



Samsung obtains partial revocation of Tissot's trademark rights

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Legal updates: case law analysis and intelligence

- Samsung sought the revocation of the mark TISSOT for a range of goods in Class 14, arguing that Tissot had failed to demonstrate genuine use of the mark
- The Cancellation Division found that, while the evidence sufficiently demonstrated genuine use for watches, it was insufficient for other goods in Class 14
- No evidence demonstrated the independent marketing or sale of jewellery or precious stones under the mark

The EUIPO has partially revoked Tissot SA's EU trademark No 225 698, depicted below, following a revocation action initiated by Samsung Electronics Co Ltd ([Cancellation No C 55 201](#)):

TISSOT

The decision, issued on 5 December 2024, narrows Tissot's trademark protection and marks a significant development in the ongoing dispute between the two companies.

Background

Samsung's revocation action targeted a range of goods in Class 14, which includes watches, jewellery and related products. Samsung argued that Tissot had failed to demonstrate genuine use of the trademark for certain goods during the relevant five-year period, as required by Article 58(1)(a) of [Regulation 2017/1001](#). The revocation action sought to limit Tissot's trademark rights to reflect its actual use and mitigate the impact of EU-wide injunctions that Tissot had obtained against Samsung for alleged trademark infringement in earlier UK proceedings.

Decision

The EUIPO's Cancellation Division partially upheld Samsung's request, revoking Tissot's trademark rights for following goods in Class 14:

“ *Precious metals and their alloys and goods in precious metals or coated therewith (except watches); jewellery, precious stones, horological and chronometric instruments (except watches), cases for watches [presentation], parts of watches, watch movements.* ”

However, the trademark remained valid for the following goods in Class 14:

“ *Goods in precious metals or coated therewith, namely watches; horological and chronometric instruments, namely watches; watches.* ”

Under Article 58(1)(a) of the regulation, a trademark may be revoked if it has not been put to genuine use in the European Union for a continuous period of five years in connection with the goods or services for which it is registered.

To prove use, Tissot submitted various forms of evidence, including invoices, product catalogues and advertising materials. While these documents sufficiently demonstrated genuine use for watches, the Cancellation Division found the evidence insufficient for other goods in Class 14. For instance, the Cancellation Division noted that, while some Tissot watches incorporated these materials no evidence demonstrated the independent marketing or sale of jewellery or precious stones under the contested trademark. Further, the evidence showed use of watch movements and parts within complete watches, but failed to establish their sale as standalone goods under the trademark. Lastly, the Cancellation Division determined that presentation cases for watches were merely ancillary to the sale of watches and were not marketed independently in a manner that showed genuine use.

Samsung had argued that the trademark's protection should be limited to analogue watches, reflecting its actual use. The Cancellation Division rejected this argument, deciding that watches constitute a homogeneous category that cannot be divided by specific features, such as analogue or digital mechanisms.

Comment

This decision could impact both parties, but is not unexpected as it reflects established case law. For Samsung, the partial revocation slightly reduces Tissot's trademark rights, potentially undermining the enforceability of the EU-wide injunctions issued against Samsung. This may provide Samsung with more flexibility to defend its smartwatches against infringement claims.

For Tissot, the ruling highlights the importance of maintaining comprehensive evidence of genuine use for all goods covered by a trademark registration. Although the company kept its core rights over watches, the revocation of protection for related goods narrows its trademark portfolio, which could have broader commercial implications.

The EUIPO's decision reinforces the principle that trademark rights depend on genuine use. This ruling not only highlights the importance of aligning trademark registrations with actual commercial practices, but also reflects the growing complexities of trademark disputes in industries where traditional and technological products increasingly overlap.

As this case progresses in related litigation, the partial revocation could, to some degree, influence the strategic decisions of both Samsung and Tissot, although substantial changes are unlikely. For other trademark owners, it serves as a clear reminder to review their portfolios regularly to ensure alignment with genuine use and avoid potential vulnerabilities in legal challenges.

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