is a descriptor, adding nothing of trade mark impact, as opposed to confirming that Swatch watches are Swiss made.</p>
5.	<p>The app name is identical to Swatch EU569 (1.5) and Swatch EU019 (2.6). “Orange Black WF” is clearly a descriptor of the watch face, which has a black background and orange hands and markings. The relevant sign is Swatch.</p> <p>The sign on the watch face is identical to Swatch EU569 (1.5) and Swatch EU019 (2.6): see 4. above</p>
6.	<p>The app name is identical to Jaquet Droz EU802 (1.6) and Jaquet Droz EU224 (2.7). In context “Thomasse clock” appears descriptive of the design or designer, whereas “Jaquet Droz” has clear trade mark impact. The sign is Jaquet Droz.</p> <p>The sign on the watch face is identical to Jaquet Droz EU802 (1.6) and Jaquet Droz EU224 (2.7): see 2. above.</p>
7.	<p>The app name is identical to TISSOT NAVIGATOR UK141 (4.2), with the 3000 appearing as descriptive of the design rather than as part of the sign, or alternatively</p>




¹⁷ References in parenthesis relate to the location in Appendix 1 to the APoC.

App Number	Conclusions ¹⁷
	<p>as a number that may go unnoticed. The app name is not identical to TISSOT Tissot Stylised EU698 (2.8) or Tissot EU550 (1.7). “Tissot” is not all capitalised in the app name (as compared to the stylised mark) and the “Navigator” that follows appears on the same line and has equal prominence: it is part of the sign. However, the app name has a medium to high level of similarity with Tissot EU550 (1.7) and TISSOT Tissot Stylised EU698, and there is also a likelihood of confusion. In context, the visual, aural and conceptual impact of the distinctive “Tissot” would dominate.</p> <p>The sign on the watch face has a medium to high level of similarity to TISSOT NAVIGATOR UK141 (4.2), Tissot EU550 (1.7) and TISSOT Tissot Stylised EU698 (2.8), in each case with a likelihood of confusion.</p> <p>Unlike the app name, “Tissot” and “Navigator” not only appear on different lines but with different fonts and text sizes (the latter being much smaller). The “3000” is also presented in a way that appears to give it greater significance than in the app name, adjacent to Navigator but coloured and in bold for emphasis. This is sufficient to prevent identity with UK141. There is clearly similarity and a likelihood of confusion, but the identity of words is offset by these factors.</p> <p>However, the distinction in appearance between “Tissot” and “Navigator” also means that the “Tissot” element stands out (albeit that there is some difference in font from the stylised mark), such that there is relatively strong visual similarity (in particular) with Tissot EU550 (1.7) and TISSOT Tissot Stylised EU698 (2.8), as well as aural and conceptual similarity.</p>
8.	<p>The app name is identical to Tissot EU550 (1.8). “Watch Face” is a descriptor and the relevant sign is Tissot. The app name is not identical to TISSOT Tissot Stylised EU698 (2.9) because the Tissot is not all capitalised and so is visually different (although aurally and conceptually the same), but it is highly similar with a likelihood of confusion.</p> <p>The sign on the watch face is identical to Tissot EU550 (1.8) and TISSOT Tissot Stylised EU698 (2.9). “1853” is a descriptor. The relevant sign is “TISSOT”. The slight difference in font as compared to EU698 is too small to be noticed.</p>
9.	<p>The app name is identical to Swatch EU569 (1.9) and Swatch EU019 (2.11). The relevant sign is “Swatch” and the addition of “Gold” is descriptive of the colouring on the hands and markings. The words “Kirillch’s Watchface” appear on a separate line, as a separate sign and/or indicative of the designer.</p> <p>The sign on the watch face is identical to Swatch EU569 (1.9) and Swatch EU019 (2.11). The addition of “Chronometer” is descriptive and the relevant sign is “Swatch”.</p>
10.	<p>The app name is identical to Swatch EU569 (1.10) and Swatch EU019 (2.13). The additional words “Red Sunday”, following a dash, are descriptive of the product, or alternatively a separate sign. The relevant sign is “Swatch”.</p>

App Number	Conclusions ¹⁷
	The sign on the watch face is identical to Swatch EU569 (1.10) and Swatch EU019 (2.13): see app 4 above.
11.	The app name is identical to Swatch EU569 (1.11) and Swatch EU019 (2.15) (as admitted by the Defendants).
12.	The sign on the watch face is identical to  Glashütte Original Device EU994 (1.12) and  Glashütte Original Device EU773 (2.16) (as admitted by the Defendants).
13.	The app name is identical to Blancpain EU990 (1.13) and EU772 (2.17). Blancpain stands out as the sign. “Villeret Black” is descriptive (Villeret is a Swiss municipality). The addition of “BFF:” is likely to go unnoticed. Alternatively, if either of these points were wrong there is a high level of similarity and a likelihood of confusion. The use of the distinctive “Blancpain” dominates and there is a precise visual, aural and conceptual match in respect of that word. “BFF-Storm” is in any event a separate sign.
14.	<p>The app name is identical to Hamilton EU013 (1.14, 2.5). The relevant sign is “Hamilton”. Although the addition of “by BFX” conveys origin or source, it is not sufficient to mean that “Hamilton” is being used for purely descriptive purposes, rather than in a way liable to affect the functions of the mark. The “by” also separates the sign Hamilton from BFX.</p> <p>The sign on the watch face is identical to Hamilton EU013 (1.14, 2.5). “BUTTERFLYFX” conveys the impression of describing the particular design rather than denoting trade origin, and/or is a separate sign. In respect of the pleading in Part 2 of Appendix 1 to the APoC, there is a likelihood of confusion. Hamilton is a highly distinctive mark.</p>
15.	The sign on the watch face is identical to  T Touch Stylised EU521 (2.10). The mark is registered in black and white rather than limited by reference to certain colours, so there is no issue with the red colouring of the encircled “T”.
16.	The sign on the watch face is identical to Speedmaster EU615 (2.12). The remainder is descriptive, and its different colour and font also separate it from the sign, which is Speedmaster.
17.	<p>The app name is not identical to Longines EU233 (2.14). Whilst “Chronometer Classic Black” is descriptive and not part of the sign, and “AOD/AURORA” are separate signs, the addition of “Aurora” before “Longines” would not go unnoticed and is part of the sign. However, there is at least a medium degree of similarity and a likelihood of confusion. Longines is highly distinctive and exactly matches the mark, more so than Aurora, which has an independent meaning as a word and an element of descriptiveness in concept. “1973” is descriptive.</p> <p>The sign on the watch face is not similar to  Longines Device EU298 (3.16).</p>

App Number	Conclusions ¹⁷
18.	<p>The figurative sign at the top of the watch face is not identical to Ω Omega Device EU474 (2.18). The shape somewhat resembles the mark but without the distinctive horizontal lines at the base. The shape is also more elongated and less well defined. The differences would not go unnoticed by the average consumer. However, they have a medium degree of similarity (visually and also conceptually) and there is a likelihood of confusion.</p> <p>The word sign on the watch face is alleged to read DE VILLE and is therefore said to be identical to De Ville EU282. Samsung suggests that it is not clear whether the sign comprises only the letters DE V E. However, this is because the sign is partially obscured by a watch hand. Given the spacing and the obvious attempt to produce a sign elsewhere on the watch face that is similar to an Omega mark, I am prepared to conclude that the sign used has a high degree of similarity with the DE VILLE mark (visually but also aurally and conceptually) and a likelihood of confusion (noting, relevant to context, that the DE VILLE mark is also an Omega mark, and the sign is being used on a watch face with another sign similar to the Omega device).</p>
19.	<p>The sign on the watch face has a low level of similarity to Ω OMEGA Omega & Device EU609 (3.1). The word represents a different Greek letter (“Alpha”). The symbol at the top is partially obscured but I infer that it is the alpha symbol α. However, there is an element of similarity given similarity in visual shape and concept. Both use Greek letters, with the word appearing under the shape and in what appears to be a not dissimilar font. Alpha and Omega are also often used in conjunction. Despite these points, the distinctiveness of the Omega mark and the context of use on a watch face, I consider the similarity to be insufficient for there to be a likelihood of confusion. In particular, the visual differences are too great. This conclusion is reinforced by the addition of “BY DXB WATCHES” on the watch face. However, the sign does call the mark to mind for Article 9(2)(c) purposes.</p>
20.	<p>The app name has a low level of similarity to Speedmaster EU615 (3.2). The “Boogaloo-Mega” appears as part of the sign and the word that follows also reads “Studiomaster” not Speedmaster. That word has some visual (and aural) similarity to Speedmaster but the similarity is limited. Given the limited similarity and in particular the prior reference to “Boogaloo-Mega”, I do not consider there to be a likelihood of confusion, despite the distinctiveness of Speedmaster and the context of a watch face app.</p> <p>There are two relevant signs on the watch face, which respectively have a medium level of similarity to Ω OMEGA Omega & Device EU609 and a low to medium level of similarity to Speedmaster EU615. I disagree with Samsung that the relevant sign has to be read as including both “MEGA” and “Studiomaster” (though I do agree that the marks cannot be combined as part of the assessment of similarity). Rather, the average consumer, who would be familiar with the distinctive Ω OMEGA, would read them as separate signs. They are not only on separate lines but in very different fonts. They are also followed by an additional separate sign, “Boogaloo”.</p>

App Number	Conclusions ¹⁷
	<p>As regards EU609, the watch face shows a sign consisting of a nearly closed circle with two shorter lines drawn towards the centre of the circle from the bottom. Below this shape the word “MEGA” is written. There is a medium level of similarity, particularly visual but to some extent conceptual and aural, given that they both contain open, circular shapes and the letters “MEGA” underneath. There is also a likelihood of confusion given that the sign includes important features of Omega’s circular symbol and the letters “MEGA” comprise four out of the five letters of Omega. This is despite the fact that “MEGA” can be regarded as conceptually different, conveying a sense of something very large.</p> <p>As regards Speedmaster EU615 and the sign on the watch face, the app displays the word “Studiomaster” underneath the “MEGA” sign discussed above. A low to medium level of similarity exists here, as well as a likelihood of confusion because the word “Studiomaster” has some similarity to “Speedmaster” visually and aurally, and appears in the context of the MEGA sign on a watch face. Further, the italicized font in which the word appears on the watch face make distinguishing it from the protected word mark more difficult, especially when not examining the depicted sign in detail.</p>
21.	See findings on app 20 in respect of the watch face.
22.	See findings on app 20 in respect of the watch face. Here the separateness of the signs is also reinforced by the different colour in which “Studiomaster” appears.
23.	<p>The app name has a low level of similarity to  Omega Globemaster & Device WO944 (3.5). I am not persuaded that there is a likelihood of confusion given the use of “Akemo” rather than Omega and given the reference to “Swiss inspired”.</p> <p>The sign on the watch face has a low level of similarity to  Omega Globemaster & Device WO944. The watch face shows a triangular shape at the top, below which the words “Akemo” and “Globemaster” appear (the latter in smaller letters and italicised). The use of the word “Globemaster” give rise to some similarity with an Omega Globemaster. However, I do not consider there is a likelihood of confusion given the differences in this watch face, in particular the word “Akemo”, which is not similar to “Omega” (visually, aurally or conceptually), and the triangular sign as opposed to Omega’s rounded sign. Globemaster is not a dominant element of the mark or sign. However, the sign does call the mark to mind for Article 9(2)(c) purposes.</p>
24.	<p>On the watch face of this app the word “Contact” appears with the “C” in red and encircled in a manner similar to the mark. This has a low level of similarity to  T Touch Stylised EU521 (3.6), visually and conceptually, bearing in mind the use of a synonym of “Touch”. However, I do not consider there is a likelihood of confusion given that an entirely different word is being used and the design, whilst reminiscent of the mark, is sufficiently differentiated visually (e.g., the</p>

App Number	Conclusions ¹⁷
	letter encircled in red is a “C” and not a “T”) to avoid a likelihood of confusion. However, it does call the mark to mind for Article 9(2)(c) purposes.
25.	<p>The sign on the watch face has a low to medium degree of similarity to  Omega & Device EU609 (3.7).</p> <p>In this App an open circular shape is shown at the top of the watch face with the letters “OMG” below it. The circular sign has some similarity to the circular part of the Omega sign (albeit without the two horizontal lines at the bottom opening of the circle) and the letters (likely deliberately) invoke Omega in a font similar to that of the mark. However, in view of the difference in visual appearance and the difference in meaning (as well as difference phonetically) that “OMG” would convey to the average consumer I do not consider there to be a material likelihood of confusion. Nevertheless the sign does call the mark to mind for Article 9(2)(c) purposes.</p>
26.	<p>The sign on the watch face has a low level of similarity to  TOUCH T Touch Stylised EU521 (3.8)</p> <p>In the middle of the watch face, just below the centre, there is a sign, which reads “T RTWatch”. The first “T” is encircled in red, in a manner very similar to the first T in the mark. The font used in the app’s sign has some similarity to the font used in the mark, but with some characters in lower case. The combination of some visual and conceptual similarity, in particular the use of an encircled “T”, which provides a strong associative link to the mark, leads to a conclusion that there is some similarity. In this case I am also prepared to accept that there is a likelihood of confusion, taking account of the context and distinctiveness of the mark.</p> <p>The watch face also says “Galaxy Watch” in the upper part of the dial. This is a separate sign, indicative of Samsung Galaxy. The overall impression given is one of collaboration.</p>
27.	See findings on app 26.
28.	See findings on app 26.
29.	<p>The app name has at least a high level of similarity to Mido EU358 (3.14). (I note that identity was not pleaded.)</p> <p>The app name is “Mido Time / by Andi”. “Time” is descriptive and the relevant sign is Mido. Although the “by Andi” suggests origin or source, it is not sufficient to mean that Mido is being used for purely descriptive purposes rather than as an indicator of origin. The “by” also separates the sign Mido from Andi. Taking account of the distinctiveness of Mido, there is a likelihood of confusion.</p>
30.	<p>The app name has a low to medium level of similarity to  Omega & Device EU609 (3.15). The app name includes “Omega”, as part of a longer phrase that includes “RM” separated by an underscore, and with the addition of “Classic” with no space but a capital letter to distinguish it, and “Mens”. Both “Classic” and “Mens” are descriptive and the initial “RM” is not enough to prevent similarity (and indeed may well go unnoticed). “SWFD” appears as a separate sign. Given in particular the distinctiveness of Omega as a watch brand there is a likelihood of confusion.</p>

App Number	Conclusions¹⁷
	The sign on the watch face is not similar to ^Ω OMÉGA Omega & Device EU609. The only sign displayed on the watch face appears to be “rm” in dark letters and a font different from the mark. The sign displayed also contains no Greek letters or other symbols that could establish a similarity with the mark.