

**GUIDELINES FOR EXAMINATION OF  
EUROPEAN UNION TRADE MARKS**

**EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE  
(EUIPO)**

**Part C**

**Opposition**

**Section 6**

**Proof of use**

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## **1 General Considerations**

### **1.1 Function of proof of use**

European Union legislation on trade marks establishes an obligation for the owner of a registered trade mark to use that mark in a genuine manner. The obligation of use is not applicable immediately after registration of the earlier mark. Instead, the owner of a registered mark has a 'grace period' of five years, during which it is not necessary to demonstrate use of the mark in order to rely upon it — including in opposition proceedings before the Office. After this grace period, the owner may be required to demonstrate use of the earlier mark for the relevant goods and services. Before this period lapses, the mere formal registration gives the mark full protection.

The reason behind the requirement that earlier marks can be required to demonstrate that they have been put to genuine use is to restrict the number of trade marks registered and protected and, consequently, the number of conflicts between them (12/03/2003, T-174/01, Silk Cocoon, EU:T:2003:68, § 38).

When it comes to the requirement to prove use in opposition proceedings before the Office, it is important to bear in mind that the purpose of Article 47(2) and (3) EUTMR is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to only large-scale commercial use of the marks (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 32; 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 38).

The Office does not inquire *ex officio* whether the earlier mark has been used. Such examination takes place only when the EUTM applicant makes an explicit request for proof of use. Such a request, if the legal requirements are met, triggers the procedural and substantive consequences laid down in the EUTMR, EUTMDR and EUTMIR.

### **1.2 Legislative framework**

The legislative framework consists of provisions of the EUTMR, the EUTMDR, the EUTMIR and Directive (EU) 2015/2436 approximating the laws of the Member States relating to trade marks<sup>69</sup> (the Directive), as implemented in the national law of the Member States.

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<sup>69</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

## 1.2.1 EUTMR, EUTMDR and EUTMIR

### 1.2.1.1 Article 18 EUTMR — obligation to use registered marks

Article 18 EUTMR stipulates the basic substantive requirement for the obligation to use registered marks. It reads as follows:

If, within a period of five years following registration, the proprietor has not put the EU trade mark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the EU trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

According to Article 18(1)(a) and (b) EUTMR, use of the EUTM in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor, and the affixing of the EUTM to goods or to the packaging thereof in the European Union solely for export purposes, also constitute use within the meaning of Article 18(1) EUTMR.

According to Article 18(2) EUTMR, use of the EUTM with the consent of the proprietor will be deemed to constitute use by the proprietor.

### 1.2.1.2 Article 47 EUTMR — consequences of lack of use

The consequences of a lack of use in opposition proceedings are dealt with in Article 47(2) and (3) EUTMR. According to Article 47(2) EUTMR:

If the applicant so requests, the proprietor of an earlier EU trade mark who has given notice of opposition shall furnish proof that, during the five-year period preceding the date of filing or the date of priority of the EU trade mark application, the earlier EU trade mark has been put to genuine use in the Union in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier EU trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier EU trade mark has been used in relation to only part of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

This wording is the result of Amending Regulation (EU) 2015/2424<sup>70</sup>, which entered into force on 23/03/2016. Previously, the 5-year period was computed backwards from the date of publication of the contested EUTM application. For oppositions filed before the date of entry into force of Amending Regulation (EU) 2015/2424, the relevant

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<sup>70</sup> Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2839/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

period will continue to be counted from the date of publication of the contested EUTM application.

In accordance with Article 47(3) EUTMR:

Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Union.

There is no express provision in the EUTMR that such forms of use as mentioned in Article 18(1) and (2) EUTMR may also be regarded as use of earlier national trade marks. However, the concept of the obligation to use the registered mark is harmonised as a consequence of Article 10(2) and (3) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (Codified version). Hence, it is appropriate to apply the same substantive provision as Article 18(1) and (2) EUTMR to the use of earlier national trade marks, with the only difference being that such use must be made in the Member State in which the national mark is registered.

Moreover, it follows from the wording of Article 47(2) and (3) EUTMR that proof of use can only be requested if the earlier right is an EUTM or other trade mark having effect in the EU or an EU Member State, as defined in Article 8(2)(a) EUTMR. Since oppositions brought under Article 8(4) EUTMR cannot be based on either EUTMs or other trade marks referred to in Article 8(2)(a) EUTMR, the EUTM applicant is not entitled to request proof of use for earlier rights relied upon in oppositions brought under this provision. Nevertheless, Article 8(4) EUTMR requires the opponent to prove use in the course of trade of more than mere local significance for the earlier rights in question.

As for Article 8(3) EUTMR, the Office's practice is that requests for proof of use of the earlier right cannot be made. The reason is that such earlier rights include both trade marks having effect in the EU/EU Member States (EUTMs, national trade marks, IRs) and national non-EUTMs, requests for proof of use of the latter not being possible under the EUTMR. It would be discriminatory to request proof of use for some countries' trade marks but not for others. Accordingly, and in view of the specific subject matter for protection under Article 8(3) EUTMR, while the use or lack of use made of the earlier rights may have a bearing on arguments regarding the justification for applying for the EUTM, the opponent cannot be obliged to provide proof of use under Article 47(3) EUTMR for any earlier rights thereby relied upon.

#### 1.2.1.3 Article 10 EUTMDR — procedural rules, evidence and language

In accordance with Article 10(2) EUTMDR, where, pursuant to Article 47(2) or (3) EUTMR, the opponent has to submit proof of use or show that there are proper reasons for non-use, the Office will invite the opponent to provide the proof required within a period specified by the Office. If the opponent does not provide such proof before the time limit expires, the Office will reject the opposition.

In accordance with Article 10(3) EUTMDR, the indications and evidence required to prove use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 4.

In accordance with Article 10(4) EUTMDR, the evidence must consist of written documents and in principle be confined to supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 97(1)(f) EUTMR.

In accordance with Article 10(5) EUTMDR, a request for proof of use may be submitted at the same time as observations on the grounds on which the opposition is based. Such observations may also be filed together with the observations in reply to the proof of use.

In accordance with Article 10(6) EUTMDR, where the evidence submitted pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opponent to submit a translation of the evidence in that language, within a period specified by the Office.

#### 1.2.2 The Directive and national law implementing it

Article 16 of the Directive contains provisions identical to Article 18 EUTMR, except with 'use in the Union' being replaced by 'use in the Member State'.

## 2 Substantive Law

### 2.1 Genuine use: the principles of the Court of Justice

The EUTMR, the EUTMDR and the EUTMIR do not define what is to be regarded as 'genuine use'. However, the Court of Justice (the 'Court') has laid down several important principles as regards the interpretation of this term.

In *Minimax* (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145), the Court established the following principles:

- genuine use means actual use of the mark (paragraph 35);
- genuine use must, therefore, be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark (paragraph 36);
- genuine use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling the latter, without any possibility of confusion, to distinguish the product or service from others that have another origin (paragraph 36);
- genuine use entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned (paragraph 37);



- genuine use must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (paragraph 37);
- when assessing whether there has been genuine use, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark (paragraph 38);
- the circumstances of the case may, therefore, include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark (paragraph 39);
- use need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (paragraph 39).

In its order of 27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, the Court further elaborated the Minimax criteria as follows:

- the question whether use is sufficient to preserve or create market share for the goods or services concerned depends on several factors and on a case-by-case assessment. The characteristics of the goods and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence that the proprietor is able to provide, are among the factors that may be taken into account (paragraph 22);
- use of the mark by a single client that imports the goods for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (paragraph 24);
- a *de minimis* rule cannot be laid down (paragraph 25).

## **2.2 Genuine use: standard of proof applied by the Office**

Article 47 EUTMR requires proof of genuine use of the earlier mark. Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (18/01/2011, T-382/08, *Vogue*, EU:T:2011:9, § 22).

Moreover, the Office cannot determine *ex officio* the genuine use of earlier marks. Even proprietors of purportedly well-known marks must submit evidence to prove genuine use of the earlier mark(s).

The Office does not necessarily require a high threshold of proof of genuine use. The Court has indicated that it is not possible to prescribe, in the abstract, what quantitative threshold should be chosen in order to determine whether use was genuine or not, and accordingly there can be no objective *de minimis* rule to establish *a priori* the level of use needed in order for it to be 'genuine'. So, whilst a minimum extent of use must be

shown, what exactly constitutes this minimum extent depends on the circumstances of each case. The general rule is that, when it serves a real commercial purpose, even minimal use of the trade mark could be sufficient to establish genuine use, depending on the goods and services, and the relevant market (23/09/2009, T-409/07, *acopat*, EU:T:2009:354, § 35 and case-law cited therein; 02/02/2012, T-387/10, *Arantax*, EU:T:2012:51, § 42).

In other words, it is sufficient if the evidence of use proves that the trade mark owner has seriously tried to acquire or maintain a commercial position in the relevant market as opposed to having solely used the mark with the intention of preserving the rights conferred by the mark (token use). For instance, in some cases, relatively few sales might be sufficient to conclude that the use is not merely token, in particular with regard to expensive goods (04/09/2007, R 35/2007-2, *DINKY*, § 22). Nonetheless, even if *inter alia* a very modest amount of use can suffice in certain circumstances, proprietors should adduce comprehensive evidence of use.

According to Article 10(3) EUTMDR, the indications and evidence required in order to provide proof of use must concern the place, time, extent and nature of use of the opponent's trade mark for the relevant goods and services.

These requirements for proof of use are cumulative (05/10/2010, T-92/09, *STRATEGI / Stratégies*, EU:T:2010:424, § 43). This means that the opponent is obliged not only to indicate but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the entirety of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (17/02/2011, T-324/09, *Friboi*, EU:T:2011:47, § 31).

Thus, the Office evaluates the evidence submitted in an overall assessment. All the circumstances of the specific case have to be taken into account and all the materials submitted must be assessed in conjunction with each other. Therefore, although pieces of evidence may be insufficient by themselves to prove the use of an earlier trade mark, they may contribute to proving use in combination with other documentation and information.

Evidence of use may be of an indirect/circumstantial nature, such as evidence about the share in the relevant market, the importing of the relevant goods, the supply of the necessary raw materials or packaging to the owner of the mark, or the expiry date of the relevant goods. Such indirect evidence can play a decisive role in the overall assessment of the evidence submitted. Its probative value has to be carefully assessed. For instance, the judgment of 08/07/2010, T-30/09, *Peerstorm*, EU:T:2010:298, § 42 *et seq.* found that catalogues in themselves could — under certain circumstances — be conclusive evidence of sufficient extent of use.

It is necessary to take into account the specific kind of the goods and services involved when assessing the probative value of the evidence submitted. For example, it may be common in a particular market sector for the samples of the goods and services themselves not to bear indications of the place, time, extent and nature of use. In these

cases it is obviously inappropriate to disregard such evidence of use if indications in this respect can be found in the other evidence submitted.

Each of the documents submitted has to be carefully evaluated as to whether it really reflects use in the five years preceding the date of filing or the date of priority<sup>71</sup> of the EUTM application (see paragraph 2.5 below) and use in the relevant territory (see paragraph 2.4 below). In particular, the dates and place of use shown on orders, invoices and catalogues are carefully examined.

Material submitted without any indication of date of use may, in the context of an overall assessment, still be relevant and taken into consideration in conjunction with other pieces of evidence that are dated (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 33). This is the case in particular if it is common in a particular market sector for the samples of the goods and services themselves not to bear indications of time (05/09/2001, R 608/2000-4, PALAZZO / HELADERIA PALAZZO, § 16, noting that ice-cream menus are rarely dated).

For implementation of the abovementioned general principles in practice, see the examples in paragraph 3.7.5 below.

## **2.3 Nature of use**

The term 'nature of use' refers to:

- use of a mark in accordance with its essential function (paragraph 2.3.1 below);
- use of the mark as registered or of a variation thereof in accordance with Article 18(1)(a) EUTMR (paragraph 2.7 below); and
- use in connection with the goods and services for which it is registered (paragraph 2.8 below).

### **2.3.1 Use of a mark in accordance with its function**

#### **2.3.1.1 Use of individual marks**

Article 18 and Article 47(2) EUTMR require proof of genuine use in connection with the goods or services for which the trade mark is registered and which the opponent cites as justification for its opposition. Hence, the opponent has to show that the mark has been used as a trade mark on the market.

As a trade mark has, inter alia, the function of operating as a link between the goods and services and the person responsible for their marketing, the proof of use must establish a clear link between the use of the mark and the relevant goods and services. As clearly indicated in Article 10(4) EUTMDR, it is not necessary for the mark to be affixed to the goods themselves (12/12/2014, T-105/13 TrinkFix, EU:T:2014:1070, § 28-38). A representation of the mark on packaging, catalogues, advertising material

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<sup>71</sup> Publication date of the contested EUTM application in the event of oppositions filed before 23/03/2016, see paragraph 2.5.2 below.

or invoices relating to the goods and services in question constitutes direct evidence that the mark has been put to genuine use (see also paragraph 2.3.3.2 below).

Genuine use requires that use is made as a trade mark:

- not for purely illustrative purposes or on purely promotional goods or services,
- in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43).

Therefore, by way of example, the following are not suitable for supporting genuine use of a trade mark.

1. Use as a certification mark. Certification marks can be obtained in some jurisdictions for compliance with defined standards. The holder of a certification mark is not the authorised user, producer or provider of the certified goods or services, but rather the certifier, which exercises legitimate control over use of the certification mark. Certification marks may be used together with the individual trade mark of the producer of the certified goods or of the provider of the certified services. The essential function of a certification mark is different from the essential function of an individual trade mark: while the latter primarily serves to identify the origin of goods and services, the former serves to certify that the goods or services meet certain established standards and possess particular characteristics. Therefore, use as a certification mark does not serve as use as an individual trade mark, which is the use required by Article 47(2) and (3) EUTMR (16/08/2011, R 87/2010-2, *DVC DIGITAL VIDEO CALLING (fig.) / DVB DIGITAL VIDEO BROADCASTING (fig.)*, § 32).
2. Use as a Protected Geographical Indication (PGI)/Protected Denomination of Origin (PDO). The essential function of PGIs/PDOs is to designate the origin of goods as being from a particular region or locality. This is in contrast with the main function of an individual trade mark, namely to serve as an indicator of commercial origin. When a PGI/PDO has been registered as an individual mark (and not, for example, as a collective mark), the opponent has to submit proof of use as an individual mark. Evidence of use as a PGI/PDO (e.g. general statements of Regulatory Councils) cannot serve for proving use as an individual mark.  
Depending on the circumstances, the following situations may be suitable for supporting genuine use of the registered trade mark. That is because use of the sign can serve more than one purpose at the same time. Consequently, the following uses can also be use of the sign as a trade mark. However, the purpose for which a sign is used needs to be assessed individually.
3. Use of a sign as a business, company or trade name can be regarded as trade mark use provided that the relevant goods or services themselves are identified and offered on the market under this sign (13/04/2011, T-209/09, *Alder Capital*, EU:T:2011:169, § 55-56). In general, this is not the case when the business name is merely used as a shop sign (except when proving use for retail services), or appears on the back of a catalogue or as an incidental indication on a label (18/01/2011, T-382/08, *Vogue*, EU:T:2011:9, § 47).

In principle, use of the sign as a company name or trade name, is not, of itself, intended to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business that is being run. Accordingly, where use of a company name, trade name or shop name is limited to identifying a company or designating a business that is being run, such use cannot be considered as being 'in relation to goods or services' (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21; 13/05/2009, T-183/08, Jello Schuhpark II, EU:T:2009:156, § 31-32).

Use of a business, company or trade name can be regarded as use 'in relation to goods' where:

- a party affixes the sign constituting its company name, trade name or shop name to the goods or;
- even though the sign is not affixed, the party uses the sign in such a way that a link is established between the company, trade or shop name and the goods or services (11/09/2007, C-17/06, Céline, EU:C:2007:497, § 21-23).

Provided that either of these two conditions is met, the fact that a word element is used as the company's trade name does not preclude its use as a mark to designate goods or services (30/11/2009, T-353/07, Coloris, EU:T:2009:475, § 38).

For example, the presentation of the business name at the top of order forms or invoices, depending on how the sign appears on them may be suitable to support genuine use of the registered trade mark (06/11/2014, T-463/12, MB, EU:T:2014:935, § 44-45).

However, mere use of a business name at the top of invoices without a clear reference to specific products/services is not sufficient.

4. Use of a sign as a domain name or as part of a domain name primarily identifies the website as such. However, depending on the circumstances, such use may also be use of a registered mark (this presupposes that it connects to a site on which the goods and services appear).

The mere fact that the opponent has registered a domain name containing the earlier trade mark is not sufficient in itself to prove genuine use of the trade mark. It is necessary for the party to prove that the relevant goods or services are offered under the trade mark contained in the domain name.

#### 2.3.1.2 Use of collective and certification marks

National and EU collective marks and certification marks can also constitute 'earlier trade marks' within the meaning of Article 8(2) EUTMR on which an opposition can be based and, as such, be subject to the requirement of use pursuant to Article 47(2) and (3) EUTMR.

The requirements of the EUTMR relating to the conditions of use apply. However, the different function of these marks must be taken into account. The opponent must

demonstrate that the authorised persons (see paragraph 2.9.3 below) used the collective or certification mark in accordance with its essential function.

The essential function of a collective mark is to distinguish the goods or services of the members of the association that is the proprietor of the mark from those of other undertakings. The specific characteristic of collective marks is to indicate the collective trade origin of the goods or services (and not an individual trade origin as is the case with individual marks).

The essential function of a certification mark is not to indicate trade origin, as for individual and collective marks, but to differentiate the goods and services that are certified by the proprietor of the mark as meeting established standards and possessing particular characteristics from those that are not so certified.

### 2.3.2 Public use in the course of trade

#### 2.3.2.1 Public use versus internal use

The use must be public, that is to say it must be external and apparent to actual or potential customers of the goods or services. Use in the private sphere or purely internal use within a company or a group of companies does not amount to genuine use (09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 22; 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; 09/09/2015, T-584/14, ZARA, EU:T:2015:604, § 33).

The mark must be used publicly and outwardly in the context of commercial activity with a view to economic advantage for the purpose of ensuring an outlet for the goods and services that it represents (12/03/2003, T-174/01, Silk Cocoon, EU:T:2003:68, § 39; 30/04/2008, T-131/06, Sonia Sonia Rykiel, EU:T:2008:135, § 38). Outward use does not necessarily imply use aimed at end consumers. For instance, the relevant evidence can validly stem from an intermediary, whose activity consists of identifying professional purchasers, such as distribution companies, to which the intermediary sells products it has had manufactured by original producers (21/11/2013, T-524/12, RECARO, EU:T:2013:604, § 25-26).

Relevant evidence can also validly come from a distribution company that forms part of a group. Distribution is a method of business organisation that is common in the course of trade and implies use of the mark that cannot be regarded as purely internal use by a group of companies, since the mark is also used outwardly and publicly (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 32).

Use of the mark must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way. Mere preparation to use the mark — such as the printing of labels, producing of containers, etc. — is internal use and, therefore, not use in the course of trade for the present purposes (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37).

### 2.3.2.2 Commercial activity versus promotional activity

Where the mark is protected for goods or services of not-for-profit enterprises, and the mark has been used, the fact that there is no profit motive behind the use is irrelevant: 'The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services' (09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 17).

Goods and services offered free of charge may constitute genuine use when they are offered commercially, that is to say with the intention of creating or maintaining an outlet for those goods or services in the EU, as opposed to the goods or services of other undertakings, and therefore of competing with them (09/09/2011, T-289/09, Omnicare Clinical Research, EU:T:2011:452, § 67-68).

Mere use of the mark on promotional material for other goods cannot normally be considered as sufficient (indirect) evidence of use within the meaning of trade mark law for the type of promotional items on which the mark is or has been used. For example, giving away articles of clothing such as T-shirts and baseball caps at promotional events with the purpose of marketing a certain other product, such as a drink, cannot be considered as genuine use of the mark at issue for clothing.

The Office practice concerning 'genuine use' with regard to promotional articles has been confirmed by the Court.

| Earlier sign  | Case No  |
|---|--|
| WELLNESS  | 15/01/2009, C-495/07, EU:C:2009:10<br>(preliminary ruling) |
| <p>The opponent owned the mark 'WELLNESS' in Classes 25 and 32. In the context of selling its 'WELLNESS' clothing, it also used the mark to designate an alcohol-free drink, which was handed out in small bottles as a gift along with the clothing sold. No drinks were sold separately under the 'WELLNESS' mark.</p> <p>The Court held that, where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter, the mark loses its commercial raison d'être for the promotional goods and cannot be considered to have been genuinely used on the market for goods in that class (para. 22).</p> |  |

### 2.3.3 Use in relation to goods or services

#### 2.3.3.1 Use in relation to goods

Trade marks have traditionally been used on goods (printed on the goods, on labels, etc.) or their packaging. However, showing use on goods or their packaging is not the only way of proving use in relation to goods. It is sufficient, if there is a proper

connection between the mark and the goods, for the mark to be used ‘in relation to’ the goods or services, such as on brochures, flyers, stickers, signs inside places of sale, etc.

For example, when the opponent sells its goods only through catalogues (mail-order sales) or the internet, the mark may not always appear on the packaging or even on the goods themselves. In such cases, use on the (internet) pages where the goods are presented — provided it is otherwise genuine in terms of time, place, extent and nature (see paragraph 2.3.4.4 below) — will generally be considered sufficient. The owner of the mark will not have to provide proof that the mark actually appeared on the goods themselves.

| Earlier sign   | Case No                        |
|--|--------------------------------|
| PETER STORM  | 08/07/2010, T-30/09, Peerstorm |
| The evidence produced to show genuine use of the mark at issue may include catalogues. ‘It must be pointed out that, in addition to items of clothing designated by different marks, more than 80 different items are offered for sale in that catalogue under the mark PETER STORM. They comprise men’s and women’s jackets, jumpers, trousers, tee-shirts, footwear, socks, hats and gloves, the respective characteristics of which are briefly described. The earlier mark appears, in stylised characters, next to each item. In that catalogue, the prices of the items in GBP and the reference number for each item are stated’ (paras 38-39). |                                |

However, the situation is different when a trade mark is used, for example, in a catalogue or advertisements, or on bags or invoices, to designate the retailer of the goods and not the goods themselves.

| Earlier sign   | Case No                                  |
|--|--|
| Schuhpark  | 13/05/2009, T-183/08, Jello Schuhpark II |
| The General Court found that the use of the sign Schuhpark for footwear on advertisements, bags and invoices was not meant to identify the origin of the shoes (which bore their own mark or no mark at all) but rather the company name or trade name of the shoe retailer. This was considered insufficient to establish a link between the sign Schuhpark and the shoes. In other words, Schuhpark may well be a mark for the retail of shoes, but it was not used as a trade mark for goods (paras 31-32). |  |

### 2.3.3.2 Use in relation to services

Marks cannot be directly used ‘on’ services. Therefore, use of marks registered for services will generally be on business paper, in advertising, or in some other way directly or indirectly related to the services. Where the use on such items demonstrates genuine use, such use will be sufficient.



|   |  |
|---|--|
| Earlier sign  | Case No                                      |
| <b>M&amp;P</b>  | 06/11/2014, T-463/12, MB                     |
| The earlier trade mark was registered in Class 42 for, inter alia, the services of a patent attorney. Its use on invoices, business cards and business correspondence was considered sufficient to show genuine use in connection with the services of a patent attorney.   |  |
| STRATEGIES  | 05/10/2010, T-92/09<br>STRATEGI / Stratégies |
| Where an earlier mark was registered for business management services and used as the title of business magazines, the General Court did not exclude that such use could be considered genuine for the services in question if it were shown that the magazine provides support for the supply of the business management services, i.e. if the services are provided through the medium of a magazine. The fact that there is no 'direct bilateral link' between the publisher and the recipient of the services does not impair such a finding of genuine use. This is because the magazine is not distributed free of charge, which could lend credibility to the claim that payment of the price of the magazine constitutes remuneration for the service provided (paras 31-35). |  |

### 2.3.3.3 Use in advertising

Trade marks fulfil their function of indicating the commercial origin of goods or services and symbols of the goodwill of their owner not only when they are actually used on or for goods or services, but also when they are used in advertising. In fact, the advertising or market communication function of trade marks is one of their most important functions.

Therefore, use in advertising will generally be considered as amounting to genuine use:

- if the volume of advertising is sufficient to constitute genuine public use of the mark; and
- if a relation can be established between the mark and the goods or services for which the mark is registered.

The Court confirmed this approach in the Minimax case, where it held that use of the mark must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37).

However, the outcome in a particular case will depend very much on the individual circumstances, as demonstrated by the following examples:

| Earlier sign  | Case No   |
|---|---|
| BLUME   | 28/10/2002, R 681/2001-1,<br>Blumen Worldwide (fig.) / BLUME, LEOPOLDO<br>BLUME |
| <p>Services: services of a publishing company in Class 41.</p> <p>The Board confirmed that the evidence (consisting of catalogues, press notes and advertisements) read in conjunction was enough to prove genuine use of the trade mark.</p> <p>'Although the order record and the receipt of the bank account do not provide any information on how and to what extent the mark was used in Spain, the remaining documents, namely the catalogues, press notes and advertisements, when read in conjunction, demonstrate that during the relevant period, the opponent has published in Spain books and magazines under the trade mark BLUME. Even if the opponent does not provide any invoices, orders or sales figures, there is some reason to assume that it advertised its books and magazines, promoted and sold them under the trade mark BLUME. Although the advertising documents and the press notes were identified and dated by the opponent, the trade mark BLUME is always mentioned in the press notes and on the cover page of the quoted books. In addition, the text is in the Spanish language and the price mentioned in pesetas. When read together with the catalogues, these press notes demonstrate that they refer to some of the books expressly quoted in the catalogues' (para. 23).</p> |   |

| Earlier sign | Case No   |
|--------------|---|
| BIODANZA     | 13/04/2010, R 1149/2009-2, BIODANZA (fig.) /<br>BIODANZA;<br>confirmed 08/03/2012, T-298/10, Biodanza,<br>EU:T:2012:113 |

G&S: Classes 16 and 41.

The Board rejected the Opposition Division's finding that the evidence (only advertisements) proved genuine use.

It follows clearly from the finding of the contested decision that the evidence of use submitted by the opponent consists solely of advertisements that can prove only that the opponent advertised a yearly 'BIODANZA' festival during the whole of the relevant period and workshops on both a regular and irregular basis from 2002.

However, contrary to the finding of the contested decision, such advertisements cannot provide proof of their distribution to a potential German clientele. Nor can they prove the extent of any distribution or the number of sales or contracts made for the services protected by the mark. The mere existence of advertisements could, at most, make it probable or credible that the services advertised under the earlier mark were sold or, at least, offered for sale within the relevant territory, but it cannot prove this, as was unduly supposed by the contested decision.

Where advertising is carried out in parallel with the marketing of goods and services and there is proof of both activities, advertising will support the genuineness of the use.

Advertising in advance of the actual marketing of goods and services — if it is with a view to establishing a market for the goods or services — will generally be considered to constitute genuine use.

Whether mere advertising, without any current or future plans to actually market goods or services, constitutes genuine use appears doubtful. As in most other situations, the outcome will depend on the circumstances of each case. For example, where the goods or services are available abroad, such as holiday accommodation or particular products, advertising alone may be sufficient to amount to genuine use.

#### 2.3.3.4 Use on the internet

The standard applied when assessing evidence in the form of printouts from the internet is no stricter than when evaluating other forms of evidence. Consequently, the presence of the trade mark on websites can show inter alia the nature of its use or the fact that products or services bearing the mark have been offered to the public. However, the mere presence of a trade mark on a website is, of itself, not sufficient to prove genuine use unless the website also shows the place, time and extent of use or unless this information is otherwise provided.

| Earlier sign | Case No   |
|--------------|---|
| SHARP        | 20/12/2011, R 1809/2010-4, SHARPMaster / SHARP (fig.) |

| Earlier sign   | Case No |
|--|---------|
| The opponent submitted 'extracts from the opponent's websites for different countries'. The Board considered that 'simple print-outs from a company's own Internet page is not able to prove use of a mark for certain goods without complementary information as to the actual use of the Internet site by potential and relevant consumers or complementary advertising and sales figures regarding the different goods, photos of the goods with the corresponding mark etc.' (para. 33). |         |

| Earlier sign   | Case No   |
|--|---|
| WALZERTRAUM  | 17/01/2013, T-355/09, Walzer Traum, EU:T:2013:22;<br><br>confirmed 17/07/2014, C-141/13 P, Walzer Traum, EU:C:2014:2089 |
| The opponent, a confectioner, which owns the German trade mark 'WALZERTRAUM' for goods in Class 30, sought to prove the extent of use of its mark by submitting evidence relating to an advertising brochure published on the internet, which gives general information about its working methods, the ingredients used for its products and the product range, including its 'WALZERTRAUM' chocolate. However, the goods could not be ordered online via the web page. For this reason the General Court held that a connection between the website and the number of items sold could not be established (para. 47). |   |

In particular, the value in terms of evidence of internet extracts can be strengthened by submitting evidence that the specific website has been visited and, in particular, that orders for the relevant goods and services have been made through the website by a certain number of customers in the relevant period. For instance, useful evidence in this regard could be records that are generally kept when operating a business web page, for example records relating to the number of hits attained at various points in time or, in some cases, the countries from which the web page has been accessed.

As to the relevant period, information on the internet or in online databases is considered to be of the date on which the information was posted. Internet websites often contain highly relevant information. Certain information may even be available only from such websites. This includes, for example, online catalogues that are not available in printed format.

The nature of the internet can make it difficult to establish the actual date on which information was in fact made available to the public. For instance, not all web pages mention when they were published. In addition, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records that enable members of the public to establish precisely what was published when.

In this context, the date of use on the internet will be considered reliable in particular where:

- the website time-stamps each entry and thus provides information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or
- indexing dates are given to the web page by search engines (e.g. from the Google™ cache); or
- a screenshot of a web page bears a given date.

The evidence submitted must show that the online transactions were connected with the goods or services designated by the mark.

| Earlier sign   | Case No                                     |
|--|---|
| ANTAX  | 02/02/2012, T-387/10, Arantax, EU:T:2012:51 |
| The opponent has submitted, inter alia, internet extracts from the home pages of several tax consultancies using the opposing mark. The General Court considered that the indications on the internet pages allowed the reader to establish a link between the trade mark and the services provided (paras 39-40). |   |

Whereas the nature of the mark and, to a certain extent, the time (as seen above) and place are less complex elements to prove, the extent of use presents more difficulties if only evidence of internet use is provided. It should be taken into account that transactions on the internet tend to eliminate most of the 'traditional' evidence of sales such as invoices, turnover, taxation documents, etc. New 'electronic' evidence tends to substitute them, or has already substituted them, as certified means of payment, orders and confirmations thereof, registrations of safe transactions, etc.

| Earlier sign  | Case No   |
|---|---|
| Skunk funk (fig.)   | 31/03/2011, R 1464/2010-2, SKUNK FU! (fig.) / SKUNK FUNK (fig.) |
| '[E]xcerpts from third parties' websites, despite having been printed out on 10 June 2008, contain consumers' comments about 'SKUNKFUNK' clothes and shops dated within the relevant period. In particular, as regards the relevant territory, the documents show various comments made by consumers in Spain and dated December 2004 and February-March-April-May-July 2007. Moreover, as the Opposition Division pointed out, a blog comment (dated 4 March 2007) on the Internet page <a href="http://www.cybereuskadi.com">www.cybereuskadi.com</a> mentions that the opponent ('designer of Skunkfunk') "exports surf clothes worldwide and has a turnover of nearly 7 million euros per year" (para. 21). |   |

## **2.4 Place of use**

### **2.4.1 Use on the 'domestic' market**

Trade marks must be used in the territory where they are protected (European Union for EUTMs, the territory of the Member State for national marks or Benelux for Benelux marks, and the territories of the relevant countries for international registrations).

As the Court held in para. 30 of *Leno Merken*, its judgment of 19/12/2012, C-149/11, *Onel / Omel*, EU:C:2012:816, 'the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not'. The Court further indicated that use of the mark in non-EU territories cannot be taken into account (para. 38).

In view of the globalisation of trade, an indication of the registered seat of the owner of the mark may not be regarded as sufficient indication that the use has taken place in that particular country. Even though Article 18(1)(b) EUTMR stipulates that the affixing of the trade mark to goods or to the packaging thereof in the European Union solely for export purposes is considered as use of the mark, mere indication of the opponent's seat as such does not constitute evidence of such acts. On the other hand, the fact that clients that have their seats outside the relevant territory are listed in the documents for proving use of the earlier mark is in itself not sufficient to rule out that services (e.g. promotion services) may actually have been rendered in the relevant territory for the benefit of these companies located in other territories (09/06/2010, R 952/2009-1, *GLOBAL (fig.) / GLOBAL TABACOS (fig.)*, § 16).

### **2.4.2 EUTMs: use in the European Union**

If the earlier mark is a European Union mark, it must be used 'in the Union' (Articles 18(1) and 47(2) EUTMR). Following *Leno Merken*, Article 18(1) EUTMR must be interpreted as meaning that the territorial borders of the Member States should be disregarded when assessing whether an EUTM has been put to 'genuine use' in the European Union (para. 44).

In territorial terms and in view of the unitary character of the EUTM, the appropriate approach is not that of political boundaries but of market(s). Moreover, one of the aims pursued by the EUTM system is to be open to businesses of all kinds and sizes. Therefore, the size of an undertaking is not a relevant factor for establishing genuine use.

As the Court indicated in *Leno Merken*, it is impossible to determine a priori and in the abstract what territorial scope should be applied in order to determine whether the use of the mark is genuine or not (para. 55). All the relevant facts and circumstances must be taken into account, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and scale of the use as well as its frequency and regularity (para. 58). Use of an EUTM in the UK (15/07/2015, T-398/13, *TVR ITALIA (fig.) / TVR et al.*, EU:T:2015:503, § 57) or even in

London and its immediate surroundings may be geographically sufficient (30/01/2015, T-278/13, now, EU:T:2015:57). The Board of Appeal decision of 07/03/2013, R 234/2012-2, now (fig.) (confirmed 30/01/2015, T-278/13, now, EU:T:2015:57), considered the use of an EUTM for wireless broadband services in Class 42 in the geographical area comprising London and the Thames Valley sufficient to constitute genuine use in the United Kingdom and also in the European Union, taking into account the territorial extent [London being ‘the largest city in the United Kingdom and the largest urban zone in the European Union’, having ‘a metropolitan area ... with an estimated total population of between 12 million and 14 million people’, being ‘the world’s leading financial centre along with New York’, ‘a leading centre of arts, science, tourism and media and information technology’, and having a profile on the European commercial scene ‘disproportionately high in respect to the services in question’ (R 234/2012-2, para. 47), and the Thames Valley being ‘200 miles long and 30 miles wide’ and including ‘populous towns and cities of significant economic activity’ (R 234/2012-2, para. 45-46)], the scale, frequency and regularity of use and the characteristics of the market concerned (R 234/2012-2, para. 52).

The Office must determine on a case-by-case basis whether the various indications and evidence can be combined for the purpose of assessing the genuine character of use, the geographical dimension of which is only one of the aspects to be considered.

In any event, it must be underlined that the European requirements or standards for genuine use are applicable (i.e. the conditions of Article 18 EUTMR) and not national standards or practices applied to EUTMs.

#### 2.4.3 National marks: use in the relevant Member State

If the earlier mark is a national mark with effect in one of the Member States of the European Union, the mark must have been genuinely used in the country where it is protected (Article 47(3) EUTMR). Use in a part of the Member State, provided it is genuine, may be considered sufficient:

| Case No                              | Earlier trade mark | Comment   |
|--------------------------------------|--------------------|---|
| 11/05/2006, C-416/04 P,<br>Vitafruit | VITAFRUT           | Use considered sufficient, even though the earlier Spanish mark was not present in a substantial part of the territory of Spain as the evidence referred to the sale of everyday consumer goods (concentrated fruit juices) to only a single customer in Spain (paras 60, 66 and 76). |

If the earlier mark is an international mark or a Benelux mark, the mark must have been genuinely used in the territory of the relevant countries of the international registration or in Benelux, respectively.

#### 2.4.4 Use in the import and export trade

According to Article 18(1)(b) EUTMR, the affixing of the European Union trade mark to goods or to the packaging thereof in the European Union solely for export purposes also constitutes use within the meaning of Article 18(1) EUTMR. The mark has to be used (i.e. affixed to goods or their packaging) in the relevant market — that is, the geographical area where it is registered.

| Case No                             | Earlier trade mark | Comment  |
|-------------------------------------|--------------------|--|
| 04/06/2015, T-254/13, EU:T:2015:156 | STAYER             | Genuine use may result from the export to a single operator located outside Europe, who can be an intermediary, for the purpose of selling to the end consumer in a non-EU country. Proof that the products have been put on the market in the non-EU importing country is not required (paras 57-61). |
| 14/07/2010, R 602/2009-2            | RED BARON          | The Board indicated that sales in Austria and Great Britain from the Netherlands also constituted genuine use in the Netherlands (para. 42).   |

Evidence relating only to the import of the goods in the relevant area may, depending on the circumstances of the case, suffice as proof of use in this area (see by analogy 09/07/2010, T-430/08, Grain Millers, EU:T:2010:304, § 33, 40 et seq. regarding proof of use in the course of trade of a sign, on the basis of imports from Romania to Germany).

The Court has held that transit, which consists in transporting goods lawfully manufactured in a Member State to a non-member country by passing through one or more Member States, does not involve any marketing of the goods in question and is therefore not liable to infringe the specific subject matter of the trade mark (regarding the transit through France of goods originating in Spain and destined for Poland, see judgments of 23/10/2003, C-115/02, Rioglass and Transremar, EU:C:2003:587, § 27; 09/11/2006, C-281/05, Diesel, EU:C:2006:709, § 19). Therefore, mere transit through a Member State cannot constitute genuine use of the earlier mark in that territory (09/12/2015, T-354/14, ZuMEX (fig.) / JUMEX, EU:T:2015:947, § 62).



## **2.5 Time of use**

### **2.5.1 Oppositions filed on or after 23/03/2016**

If the earlier mark is subject to the use requirement at all (registered for not less than five years), the actual period for which use must be shown can simply be computed backwards from the filing or, if the contested EUTM application has a priority date, from the priority date of the contested EUTM application. For example, if the contested EUTM application was filed on 15/06/2016, or if this date was the priority date of the contested EUTM application, the opponent would have to prove genuine use of its mark within the period from 15/06/2011 to 14/06/2016.

If the contested mark is an international registration designating the European Union, the actual period for which use must be proven can simply be computed backwards from the date of registration (INID code 151) or the date of priority (INID code 300), or, as the case may be, the date of subsequent designation of the European Union (INID code 891). For example, if the contested international registration were registered, or if the European Union were subsequently designated, on 15/06/2016, the opponent would have to prove genuine use of its mark within the period from 15/06/2011 to 14/06/2016.

Evidence referring to use made outside the relevant time frame is in general immaterial, unless it constitutes conclusive indirect proof that the mark must have also been put to genuine use during the relevant period. The Court held in this context that circumstances subsequent to the relevant point of time may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time (27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, § 31).

Where a mark has not been genuinely used for more than five years before the filing or priority date of the contested EUTM application, the fact that there may be remaining goodwill or knowledge of the mark in the mind of the trade or customers does not 'save' the mark.

The use need not have been made throughout the period of five years, but rather within the five years. The provisions on the use requirement do not require continuous use (16/12/2008, T-86/07, *Deitech*, EU:T:2008:577, § 52).

### **2.5.2 Oppositions filed before 23/03/2016**

Before the entry into force of the Amending Regulation, the five-year period was computed backwards from the date of publication of the contested EUTM application. In the case of contested IRs, the equivalent date was the beginning of the opposition period (which is, pursuant to Article 152(1) and Article 156(2) of Regulation (EC) No 207/2009 on the Community trade mark (Regulation (EC) 207/2009)<sup>72</sup>, six months after the date of publication of the international registration or subsequent designation).

For example, if the contested international registration or its subsequent designation of the European Union was published on 15/06/2009, the opponent would have to prove genuine use of its mark within the period from 15/12/2004 to 14/12/2009.

## **2.6 Extent of use**

### **2.6.1 Criteria**

In this regard, it has to be evaluated whether, in view of the market situation in the particular industry or trade concerned, it can be deduced from the material submitted that the owner has seriously tried to acquire a commercial position in the relevant market. The trade mark has to be used for goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37). This does not mean that the opponent has to reveal the total volume of sales or turnover figures.

Concerning the extent of use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, as well as the frequency of those acts, on the other (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 35).

The assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 42).

Under certain circumstances, even circumstantial evidence such as catalogues featuring the trade mark, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment (15/07/2015, T-398/13 TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 57-58; 08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 42 et seq.).

Use does not have to be made during a minimum period of time to qualify as 'genuine'. In particular, use does not have to be continuous throughout the relevant period of five years. It is sufficient if use was made at the very beginning or end of the period, provided the use was genuine (16/12/2008, T-86/07, Deitech, EU:T:2008:577).

The exact decisive threshold proving genuine use cannot be defined out of context. The turnover and volume of sales of the product must always be assessed in relation to all the other relevant factors, such as the volume of business, production or marketing capacity, or the degree of diversification of the undertaking using the trade mark, and the characteristics of the products or services on the relevant market. Use need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market

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<sup>72</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version).

(11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39; 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 42).

Low turnover and sales, in absolute terms, of a medium- or low-priced product might support the conclusion that use of the trade mark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient (04/09/2007, R 35/2007-2, DINKY, § 22). It is, therefore, always necessary to take the characteristics of the market in question into account (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 51).

A de minimis rule cannot be laid down. Use of the mark by a single client, which imports the products for which the mark is registered, can be sufficient to demonstrate that such use is genuine if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 24 et seq.).

Genuine use is not excluded only because all use involves the same customer, as long as the trade mark is used publicly and outwardly and not solely within the undertaking that owns the earlier trade mark or within a distribution network owned or controlled by that undertaking (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 50; 08/10/2014, T-300/12, Fairglobe, EU:T:2014:864, § 36).

The smaller the commercial volume of the exploitation of the mark, the more necessary it is for the opposing party to produce additional evidence to dispel any doubts as to its genuineness (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 37).

Concerning the ratio between the turnover generated by the sales of products under the earlier mark and the applicant's annual turnover, it should be noted that the degree of diversification of the activities of undertakings operating in one and the same market varies. Moreover, the obligation to produce evidence of genuine use of an earlier trade mark is not designed to monitor the commercial strategy of an undertaking. It may be economically and objectively justified for an undertaking to market a product or a range of products even if their share in the annual turnover of the undertaking in question is minimal (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 49).

Special circumstances, for example, lower sales figures during the initial marketing phase of a product, could be of relevance when assessing the genuineness of use (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 53). The initial phase of marketing a product may last more than a few months but it cannot be prolonged indefinitely (18/03/2015, T-250/13, SMART WATER, EU:T:2015:160, § 54-55; confirmed 17/03/2016, C-252/15 P, SMART WATER, EU:C:2016:178).

## 2.6.2 Examples of insufficient use

| Case No   | Comment  |
|---|--|
| 18/03/2015, T-250/13,<br>SMART WATER  | The test sales of 15 000 water bottles are considered symbolic in the light of the size of the European market (para. 34-35).  |
| 16/07/2014,<br>T-196/13,<br>NAMMU,<br>EU:T:2014:1065  | The applicant provided an affidavit signed by the Head of the Import Department and Quality Manager, as well as photos, including one of a Nanu-Nana shop front, and others, undated, of various goods, such as folded paper boxes, albums, calendars, stickers, blocks, artists' materials, cards and other paper products, napkins, recipe books, furniture and home decor articles. The goods depicted all bear labels and stickers with the earlier mark on their packaging.<br><br>No evidence was submitted to prove the turnover figures given in the affidavits, and the photos were undated (para. 33). |
| 17/01/2013, T-355/09, Walzer Traum,<br>EU:T:2013:22;<br>confirmed 17/07/2014, C-141/13 P,<br>Walzer Traum | The opponent, a German bakery located in a city of 18 000 inhabitants, proved constant monthly sales of approximately 3.6 kg of exclusive, handmade chocolates over a period of 22 months. Despite being advertised on a web page accessible throughout the world, the chocolates could only be ordered and bought in the opponent's bakery. In view of the territorial and quantitative limits, the General Court considered that use had not been sufficiently proven (para. 32 et seq.).  |
| 30/04/2008, T-131/06,<br>Sonia Sonia Rykiel,<br>EU:T:2008:135   | 54 units of women's slips and 31 units of petticoats were sold over a period of 13 months, for a total sum of EUR 432. The General Court considered these modest quantities with regard to the relevant market (everyday consumption goods, sold at a very reasonable price) to be insufficient.   |
| 27/02/2009, R 249/2008-4,<br>AMAZING ELASTIC PLASTIC II   | 500 plastic balloon kits given away as 'samples' free of charge cannot constitute genuine use.   |

| Case No  | Comment   |
|--|---|
| 20/04/2001, R 378/2000-1, RINASCIMENTO/<br>RENACIMIENTO  | The Board of Appeal confirmed the decision of the Opposition Division that the submission of one bill of lading showing the delivery of 40 packages of sherry is insufficient to prove genuine use.   |
| 09/02/2012, R 239/2011-1,<br>GOLF WORLD (fig.9 /<br>GOLF WORLD et al.<br>(B 1 456 443, Golf World) | As the only evidence of use for printed matter, the opponent submitted evidence that proved 14 subscribers for a magazine in Sweden. The OD held that this is insufficient to prove genuine use in Sweden, particularly taking account of the fact that magazines are not high-priced articles.   |
| 20/05/2011,<br>R 2132/2010-2,<br>SUSURRO (fig.) / SUSURRO  | Nine invoices concerning the sale of wine in 2005, 2006, 2007 and 2008, showing that over a period of 36 months, goods marketed under the earlier mark and worth EUR 4 286.36 were sold, as well as an undated sample of a product label, were not considered sufficient proof of genuine use of a Spanish trade mark registered for alcoholic drinks (except beers) in Class 33. The evidence showed that the sales of wine had been made in a small, very provincial, part of Spain. For a country with over 40 million inhabitants, the amount sold of a relatively cheap wine was found to be too small to create or preserve an outlet for goods (wine) that are consumed in large quantities by the average Spanish consumer. |
| 07/07/2011,<br>R 908/2010-2,<br>ALFA-REN / ALPHA D3 et al.   | Table of sales figures for ALFACALCIDOL products in Lithuania between 2005 and 2008, indicating products sold by Teva Corp. under the trade mark 'ALPHA D3' (source: IMS health database, Lithuania); an undated copy of packaging for a product 'ALPHA D3' (undated); and a copy of an advertisement for 'ALPHA D3' products sold in Lithuania (not translated) were found insufficient to show genuine use of the mark in Lithuania. It could not be seen from the evidence submitted whether the marked goods were actually distributed and, if so, the quantities involved.   |

| Case No   | Comment   |
|---|---|
| 16/03/2011,<br>R 820/2010-1,<br>BE YOU / BEYU                         | Sales of goods with profits below EUR 200 during the 9-month period of use were not considered sufficient proof of genuine use of the opposing mark in respect of the goods in Class 14.  |
| 06/04/2011,<br>R 999/2010-1,<br>TAUTROPFEN CHARISMA (fig.) / CHARISMA | Eleven invoices showing that 13 units of perfumery goods were sold in Spain between 2003 and 2005, for a total amount of EUR 84.63, were deemed as insufficient proof of genuine use of the sign. Account has been taken of the fact that the goods were intended for daily use and available at a very affordable price. |
| 27/10/2008,<br>B 1 118 605,<br>Viña la Rosa                           | Photocopies of three independent wine guides mentioning the opponent's trade mark (without further explanation as to the volume, edition, publisher, etc.) were not considered sufficient to prove use for wines.   |
| 21/06/1999, B 70 716,<br>Oregon                                       | The Opposition Division found an invoice for 180 pairs of shoes as insufficient to prove genuine use.   |
| 30/01/2001,<br>B 193 716,<br>Lynx                                     | As evidence of use the opponent submitted two invoices, for a total amount of 122 items of clothing, and four undated labels with no indication of what goods they were to be affixed to. The Opposition Division considered them insufficient.   |

## 2.6.3 Examples of sufficient use

| Case No   | Comment   |
|---|---|
| 16/11/2011,<br>T-308/06,<br>Buffalo Milke,<br>EU:T:2011:675 | <p>Nine invoices dated between April 2001 and March 2002, representing sales of around EUR 1 600 (with a turnover figure barely above EUR 1 000 000 per year) and showing that items were delivered to different customers in small quantities (12, 24, 36, 48, 60, 72 or 144 pieces), for widely used products like shoe polish, in the largest European market, Germany, with approximately 80 million potential consumers, were deemed as providing evidence of use that objectively is such as to create or preserve an outlet for polishing cream and leather conditioner. Furthermore, the volume of sales, in relation to the period and frequency of use, was deemed to be significant enough not to be considered merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. Confirmed by the General Court (para. 68)</p> |
| 10/09/2008,<br>T-325/06,<br>Capio,<br>EU:T:2008:338         | <p>Evidence (invoices, lists of sales) proving that the intervener sold 4 hollow-fibre oxygenators with detachable hard-shell reservoirs in Finland in 1998, 105 in 1999 and 12 in 2001, for a total amount of EUR 19 901.76, was deemed sufficient proof of genuine use of the EUTM registered for oxygenators with integrated pump; controllers for integrated pump; regulating devices of air pressure for integrated pump; suction pumps; blood flow meters in Class 10 (paras 48, 60).</p>   |

| Case No  | Comment  |
|--|--|
| <p>27/09/2007,<br/>T-418/03,<br/>La Mer,<br/>EU:T:2007:299</p>   | <p>Ten invoices over a period of 33 months, relating to several product ranges, the packaging of which bears the trade mark concerned, with numbers very far apart (22 214 for the invoice of 03/01/1995, 24 085 for that of 04/05/1995, 24 135 for that of 10/05/1995 and 31 348 for that of 26/03/1997), showing that the sales were made to different persons, were deemed as permitting the inference that they had been submitted merely by way of illustration of total sales but not as showing that the trade mark was used publicly and outwardly rather than solely within the undertaking that owned the earlier trade mark or within a distribution network owned or controlled by that undertaking. Nevertheless, the sales effected, while not considerable, were deemed as constituting use that objectively was such as to create or preserve an outlet for the products concerned and entailing a volume of sales that, in relation to the period and frequency of use, was not so low as to allow the conclusion that the use was merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark (paras 87-90).</p> |
| <p>25/03/2009,<br/>T-191/07,<br/>Budweiser,<br/>EU:T:2009:83</p> | <p>The Board of Appeal (20/03/2007, R 299/2006-2, 'BUDWEISER/BUDWEISER BUDVAR (fig.) et al., § 26) found essentially that the documents presented to it during the administrative proceedings — invoices proving the sale of beer in France amounting to more than 40 000 litres between October 1997 and April 1999, 23 invoices issued in Austria between 1993 and 2000 to a single buyer in Austria, and 14 invoices issued in Germany between 1993 and 1997 — were sufficient to demonstrate the extent of use of the earlier international word mark BUDWEISER (IR No 238 203) in those countries. The Board's findings were confirmed by the General Court.</p>  |



| Case No   | Comment  |
|---|--|
| 11/05/2006,<br>C-416/04 P,<br>Vitafruit,<br>EU:C:2006:310 | Evidence of the sale to a single customer in Spain of concentrated fruit juices during a period of 11.5 months, with a total volume of sales of EUR 4 800, corresponding to the sale of 293 cases of 12 items each, was considered sufficient use of the earlier Spanish trade mark (paras 68-77).   |
| 08/07/2010,<br>T-30/09,<br>Peerstorm,<br>EU:T:2010:298    | As evidence of use, the opponent (merely) provided several catalogues for end consumers, featuring the relevant trade mark on clothing articles. The Court held that ‘...it is true that those catalogues provide no information on the quantity of goods actually sold by the intervener under the trade mark PETER STORM. However, it is necessary to take into account ... the fact that a large number of items designated by the trade mark PETER STORM were offered in the catalogues and that those items were available in more than 240 shops in the United Kingdom for a significant part of the relevant period. Those factors support the conclusion, in the context of a global assessment ... that the extent of its use was fairly significant’ (paras 42 to 43). |
| 04/09/2007,<br>R 35/2007-2, DINKY                         | The sale of approximately 1 000 miniature toy vehicles was considered sufficient extent of use in light of the products being sold mainly to collectors at a high price in a particular market.  |
| 11/10/2010,<br>R 571/2009-1,<br>VitAmour / VITALARMOR     | The sale of 500 kg of milk proteins for a total value of EUR 11 000 was considered sufficient to prove genuine use for milk proteins for human consumption. In view of the nature of the products, which are not consumer goods but ingredients for use by the food processing industry, the amount and values shown did demonstrate a market presence above the threshold required.   |

| Case No   | Comment  |
|---|--|
| 27/07/2011,<br>R 1123/2010-4,<br>Duracryl / DURATINT et al. | Eleven invoices made out to different undertakings in various regions of Spain, showing that the proprietor of the mark sold, in the relevant period and under the mark, 311 containers of the product, in different sizes, for a net amount of EUR 2 684, were deemed sufficient to prove genuine use of a mark registered for preservatives against deterioration of wood in Class 2.                                      |
| 01/02/2011,<br>B 1 563 066                                  | An annual turnover of more than EUR 10 million over several years was claimed for medical preparations. The corresponding invoices (one per relevant year) only proved actual sales of about EUR 20 per year. In an overall assessment, and in the context of further material submitted, such as price lists, a sworn statement, packaging and advertising material, the Office found this sufficient to prove genuine use. |
| 26/01/2001,<br>B 150 039                                    | The Opposition Division regarded evidence of sales of around 2 000 furry toy animals in a high-priced market sector as sufficient.   |
| 18/06/2001,<br>B 167 488                                    | The opponent submitted one invoice referring to the sale of one high-precision laser cutting machine for FRF 565 000, a catalogue describing its performance and some photographs depicting the product. The Opposition Division considered them as sufficient evidence taking into account the nature of the product, the specific market and its considerably high price.  |

## 2.7 Use of the mark in forms different from that registered

### 2.7.1 Introduction

Article 18 EUTMR states that use of the mark in a form different from that registered still constitutes use of the trade mark as long as the differing elements do not alter the distinctive character of the trade mark, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor.

The purpose of this provision is to allow its proprietor to make variations in the sign that, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50).

The General Court further mentioned that strict conformity between the sign as used and the sign registered is not necessary. However, the difference must be in negligible elements and the signs as used and registered must be broadly equivalent (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50).

In order to decide whether the sign as used and the sign as registered are broadly equivalent, it must first be established what elements are negligible. The General Court has developed criteria for doing so in several judgments.

Paragraph 2.7.2 will deal with these criteria. Paragraph 2.7.3 will describe Office practice in relation to the 'variation' of marks, 'additions' of elements to marks and 'omissions' of elements of marks.

### 2.7.2 Criteria of the Court

In brief, the test developed by the Court consists of first determining what the distinctive and dominant elements of the registered sign are and then verifying if they are also present in the sign as used.

The General Court has held that:

the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 36).

With regard to additions:

- several signs may be used simultaneously without altering the distinctive character of the registered sign (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 34);
- if the addition is not distinctive, is weak and/or is not dominant, it does not alter the distinctive character of the registered trade mark (30/11/2009, T-353/07, Coloris, EU:T:2009:475, § 29-33 et seq.; 10/06/2010, T-482/08, Atlas Transport, EU:T:2010:229, § 36 et seq.).

With regard to omissions:

- if the omitted element is in a secondary position and not distinctive, its omission does not alter the distinctive character of the trade mark (24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 37).

### 2.7.3 Office practice

In general, it has to be assessed whether use of the mark constitutes an acceptable or unacceptable 'variation' of its registered form.

Therefore, there are two questions to be answered. Firstly, it must be clarified what is to be regarded as the distinctive character of the mark as registered <sup>73</sup>. Secondly, it must be evaluated whether the mark as used alters this distinctive character. These questions have to be answered on a case-by-case basis.

There is interdependence between the strength of the distinctive character of a mark and the effect of alterations. Marks of strong distinctive character may be less influenced by changes than marks of limited distinctiveness. Adding elements to or omitting elements from the mark are more likely to affect the distinctive character of marks of limited distinctiveness.

Where a mark is composed of several elements, only one or some of which are distinctive and have rendered the mark as a whole registrable, an alteration of that distinctive element(s) or its omission or replacement by another element will generally mean that the distinctive character is altered.

In order to determine whether the use of a variation of the mark should be accepted or whether the distinctive character is altered, account must be taken of the practices in the branch of business or trade concerned and the relevant public.

| Case No                        | Registered mark | Actual use   | Comment   |
|--------------------------------|-----------------|--|---|
| 12/12/2014, T-105/13, TrinkFix | Drinkfit        |  | Relevant goods were beverages in Classes 29 and 32.<br><br>The labels on bottles of beverages are narrow, so it is not unusual for a word mark to be written on two lines (para. 47). |

The following paragraphs contain a number of practical guidelines for assessing whether additions (paragraph 2.7.3.1), omissions (paragraph 2.7.3.2) and alterations in the form of the sign as used (paragraph 2.7.3.3) alter the distinctive character of the registered trade mark.

#### 2.7.3.1 Additions

As indicated above, with regard to additions, (i) several signs may be used simultaneously without altering the distinctive character of the registered sign and (ii) if

<sup>73</sup> See the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs.

the addition is non-distinctive or weak and/or not dominant, it does not alter the distinctive character of the registered trade mark.

The following paragraphs provide examples of these two types of scenarios:

- use of several signs simultaneously;
- additions of other verbal elements;
- additions of figurative elements.

#### Use of several marks or signs simultaneously

It is quite common in some market areas for goods and services to bear not only their individual mark, but also the mark of the business or product group ('house mark'). In these cases, the registered mark is not used in a different form, but the two independent marks are validly used at the same time.

There is no legal precept in the European Union trade mark system that obliges the opponent to provide evidence of the earlier mark alone when genuine use is required within the meaning of Article 47 EUTMR. Two or more trade marks may be used together in an autonomous way, or with the company name, without altering the distinctive character of the earlier registered trade mark (06/11/2014, T-463/12, MB, EU:T:2014:935, § 43). It is common practice in the trade to depict independent marks in different sizes and typeface, so these clear differences, which emphasise the house mark, indicate that two different marks are being used jointly but autonomously (07/08/2014, R 1880/2013-1, HEALTHPRESSO / PRESSO, § 42).

The Court has confirmed that the condition of genuine use of a registered trade mark may be satisfied both where it has been used as part of another composite mark or where it is used in conjunction with another mark, even if the combination of marks is itself registered as a trade mark (18/04/2013, C-12/12, Colloseum Holding, EU:C:2013:253, § 36.). Similarly, the Court has clarified that use can be genuine where a figurative mark is used in conjunction with a word mark superimposed over it, even if the combination of those two marks is itself registered, to the extent that the differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of that trade mark as registered (18/07/2013, C-252/12, Specsavers, EU:C:2013:497, § 31).

| Registered form  | Actual use  | Case No  |
|--|---|--|
| CRISTAL  |  | 08/12/2005<br>T-29/04<br>Cristal Castellblanch |
| <p>'In the present case the mark CRISTAL appears clearly four times on the neck of the bottle marketed by the intervener and twice on the main label, accompanied by the symbol ®. On the neck, that mark is separate from the other elements. In addition, the mark CRISTAL appears alone on the boxes in which bottles of the mark CRISTAL are marketed. Equally, on the invoices produced by the intervener reference is made to the term "cristal" with the mention "1990 coffret". It should be noted that the mark CRISTAL thus identifies the product marketed by the intervener' (para. 35).</p> <p>'As regards the mention "Louis Roederer" on the main label, it merely indicates the name of the manufacturer's company, which may provide a direct link between one or more product lines and a specific undertaking. The same reasoning applies to the group of letters "lr", which represents the initials of the intervener's name. As pointed out by [the Office], joint use of those elements on the same bottle does not undermine the function of the mark CRISTAL as a means of identifying the products at issue' (para. 36).</p> <p>'Furthermore, [the Office's] finding that the use of the word mark together with the geographical indication "Champagne" cannot be considered to be an addition capable of altering the distinctive character of the trade mark when used for champagne must be endorsed. In the wine sector the consumer is often particularly interested in the precise geographical origin of the product and the identity of the wine producer, since the reputation of such products often depends on whether the wine is produced in a certain geographical region by a certain winery' (para. 37).</p> <p>'In those circumstances it must be held that the use of the word mark CRISTAL together with other indications is irrelevant and that the Board of Appeal did not infringe Article 15(2)(a) of Regulation No 40/94 [now Article 18(2)(a) EUTMR], Article 43(2) and (3) thereof [now Article 47(2) and (3) EUTMR], or Rule 22(2) of the implementing regulation [now Article 10(2) EUTMDR]' (para. 38).</p> |   |  |

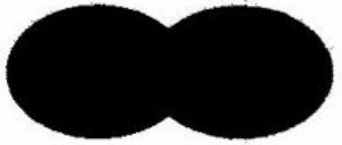

| Registered form   | Actual use   | Case No   |
|---|--------------|---|
| L.114   | Lehning L114 | 29/02/2012, T-77/10 & T-78/10, L112, EU:T:2012:95 |
| <p>L.114 is a French trade mark registered for pharmaceutical products in Class 5.</p> <p>The Court found that:</p> <p>1) the missing full-stop between the capital letter 'L' and the number 114 constituted a minor difference that did not deprive earlier mark L.114 of its distinctive character (para. 53).</p> <p>2) 'Lehning' was the house mark. The fact that earlier mark 'L.114' was used together with that house mark did not alter its distinctive character within the meaning of Article 15(1)(a) of Regulation (EC) 207/2009 [now Article 18(1)(a) EUTMR] (para. 53).</p> |              |   |

| Registered form  | Actual use  | Case No  |
|--|---|--|
| YGAY   | YGAY together with a number of other verbal and figurative elements | 24/09/2008, R 1695/2007-1, I GAI (fig.) / YGAY et al.; confirmed 21/09/2010, T-546/08, i Gai |
| <p>In the Board's decision (confirmed 21/09/2010, T-546/08, i Gai, EU:T:2010:404, § 19, 20) it was pointed out that the trade mark YGAY appears in many photographs on both the label and the box in which the bottle is sold. On the labels, the trade mark in question is separated from the other elements. On some labels, it appears on its own, beneath the phrase MARQUES DE MURRIETA, written in large bold letters. On others, the phrase BODEGAS MARQUES DE MURRIETA is written in small letters in the upper part, while the elements CASTILLO YGAY are written in large, stylised letters across the label. The trade mark YGAY also appears on its own or together with the phrase CASTILLO YGAY on the boxes in which the bottles are sold. Reference is also made, on the invoices submitted by the opponent, to the trade mark YGAY, along with general information such as the year of production and origin, etc. It follows, therefore, that the sign YGAY functions as the trade mark identifying the goods, wine, sold by the opponent (para. 15).</p> <p>The mention of MARQUES DE MURRIETA in this context might merely be an indication of the name of the manufacturer's company or the vineyard that produces and sells the wine, which might provide a direct link between one or more product lines and a specific undertaking (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 36) (para. 16).</p> |   |  |







| Registered form | Actual use | Case No |
|-----------------|------------|---------|
|-----------------|------------|---------|

|  |  |   |
|--|--|---|
|  <p>Mark No 1</p> |  <p>Mark No 2</p> | <p>18/04/2013,<br/>C-12/12,<br/>Colloseum Holding</p> |
|--|--|---|

Levi Strauss is the proprietor of the two EUTMs reproduced above. Mark No 1 is always used in conjunction with the word mark LEVI'S, i.e., as in Mark No 2. The Court found that the condition of 'genuine use' may be fulfilled where an EU figurative mark is used only in conjunction with an EU word mark that is superimposed over it, and the combination of those two marks is, furthermore, itself registered as a European Union trade mark, to the extent that the differences between the form in which the trade mark is used and that in which it was registered do not change the distinctive character of the trade mark as registered.

| Registered form   | Actual use  | Case No                                     |
|---|---|---|
|  |  | <p>18/07/2013, C-252/12,<br/>Specsavers</p> |



| Registered form  | Actual use | Case No |
|--|------------|---------|
| <p>Specsavers commenced proceedings for trade mark infringement and passing off on the basis of the earlier EUTM SPECSAVERS (word mark), as well as the figurative signs</p>   <p>and</p>  <p>, against ASDA, a supermarket chain, which relaunched its optical business and targeted Specsavers in its marketing campaign. Specsavers used its black and white registrations in colour and acquired reputation in the UK for the colour green, using its sign as follows:</p>  <p>. ASDA also acquired reputation in the UK for another shade of green in its supermarket business and applied it to the optical business:</p>  <p>.</p> <p>The Court found that the use of</p>  <p>with the superimposed word sign may be considered genuine use of the wordless logo mark to the extent that the wordless logo mark as registered always refers in that form to the goods of the Specsavers group (to be determined by the referring court) (para. 24).</p> |            |         |

It is up to the opponent to provide evidence that the additional sign is in fact an independent mark or sign, which refers, for instance, to the company mark, the manufacturer, etc.

| Registered form | Actual use    | Case No                                     |
|-----------------|---------------|---|
| MINUTO          | DUBOIS MINUTO | 12/09/2001, R 206/2000-3,<br>MINU' / MINUTO |


| Registered form  | Actual use | Case No |
|--|------------|---------|
| <p>The Board of Appeal regarded the presentation of the two words as the use of two separate marks, since the evidence submitted by the opponent showed that one of them was an old brand of the opponent with its own identity and was present on the market with a number of accompanying signs, as is common practice in the labelling of the specific products (wine).</p> <p>“DUBOIS” and “MINUTO” are separate marks that are affixed together in the concrete product, as is common practice in the labelling of wine products (name of the winery and name of the product). As regards Spanish brands, see for example “TORRES” — “Sangre de Toro”, “TORRES” — “Acqua d’Or”. When asking for “MINUTO” wine, the relevant consumer will be aware that such wine is included within the line of products “DUBOIS”, however, “MINUTO” will be perceived as a trade mark of its own, even if it may appear next to the sign “DUBOIS” in the invoices, brochures and/or product labels’ (para. 18).</p> |            |         |

On the other hand, doubt could be cast on the genuineness of use in cases where the registered mark, when used together with another mark is perceived as a mere decorative element.

#### Addition of other verbal elements

In principle, a difference in words or even letters constitutes an alteration of the distinctive character of the mark. However, in the following three paragraphs a number of situations are described where additions are acceptable. The fourth paragraph provides examples of unacceptable additions.

#### Addition of non-dominant elements



| Registered form  | Actual use  | Case No                             |
|--|---|-------------------------------------|
| COLORIS  |  | 30/11/2009,<br>T-353/07,<br>Coloris |
| <p>The General Court confirmed that the use of the mark Coloris with additional word elements such as ‘global coloring concept’ or ‘gcc’ did not alter its distinctive character because the additional elements were merely used together with the mark Coloris and positioned below it and were of such a size that they were not predominant in the mark.</p> <p>The same finding applies with even greater force to the additional words (global coloring concept) as ‘they are words with a general meaning. Furthermore, the word “coloring” refers to the goods concerned and, consequently, has a certain descriptive character’ (para. 31).</p> |   |                                     |

#### Additions with generic or descriptive meaning

Use of a registered word mark (or any other mark) together with a generic indication of the product or descriptive term will be considered as use of the registered mark. Additions that are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, do not in general constitute use of a variant but use of the mark itself.


For example:

| Registered form  | Actual use   | Case No                                   |
|--|--|---|
| HALDER   | HALDER I, HALDER II,<br>HALDER III, HALDER IV,<br>HALDER V | 13/04/2011,<br>T-209/09,<br>Alder Capital |
| The Court indicated that 'the fact that, in that newspaper article, the names of the funds are composed of the term "halder", to which a number in Roman numerals has been added, is not such as to call into question the conclusion on use of the mark, since, because of their brevity, their weak distinctive character and their ancillary position, those additions do not alter the distinctive character of the mark in the form in which it was registered' (para. 58). |  |   |

| Registered form   | Actual use  | Case No  |
|---|---|--|
|  |  | <p>09/07/2013, R 1190/2011-4,<br/>VIÑA ALBERDI / VILLA ALBERTI;<br/>confirmed 30/06/2015, T-489/13,<br/>VIÑA ALBERDI / VILLA ALBERTI</p> |

| Registered form   | Actual use | Case No |
|---|------------|---------|
| <p>The figurative signs reproduced in the evidence of use contain the distinctive elements of the earlier mark and those elements are clearly visible on the labels. The inversion of the figurative and word elements of the sign and the additional indication of the respective appellation of origin (Soave, Soave Superiore and Chianti) do not alter the distinctive character of the earlier mark, which appears reproduced in the sign with all its distinctive elements. Consumers of wines are particularly interested in knowing the precise geographical origin of these products; however, the addition of this information about the geographical origin of the goods is not capable of altering the distinctive character of a trade mark in its essential function of identifying a particular commercial origin (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 19).</p> |            |         |

| Registered form  | Actual use  | Case No                                     |
|--|-------------|---|
| ARKTIS   | ARKTIS LINE | 16/04/2015, T-258/13, ARKTIS, EU:T:2015:207 |
| <p>The Court stated that the term 'line', synonymous with the German word 'Linie', is commonly used in advertising and business in relation to a product line. It is likely to be perceived automatically as an additional element by the average consumer, particularly in Germany. The Court agreed with the Board of Appeal that the term 'line' did not alter the distinctive character of the disputed mark and that use of this trade mark in combination with this term was a use of that mark (paras 26-27).</p> |             |   |

| Registered form | Actual use   | Case No                             |
|-----------------|--|-------------------------------------|
| AINHOA          | <p>AINHOA in combination with 'BIO', 'LUXE', 'MINERAL PASSION', 'SPA WORLD CHOCOLATE' or</p>  | 23/09/2015, T-426/13, EU:T:2015:669 |

| Registered form  | Actual use | Case No |
|--|------------|---------|
| <p>The figurative element consists of a square representing the sky, with clouds concentrated in the lower part of the square. This element has no obvious connection with the goods in question, and is not original. Therefore, and taking into account its size and accessory position, it does not alter the overall impression produced by the mark at issue. The use of the figurative element must be regarded as an acceptable variation of the contested mark. Furthermore, the elements added, such as, 'bio', 'luxe', 'mineral passion' or 'spa world chocolate', are descriptive of the characteristics of the goods. The element 'bio' may easily be perceived as an abbreviation of the term 'biological' and refers to the origin or composition of the goods concerned. The term 'mineral' describes the components of the goods in question as minerals are commonly used in cosmetics. In addition, the word 'spa' has a particular meaning with regard to health and wellness establishments. Finally, the word 'luxe' is intended to describe the range of goods in question. Consequently, such additional elements do not alter the distinctive character of the mark (paras 30-32).</p> |            |         |

#### Other acceptable additions

The addition of insignificant elements such as punctuation marks does not alter distinctive character:


| Registered form   | Actual use   | Case No   |
|---|--------------|---|
| PELASPAN-PAC  | PELASPAN PAC | 22/03/2013, R 1986/2011-4, PELASPAN / PELASPAN et al. |
| <p>The use of the earlier mark 'PELASPAN-PAC' without the hyphen connecting the elements 'PELASPAN' and 'PAC' does not alter the distinctive character of the earlier mark as registered and therefore counts for the genuine use assessment.</p> |              |   |

In the same way, the use of plural or singular forms in meaningful words (for instance, by adding/omitting a letter 's' in English or other languages) normally does not alter distinctive character:

| Registered form | Actual use | Case No   |
|-----------------|------------|---|
| Tentation       | Tentations | 29/07/2008, R 1939/2007-1, TEMPTATION FOR MEN YANBAL (fig.)/TENTATION |

| Registered form   | Actual use | Case No |
|---|------------|---------|
| <p>'In the case in hand, and after an examination of the proof submitted, which focuses essentially on the Spanish market, the Board is of the opinion that use of the "TENTATION" registered trade mark through use of the "TENTATIONS" sign does not alter the distinctive character of the original registered trade mark. Specifically, the mere addition of the letter "S" to the end of the trade mark does not substantially alter the visual appearance or pronunciation of the registered trade mark and does not create a different conceptual impression on the Spanish market either. The trade mark in question will be perceived merely as being in its plural form as opposed to its singular form. Therefore, said change does not alter the distinctive character of the sign' (para. 17).</p> |            |         |

The addition of the 'type of enterprise' is also acceptable:

| Registered form   | Actual use  | Case No   |
|---|---|---|
|   | <p>The form used contained the logo plus the words 'SOCIEDAD LIMITADA' (in small letters) underneath the term 'SISTEMAS' and/or the 'E' device with the words 'epco SISTEMAS, S.L.' in bold</p> | <p>19/01/2009 R 1088/2008-2,<br/>EPCOS (fig.) / E epco<br/>SISTEMAS (fig.);<br/>confirmed 15/12/2010, T-132/09,<br/>Epcos</p> |
| <p>'... these signs are not, as the applicant seems to suggest, significant alterations of the distinctive character of the earlier mark as registered' (para. 24).</p> |   |   |

### Unacceptable additions


| Registered form   | Actual use   | Case No  |
|---|--|--|
| VILA VITA PARC  | <p>vila vita hotel &amp; feriendorf<br/>panno[n]ja</p> | <p>14/07/2014, T-204/12,<br/>Via Vita, EU:T:2014:646</p> |
| <p>'... whereas the German word "Feriendorf", meaning "holiday village", could be perceived as descriptive of the relevant [hotel] services, the same was not true for the word element "panno[n]ja"' (para. 30). Consequently, the addition of the word 'panno[n]ja' alters the distinctive character of the mark.</p> |  |  |


| Registered form | Actual use | Case No |
|-----------------|------------|---------|
|-----------------|------------|---------|

|  |                   |  |
|--|-------------------|--|
| Captain  | Captain Birds Eye | 23/04/2001, R 89/2000-1<br>EL CAPITAN PESCANOVA /<br>CAPTAIN |
| 'It cannot be considered ... that the use of CAPTAIN BIRDS EYE constitutes use of the mark CAPTAIN in a form which does not alter the distinctive character of the mark as registered, since the two signs appear essentially different' (para. 20). |                   |  |


### Addition of figurative elements

In cases where the figurative element plays only a minor role, being merely decorative, the distinctive character of the sign as registered is not affected.

| Registered form  | Actual use  | Case No                              |
|--|---|--------------------------------------|
| DRINKFIT   |  | 12/12/2014,<br>T-105/13,<br>TrinkFix |
| The addition of the semi-circular graphical element does not change the overall impression of the sign (para. 49). |   |                                      |

| Registered form   | Actual use  | Case No  |
|---|---|--|
| SEMBELLA  |  | 23/01/2014,<br>T-551/12,<br>Rebella,<br>EU:T:2014:30 |
| The figurative elements are only decorative or even negligible and do not alter the distinctive character of the mark (para. 43). |   |  |

| Registered form | Actual use | Case No |
|-----------------|------------|---------|
|-----------------|------------|---------|



|  |   |                              |
|--|---|------------------------------|
| BIONSEN  |  | 18/04/2008,<br>R 1236/2007-2 |
| <p>'[T]his material shows that the respondent's products also contain other elements, in particular a Japanese character within a small circle, which is depicted either above or below the word "BIONSEN" (para. 19).</p> <p>'However, in the present case, the combination of the stylised form of the word "BIONSEN" and the Japanese character, independently of whether it is above or under the word "BIONSEN", constitutes at the most use which differs from the form in which it was registered only in negligible elements. The word "BIONSEN" as used is merely a slight and banal stylisation of the word 'BIONSEN'. As to the addition of the figurative element in the form of a circular element with a Japanese character, this will hardly be noticed by the average consumer due to its relatively small size and position, either under or on the right side above the word "BIONSEN" (para. 23).</p> |   |                              |

### 2.7.3.2 Omissions

When considering 'omissions' of elements of a mark in its used form, care has to be taken to check that the distinctive character of the mark has not been altered.

If the omitted element is in a secondary position and not distinctive, its omission does not alter the mark (24/11/2005, T-135/04, Online Bus, EU:T:2005:419).

Omissions of non-dominant elements

| Registered form   | Actual use  | Case No                                |
|---|---|--|
|  |  | 24/11/2005,<br>T-135/04,<br>Online Bus |





The General Court considered that both the registered form of the earlier mark and the form used included the word 'BUS' and the figurative element of 'three interlaced triangles'. The presentation of the elements is not particularly original or unusual in either form. The variation in them does not affect the distinctive character of the trade mark. As regards the omission of 'Betreuungsverbund für Unternehmer und Selbständige e.V.', the latter was 'a string of words, written in small characters and occupying a secondary position, at the bottom of the sign. Its meaning (Association for the assistance of businessmen and the self-employed, registered association) refers to the services in question. 'Therefore, in the light of the descriptive content of that element and its accessory position in the presentation of the sign, it must be held that it is not distinctive ... It follows from the foregoing that the form used of the earlier trade mark used does not contain any differences such as to alter the distinctive character of that trade mark' (para. 34 et seq.).

### Omissions of generic or descriptive elements

Where a registered mark contains a generic indication of the product or descriptive term, and this term is omitted in the used form of the sign, such use will be considered as use of the registered mark.

Omissions that are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, in general constitute use of an acceptable variant.

| Registered form   | Actual use  | Case No  |
|---|---|--|
|  |  | 29/09/2011, T-415/09, Fishbone,<br>EU:T:2011:550;<br><br>confirmed 18/07/2013,<br>C-621/11 P, Fishbone,<br>EU:C:2013:484 |

The Board considered that although in some pieces of evidence the earlier mark did not include the word 'beachwear', this did not alter the distinctiveness of the earlier mark because it was plainly descriptive of the nature of the goods (t-shirts, beachwear).

The General Court held:



'In the present case, the earlier mark is a composite mark, representing a ship's wheel, that is to say, a sign with a rounded shape. In the centre of the sign there is a fish skeleton, at the top of which is written the term "fishbone", and at the bottom the term "beachwear". ... although the use of the earlier mark varies in certain items of evidence and is used in a form different from that under which it was registered, in the sense that the sign does not include the term "beachwear", such a fact does not affect its distinctive character. The term "beachwear", which means "beach clothing" in English, is descriptive of the nature of the goods covered by the earlier mark [emphasis added]. That descriptive character is obvious in the case of the "beach clothing" covered by the earlier mark, but also in the case of "t-shirts", for which the term "beachwear" will immediately be perceived as meaning that it refers to a t-shirt to be worn in casual situations, for example, on the beach in summer. Consumers will thus understand that term as designating the type of goods and will not perceive it as an indication of their commercial origin. The fact that the term "beachwear" is written in a more fanciful font than that of the term "fishbone", which is written in ordinary capital letters, cannot alter such an assessment. Furthermore, ... the font of the term "beachwear" cannot be regarded as uncommon, since it comprises printed lower-case characters. As for the horizontal position of the term "beachwear" in the earlier mark, which runs in a perpendicular sense across the bottom of a ship's wheel, it is no more graphically incisive than that of the term "fishbone" which, also written horizontally, follows the rounded shape of that wheel' (paras 62-63).

### Other acceptable omissions

The omission of insignificant prepositions does not alter the distinctive character:

| Registered form   | Actual use        | Case No   |
|---|-------------------|-----------|
| CASTILLO DE PERELADA  | CASTILLO PERELADA | B 103 046 |
| It is not considered that the absence of the word 'de' affects the distinctive character of the trade mark. |                   |           |

There are instances where the earlier sign is composed of a distinctive verbal element (or several) and a figurative element (or several), with the latter perceived by the relevant public as banal. Such banal elements are considered non-distinctive, and their omission does not change the distinctive character of the sign. Therefore, it is important to establish which elements influence the distinctive character of the mark and how consumers will perceive them.


| Registered form  | Actual use  | Case No   |
|--|---|---|
|   |  | 27/02/2014,<br>T-225/12,<br>LIDL express,<br>EU:T:2014:94, paras 49-53;<br>appealed 06/09/2016,<br>C-237/14 P,<br>LIDL express (fig.) / LIDL MUSIC (fig.)<br>et al. |
| The Court confirmed (para. 53) the finding of the Board that the 'distinctiveness of the mark is largely dominated by the wording 'LIDL MUSIC' and only marginally influenced by the figurative elements used to represent the letters and the small monogram underneath' (21/03/2012, R 2379/2010-1, LIDL express (fig.)/LIDL MUSIC (fig.) et al., para. 19). |   |   |



The omission of the transliteration of a term is generally considered as an acceptable alteration.

| Registered form  | Actual use | Case No   |
|--|------------|---|
| APALIA-ΑΠΑΛΙΑ  | APALIA     | 15/09/2011, R 2001/2010-1,<br>APANI / APALIA-ΑΠΑΛΙΑ |
| The omission of the transliteration of the term in Greek characters does not alter the distinctive character of the mark as the form used contains the term APALIA, which is distinctive and dominant. |            |   |

#### Unacceptable omissions

In principle, a difference in words or even letters constitutes an alteration of the distinctive character of the mark.

| Registered form  | Actual use  | Case No     |
|--|---|-------------|
| TONY HAWK  | HAWK<br> | B 1 034 208 |
| [T]he absence of the word element 'TONY' in the first two marks significantly alters the distinctive character of the registered earlier mark 'TONY HAWK'. Therefore, these marks shall be perceived as separate marks and their use cannot be considered as the use of the word mark 'TONY HAWK'. |   |             |

| Registered form   | Actual use  | Case No  |
|---|---|--|
| <br>(in Spain) |  | 03/02/2010,<br>R 1625/2008-4<br>LT LIGHT-TECHNO /<br>(FIGURATIVE);<br>appeal 10/11/2011, T-143/10, LT<br>LighT-Thecno, EU:T:2011:652 did<br>not refer to the Spanish trade<br>marks) |

'In the present matter, the Board has been able to verify that none of the proof of use supplied reproduces the earlier Spanish signs in the form in which they were registered, as either a representation of the mark in its purely visual form appears, that is, without the expression "light technology", or the visual element accompanied only by the term "Light" and other word elements or the expression "LT Light-Technology" also in word form without the visual element which obviously characterises the earlier Spanish marks on which the opposition is based ... In view of these circumstances, and taking into consideration that the modifications made to the representation of earlier marks modify their distinctive character, it is considered that, in any event, the proof submitted does not demonstrate the use of the Spanish marks in the basis of the opposition' (paras 15-16).

| Registered form | Actual use                      | Case No   |
|-----------------|---------------------------------|---|
| SP LA SPOSA     | LA SPOSA<br>LA SPOSA COLLECTION | 26/03/2010, R 1566/2008-4<br>ESPOSA / SP LA SPOSA |

'The earlier trade mark is registered as "SP LA SPOSA". The documents submitted as proof of use refer only to female wedding dresses. The element "LA SPOSA" is a common term, which will be understood by the Italian and Spanish public as "the bride" and has a weak distinctive character for the goods in issue, namely wedding dresses. The opponent itself, in its price list "tarifa de precios" which is drafted in various official languages of the EC, translated this term into the respective languages; underneath the term "LA SPOSA", the terms "novia" are mentioned in the Portuguese version of the list, "bride" in the English version, "Braut" in the German version, and so on. This shows that even the respondent itself understands the term "LA SPOSA" as a reference to the consumer targeted, namely the bride' (para. 18).

'Therefore the element "SP" at the beginning of the earlier mark is a distinctive element and cannot be disregarded. This element cannot be neglected, first and foremost as it is placed at the beginning of the mark. Also, it is meaningless and distinctive on its own, in all the languages of the European Union' (para. 19).


'[T]he omission of the letter "SP" in the word "LA SPOSA" or "LA SPOSA COLLECTION" is not an acceptable variation of the earlier mark but a significant modification to the distinctive character of the mark. The documents submitted by the respondent are insufficient to prove that the mark "SP LA SPOSA" has been put to genuine use' (para. 26).

| Registered form   | Actual use  | Case No  |
|---|---|--|
|  |  | <p>21/01/2015,<br/>T-46/13,<br/>KIT, EL SABOR DE NAVARRA,<br/>EU:T:2015:39</p> |

In this case the Court examined whether the omission, in the form as used, of the expression 'La Sabiduría del Sabor' alters the distinctive character of the earlier mark as registered. Firstly, the words 'Sabores de Navarra' (tastes/flavours of Navarra) refer to sensations or impressions evoking a region of northern Spain. Thus, the elements can be perceived by the Spanish-speaking public as descriptive of the geographical origin of the goods in question. Moreover, the word 'sabores' (flavours) may be perceived as an indication of product quality, i.e. flavour. It follows that the elements 'Sabores de Navarra' must be regarded as essentially descriptive.

The elements 'La Sabiduría del Sabor', given the meaning of the word 'La Sabiduría' (wisdom) and the word 'sabor' (flavour), constitutes a play of words and cannot be considered descriptive. It follows that the distinctiveness of the earlier mark comes essentially from the words 'La Sabiduría del Sabor'. The Court found that in the present case, the omission of the words 'La Sabiduría del Sabor' in the form used alters the distinctive character of the mark (paras 31-45).

In cases where the figurative element is the dominant or distinctive element and not merely decorative or banal, its omission can alter the distinctive character of the sign.

| Registered form  | Actual use | Case No   |
|--|------------|---|
|   | ESCORPION  | 28/03/2007,<br>R 1140/2006-2<br>SCORPIO / ESCORPION |
| <p>'The earlier trade marks are strongly characterised by the presence of the figurative element. However, the documents submitted during the opposition proceedings and, even if they were to be taken into account, the appeal proceedings, do not show any use of the figurative element contained in the earlier trade marks' (para. 19).</p> <p>'Therefore, the Office considers that the alteration of the opponent's trade mark appearing in the way it is currently used is not an acceptable alteration and consequently use of the registered mark is not shown. The opponent has not complied with the requirements of Article 43(2) and (3) of Regulation No 40/94 [now Article 47(2) and (3) EUTMR] and thus the opposition must be rejected, as far as it was based on the Spanish trade mark registrations' (para. 20).</p> |            |   |

### 2.7.3.3 Other alterations

#### Acceptable alterations


##### Word marks


Word marks are considered used as registered regardless of typeface, use of upper/lower case or colour. It would not be correct to analyse this type of use from the perspective of whether distinctive character is altered. However, a very particular typeface (highly stylised) may lead to a different conclusion.


Changing the letter size or switching between upper/lower case is customary when using word marks. Therefore, such use is considered use of the registered mark.

| Registered form | Actual use  | Case No   |
|-----------------|---|---|
| PALMA MULATA    |  | 12/03/2014,<br>T-381/12,<br>Palma Mulata<br>EU:T:2014:119 |

| Registered form  | Actual use | Case No |
|--|------------|---------|
| The Court confirmed that the use of a [standard] typeface does not alter the distinctive character of a word mark. It rather helps to distinguish the mark from the descriptive elements 'ron' and 'de Cuba' (para. 34). |            |         |

| Registered form   | Actual use  | Case No   |
|---|---|---|
| MILENARIO   |  | 18/09/2009,<br>R 289/2008-4<br>Sierra Milenario / MILENARIO |
| The Board confirmed OD's views that use of the word mark 'MILENARIO' written in stylised bold characters did not affect the distinctive character of the mark, as the word 'MILENARIO' was considered to be the dominant element of the mark registered for sparkly wines and liquors in Class 33 (para. 13). |   |   |

| Registered form   | Actual use  | Case No  |
|---|---|--|
| AMYCOR  |  | 25/05/2009,<br>R 1344/2008-2,<br>CLAMYCOR / AMYCOR |
| Representation of the word mark, registered for pharmaceutical and sanitary preparations; plasters; materials for dressings; fungicides; disinfectants covered by the earlier trade mark in Class 5, in a stylised form together with figurative elements was not considered as substantially changing the distinctive character of the word trade mark 'AMYCOR' as registered. |   |  |


| Registered form | Actual use  | Case No  |
|-----------------|---|--|
| THE ECONOMIST   |  | 05/08/2011,<br>R 56/2011-4<br>eIECONOMISTA (fig.) / THE ECONOMIST et al. |

| Registered form  | Actual use | Case No |
|--|------------|---------|
| <p>'The applicant's argument that the proof of use is insufficient because it refers to the device mark ... and not to the word mark 'THE ECONOMIST' fails. First, the submitted evidence refers to both earlier marks (i.e. the word mark and the device mark). Furthermore, use of the earlier device mark constitutes use of the earlier word mark. In this respect it should be noted that word marks are considered used as registered, also if the typeface is different (this may be different if the typeface is a very particular one), if there is a usual change in the letter size or a usual change between lower-case and capital letters, if used in a specific colour or if used in combination with generic additions. Use of the word "THE ECONOMIST" in a standard typeface, with the usual use of capitals at the beginning of the words "The" and "Economist", in a white colour on a contrasting background is considered use, not only of the earlier device mark but of the earlier word mark as well' (para. 14).</p> |            |         |

Word marks are registered in black and white. It is customary to use marks in colour. Such use does not constitute a variant but use of the registered mark.

| Registered form   | Actual use | Case No   |
|---|------------|---|
| BIOTEX  | (various)  | 02/10/2001, R 812/2000-1<br>BIO TEK (fig.) / BIOTEX |
| <p>'The mark, as shown in those documents, has been variously depicted in the following styles:</p> <ul style="list-style-type: none"> <li>– The word BIOTEX in white block capitals on a dark background in advertisements.</li> <li>– Reference in newspaper articles to the word BIOTEX in plain typeface.</li> <li>– The word BIOTEX in white block capitals with the top-most point of the letter 'l' in darker colouring.</li> <li>– The word BIOTEX in plain block white capitals on the labels and packaging of detergent products.</li> <li>– The word BIOTEX in plain typeface on shipping invoices.</li> <li>– The word BIOTEX in white upper and lower cases block letters on a darker background incorporating a figurative 'wave' device' (para. 14).</li> </ul> <p>'The evidence of use shows the mark has remained, in spite of various stylistic changes, essentially BIOTEX. The letters forming the mark have in general been mere block capitals, lacking anything fanciful. Sometimes the capitals are plain and two-dimensional, at other times they are shadowed to give the impression of being three-dimensional. Sometimes the letter "l" has a different colour tip. The Board considers these variations minimal and routine and that they demonstrate a practice that is commonplace not only in the particular business field of relevance here, but in other fields also. The Board does not consider that these variations invalidate use of the mark BIOTEX and therefore the contested decision must be annulled at this point' (para. 17).</p> |            |   |

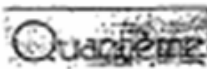



| Registered form  | Actual use  | Case No  |
|--|---|----------|
| SILVER   |  | B 61 368 |
| <p>'The actual use of the trade mark which can be seen on the beer pack, the newspaper extract and on the calendar is not the use of the registered word mark SILVER, but of the colour device mark, namely a beer label with the word SILVER written in white capital letters in a red banner which overlaps a golden circle which contains the word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg". This does not automatically mean that the mark was not used as registered. Each case must be looked at on its own merits. In this case, the Office finds that the mark SILVER is the actual trade mark. The appearance of the other word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg" and the figurative element is only secondary to the mark SILVER. It is also clear from the marketing study, the newspaper extract and the invoices that the actual trade mark is SILVER. The Office finds that the use of the word SILVER is so dominant in the figurative mark that it fulfils the requirements of having been used as registered.'</p> |   |          |



### Figurative marks


Using a purely figurative mark (without word elements) in a form other than registered often constitutes an unacceptable alteration.

In the case of composite marks (i.e. marks composed of word and figurative elements), changes to certain figurative elements do not normally affect the distinctive character of the marks.

| Registered form   | Actual use  | Case No   |
|---|---|---|
|  |  | 12/01/2006, T-147/03, Quantum,<br>EU:T:2006:10;<br><br>dismissed 15/03/2007,<br>C-171/06 P, Quantum,<br>EU:C:2007:171 |

| Registered form  | Actual use | Case No |
|--|------------|---------|
| <p>'[T]he only elements which differentiate the earlier national mark, as it was registered, from the sign used by the applicant are the stylisation of the letter "q", suggesting the face of a watch, and the use of capital letters to write the verbal element of the earlier national mark ... In the first place, although it is true that the stylisation of the letter "q" is more pronounced in the representation of the sign used than in that of the earlier national mark, the distinctive character of the earlier mark is still based on the entire verbal element of that mark. In any case, since the stylisation of the letter "q" suggests, as has just been said, the face of a watch, it is not particularly distinctive for goods in Class 14, the only goods for which the applicant has furnished proof of use of the earlier mark. In the second place, as regards the use of capital letters, it suffices to note that that is not at all original and also does not alter the distinctive character of the earlier national mark ... It follows that the proof furnished by the applicant which refers to the sign reproduced in paragraph 10 above for the Class 14 goods "watches and watch bands or straps" could legitimately be taken into account by the Board of Appeal for the purposes of assessing whether the applicant had shown genuine use of the earlier national mark' (paras 28-30).</p> |            |         |

| Registered form   | Actual use  | Case No   |
|---|---|---|
|    |  | <p>18/11/2015,<br/>T-361/13,<br/>VIGOR / VIGAR,<br/>EU:T:2015:859</p> |
| <p>The word 'vigar' is an invented word and is, therefore, inherently distinctive. Given the fact that the word 'vigar' is the only word element, and given its inherent distinctiveness, its central position and the fact that the additional elements highlight its presence, the word is the most distinctive element of the earlier mark.</p> <p>The form as used differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of lower case instead of upper case letters and the replacement of the crown element by a sequence of three dots. The Court agreed that a different orientation of the same background, the use of upper case or lower case letters when they are standard letters that reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term 'vigar', are minor differences that do not alter the distinctive character of the earlier trade mark as registered.</p> <p>That finding is not called into question if the second form of use is taken into account, inasmuch as, even though, in that case, the basic background disappears and the word 'spain' is present, the latter will be understood as a merely descriptive addition (paras 70-74).</p> |   |   |

| Registered form | Actual use   | Case No   |
|-----------------|--|---|
|                 | vieta<br><br> | 10/12/2015,<br><br>T-690/14,<br><br>Vieta,<br><br>EU:T:2015:950 |

The distinctive character of the mark is essentially derived, not from its figurative elements, but from the word 'vieta'. The element has a high level of distinctive character and occupies an important position in the overall impression created by the mark as registered, whilst the figurative elements have only weak distinctive character and occupy merely an ancillary position in the overall impression. Those figurative elements, including the typeface used, have a relatively marginal visual impact. The rectangular border does not present any originality in relation to usual commercial use. As regards the figurative elements made up of, on the one hand, grey rectangles separating the letters of the word 'vieta' and, on the other hand, white rectangles appearing in the middle of the sides of the rectangular border, they are very small in size, are not striking and do not present any originality (paras 47 and 48).

This is particularly relevant in cases where the figurative element is mainly descriptive of the relevant goods and services.



| Registered form | Actual use  | Case No  |
|-----------------|---|--|
| GRECO TAVERNA   |  | 01/03/2013,<br><br>R 2604/2011-1,<br><br>Taverna MEDITERRANEAN<br>WHITE CHEESE |

'In relation to the "FETA" product, as regards the two Greek flags next to the word "TAVERNA" it should be noted that the obligation of using a trade mark as registered does not require its proprietor to use the mark in isolation in the course of trade. Article 15(1) CTMR [now Article 18(1) EUTMR] does not preclude the possibility of the trade mark's proprietor adding further (decorative or descriptive) elements, or even other marks such as its house mark on the packaging of the product, as long as the trade mark 'as registered' remains clearly recognisable and in an individual form. The two Greek flags do not possess any distinctive character in relation to the products at hand which are commonly known to be food specialities originating from Greece. This is supported by the whole get-up of the product, coloured in blue and white in accordance with the colours of the Greek flag, the depiction of scenery which calls to mind a Mediterranean scene and the symbol for a Protected Designation of Origin below the picture' (para. 39).



This is also the case where the dominant elements remain unchanged (24/11/2005, T-135/04, Online Bus, EU:T:2005:419 above).



For alterations in colour specifically, the main question that needs to be addressed is whether the mark as used alters the distinctive character of the registered mark, that is to say whether use of the mark in colour, while being registered in black and white or greyscale (and vice versa) constitutes an alteration of the registered form. The Office and a number of IP offices of the European Union have agreed on a common practice under the European Trade Mark and Designs Network, whereby a change only in colour does not alter the distinctive character of the trade mark as long as:

- the word/figurative elements coincide and are the main distinctive elements;
- the contrast of shades is respected;
- the colour or combination of colours does not have distinctive character in itself;
- the colour is not one of the main contributors to the overall distinctiveness of the sign.

| Registered form   | Actual use  | Case No   |
|---|---|---|
|  |  | <p>24/05/2012,<br/>T-152/11,<br/>Mad,<br/>EU:T:2012:263</p> |

The Court took the view that, if no colour is claimed in the application, the use of different colour combinations 'must be allowed, as long as the letters contrast against the background.' The Court also noted that the letters M, A, D were arranged in a particular way in the EUTM. Accordingly, representations of the sign that do not alter the arrangement of the letters, or the contrast of colour, constitute genuine use (paras 41 and 45).

| Registered form  | Actual use  | Case No   |
|--|---|---|
|   |  | 23/06/2011,<br>R 1479/2010-2,<br>VOLKS-LASUR (fig.) /<br>LASUR et al. |
| The word element was considered to be the dominant feature of the figurative mark, since it was in a central position and in large letters. It was considered that the distinctive character was not changed (para. 15). |   |   |

| Registered form   | Actual use  | Case No   |
|---|---|---|
|    |  | 29/04/2010,<br>R 877/2009-1,<br>Kaiku Bifi actiVium (fig.) / Bi-Fi (fig.) |
| 'The orange background is the colour of packaging of the products. The mark is used in black on a white background, outlined in silver similar to the earlier registered mark. The typeface has been slightly modernised and the small hyphen between "Bi" and "Fi" has been deleted. Nevertheless, these may be considered as minor changes which do not alter the distinctive character of the mark in the form in which it is registered ... The typeface has been modernised but the letters keep their rounded shape and the deletion of the hyphen may pass unnoticed. The distinctive character of the earlier mark is still based on the large black letters "Bi Fi", the "B" and "F" being in capital letters and the two "i" letters in lower case, on a white background and outlined in silver' (para. 45). |   |   |

### 3D marks

The use of a 3D mark in varying sizes usually amounts to use of the mark as registered. The addition of a word/figurative element to such a mark does not generally alter the distinctive character of the sign.



### Colour marks

Colour marks are marks consisting of one or more colours. Where the mark is a colour combination, the registration must indicate the proportion of each colour and specify how they will appear.

Colour marks must be used with the colours as registered. Insignificant variations in the colour shade and strength will not alter distinctive character.

Where a colour combination is registered without specifying the respective proportions, use in varying proportions will not affect distinctive character. The case is different when particular proportions were claimed and these are substantially altered in the variant as used.




Where a colour or colour combination is registered, use in combination with a distinctive or descriptive word will not affect distinctive character. See, by analogy, the Court judgment below regarding the proof of acquired distinctiveness of a mark (examination).



| Registered form  | Actual use                  | Case No   |
|--|-----------------------------|---|
|    | (with word mark John Deere) | 28/10/2009,<br>T-137/08,<br>Green/Yellow,<br>EU:T:2009:417<br>(AG case) |
| <p>'The colours covered by the application for registration were designated using the Munsell system as: 9.47 GY3.57/7.45 (green) and 5.06 Y7.63/10.66 (yellow). The arrangement is described as being 'green for the vehicle body and yellow for the wheels', as is shown by a picture attached to the application and reproduced below</p> <p></p> <p>' (para. 3).</p> <p>'[A]lthough it is true that the disputed mark was used and promoted in conjunction with the word mark John Deere [underlining added] and that the intervener's advertising expenditure in the European Union was presented as a whole and not individually for each country, the applicant is wrong to claim that it was not proved to the required legal standard that the intervener had used the combination of the colours green and yellow on its goods as a trade mark and that the market penetration of its goods had been deep and long-lasting in all the Member States of the European Union as at 1 April 1996' (para. 46).</p> |                             |   |

### Unacceptable alterations

Where a mark is composed of several elements, only one or some of which are distinctive, that have rendered the mark as a whole registrable, an alteration of that element or its omission or replacement by another element will generally mean that the distinctive character is altered.

| Registered form  | Actual use | Case No  |
|--|------------|--|
| MEXAVIT  | MEXA-VIT C | 30/03/2007, R 159/2005-4,<br>Metavit / MEXA-VIT C et al. |
| In this case the use of the mark with a different spelling and the addition of the letter 'C' alter the distinctive character of the registered sign, because the letters 'VIT' are now seen as a descriptive element, namely 'VIT C' (which refers to 'Vitamin C'). |            |  |

| Registered form  | Actual use  | Case No   |
|--|---|---|
|   |  | 09/09/2011, R 2066/2010-4,<br>HAPAG LLOYD EXPRESS |
| <p>'[T]he 'NOVEDADES' catalogues dated 2004-2009 consistently show the mark</p> <p></p> <p>and only this version. This does not constitute use of the mark [as registered] (with or without colour) as admissible under Article 15(1)(a) CTMR [now Article 18(1)(a) EUTMR]. The mere fact that both marks include a word element LLOYD'S is not enough for that purpose, also the figurative elements of the earlier mark must appear in the form as used. The form as used is in a different font, lacks the single letter L at the end and surrounded by an orbital device, and lacks the circular or orbital device around the word 'LLOYD'S'. In other words, all its figurative elements are missing in the form as used. On top, the form as used contains the conspicuous device of a flying bird with a long beak. The omission of all the figurative elements of the mark as registered and the addition of another figurative element does alter, in the form as used, the distinctive character of the mark and is much more than a mere variation or modernisation' (para. 35).</p> |   |   |

| Registered form   | Actual use  | Case No  |
|---|---|--|
|  |  | 15/12/2015,<br>T-83/14,<br>ARTHUR & ASTON / Arthur,<br>EU:T:2015:974 |

There are significant differences between the sign used and the earlier mark in its registered form. Those differences are such as to alter, from the perspective of the average French consumer to whom the goods in Class 25 are addressed, the distinctiveness of the earlier mark in its registered form. The graphic element of that mark, consisting of a stylised signature, disappears entirely from the sign used and is replaced by a radically different graphic element which is very classical, symmetrical and static. The earlier mark in its registered form attracts attention by its asymmetry and the dynamism conferred by the movement of the letters from left to right. The differences between the abovementioned mark and sign are not negligible and the mark and sign cannot be regarded as being broadly equivalent within the meaning of the case-law. Having regard to the fact that the particular graphic design of the word 'arthur' contributes, with that word, to the distinctiveness of the earlier mark in its registered form and that it is radically altered in the sign used, the differences between the mark and the sign at issue are such that the distinctiveness of the first has been altered (paras 22 to 24).

## **2.8 Use for the goods or services for which the mark is registered**

In accordance with Article 18 EUTMR, the mark must be used for the goods or services for which it is registered in order to be enforceable. In accordance with the first sentence of Article 47(2) EUTMR, the earlier registered mark must have been put to genuine use in connection with the goods or services in respect of which it is registered and which the opponent cites as justification for its opposition. The third sentence of Article 47(2) EUTMR stipulates that if the earlier trade mark has been used for part only of the goods or services for which it is registered it will, for the purposes of the examination of the opposition, be deemed to be registered for only that part of the goods or services.

As the General Court stated in the Aladin case:

The provisions of Article 43 of Regulation No 40/94 [now Article 47 EUTMR] allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration ..., and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him. That is particularly so when, as here, the goods and services for which the trade mark has been registered form a sufficiently narrowly-defined category.

(14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 51, emphasis added.)

The analysis of genuine use must in principle extend to all of the registered goods and/or services on which the opposition is based and for which the EUTM applicant has made an explicit request for proof of use. However, in situations where it is clear



that likelihood of confusion can be established on the basis of some of the earlier goods and/or services, the Office's analysis of genuine use need not extend to all the earlier goods and/or services but instead may focus on only those goods and/or services sufficient for establishing identity/similarity to the contested goods and/or services.

In other words, since likelihood of confusion can be established on the basis of a finding of genuine use for some of the earlier goods and/or services, it is unnecessary to examine the evidence of use submitted by the opponent with respect to the remaining earlier goods and/or services.

The following sections include a number of guidelines to help establish whether the earlier trade mark has been effectively used for the registered goods and services. For further details, see the Guidelines, Part C, Opposition, Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services and, in particular, the practice regarding the use of all the general indications in the class heading, and the Guidelines, Part B, Examination, Section 3, Classification.

#### 2.8.1 Comparison between goods/services used and specification of goods/services

It must always be carefully assessed whether the goods and services for which the mark has been used fall within the category of the registered goods and services.

##### Examples

| Case No   | Registered G&S   | Used G&S                                   | Comment  |
|---|--|--|--|
| 18/01/2011, T-382/08, Vogue                                 | Footwear.  | Retail of footwear.                        | Not OK (paras 47 and 48).  |
| 13/05/2009, T-183/08, Jello Schuhpark II                    | Footwear.  | Retail services regarding footwear.        | Not OK (para. 32)  |
| 08/11/2001, R 807/2000-3, DEMARA / DEMAR Antibioticos, S.A. | Pharmaceuticals, veterinary and disinfectant products. | Napkins and napkin pants for incontinence. | Not OK, even though the specific goods might be distributed by pharmacies (paras 14 and 16). |
| 03/10/2008, R 1533/2007-4, Geo Madrid (fig.) / GEO          | Telecommunication services in Class 38.                | Providing an internet shopping platform.   | Not OK (para. 16).   |

| Case No  | Registered G&S   | Used G&S   | Comment   |
|--|--|--|---|
| 03/05/2004,<br>R 68/2003-2,<br>SWEETIE / SWEETY      | Preserved, dried and cooked fruits and vegetables;<br>concentrated citrus fruit and fruit extracts, preserves; sugar, biscuits, cakes, pastry and confectionery. | Dessert toppings that are strawberry, caramel or chocolate flavoured.          | Not OK (para. 20).  |
| 24/02/2010,<br>R 1519/2008-1, DADO /<br>DODOT et al. | Baby diapers of textile in Class 25.   | Disposable diapers of paper and cellulose (Class 16).                          | Not OK (para. 29).  |
| 18/06/2010,<br>R 594/2009-2, BANIF /<br>BANIF (fig.) | Administration, representation and general counsel in Class 35<br>Technical, economic and administrative projects in Class 42.                                   | Administration of funds and personal assets or real estate affairs (Class 36). | Not OK (para. 39).  |
| 31/05/2011, B 1 589 871                              | Electric switches and 'parts of lamps'.  | Apparatus for lighting.  | Not OK.   |
| 25/11/2002, B 253 494                                | Education services.  | Entertainment services.  | Not OK.   |
| 28/04/2011,<br>B 1 259 136                           | Transportation and distribution services in Class 39.  | Home delivery of goods purchased in a retail store.                            | Not OK as the registered services are provided by specialist transport companies whose business is not the provision of other services, while the home delivery of goods purchased in a retail store is just an additional auxiliary service integrated in retail services. |

| Case No                                    | Registered G&S  | Used G&S         | Comment   |
|--|---|------------------|---|
| 23/08/2012,<br>R 1330/2011-4,<br>AF (fig.) | Advertising, business<br>management, business<br>administration, office<br>functions in Class 35. | Retail services. | Not OK. If a trade mark is registered for the general indications in Class 35, but use is proven only for retail services for particular goods, this cannot amount to valid proof of use for any of the specific indications of Class 35 or the class heading as a whole (para. 25 by analogy). |

### 2.8.2 Relevance of the classification

It is relevant to establish whether the specific goods or services for which a mark has been used fall under any general indication listed in the class heading of a particular class of goods or services, and if so, which.

For instance, in Class 25, the class heading is clothing, footwear, headgear, and each of these three items constitutes a 'general indication'. Whereas, in general, classification does not serve more than administrative purposes, it is relevant, in order to assess the nature of the use, to establish whether the goods for which a mark has been used fall under the general indication of clothing, footwear, headgear.

This is apparent when similar categories of goods have been classified differently for certain reasons. For instance, shoes have been classified in various classes according to their intended purpose: orthopaedic shoes in Class 10 and ordinary shoes in Class 25. It must be established, according to the evidence provided, to which kind of shoes the use relates.

### 2.8.3 Use and registration for general indications in 'class headings'

Where a mark is registered under all or part of the general indications listed in the class heading of a particular class and where it has been used for several goods or services that are properly classified in the same class under one of these general indications, the mark will be considered as having been used for that specific general indication.

Example: The earlier mark is registered for clothing, footwear, headgear in Class 25. The evidence relates to 'skirts', 'trousers' and 'T-shirts'.

Conclusion: The mark has been used for clothing.

On the other hand, when a mark is registered for only part of the general indications listed in the class heading of a particular class but has been used only for goods or services which fall under another general indication of that same class, the mark will not be considered as having been used for the registered goods or services (see also paragraph 2.8.4 below).

Example: The earlier mark is registered for clothing in Class 25. The evidence relates to 'boots' only.

Conclusion: The mark has not been used for the goods for which it is registered.

#### 2.8.4 Use for subcategories of goods/services and similar goods/services

This part deals with the extent of protection granted where there is use for subcategories of goods and of 'similar' goods (or services).

In general, it is not appropriate to accept proof of use for 'different' but somehow 'linked' goods or services as automatically covering registered goods and services. In particular, the concept of similarity of goods and services is not a valid consideration within this context. The third sentence of Article 47(2) EUTMR does not provide any exception in this regard.

Example: The earlier mark is registered for clothing in Class 25. The evidence relates to 'boots' only.

Conclusion: The mark has not been used for the goods for which it is registered.

##### 2.8.4.1 Earlier mark registered for broad category of goods/services

In the Aladin case, the General Court held:

if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong.

(14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45.)

Therefore, if the earlier mark has been registered for a broad category of goods or services but the opponent provides evidence of use only for specific goods or services falling within this category, this raises the question of whether the submitted evidence is to be regarded strictly as proof of use only for the particular goods or services, which are not mentioned as such in the list of goods or services, or for the broad category as specified in the registration.

The General Court further pointed out, on the one hand, that it is necessary to interpret the last sentence of Article 47(2) EUTMR as seeking to deny a trade mark extensive protection, if it has only been used in relation to part of the goods or services for which it is registered, merely because it has been registered for a wide range of goods or

services. Therefore, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark is registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do so in the light of the goods or services for which genuine use has actually been established (paragraph 44).

On the other hand, it is not necessary for the opponent to file evidence of all the commercial variations of similar goods or services but merely of those goods or services that are sufficiently distinct to constitute coherent categories or subcategories (paragraph 46). The underlying reason is that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration.

Thus, protection is available only for the subcategory or subcategories to which the used goods or services belong if:

1. a trade mark has been registered for a category of goods or services:
    - a. that is sufficiently broad to cover a number of subcategories other than in an arbitrary manner;
    - b. that are capable of being perceived as being independent from each other;
- and
- 2. it can be shown that the mark has been genuinely used in relation to only part of the initial broad specification.

Appropriate reasoning should be given for defining the subcategories and, on the basis of the evidence submitted by the opponent, it must be explained whether use has been shown in relation to only part of the initial broad specification or subcategory/subcategories. See examples in paragraph 2.8.4.3 below.

This is especially important in the case of trade marks registered for pharmaceutical preparations, which are usually used only for one kind of medicine for treating a certain disease (see the examples of pharmaceutical preparations in paragraph 2.8.4.3 below).

On the other hand, the use for a whole category has to be accepted if there are examples of different kinds of products belonging to this category and there is no other subcategory that covers the different products.

| Contested sign | Case No                                   |
|----------------|---|
| CARRERA        | 09/09/2009, R 260/2009-4,<br>(revocation) |

| Contested sign   | Case No |
|--|---------|
| <p>The proven use of a trade mark for:</p> <ul style="list-style-type: none"> <li>• decorative lettering;</li> <li>• increased performance packages;</li> <li>• covers for storage compartments;</li> <li>• wheel sets and complete wheel sets for summer and winter; and</li> <li>• door sill cover plates</li> </ul> <p>was considered sufficient proof of use for motor vehicle and land vehicle parts overall, for which the mark was registered. The main arguments were that it was used for numerous different motor vehicle parts and the goods for which use had been proven thus covered a wide spectrum of motor vehicle parts: elements of the chassis, the bodywork, the engine, the interior design and decorative elements.</p> |         |

#### 2.8.4.2 Earlier mark registered for precisely specified goods/services

In contrast, proof of genuine use of the mark for some of the specified goods or services necessarily covers the entire category if:

1. a trade mark has been registered for goods or services specified in a relatively precise manner; so that
2. it is not possible, without any artificiality, to make any significant subdivisions within the category concerned (14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45).


The decision should duly indicate in which cases it is considered impossible to make subdivisions and, if necessary, why.

#### 2.8.4.3 Examples

In order to define adequate subcategories of general indications, the criterion of the purpose or intended use of the product or service in question is of fundamental importance, as consumers do employ this criterion before making a purchase (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 29-30; 23/09/2009, T-493/07, Famoxin, EU:T:2009:355, § 37). Other applicable criteria for defining adequate subcategories could be the characteristics of the product or service, for instance the nature of the product or service or the target consumer of the product or service. The geographical origin of the goods is not relevant. Even if the geographical origin of wines is an important factor when they are being chosen, such a factor is not so important that wines with different appellations of origin could constitute subcategories of goods that could be viewed autonomously (30/06/2015, T-489/13, VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446, § 37).

| Earlier sign   | Case No              |
|--|----------------------|
| ALADIN   | 14/07/2005, T-126/03 |
| <p>G&amp;S: polish for metals in Class 3.</p> <p>Assessment of PoU: the earlier mark was registered for polish for metals in Class 3, but was actually used genuinely only for magic cotton (a product for polishing metals consisting of cotton impregnated with a polishing agent). The Court held that 'polish for metals', which in itself is already a subcategory of the class heading term polishing preparations, is sufficiently precise and narrowly defined in terms of the function and intended purpose of the claimed goods. No further subcategory can be established without being artificial, and thus, use for the entire category of polish for metals was assumed.</p> |                      |

| Contested sign   | Case No                                       |
|--|---|
| Turbo  | 19/06/2007, R 378/2006-2, TURBO<br>Revocation |
| <p>G&amp;S: clothing in Class 25.</p> <p>Assessment of PoU: the Board found that, in addition to swimwear, other types of clothing were referred to in the invoices and could be found in the catalogues. Thus, the Board found that use of the contested mark had been proved for clothing (para. 22). The Board, moreover, found it almost impossible and certainly unduly onerous to impose on the proprietor of a registered EUTM for clothing the obligation to demonstrate use in all possible subcategories that could be endlessly subdivided by the applicant (para. 25).</p> |   |

| Earlier sign   | Case No   |
|--|---|
|   | 19/01/2009, R 1088/2008-2,<br>EPCOS (fig.) / E epco SISTEMAS (fig.);<br>confirmed 15/12/2010, T-132/09, Epcos |
| <p>G&amp;S: measuring apparatus and instruments in Class 9.</p> <p>Assessment of PoU: the mark was used for apparatus and parts thereof for the measurement of temperature, pressure and level. The contested decision considered that the original specification of the earlier mark for measuring apparatus and instruments was a 'very wide' one, and determined, applying the criteria established in the Aladin judgment, that use had in fact only been shown for a subcategory of goods, namely: measuring apparatus, all being for the measurement of temperature, pressure and level; parts for the aforesaid apparatus. The Board found that approach to be a reasonable one in the circumstances of the case and endorsed the reasoning and findings of the contested decision in this regard (para. 29).</p> |   |

| Contested sign  | Case No  |
|---|--|
| ICEBERG   | 23/07/2009, R 1166/2008-1, ICEBERG<br>Revocation |
| <p>G&amp;S: apparatus for heating, steam generating, refrigerating, drying, ventilating and water supply purposes in Class 11.</p> <p>Assessment of PoU: the Board concluded that the trade mark use was only proven for fridges, freezers and air-conditioning modules for yachts and boats (para. 26). These goods were included in the subcategories apparatus for heating (insofar as an air-conditioning machine can also perform as a heater), apparatus for refrigerating (insofar as an air-conditioning machine, a fridge and a freezer can keep air/things cold), and apparatus for ventilating (insofar as an air-conditioning machine, a fridge and a freezer all include ventilation circuits), for which the mark was registered. Therefore, the Board thought it should remain registered for those subcategories (para. 27). However, the Board did not consider it appropriate to limit the scope of protection of the trade mark to yachts and boats. This would have further split the 'subcategories' and would amount to unjustified limitation (para. 28).</p> <p>Conclusion: use was considered proven for apparatus for heating, refrigerating and ventilating.</p> |  |

| Contested sign  | Case No  |
|---|--|
| LOTUS   | 02/12/2008, R 1295/2007-4, LOTUS<br>Revocation |
| <p>G&amp;S: outerwear and underwear, hosiery, corsets, neckties, braces, gloves, underclothes in Class 25.</p> <p>Assessment of PoU: no evidence was submitted in respect of the goods corsets, neckties, braces. None of the pieces of evidence submitted mentions these goods or refers to them. Use must be demonstrated for all goods or services for which the trade mark is registered. The trade mark is registered for outerwear and underwear, but also for specific products within this category — inter alia corsets, neckties, braces. Use for other goods is not sufficient to maintain protection under trade mark law for these goods, even if these other goods also fall under the category outerwear and underwear. The Invalidity Division, however, considered use to be sufficient because, according to the principles of the Aladin judgment (14/07/2005, T-126/03, Aladin, EU:T:2005:288) the corsets, neckties, braces fall under the generic term of outerwear and underwear. While this is indeed true, this question is subordinate to examining whether the goods used can be subsumed under the claimed term at all. This is not the case for corsets, neckties, braces. If, alongside the broad generic term, the trade mark also explicitly claims specific goods covered by the generic term, it must also have been used for these specific goods in order to remain registered for them (para. 25).</p> |  |

| Earlier sign | Case No |
|--------------|---------|
|--------------|---------|



|   |  |
|---|--|
| GRAF-SYTECO   | 16/12/2010, R 1113/2009-4,<br>GRAFSYSTEM / GRAF-SYTECO |
| <p>G&amp;S: electric instruments (included in Class 9); optical, weighing, measuring, signalling and checking (supervision) instruments; data processing equipment and computers, in particular for operating, monitoring and checking machines, installations, vehicles and buildings; recorded computer programs; electronic counters in Class 9, repair services in Class 37 and computer programming in Class 42.</p> <p>Assessment of PoU: the devices that the opponent has proven to have placed on the market fall under the wording of hardware as specified in Class 9. This is, however, a vast category, especially considering the massive development and high specialisation taking place in this field, which can be divided into subcategories according to the actual goods produced. In the present case, the goods must be limited to the automotive industry. As the opponent is obliged to provide a legal guarantee to clients, it can be considered that it has also proven use of the service relating to repair of the hardware in question (Class 37). The Board also found that recorded computer programs in Class 9 were a very broad category and had to be limited to the actual field of activity of the opponent (paras 30-31). No evidence was submitted for Class 42.</p> |  |

|  |   |
|--|---|
| Earlier sign   | Case No   |
| HEMICELL   | 20/09/2010, R 155/2010-2,<br>HICELL (fig.) / HEMICELL |
| <p>G&amp;S: foodstuffs for animals in Class 31, and animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31.</p> <p>Assessment of PoU: the contested decision erred in considering that the earlier mark had been put to genuine use for foodstuffs for animals in Class 31, and animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31, since this finding is contrary to the findings of the Court in Aladin. The reason given by the contested decision is not acceptable because it should have been tested whether or not the category of goods covered by the earlier mark was susceptible of being divided into independent subcategories and whether the goods for which use of the earlier mark had been proven could be classified in one of those. Therefore, the Board considers that the earlier EUTM is, for the purposes of examination of the opposition, deemed to be registered in respect of additives for animal feed only in Class 31.</p> |   |

| Contested sign | Case No                                   |
|----------------|---|
| VIGOR          | 18/11/2015,<br>T-361/13,<br>VIGOR / VIGAR |

| Contested sign   | Case No |
|--|---------|
| <p>G&amp;S: all kinds of brushes and brush goods, for cleaning and hygiene purposes in Class 21.</p> <p>The proven use of a trade mark for brooms, brushes and sponges, among other goods, was considered sufficient proof of use for 'all kinds of brushes and brush goods, for cleaning and hygiene purposes', for which the mark was registered. The Court stated that these household and kitchen products do not constitute a category that is broad enough for it to be necessary to identify them within subcategories in which actual use had specifically to be proven. Rather, it must be held that it is not possible to make significant subdivisions within that category of goods.</p> |         |

### Pharmaceutical preparations

In a number of cases, the Court had to define adequate subcategories for pharmaceutical preparations in Class 5. It held that the purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. Thus, the therapeutic indication is the key for defining the relevant subcategory of pharmaceutical products. Other criteria (such as dosage form, active ingredients, whether it is sold on prescription or over the counter) are irrelevant in this regard.

The following subcategories for pharmaceutical preparations were assumed to be adequate by the Court:

| Case No                                       | Adequate  | Non-adequate   |
|---|---|--|
| 13/02/2007, T-256/04, Respicur                | Pharmaceutical preparations for respiratory illnesses.    | Multi-dose dry powder inhalers containing corticoids, available only on prescription.  |
| 23/09/2009, T-493/07, Famoxin                 | Pharmaceutical preparations for cardiovascular illnesses. | Pharmaceutical preparations with digoxin for human use for cardiovascular illnesses.   |
| 16/06/2010, T-487/08, Kremezin, EU:T:2010:237 | Pharmaceutical preparations for heart treatment.          | Sterile solution of adenosine for use in the treatment of specific heart condition, for intravenous administration in hospitals. |
| 17/10/2006, T-483/04, Galzin, EU:T:2006:323   | Calcium-based preparations.                               | Pharmaceutical preparations.   |

### 2.8.5 Use of the mark as regards integral parts and after-sales services of the registered goods

In the Minimax judgment, the Court held that, in certain circumstances, use of the mark may be considered genuine also for 'registered' goods that had been sold at one time

and were no longer available (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 40 et seq.).

- This may apply where the proprietor of the trade mark under which such goods had been put on the market sells parts that are integral to the make-up or structure of the goods previously sold.
- The same may apply where the trade mark proprietor makes actual use of the mark for after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

| Sign  | Case No             |
|---|---------------------|
| Minimax   | 11/03/2003, C-40/01 |
| <p>G&amp;S: fire extinguishers and associated products v components and after-sales services.</p> <p>Assessment of PoU: the authorisation for the fire extinguishers sold by Ansul under the Minimax trade mark expired in the 1980s. Since then, Ansul has not been selling fire extinguishers under that mark. However, Ansul nonetheless sold component parts and extinguishing substances for fire extinguishers bearing the mark to undertakings with responsibility for maintaining them. During the same period, it also maintained, checked and repaired equipment bearing the Minimax mark itself, used the mark on invoices relating to those services and affixed stickers bearing the mark and strips bearing the words 'Gebruiksklaar Minimax' (Ready for use Minimax) to the equipment. Ansul also sold these stickers and strips to undertakings that maintain fire extinguishers.</p> |                     |

However, this finding of the Court should be interpreted strictly and applied only in very exceptional cases. In Minimax, the Court accepted use for goods other than those registered, which runs counter to the general rule laid down in Article 47(2) EUTMR.

## 2.9 Use by the proprietor or on its behalf

### 2.9.1 Use by the proprietor

According to Articles 18(1) and 47(2) EUTMR, it is in general the owner who has to put the earlier registered mark to genuine use. These provisions also cover use of the mark by the previous owner during its ownership (10/12/1999, B 74 494).

### 2.9.2 Use by authorised third parties

According to Article 18(2) EUTMR, use of the mark with the consent of the proprietor is deemed to constitute use by the proprietor. This means that the owner must have given its consent prior to the use of the mark by the third party. Acceptance later is insufficient.

A typical case of use by third parties is use made by licensees. Use by companies economically related to the trade mark proprietor, such as members of the same group

of companies (affiliates, subsidiaries, etc.) is similarly to be considered as authorised use (30/01/2015, T-278/13, now, EU:T:2015:57, § 38). Where goods are produced by the trade mark proprietor (or with its consent), but subsequently placed on the market by distributors at wholesale or retail level, this is to be considered as use of the mark (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 32; 16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 73).

At the evidence stage it is *prima facie* sufficient that the opponent only submits evidence that a third party has used the mark. The Office infers from such use, combined with the opponent's ability to present evidence of it, that the opponent has given prior consent.

This position of the Office was confirmed by judgment of 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 25 (further confirmed 11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310). The Court pointed out that it was unlikely that the proprietor of a trade mark would be in a position to submit evidence if the mark had been used against its wishes. There was all the more reason to rely on that presumption, given that the applicant did not dispute the opponent's consent.

However, if the Office has doubts or, in general, in cases where the applicant explicitly contests the opponent's consent, the burden is on the opponent to submit further evidence that it gave its consent prior to use of the mark. In such cases, the Office gives the opponent a further period of 2 months for the submission of such evidence.

### 2.9.3 Use of collective and certification marks by authorised users

Collective marks are generally used not by the proprietor but by members of an association. As far as EU collective marks are concerned, this is reflected in Article 78 EUTMR, which provides that use by any authorised person satisfies the user requirement.

Certification marks are not used by their proprietors but by authorised users, for the purpose of guaranteeing to consumers that the goods or services possess a particular characteristic. As far as EU certification marks are concerned, this is reflected in Article 87 EUTMR, which provides that use by the authorised person in accordance with the regulations governing the use of the certification mark satisfies the user requirement.

## 2.10 Legal use

Whether a mark has been used in a way that satisfies the use requirements of Articles 18 and 47 EUTMR requires a factual finding of genuine use. Use will be 'genuine' in this context even if the user violates legal provisions.

Use that is deceptive within the meaning of Article 7(1)(g) or Article 58(1)(c) EUTMR or under provisions of national law remains 'genuine' for the purpose of asserting earlier marks in opposition proceedings. The sanctions for deceptive use are invalidation or

revocation, as the case may be, or a prohibition of use (provided for pursuant to Article 137(2) EUTMR).

The same principle applies where use is made under an illegal licensing arrangement (for example arrangements violating the competition rules of the Treaty on the Functioning of the European Union or national rules). Similarly, the fact that use may infringe third-party rights is also irrelevant.

## **2.11 Justification of non-use**

According to Article 47(2) EUTMR, the opponent may alternatively prove that there are justifiable reasons for non-use of its earlier registered mark. These reasons cover, as mentioned in the second sentence of Article 19(1) of the TRIPS agreement, circumstances arising independently of the will of the owner of the trade mark that constitute an obstacle to the use of the trade mark.

As an exception to the obligation of use, the concept of proper reasons for non-use is to be interpreted rather narrowly.

‘Bureaucratic obstacles’ as such, that arise independently of the will of the trade mark proprietor, are not sufficient, unless they have a direct relationship with the mark, so much so that use of the trade mark depends on successful completion of the administrative action concerned. However, the criterion of a direct relationship does not necessarily imply that use of the trade mark is impossible; it might suffice that use is unreasonable. It must be assessed on a case-by-case basis whether a change in the undertaking’s strategy to circumvent the obstacle under consideration would make use of the mark unreasonable. Thus, for example, the proprietor of a mark cannot reasonably be required to change its corporate strategy and sell its goods in its competitors’ sales outlets (14/06/2007, C-246/05, *Le Chef de Cuisine*, EU:C:2007:340, § 52).

### **2.11.1 Business risks**

The concept of proper reasons must be considered to refer to circumstances arising independently of the will of the owner that make use of the mark impossible or unreasonable, rather than to circumstances associated with commercial difficulties it is experiencing (14/05/0008, R 855/2007-4, *PAN AM*, § 27; 09/07/2003, T-162/01, *Giorgio Beverly Hills*, EU:T:2003:199, § 41, (18/03/2015, T-250/13, *SMART WATER*, EU:T:2015:160, § 67-69).

Thus, financial difficulties encountered by a company as a result of an economic recession or due to its own financial problems are not considered to constitute proper reasons for non-use within the meaning of Article 47(2) EUTMR, as these kinds of difficulties constitute a natural part of running a business.

## 2.11.2 Government or court intervention

Import restrictions or other government requirements are two examples of proper reasons for non-use that are explicitly mentioned in the second sentence of Article 19(1) of the TRIPS agreement.

Import restrictions include a trade embargo affecting the goods protected by the mark.

Other government requirements can be a state monopoly, which impedes any kind of use, or a state prohibition of the sale of goods for reasons of health or national defence. Typical cases in this respect are regulatory procedures such as:

- clinical trials and authorisation for new medicines (18/04/2007, R 155/2006-1, LEVENIA / LEVELINA); or
- the authorisation of a food safety authority, which the owner has to obtain before offering the relevant goods and services on the market.

| Earlier sign  | Case No  |
|---|--|
| HEMICELL  | 20/09/2010, R 155/2010-2, HICELL (fig.) / HEMICELL |
| The evidence submitted by the opponent duly shows that use of the earlier marks for a food additive, namely, zootechnical digestibility enhancer (feed enzyme) was conditional upon prior authorisation, to be issued by the European Food Safety Authority following an application filed before that body. Such a requirement is to be deemed a government requirement in the sense of Article 19(1) TRIPS. |  |

With regard to Court proceedings or interim injunctions the following must be differentiated:

On the one hand, the mere threat of litigation or a pending cancellation action against the earlier mark should, in general, not exempt the opponent from the obligation to use its trade mark in the course of trade. It is up to the opponent, being the attacking party in opposition proceedings, to conduct an adequate risk assessment of its chances to prevail in the litigation proceedings and to draw the appropriate conclusions from this evaluation as to whether or not to continue with use of its mark (18/02/2013, R 1101/2011-2, SMART WATER, § 40 (18/03/2015, T-250/13, SMART WATER, EU:T:2015:160).

| Earlier sign | Case No                                    |
|--------------|--|
| HUGO BOSS    | 09/03/2010, R 764/2009-4, HUGO BOSS / BOSS |

| Earlier sign  | Case No |
|---|---------|
| <p>The national [French cancellation] proceedings brought against the opposing trade mark cannot be acknowledged as a proper reason for non-use (para. 19).</p> <p>The fact remains that proper reasons for non-use are only those outside the sphere and influence of the trade mark proprietor, for instance national authorisation requirements or import restrictions. These are neutral with regard to the trade mark to be used; they concern not the trade mark but the goods and services that the proprietor wishes to use. Such national authorisation requirements or import restrictions apply to the type or properties of the product to which the trade mark is affixed, and cannot be circumvented by choosing a different trade mark. In the present case, conversely, the trade mark proprietor could have readily manufactured cigarettes in France or imported them into France if it had chosen a different trade mark (para. 25).</p> |         |

| Earlier sign  | Case No   |
|---|---|
| MANPOWER  | 18/06/2010, R 997/2009-4, MOON-POWER / MANPOWER |
| <p>According to Article 9 EUTMR and Article 5 of the Trade Marks Directive, the trade marks of third parties must not be infringed. The requirement not to infringe trade marks applies to any person using a name in the course of trade, regardless of whether it has itself applied for or been granted trade mark protection for that name. A person refraining from such infringements is acting not for 'proper reasons' but as ordered by law. Hence, even refraining from use that would otherwise infringe a right is not a proper reason (09/03/2010, R 764/2009-4, HUGO BOSS / BOSS, § 22) (para. 27).</p> <p>Nor is use in such instances 'unreasonable'. Persons who, as trade mark proprietors, are threatened with proceedings or an interim injunction if they start using the trade mark concerned, must consider the prospects of the action against them succeeding and can either capitulate (not start using the trade mark) or defend themselves against the complaint. In any event, they have to accept the decision of the independent courts, which may be in expedited proceedings. Nor, pending a decision at final instance, can they object that they must be protected by the fact that, until that decision becomes final, uncertainty is to be recognised as a proper reason for non-use. In fact, the issue of what should happen in the period between the filing of an action or the application for an interim injunction and the conclusive final decision is again to be left to the courts, in that they take decisions that are not yet final on provisional enforceability. The defendant is not entitled to ignore those decisions and be put in a position as if there were no courts (para. 28).</p> |   |

On the other hand, for example, an interim injunction or a restraining court order in insolvency proceedings, imposing a general prohibition of transfers or disposals on the trade mark owner, can be a proper reason for non-use because it obliges the opponent to refrain from using its mark in the course of trade. Use of the mark contrary to such a court order would make the trade mark owner liable to damage claims (11/12/2007, R 77/2006-1, MISS INTERCONTINENTAL (fig.), § 51).

### 2.11.3 Defensive registrations

The General Court has clarified that the existence of a national provision recognising what are known as 'defensive' registrations (i.e. of signs not intended to be used in trade on account of their purely defensive function in relation to another sign that is being commercially exploited) cannot constitute a proper reason for non-use of an earlier trade mark invoked as a basis of an opposition (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 46).

### 2.11.4 Force majeure

Further justifiable reasons for non-use are cases of force majeure that hinder the normal functioning of the owner's enterprise.

### 2.11.5 Consequences of justification of non-use

The existence of justified reasons does not mean that non-use during the period concerned is treated as equivalent to actual use, which would result in a new grace period beginning after the end of the period of justified non-use.

Rather, non-use during such period merely stops the 5-year period from running. This means that the period of justified non-use is not taken into account in calculating the grace period of five years.

In addition, the length of time during which justified reasons existed may be significant. Reasons for non-use existing during only part of the relevant 5-year-period may not always be considered justification for setting the proof-of-use requirement aside. In this context, the period of time during which these reasons were pertinent and the elapse of time since they no longer applied are of particular importance (01/07/1999, B 2 255).

## 3 Procedure

### 3.1 Admissibility of the request for proof of use

According to Article 47(2) EUTMR, use of the earlier mark needs to be shown only if the applicant requests proof of use. The institution of proof of use is, therefore, designed in opposition proceedings as a defence plea of the applicant.

The Office may neither inform the applicant that it could request proof of use nor invite it to do so. In view of the Office's impartial status in opposition proceedings, it is left to the parties to provide the factual basis and to argue and defend their respective positions (see second sentence of Article 95(1) EUTMR).

Article 47(2) EUTMR is not applicable when the opponent, on its own motion, submits material relating to use of the earlier mark invoked (see paragraph 3.1.3 below for an exception to this rule). As long as the EUTM applicant does not request proof of use,



the issue of genuine use will not be addressed by the Office ex officio. In such cases, in principle, it is even irrelevant that the evidence produced by the opponent might demonstrate only a particular type or manner of use, or use that is limited to only part of the goods or services for which the earlier mark is registered.

The request to submit proof of use is only valid if the earlier mark is under the use requirement at all, that is to say if it has been registered for not less than 5 years.

### 3.1.1 Time of request

Pursuant to Article 10(1) EUTMDR, the request for proof of use pursuant to Article 47(2) or (3) EUTMR will be admissible only if the applicant submits such a request within the period specified by the Office. The request for proof of use must be made within the first time limit for the applicant to reply to the opposition under Article 10(2) EUTMDR.

If the request for proof of use is submitted during the cooling-off period or during the 2-month period given to the opponent for filing or amending facts, evidence and arguments, it is forwarded to the opponent without delay.

### 3.1.2 Earlier mark registered for not less than five years

In accordance with Article 47(2) EUTMR, the obligation to provide proof of use requires that the earlier registered mark has, at the date of filing or the date of priority<sup>74</sup> of the EUTM application, been registered for not less than five years.

For oppositions filed against international registrations designating the EU, the opponent's mark is under use obligation if on the date of registration (INID code 151) or on the date of priority (INID code 300), or, as the case may be, the date of subsequent designation of the European Union (INID code 891)<sup>75</sup>, it has been registered for not less than five years.

#### 3.1.2.1 Earlier EUTMs

The decisive date for establishing whether a trade mark has been registered for not less than five years at the relevant date is, according to Article 18 and Article 47(2) EUTMR, the registration date of the earlier EUTM. If five years or more have elapsed between the registration date of the earlier EUTM and the relevant date, the applicant (or in the case of a contested IR, the holder) is entitled to request proof of use.

#### 3.1.2.2 Earlier national marks

For national marks, it is necessary to determine the date that is equivalent to the registration date for EUTMs. In interpreting this term, it should be taken into account that some national trade mark systems have an opposition procedure after registration.

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<sup>74</sup> For oppositions filed before 23/03/2016, the relevant date is the date of publication.

<sup>75</sup> For oppositions filed before 23/03/2016, the relevant date is 6 months after the date of the first re-publication by the Office.

In view of these differing national proceedings, Article 10(1) of Directive (EC) 2008/95 (which is the equivalent of Article 47 EUTMR) refers, as concerns the use requirement for national marks, to the period of 'five years following the date of the completion of the registration procedure'.

The date of completion of the registration procedure (Article 10(1) of Directive (EC) 2008/95) that serves for calculating the starting point of the 5-year period for the obligation of use for national and international registrations (Article 47(2) and (3) EUTMR) is determined by each Member State according to its own procedural rules (14/06/2007, C-246/05, *Le Chef de Cuisine*, EU:C:2007:340, § 26-28).

The owner of a mark is not expected to make genuine use of the mark while examination or opposition proceedings are pending, before the 5-year grace period mentioned. This is in harmony with the approach towards earlier EUTMs, since the registration date of an EUTM, which is mentioned in Article 47(2) EUTMR as the decisive date for the beginning of the grace period, is always the date of completion of the registration procedure. Furthermore, this interpretation keeps the use requirement under the EUTMR in line with the relevant national laws (06/05/2004, R 463/2003-1, *Wrap House* (fig.) / *HOUSE OF WRAPS*, § 19; 18/06/2010, R 236/2008-4, *RENO 911!* / *RENO*).

The completion of the registration procedure occurs after a pre-registration opposition or in some Member States even after completion of a post-registration opposition. The exact relevant dates can be found in the table in the Annex.

The Office does not investigate on its own initiative the actual date of completion of the registration proceedings. Without evidence to the contrary, the Office assumes that the registration procedure was completed on the date that is indicated as the registration date in the evidence submitted. The opponent has to rebut this presumption by proving the exact date when the registration procedure was completed.

### 3.1.2.3 Earlier international registrations designating a Member State

Under Article 5(2)(a) and (b) of the Madrid Protocol, the Designated Offices have a period of 12 or 18 months from the date of notification of the designation to issue provisional refusals.

Where the Member State has not been designated in the international application but in a subsequent designation, the 12 or 18 months start from the date the subsequent designation was notified to the Designated Offices.

Member States that use the 12-month deadline to issue a provisional refusal under the Protocol when acting as a designated party are: Benelux, Czech Republic, Germany, Spain, France, Croatia, Latvia, Hungary, Austria, Portugal, Romania and Slovenia.

Member States that have opted for the 18-month deadline to issue a provisional refusal under the Protocol when acting as a designated party are: Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden and the United Kingdom.

The applicable deadline (12 or 18 months) for Bulgaria, Italy, Cyprus, Poland and Slovakia when acting as a designated party depends on whether (i) such country was

designated or subsequently designated before or after 01/09/2008 and (ii) the Office of origin is bound by both the Agreement and the Protocol (deadline: 12 months) or only the Protocol (deadline: 18 months).

See overview table below:

| Designated country <sup>76</sup>   | Country of origin   | Deadline to issue a refusal |
|--|---|-----------------------------|
| Benelux, Czech Republic, Germany, Spain, France, Croatia, Latvia, Hungary, Austria, Portugal, Romania and Slovenia<br><br>(Contracting EU parties bound by both the Agreement and the Protocol).   | All contracting parties<br><br>[Status 15/04/2015: 95 Member States] <sup>77</sup><br><br>(Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only). | 12 months                   |
| Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden, United Kingdom<br><br>(Contracting EU parties bound by the Protocol only).  | All contracting parties<br><br>[Status 15/04/2015: 95 Member States]<br><br>(Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only).               | 18 months                   |
| Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated before 01/09/2008 <sup>78</sup><br><br>(Contracting EU parties bound by both the Agreement and the Protocol that have opted for an extended deadline). | All contracting parties<br><br>[Status 15/04/2015: 95 Member States]<br><br>(Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only).               | 18 months                   |

<sup>76</sup> Malta is not part of the Madrid System.

<sup>77</sup> For the full list of all Member States to the Madrid Agreement and to the Madrid Protocol see: [http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid\\_marks.pdf](http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf).

<sup>78</sup> The date of entry into force of Article 9sexies(1)(b) of the Protocol, which rendered inoperative any declaration under Article 5(2)(b) or (c) of the Protocol (extension of the time limit for notifying a provisional refusal) between Contracting Parties bound by both the Agreement and the Protocol.

| Designated country <sup>76</sup>  | Country of origin  | Deadline to issue a refusal |
|---|--|-----------------------------|
| Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated on or after 01/09/2008      | Contracting parties bound by both the Agreement and the Protocol<br>[Status 15/04/2015: 54 Member States]. | 12 months                   |
| (Contracting EU parties bound by both the Agreement and the Protocol that have opted for an extended deadline). | Contracting parties bound by the Protocol only<br>[Status 15/01/2013: 33 Member States].                   | 18 months                   |

The Office will, on its own motion, apply the 12-month or 18-month deadline according to the above rules. Deadlines are calculated by adding the relevant periods to the date of notification from which the time limit to notify the refusal starts, indicated by INID code 580 on the ROMARIN extract (i.e. not the date of international registration or subsequent designation) (Rule 18(1)(a)(iii) and Rule 18(2)(a) of the Common Regulations).

Only when it is decisive for determining whether the earlier mark is subject to the proof of use obligation is it for the opponent to claim a date that is later (e.g. when a provisional refusal has been lifted after these dates or if the designated country opted for a period even longer than 18 months for notifying a refusal based on an opposition pursuant to Article 5(2)(c) of the Protocol) and for the applicant or holder to claim a date that is earlier than these dates (e.g. when a Statement of Grant of Protection has been issued before these dates) and to provide the Office with conclusive documentation thereof.

In particular, the Court confirmed, in relation to an earlier international registration designating Germany, that the date on which an earlier international registration was deemed to have been 'registered' had to be established in accordance with the German law giving effect to the earlier right, and not by reference to the date of registration with the International Bureau of WIPO. Under German trade mark law, if protection for an internationally registered trade mark is provisionally refused but subsequently granted, the registration is regarded as having taken place on the date of receipt by the International Bureau of WIPO of the final notification that protection has been granted. Proper application of Article 47(2) and (3) EUTMR and of Article 4(1) of the Madrid Agreement cannot lead to a breach of the principle of non-discrimination (16/09/2010, C-559/08 P, Atoz, EU:C:2010:529, § 44, 53-56).

#### 3.1.2.4 Earlier international registrations designating the European Union

For international registrations designating the European Union, Article 203 EUTMR provides that:

<sup>76</sup> Malta is not part of the Madrid System.

For the purposes of applying Article 18(1), Article 47(2), Article 58(1)(a) and Article 64(2), the date of publication pursuant to Article 190(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the Union shall be put to genuine use in the Union.

As from that publication, the international registration has the same effects as a registered EUTM pursuant to Article 189(2) EUTMR.

### 3.1.2.5 Summary of calculation of the grace period

| Earlier mark                 | Calculation of the beginning of the 5-year period (grace period)   |
|------------------------------|--|
| EUTM                         | Date of registration.  |
| National mark                | By default, date of registration or of completion of registration proceedings if proven by opponent.   |
| IR designating Member States | By default, 12 or 18 months after the date of notification from which the time limit to notify the refusal starts (INID code 580). Can be earlier or later if proven by parties. |
| IR designating the EU        | Date of the second republication of the EU designation in part M.3. of the Bulletin.   |

### 3.1.3 Request must be unconditional, explicit and unambiguous

The applicant's request is a formal declaration with important procedural consequences.

Pursuant to Article 10(1) EUTMDR, the request has to be unconditional. Phrases such as 'if the opponent does not limit its goods/services in Classes 'X' or 'Y', we demand proof of use', 'if the Office does not reject the opposition because of lack of likelihood of confusion, we request proof of use' or 'if considered appropriate by the Office, the opponent is invited to file proof of use of its trade mark' contain conditional or auxiliary claims and, therefore, are not valid requests for proof of use (26/05/2010, R 1333/2008-4, RFID SOLUTIONS (fig.) / rfid (fig.)).

Moreover, the request has to be explicit and unambiguous. In general, the request for proof of use must be expressed in positive wording. As use or non-use can be an issue in manifold constellations (for example, to invoke or deny a higher degree of distinctiveness of the earlier mark), mere observations or remarks by the applicant in respect of the (lack of) use of the opponent's mark are not sufficiently explicit and do not constitute a valid request for proof of genuine use (16/03/2005, T-112/03, Flexi Air, EU:T:2005:102).

## Examples

Sufficiently explicit and unambiguous request:

- ‘I request the opponent to submit proof of use ...’;
- ‘I invite the Office to set a time limit for the opponent to prove use ...’;
- ‘Use of the earlier mark is hereby contested ...’;
- ‘Use of the earlier mark is disputed in accordance with Article 47 EUTMR.’;
- ‘The applicant raises the objection of non-use.’ (05/08/2010, R 1347/2009-1, CONT@XT / CONTEXTA).

Not sufficiently explicit and unambiguous request:

- ‘The opponent has used its mark only for ...’;
- ‘The opponent has not used its mark for ...’;
- ‘There is no evidence that the opponent has ever used its mark ...’;
- ‘[T]he opponents’ earlier registrations cannot be “validly asserted against the [EUTM] application...”, since “...no information or evidence of use ... has been provided...” (22/09/2008, B 1 120 973).

An implicit request is accepted as an exception to the above rule when the opponent spontaneously sends evidence of use before the applicant’s first opportunity to file arguments and, in its first reply, the applicant challenges the evidence of use submitted by the opponent (12/06/2009, T-450/07, Pickwick Colour Group, EU:T:2009:202). In such a case, there can be no mistake as to the nature of the exchange, and the Office should consider that a request for proof of use has been made and give the opponent a deadline for completing the evidence. In the event that proceedings have been closed and the existence of a request for proof of use is found out only when a decision has been taken, the examiner should re-open the proceedings and give the opponent a deadline for completing the evidence.

Finally, the request for proof of use must be submitted in a separate document. For more information see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.4.1.

### 3.1.4 Applicant’s interest to deal with proof of use first

Under Article 10(5) EUTMDR a request for proof of use may be submitted at the same time as observations. The applicant may limit its first observations to requesting proof of use. It must then reply to the opposition in its second observations, namely when it is given the opportunity to reply to the proof of use submitted. It may also do this if only one earlier right is subject to the use requirement, as the applicant should not be obliged to split its observations.

If, however, the request is completely invalid, the Office will close proceedings without granting the applicant a further opportunity to submit observations (see paragraph 3.1.5 below).

### 3.1.5 Reaction if request is invalid

If the request is invalid on any of the above grounds or if the requirements of Article 47(2) and (3) EUTMR are not met, the Office nevertheless forwards the applicant's request to the opponent but advises both parties of the invalidity of the request.

The Office will immediately terminate the proceedings if the request is completely invalid and not accompanied by any observations by the applicant. However, the Office can extend the time limit established in Article 8(2) EUTMDR if such an invalid request was received before expiry of the time limit set for the applicant but was not dealt with by the Office until after expiry thereof. Because refusal of the request for proof of use after expiry of the time limit will disproportionately harm the interests of the applicant, the Office extends the time limit by the number of days that were left when the party submitted its request. This practice is based on the rules of fair administration.

If the request is only invalid as regards part of the earlier rights on which the opposition is based, the Office expressly limits the invitation to the opponent to submit proof of use to the rights that are subject to the use requirement.

## 3.2 Express invitation by the Office

If the applicant's request for proof of use is valid, the Office gives the opponent two months to submit proof of use or show that there are proper reasons for non-use. Taking a decision on use in the absence of an explicit invitation by the Office to submit proof of use constitutes a substantive procedural violation, even if the applicant's request is clear, and the opponent understands it and submits the requested evidence of use (28/02/2011, R 16/2010-4, COLORPLUS, § 20; 19/09/2000, R 733/1999-1, AFFINITÉ / AFFINAGE).

In cases where the request for proof of use arrives during the cooling-off period and is communicated to the opponent during that period, the deadline for submitting proof of use will coincide with the deadline for providing initial or additional facts, evidence and arguments. The time limit will be extended automatically if the cooling-off period is extended.

If the request reaches the Office before the end of the period for submitting or amending facts, evidence and arguments, and is dealt with in this period, the deadline for submitting such facts, evidence and arguments will be extended to coincide with the deadline of two months for submitting proof of use.

### **3.3 Reaction from the opponent: providing proof of use**

#### **3.3.1 Time limit for providing proof of use**

The Office gives the opponent two months to submit proof of use. The opponent may request an extension of the deadline in accordance with Article 68 EUTMDR. The common practice on extensions is applicable to these requests <sup>79</sup>.

Article 10(2) EUTMDR expressly states that the Office will reject the opposition if the opposing party does not provide proof of use before the time limit expires.

Three scenarios are to be differentiated.

- Any evidence that has been submitted by the opponent at any time during the proceedings before the expiry of the time limit for providing proof of use, even before the applicant's request for proof of use, has to be automatically taken into account when assessing proof of use.
- The opponent has not submitted any or any relevant indication or evidence within the time limit: the submission of relevant indications or evidence of proof of use for the first time after the expiry of the time limit results in rejection of the opposition without the Office having any discretionary powers. Article 10(2) EUTMDR is an essentially procedural provision and it is apparent from the wording of that provision that when no proof of use of the mark concerned is submitted within the time limit set by the Office, the opposition must automatically be rejected.
- The opponent has submitted relevant indications or evidence within the time limit and presents additional indications or evidence after the time limit has expired. The Office may take into account the evidence submitted out of time by exercising the discretion conferred on it by Article 95(2) EUTMR.

In that context, it must be assessed first, whether the Office may exercise discretion, and, if so, second, how to exercise its discretion, that is, whether to admit or reject such late facts or evidence.

According to Article 10(7) EUTMDR, the Office must exercise its discretion if the late indications or evidence merely supplement, strengthen and clarify the prior relevant evidence submitted within the time limit with the purpose of proving the same legal requirement laid down in Article 10(3) EUTMDR, namely, place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which opposition is based. It follows that the Office may not exercise any discretion if the late evidence intends to prove a legal requirement for which no initial evidence at all had been submitted. For example, if no indications or evidence related to the place of use were submitted at all within the relevant time limit, any evidence submitted in this respect after the time limit must be discarded.

When exercising its discretion, the Office must take into account, in particular, the stage of proceedings and whether the facts or evidence are, *prima facie*, likely to be

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<sup>79</sup> See the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 6.2.1, Extension of time limits in opposition proceedings.



relevant for the outcome of the case and whether there are valid reasons for the late submission of the facts or evidence.

These factors are interdependent. The later the stage of proceedings, the stronger must be the reason for late submission or the relevance of the evidence. Therefore, additional indications or evidence can be accepted if, *prima facie*, they are likely to be relevant for the outcome of the case and are submitted at an early stage of the proceedings with justification for why they are submitted at this stage of the proceedings.

There may be other relevant factors. The intention to prolong the proceedings by submitting evidence in parts (delaying tactics), if the circumstances of the case allow that conclusion, argues against the admission of late evidence.

The natural difficulties in obtaining the evidence are not, as such, a valid reason for its belated submission.

The Office will duly provide reasons for why it rejects or takes into account 'additional evidence' in the decision.

### 3.3.2 Means of evidence

#### 3.3.2.1 Principles

The evidence of use must be provided in a structured manner.

Article 95(1) EUTMR provides that '... in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties ...' The filing of evidence must be sufficiently clear and precise to enable the other party to exercise its right of defence and the Office to perform its examination, without reference to extraneous or supportive information.

Essentially, the Office is prevented from making the case for one or other party and cannot take the place of the opponent, or its counsel, by itself trying to locate and identify among the documents on file the information that it might regard as supporting proof of use. This means that the Office should not seek to improve the presentation of any party's evidence.

Responsibility for putting evidence in order rests with the party. Article 10(4) EUTMDR provides that the evidence of use must be submitted in accordance with Article 55 EUTMDR, which defines the basic structure and format of written evidence. This provision means that the submission must clearly identify the evidence and arguments raised by the parties and thus assure expeditious proceedings.

Pursuant to Article 55(3) EUTMDR, where the submissions or the annexes do not comply with the requirements set, the Office may invite the opponent to remedy any deficiency, within a set time limit. If the deficiencies are not remedied and it is still not possible for the Office to clearly establish to which ground or argument a document or

item refers, that item of evidence will not be taken into account (Article 55(4) EUTMDR).

In terms of format and content of evidence submitted, Article 55(2) EUTMDR provides that the documents or other items of evidence must be contained in annexes to a submission, which must be numbered consecutively.

Submissions for documents with evidence of use must include an index indicating, for each document or item annexed the following:

1. the number of each annex;
2. a short description of the document or item, and if applicable, the number of pages;
3. the page number of the submission where the document or item is mentioned.

The opponent may also indicate, in the index of annexes, which specific parts of a document it relies upon in support of its arguments.

In addition, the Office recommends that the following be taken into account as key aspects of a structured presentation:

1. the corresponding file number (EUTM, Opposition, Cancellation and Appeal) should be included at the top of all correspondence;
2. the Office strongly recommends that the opponent does not exceed a maximum of 110 pages in its correspondence;
3. if the documentation is sent in different packages, an indication of the number of packages is recommended;
4. if a large amount of documentation is submitted by fax in different batches, an indication of the total number of pages, number of batches and identification of the pages contained in each batch is recommended;
5. plain DIN-A4 sheets should be used in preference to other formats or devices for all the documents submitted, including separators between annexes or enclosures, as they can also be scanned;
6. physical specimens, containers, packaging, etc. should not be sent but, instead, a picture should be taken of them, which should be printed (if relevant in colour, otherwise in black and white) and sent as a document;
7. original documents or items sent to the Office should not be stapled, bound or placed in folders;
8. the second copy for forwarding to the other party should be clearly identified;
9. if the original is submitted to the Office only by fax, no second fax copy should be sent;
10. the front page should clearly indicate whether the correspondence submitted contains colour elements of relevance to the file;
11. a second set of colour elements should be included for sending to the other party.

These recommendations together with the requirements for written evidence set in Article 55(2) EUTMDR are sent to the opponent together with the Office's communication of the applicant's request for proof of use.

According to Article 10(4) EUTMDR, the evidence is to be submitted in accordance with Article 55(2) and Articles 63 and 64 EUTMDR and, in principle, is confined to the submission of supporting documents and items such as packages, labels, price lists,

catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 97(1)(f) EUTMR. Article 10(4) EUTMDR also allows market surveys and quotations of the mark in lists and publications of associations of the relevant profession as suitable means of evidence (14/03/2011, B 1 582 579; 18/06/2010, B 1 316 134).

Price lists and catalogues are examples of ‘material stemming directly from the party itself’. A company’s annual report and accounts would also come under that heading.

Article 10(4) EUTMDR is to be read in conjunction with Article 64 EUTMDR. This means that annexes to communications may be submitted on data carriers in accordance with technical specifications determined by the Executive Director. Nevertheless, material that cannot be scanned or photocopied (such as CDs, physical items) cannot be taken into account unless submitted in two copies so that one can be forwarded to the other party.

The requirement of proof of use always raises the question of the probative value of the submitted material. The evidence must at least have a certain degree of reliability. As a general rule, the Office considers material produced by third parties as being of a higher probative value than material produced by the owner itself or by its representative. Reference by the opponent to internal printouts or hypothetical surveys or orders is particularly problematic. However, where material must regularly be produced for use by the public and/or authorities according to statutory rules, for instance, company law and/or stock exchange regulations, and where it may be assumed that such material is subject to certain official verification, its probative value is certainly higher than ordinary ‘personal’ material produced by the opponent (see also paragraph 3.3.2.3, ‘Declarations’, below).

#### 3.3.2.2 References

The opponent may avail itself of findings of national offices and courts in parallel proceedings. Although the Office is not bound by findings of the national offices and courts, such decisions must be taken into account and may influence the Office’s decision. It is important for the Office to have the possibility of considering the kind of evidence that led to the relevant decision at national level. The Office takes into account the different procedural and substantive requirements that may exist before the respective national body (25/08/2003, R 1132/2000-4, VANETTA / VIENNETTA (fig.), § 16; 18/10/2000, R 550/1999-3, (DUKE) (fig.) / DUKE, § 23).

The opponent may wish to refer to material submitted as proof of use in previous proceedings before the Office (confirmed by the General Court in ‘ELS’ quoted above). The Office accepts such references on condition that the opponent clearly identifies the material referred to and the proceedings in which it was submitted. If the reference does not sufficiently identify the relevant material, the Office requires the opponent to clearly specify the material referred to or to file it (30/11/2010, B 1 080 300). For further details on the conditions for identifying relevant material, see the Guidelines, Part C, Opposition, Section 1, Procedural Matters.

The onus of providing proof of use is on the opponent and not on the Office or the applicant. Therefore, a mere indication of the website where the Office can find further information is insufficient, as this does not provide the Office with sufficient indications about place, nature, time and extent of use (31/10/2001, B 260 192).

### 3.3.2.3 Declarations

Whereas the means of evidence listed, such as packages, labels, price lists, catalogues, invoices, photographs and newspaper advertisements, do not present any particular problems, it is necessary to consider in some detail declarations as referred to in Article 97(1)(f) EUTMR.

The opposing party is not obliged to submit an affidavit concerning the sales made under the earlier trade mark. It is up to the opposing party to select the form of evidence that it considers suitable for the purpose of establishing that the earlier trade mark was put to genuine use during the relevant period (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 37).

The role of the affidavit is to give facts or an explanation of the supporting documents, not to give a legal opinion (06/11/2014, T-463/12, MB, EU:T:2014:935, § 56).

Distinction between admissibility and relevance (probative value)

The importance of declarations has been much debated. In this regard, there must be a clear differentiation between the admissibility and the probative value of such evidence.

As far as admissibility is concerned, Article 10(4) EUTMDR expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of proof of use. Article 97(1) EUTMR cites means of giving evidence, amongst which are sworn or affirmed written statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. Therefore, it has to be evaluated whether the statement submitted constitutes a statement within the sense of Article 97(1)(f) EUTMR. Only in cases where the statements have not been sworn or affirmed is it necessary to consider the rules of law of the national jurisdiction as to the effects of a written statement (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 40; confirmed 09/12/2014, T-278/12, PROFLEX, EU:T:2014:1045, § 49). Where there are doubts as to whether a statement has been sworn or affirmed, it is up to the opponent to submit evidence in this regard. Failing this, the statement will not be considered a statement within the sense of Article 97(1)(f) EUTMR.

Article 97(1)(f) EUTMR does not specify by whom these statements should be signed, so there is no reason to consider that statements signed by the parties to the proceedings themselves are not covered by this provision (16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 46).

The EUTMR, the EUTMDR and the EUTMIR do not support the conclusion that the evidential value of items of evidence of use of the mark, including affirmations, must be assessed in the light of the national law of a Member State (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33; 09/12/2014, T-278/12 PROFLEX, EU:T:2014:1045, § 53). The probative value of a statement depends first and foremost on the credibility

of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 42).

As far as the probative value of this kind of evidence is concerned, the Office, following the established case-law, makes a distinction between statements coming from the sphere of the opponent themselves or their employees and statements drawn up by an independent source (09/12/2014, T-278/12, *PROFLEX*, EU:T:2014:1045, § 51; 06/11/2014, T-463/12, *MB*, EU:T:2014:935, § 54).

#### Declarations by the proprietor or its employees

Statements coming from the sphere of the owner of the earlier mark (drawn up by the interested parties themselves or their employees) are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by personal interests in the matter (11/01/2011, R 490/2010-4, *BOTODERM / BOTOX*, § 34; 27/10/2009, B 1 086 240 and 31/08/2010, B 1 568 610).

Such a statement cannot in itself sufficiently prove genuine use (9/12/2014, T-278/12, *PROFLEX*, EU:T:2014:1045, § 54). However, this does not mean that such statements are totally devoid of all probative value (28/03/2012, T-214/08, *Outburst*, EU:T:2012:161, § 30). Generalisation should be avoided, since the exact value of such statements always depends on their concrete form and content. Statements including detailed and concrete information have a higher probative value than very general and abstractly drafted statements.

The final outcome depends on the overall assessment of the evidence in each individual case. In general, further material is necessary for establishing evidence of use, since such statements have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources. Therefore, the probative strength of the further material submitted is very important. An assessment should be made of whether the content of the affidavit is sufficiently supported by the further material (or vice versa). The fact that the national office concerned may adopt a certain practice in assessing such kind of evidence of use does not mean that it is applicable in proceedings concerning European Union trade marks (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 41 et seq.).

A change of ownership after the filing or priority date of the EUTM application may render declarations made by the new owners void as the latter generally do not have any direct knowledge to form a basis for making declarations concerning use of the mark by the previous owner (17/06/2004, R 16/2004-1, *REPORTER / REPORTER*).

Nevertheless, in the case of a transfer or other succession in title, any new owner may rely on use by their predecessor(s) within the grace period concerned. Use made by the predecessor may be evidenced by the predecessor and by all other reliable means, for instance, information from business records if the predecessor is not available.

#### Declarations by third parties

Statements (such as e.g. surveys) drawn up by an independent source, for example by experts, professional organisations, Chambers of Commerce, suppliers, customers or business partners of the opponent, are given more probative weight (19/01/2011, R 1595/2008-2, FINCONSUM ESTABLECIMIENTO FINANCIERO DE CREDITO / FINCONSUMO (fig.), § 9(ii); 30/03/2010, R 665/2009-1, EUROCERT (fig.) / EUROCERT, § 11; 12/08/2010, B 1 575 615).

This practice is in line with the case-law of the Court of Justice in the Chiemsee judgment (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230), where the Court gave some indications of appropriate evidence for proving the acquired distinctiveness of a mark in the market place. Although acquisition of distinctiveness is not per se the same as genuine use, the former does comprise elements of evidence of use of a sign on the market. Consequently, case-law relating to these can be used by analogy.

Statements drawn up by the parties themselves are not 'third-party evidence' whereas all other evidence, such as opinion polls, statements from Chambers of Commerce, or from professional organisations or from experts, does originate from third parties.

### **3.4 Reaction from the applicant**

#### **3.4.1 Forwarding of evidence**

After having received the evidence of use submitted by the opponent, the Office forwards the complete evidence to the applicant.

The Office, in general, allows the applicant 2 months to file its observations in reply to the evidence of use (and to the opposition).

#### **3.4.2 No evidence or no relevant evidence submitted**

However, the Office may close the proceedings immediately if, within the time limit given, the opponent has submitted no evidence, or the evidence is manifestly of no relevance, and all the earlier rights of the opposition are affected. The rationale behind this practice is to avoid the continuation of proceedings when their outcome is already known, that is, the opposition is to be rejected for lack of proof of use (principle of economy and good administration of proceedings).

In all other cases the evidence is forwarded to the applicant, which is given 2 months to file its observations. The Office must not indicate to the opponent that the sufficiency of the evidence is doubtful, or even invite the opponent to file further evidence in such cases. Such acts would be against the impartial position of the Office in adversarial proceedings (01/08/2007, R 201/2006-4, OCB (fig.) / O.C.B., OCB (fig.) § 19).

### **3.4.3 No reaction from applicant**

If the applicant does not react within the time limit, the Office will give a decision on the basis of the evidence before it. The fact that the applicant does not reply does not mean that it accepts the submitted evidence as sufficient proof of use (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 79).

### **3.4.4 Formal withdrawal of the request**

Where the applicant reacts to the proof of use by formally withdrawing its request for proof of use, the issue will no longer be relevant. As it is the applicant who sets in motion the respective procedure, the applicant logically is in a position to bring an end to this part of the proceedings by formally withdrawing its request (21/04/2004, R 174/2003-2, *SONNENGARTEN / SOMMERGARTEN*, § 23).

## **3.5 Further reaction from the opponent**

The opponent is entitled to file observations in reply to the applicant's observations. This is of particular importance in cases where the decision to be taken might be based in part on the arguments put forward by the applicant to the effect that the evidence does not prove the use of the mark.

The Board of Appeal has regarded failure to allow the opponent to comment in such a case as a substantial procedural violation (28/02/2011, R 16/2010-4, *COLORPLUS*, § 20).

For further details on the submission of additional evidence, see paragraph 3.3.1 above.

## **3.6 Languages in proof of use proceedings**

According to Article 10(6) EUTMDR, where the evidence submitted pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opponent to submit a translation of that evidence in that language, within a period specified by the Office.

It is left to the discretion of the Office whether the opponent has to submit a translation of the evidence of use into the language of the proceedings. In exercising its discretion, the Office balances the interests of both parties.

It has to be borne in mind that it might be extremely costly and burdensome for the opponent to translate the evidence of use submitted into the language of the proceedings.

On the other hand, the applicant has the right to be informed about the content of the evidence submitted in order to be capable of defending its interests. It is absolutely necessary that the applicant is able to assess the content of the evidence of use

submitted by the opponent. In this regard, the nature of the documents submitted has to be taken into account. For example, it might be considered that 'standard' invoices and samples of packaging do not require a translation in order to be understood by the applicant (15/12/2010, T-132/09, Epcos, EU:T:2010:518, § 51 et seq.; 30/04/2008, R 1630/2006-2, DIACOR / DIACOL PORTUGAL, § 46 et seq. (appealed 24/01/2017, T-258/08, DIACOR / DIACOL, EU:T:2017:22); 15/09/2008, R 1404/2007-2 & R 1463/2007-2, FAY (fig) / FAY & CO, § 26 et seq.).

If the applicant explicitly requests a translation of the evidence in the language of the proceedings, the Office, in principle, will require a translation from the opponent. However, a rejection of such a request is feasible where it appears that the applicant's request, in view of the self-explanatory character of the submitted evidence, is exaggerated or even abusive.

Where the Office requires translation of the evidence, it gives the opponent a period of 2 months to submit it. Where the evidence of use submitted by the opponent is voluminous, the Office may explicitly invite the opponent to translate only the parts of the submitted material that the opponent regards as sufficient for establishing genuine use of the mark within the relevant period. It is in general up to the opponent to evaluate whether a complete translation of all the evidence submitted is necessary. The means of evidence will only be taken into account insofar as a translation has been produced or insofar as the means of evidence are self-explanatory regardless of their textual components.

## **3.7 Decision**

### **3.7.1 Competence of the Office**

The Office makes its own evaluation of the evidence of use submitted. This means that the probative value of the evidence submitted is evaluated independently of the observations submitted by the applicant in this respect. Assessment of the relevance, pertinence, conclusiveness and efficacy of evidence lies within the discretion and power of judgment of the Office, not the parties, and falls outside the adversarial principle that governs inter partes proceedings (01/08/2007, R 201/2006-4, OCB (fig.) / O.C.B., OCB (fig.), § 19; 14/11/2000, R 823/1999-3, SIDOL / SIDOLIN).

A declaration by the applicant concluding that use has been proved does not, therefore, have any effect on the Office's findings. The request for proof of use is a defence plea by the applicant. However, once the defence plea has been raised by the applicant, it is solely up to the Office to carry out the subsequent procedure and evaluate whether the evidence submitted by the opponent is to be regarded as of sufficient probative value. However, the applicant does have the possibility of formally withdrawing the request for proof of use (see paragraph 3.4.4 above).

This is not contrary to Article 95(1) EUTMR, which stipulates that in inter partes proceedings the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. However, although the Office



is bound by the facts, evidence and arguments provided by the parties, it is not bound by the legal value that the parties may give thereto. Hence, the parties may agree as to which facts have been proved or not, but may not determine whether or not these facts are sufficient to establish genuine use (01/08/2007, R 201/2006-4, OCB (fig.) / O.C.B., OCB (fig.), § 19; 14/11/2000, R 823/1999-3, SIDOL / SIDOLIN, § 20; 13/03/2001, R 68/2000-2, MOBEC / NOVEX PHARMA).

### 3.7.2 Need for assessing proof of use

A decision on whether the obligation of having genuinely used the registered mark has been fulfilled is not always necessary.

When proof of use of the earlier rights has been requested by the applicant, the Office will also examine whether, and to what extent, use has been proved for the earlier marks, provided this is relevant for the outcome of the decision in question. The examination of proof of use is always necessary and obligatory in cases where the opposition is fully or partially successful on the basis of the earlier mark that was subject to the proof of use obligation.

The Office may decide not to assess the submitted proof of use where the question whether the earlier mark concerned was genuinely used for the relevant registered goods and/or services is irrelevant for the outcome of the opposition, for example:

- under the ground of Article 8(1)(b) EUTMR, if there is no likelihood of confusion between the contested mark and the earlier mark that is subject to the proof of use obligation (15/02/2005, T-296/02, Lindenhof, EU:T:2005:49, § 43);
- if the opposition is fully successful on the basis of another earlier mark, which is not subject to the proof of use obligation;
- if the opposition is fully successful on the grounds of Article 8(3) and/or Article 8(4) EUTMR;
- under the ground of Article 8(5) EUTMR, if one of the necessary conditions for application of this ground is not fulfilled.

However, in the event that the earlier trade mark that was subject to the proof of use obligation was examined in the decision but the assessment of the proof of use has been omitted, this will be expressly stated in the decision with a brief justification.

### 3.7.3 Overall assessment of the evidence presented

As stated in more detail above (see paragraph 2.2 above), the Office has to evaluate the evidence submitted with regard to place, time, extent and nature of use in an overall assessment. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 31).

The principle of interdependence applies, meaning that weak evidence with regard to one relevant factor (e.g. low sales volume) might be compensated by solid evidence with regard to another factor (e.g. continuous use over a long period of time).

All the circumstances of the specific case have to be taken into account in conjunction with each other in order to determine whether the mark in question has been genuinely used. The particular circumstances can include, for example, the specific features of the goods/services in question (e.g. low- or high-priced; mass products versus special products) or the particular market or business area.

Indirect/circumstantial evidence, under certain conditions even on its own, can also be suitable for proving genuine use.

As the Office does not assess commercial success, even minimal use (but not mere token or internal use) can be sufficient to be deemed 'genuine', as long as it is viewed as warranted in the economic sector concerned to maintain or acquire a share in the market.

The decision indicates what evidence was submitted. However, in general, only the evidence relevant for the conclusion is mentioned. If the evidence is found convincing, it suffices for the Office to indicate those documents that were used to come to this conclusion and why. If an opposition is rejected because the proof of use was not sufficient, neither likelihood of confusion nor Article 8(5) EUTMR, if claimed, is to be addressed.

#### 3.7.4 Treatment of confidential information

Pursuant to Article 113(1) EUTMR, the Office must publish its decisions. On the other hand, pursuant to Article 114(4) EUTMR, upon the prior request of a party with a special interest in keeping parts of the file confidential, the data concerned must be kept confidential vis-à-vis the public<sup>80</sup>. However, the need to keep certain data confidential does not exempt the Office from the obligation to state the reasons for its decisions.

Given the public nature of decisions, the justified interest of a party in keeping certain information confidential vis-à-vis the public has to be reconciled with the Office's duty to state reasons. It may be problematic to reason without divulging confidential business data, but this can be done by referring to those data in a general manner and without disclosing concrete data. For example, the decision may refer to the invoices submitted, indicate the time span, frequency and territory of sales, the significance of the sales volumes they represent and whether they are sufficient to support the finding of genuine use. What is important is that the decision reflects that the relevant business data were considered and assessed in relation to the kind of goods and services at issue and the characteristics of the relevant market. Simply stating whether the relevant factors (time, place, nature and extent of use) have been fulfilled or not is not sufficient to support the final conclusion on the issue of genuine use.

Finally, it must be clarified that, notwithstanding the confidentiality of an entire submission or annex, data contained therein that are clearly within the public domain (e.g. in the form of press extracts) can be referred to in the decision.

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<sup>80</sup> Note, however, that no parts of the file can be kept confidential vis-à-vis the other party to the proceedings due to the right of defence (see the Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 4.4.4).

### 3.7.5 Examples

The following cases present some of the decisions of the Office and the Court (with different outcomes) where the overall assessment of the submitted evidence was important.

#### 3.7.5.1 Genuine use accepted

| Case No                                    | Comment  |
|--|--|
| 17/02/2011, T-324/09, Friboi, EU:T:2011:47 | The opponent (Fribo Foods Ltd.) submitted several invoices relating to large quantities of goods, addressed to its distribution company (Plusfood Ltd.), which belongs to the same group (Plusfood Group). It is not disputed that the distribution company put the products on the market later. Furthermore, the opponent presented undated brochures, a press clip and three price lists. With regard to the 'internal' invoices, the Court held that the producer-distributor-market chain was a common method of business organisation, which could not be regarded as purely internal use. The undated brochures had to be seen in conjunction with other dated evidence such as invoices and price lists and, therefore, might still be taken into consideration. The Court accepted genuine use and stressed that an overall assessment implied that all the relevant factors be viewed as a whole and not in isolation. |

| Case No                                       | Comment   |
|---|---|
| 02/05/2011, R 872/2010-4, CERASIL / CERATOSIL | <p>The opponent submitted inter alia about 50 invoices, not in the language of proceedings. The names of the addressees as well as the quantities sold were blacked out. The Boards held that standard invoices containing the usual information (date, indication of seller's and buyer's name/address, product concerned, price paid) did not require a translation. Even though the names of the addressees and the quantities sold were blacked out, the invoices nevertheless confirmed the sale of 'CERATOSIL' products, measured in kilograms, to companies throughout the relevant territory during the relevant period. Together with the remaining evidence (brochures, affidavit, articles, photographs), this was considered sufficient to prove genuine use.</p> |
| 29/11/2010, B 1 477 670                       | <p>The opponent, which was active in the field of vehicle maintenance and the management of businesses associated with buying and selling vehicles, provided several Annual Reports giving a general overview of its overall commercial and financial activities. The OD found that these reports, by themselves, did not provide sufficient information on actual use for the majority of services claimed. However, in conjunction with advertisements and publicity displaying the mark in question for particular services, the OD concluded that the evidence as a whole provided sufficient indications as to the scope, nature, period and place of use for these services.</p>  |

| Case No                                    | Comment   |
|--|---|
| 29/11/2010, R 919/2009-4, GELITE / GEHOLIT | <p>The documents submitted by the appellant showed use of the trade mark for 'coating materials based on artificial resin (base, intermediate and top coatings) and industrial lacquers'. The attached labels showed use of the trade mark for various base, primer and top coatings. This information coincided with the attached price lists. The associated technical information sheets described the goods as corrosion coatings based on artificial resin, which are offered for sale in various colours. The attached invoices showed that these goods were supplied to various customers in Germany. Although the turnover figures stated in the written declaration in relation to the period from 2002 to 2007 did not expressly refer to Germany, it had to be concluded that they were obtained at least in part also in Germany. Consequently, the earlier mark was deemed to be used for the goods lacquer, lacquer paints, varnishes, paints; dispersions and emulsions to coat and repair surfaces because it was not possible to create any further subcategories for these goods.</p> |

| Case No   | Comment   |
|---|---|
| 20/04/2010, R 878/2009-2, SOLEA / Balea                 | <p>The solemn declaration refers to high sales figures (over EUR 100 million) for marked products from 2004 to 2006 and attaches internet extracts of pictures of the products sold during the relevant period (soap, shampoo, deodorant (for feet and body), lotions, and cleaning items). Although the internet extracts bear a copyright date of 2008, the credibility of what the declaration affirms is reinforced by the judgment of the State Court of Mannheim, a copy of which had been adduced previously by the opponent in order to demonstrate the enhanced distinctiveness of the earlier mark and which referred to the market share enjoyed by products bearing the opponent's mark for ladies' face care products (6.2 %), caring lotions (6.3 %), shower soaps and shampoos (6.1 %) and men's face care and shaving products (7.9 %). Moreover, the judgment states that, according to a GfK study, one fifth of German citizens purchase at least one BALEA product per annum. Reference is also made to two further studies that demonstrate that the brand is well known in Germany. Thus, proof of use for the mark has been demonstrated sufficiently for the products on which the opposition is based.</p> |
| 25/03/2010, R 1752/2008-1, ULUDAG / BURSA uludağ (fig.) | <p>The evidence provided to substantiate use of the earlier Danish trade mark appears to be sufficient. The Board is satisfied that the invoice provided shows place and time of use, as it proves the sale to a Danish company of 2 200 cartons of products within the relevant date. The labels submitted show use on soft drinks bearing the mark as represented on the registration certificate. As to the question whether proof consisting of one single invoice is sufficient in terms of extent of use, the content of that invoice, in the context of the remaining pieces of evidence, serves, in the Board's view, to conclude that the use made of the mark in Denmark is sufficient and genuine in connection with aerated water, aerated water with fruit taste and soda water.</p>   |

## 3.7.5.2 Genuine use not accepted

| Case No  | Comment   |
|--|---|
| 18/01/2011, T-382/08, Vogue, EU:T:2011:9                                 | <p>The opponent submitted a declaration from the opponent's managing partner and 15 footwear manufacturers that footwear had been produced for the opponent under the trade mark VOGUE over a number of years, 35 photographs of VOGUE footwear models, photographs of stores and 670 invoices issued to the opponent by footwear manufacturers. The Court held that the declarations did not provide sufficient evidence concerning the extent, place and time of use. The invoices concerned the sale of footwear to the opponent, not the sale of footwear to end consumers and, therefore, were not suitable for proving external use. Mere presumptions and suppositions ('highly unlikely', 'unreasonable to think', '... which probably explains the absence of invoices ...', 'reasonable to assume', etc.) cannot replace solid evidence. Therefore, genuine use was denied.</p> |
| 19/09/2007, 1359 C;<br>confirmed 09/09/2008, R 1764/2007-4,<br>PAN AM II | <p>The owner of the mark owned a US-based airline, operating solely in the US. The fact that flights could also be booked via internet from the European Union could not alter the fact that the actual services of transportation (Class 39) were rendered exclusively outside the relevant territory. Furthermore, the lists submitted of passengers with addresses in the European Union could not prove that the flights had actually been booked from Europe. Finally, the website was exclusively written in English, the prices were in US dollars and the relevant telephone and fax numbers were from within the US. Therefore, genuine use in the relevant territory was denied.</p>  |

| Case No   | Comment   |
|---|---|
| 04/05/2010, R 966/2009-2,<br>COAST /<br>GREEN COAST (fig.) et al. | There are no special circumstances that might justify a finding that the catalogues submitted by the opponent, on their own or in combination with the website and magazine extracts, prove the extent of use of any of the earlier signs for any of the G&S involved. Although the evidence submitted shows use of the earlier sign in connection with clothing for men and women, the opponent did not produce any evidence whatsoever indicating the commercial volume of the exploitation of this sign to show that such use was genuine.   |
| 08/06/2010, R 1076/2009-2,<br>EURO CERT (fig.)/ EUROCERT          | It is well established in the case-law that a declaration, even if sworn or affirmed in accordance with the law under which it is rendered, must be corroborated by independent evidence. The declaration in this case, drawn up by an employee of the opponent's company, contains an outline of the nature of the relevant services, but only general statements concerning trade activities. It contains no detailed sales or advertising figures or other data that might show the extent and use of the mark. Furthermore, a mere three invoices with important financial data blanked out and a list of clients can hardly be considered corroborative evidence. Therefore, no genuine use of the earlier mark has been demonstrated. |



| Case No   | Comment  |
|---|--|
| 01/09/2010, R 1525/2009-4, OFFICEMATE / OFFICEMATE (fig.) | <p>The spreadsheets with turnover figures and the Analysis and Review reports concerning sales figures are documents drawn up by or commissioned by the appellant itself and, therefore, have less probative value. None of the evidence submitted contains any clear indication concerning the place of use of the earlier mark. The spreadsheets and the Analysis and Review Reports, which contain data compiled on the total value of estimated sales (in SEK) between the years 2003 to 2007, contain no information on where the sales took place. There is no reference to the territory of the European Union, where the earlier trade mark is registered. The invoices do not cover any sales of goods made by the appellant. Therefore, the evidence submitted is clearly insufficient to prove genuine use of the earlier mark.</p> |
| 12/12/2002, T-39/01, HIWATT, EU:T:2002:316                | <p>A catalogue showing the mark on three different models of amplifiers (but not indicating place, time or extent), a catalogue of the Frankfurt International trade fair showing that a company called HIWATT Amplification International exhibited at that fair (but not indicating any use of the trade mark) and a copy of the 1997 HIWATT Amplification Catalogue showing the mark on different models of amplifiers (but not indicating place or extent of use) were not considered sufficient to prove genuine use, principally because of lack of extent of use.</p>   |

## **Annex: 5-year period for assessing use of national trade marks**

According to Article 47(2) EUTMR, the proprietor of an earlier EUTM who has given notice of opposition against the registration of an EUTM application must, where the EUTM applicant so requests, submit proof that its earlier EUTM has been put to genuine use in the European Union in connection with the goods or services for which it was registered during the five years preceding the filing or priority<sup>81</sup> date of the EUTM application, provided the earlier EUTM has at that date been registered for more than five years ('five-year grace period').

Equally, the proprietor of an earlier national mark that has given notice of opposition against the registration of a European Union trade mark must, according to Article 47(3) EUTMR and where the EUTM applicant so requests, submit proof that its earlier national trade mark has been put to genuine use in the Member State in connection with the goods and services for which it was registered during a period of five years preceding the filing or priority date<sup>82</sup> of the EUTM application, provided the earlier national mark has at that date been registered for more than five years.

The date of registration of an EUTM is the date on which it is entered in the Register of European Union trade marks. Consequently, the five-year grace period of an EUTM commences from its entry in the Register of European Union trade marks.

In order to determine the date of commencement of the five-year grace period in respect of a national mark, national law is relevant. The commencement of this period depends on the registration procedure of the Member States and, in particular, whether a Member State applies a post-registration opposition procedure (this being the case for DK, DE, FI and SE).

The following table makes reference to the relevant national provisions<sup>83</sup> on non-use of a national trade mark and specifies the relevant point in time when the five-year grace period for a national trade mark commences.

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<sup>81</sup> Date of publication of the contested EUTM application in the case of oppositions filed before 23/03/2016, see paragraph 2.5.2.

<sup>82</sup> Date of publication of the contested EUTM application in the case of oppositions filed before 23/03/2016, see paragraph 2.5.2.

<sup>83</sup> References are to the national provisions valid on 01/06/2015.

| Member State | Relevant legal provisions | Quotation of the relevant legal provisions   | Summary / Comments  |
|--------------|---------------------------|--|---|
| Austria      | Article 33a(1) AT-TML     | ... registered for a minimum of five years where it has not been used ... in Austria during the five years preceding submission of the request.  | Date of entry in the Register of trade marks.             |
| Benelux      | Article 2.26(2)(a) BCIP   | ... insofar as no normal use has been made of the mark on the Benelux territory for the goods for which the mark is registered, without valid reason, during an uninterrupted period of five years.  | Date of registration of the trade mark.                   |
| Bulgaria     | Article 19(1) BG-TML      | ... within a period of five years following registration ...   | Date of registration of the trade mark.                   |
| Croatia      | Article 29(2) HR-TMA      | ... the earlier trade mark has, on the date of publication of the application for the registration of the trade mark, been registered for not less than five years.  | Date of registration of the trade mark.                   |
| Cyprus       | Section 28A CY-TML        | If, within a period of five years from the date of entry of the mark in the Register of trade marks, the proprietor has not put the mark to genuine use in connection with the goods and services [...] in respect of which it is registered ... | Date of entry of the mark in the Register of Trade Marks. |

| Member State   | Relevant legal provisions | Quotation of the relevant legal provisions   | Summary / Comments   |
|----------------|---------------------------|--|--|
| Czech Republic | Section 13(1) CZ-TML      | ... five years following the registration, the proprietor of the trade mark has not put the trade mark to genuine use...   | Date of entry of the mark in the Register of Trade Marks.<br><br>NB: the relevant date of entry in the Register is shown on the extracts from the official database of the CZ Office under INID code 151 (registration date).  |
| Denmark        | Paragraph 25(1) DK-TML    | ... Within a period of five years following the date of the termination of the registration procedure [when] the proprietor [...] has not put the trade mark to genuine use [...], or if such use has been suspended during an uninterrupted period of five years [...] unless there are proper reasons for non-use. | Where no opposition has been lodged:<br><br>2 months after publication of the registration (post-registration opposition procedure).<br><br>Where an opposition has been lodged:<br><br>a. date where the decision on the opposition becomes final (i.e. in cases of final refusal of the opposition, namely where the time limit for appeal has expired or where possibilities for appeal have been exhausted);<br>or<br><br>b. date of withdrawal of the opposition. |

| Member State | Relevant legal provisions                                   | Quotation of the relevant legal provisions  | Summary / Comments   |
|--------------|---|---|--|
| Estonia      | Paragraph 53(1)(3) and (4), paragraph 53(2) and (3) EST-TML | ... during five consecutive years after the making of the registration, without good reason...  | Date of entry of the mark in the Register of Trade Marks.  |
| Finland      | Section 26 FI-TML<br>Section 20 FI-FML                      | ... if the trade mark has not been used for the last five years ...the registering authority shall enter the trade mark in the register and give public notice thereof. Any opposition to the registration of the trade mark shall be filed in writing with the registering authority within 2 months of the date of the public notice. | Where no opposition has been lodged:<br>date of registration (post registration opposition procedure).<br>Where opposition has been lodged:<br>date of closure of the opposition proceedings (i.e. final refusal of the opposition or disposal otherwise, e.g. by withdrawal of the opposition). |
| France       | Article L. 714-5 FR-IP CODE                                 | ... use during an uninterrupted period of five years.   | Date of publication of the registration in the 'Bulletin officiel de la propriété industrielle'.   |

| Member State | Relevant legal provisions  | Quotation of the relevant legal provisions  | Summary / Comments  |
|--------------|--|---|---|
| Germany      | Section 26(5) DE-TML   | Insofar as use within five years from the point in time of the registration is necessary, in cases in which an opposition has been lodged against the registration, the time of the registration shall be substituted by the point in time of the conclusion of the opposition proceedings. | Where no opposition has been lodged:<br><br>date of registration (post registration opposition procedure).<br><br>Where an opposition has been lodged:<br><br>date of closure of the opposition proceedings (i.e. final refusal of the opposition or disposal otherwise, e.g. by withdrawal of the opposition). |
| Greece       | Article 147(2) read jointly with Article 143(1) GR-TML<br><br>Article 160(1)(a) GR-TML | Once the decision accepting the TM is final, the filing date constitutes the registration date.<br><br>The mark is revoked if it is not used within five years from the registration ...'   | Date of filing the application.   |
| Hungary      | Article 18(1) HU-TML<br><br>Article 64(1) HU-TML                                       | ... within a period of five years following the date of registration ...<br><br>[...] The date of the decision on registration shall be the date of registration of the trade mark.   | Date of registration of the mark.   |
| Ireland      | Article 51(1)(a), (b) IE-TMA   | ... within the period of five years following the date of publication of the registration.  | Date of publication of the registration of the mark.  |

| Member State | Relevant legal provisions | Quotation of the relevant legal provisions  | Summary / Comments  |
|--------------|---------------------------|---|---|
| Italy        | Article 24(1) IT-IP CODE  | within five years from registration.  | Date of issuing of the registration certificate.          |
| Latvia       | Article 23(3) LV-TML      | ... within five years from the date of registration ... and there are not sufficient reasons for non-use.   | Date of entry of the mark in the Register of trade marks. |
| Lithuania    | Article 47(2) LT-TML      | The registration of a mark may be revoked if, within a period of 5 years after the issue of the registration certificate, a genuine use of the mark has not been started by the proprietor of the mark in the Republic of Lithuania or the proprietor has not expressed serious intention to use the mark in respect of the goods and/or services for which it is registered, or if the mark has not been put to genuine use for a period of five continuous years, except in cases where the use of the mark was prevented by serious reasons. | Date of issuing of the registration certificate.          |
| Malta        | Article 42(1)(a) MT-TMA   | ... within the period of five years following the date of completion of the registration procedure it has not been put to genuine use ...   |   |

| Member State | Relevant legal provisions                               | Quotation of the relevant legal provisions   | Summary / Comments  |
|--------------|---|--|---|
| Poland       | Article 169(1)(i) PL-IPL                                | The right of protection for a trade mark shall also lapse on failure to put to genuine use of the registered trade mark for the goods covered by the registration for a period of five successive years after a decision on the grant of a right of protection has been taken, unless serious reasons of non-use thereof exist ... | Date of the registration.<br><br>Comment: the Polish examination includes also examination of relative grounds ex officio, and the decision on the grant of a right of protection is issued after a complete examination has taken place. |
| Portugal     | Article 269(i) PT-IP Code<br>Article 269(5) PT-IP Code. | ... the registration shall lapse if the trade mark is not put to serious use over a period of five consecutive years.<br><br>The five-year period starts running as from the date of registration.   | Date of registration.   |



| Member State | Relevant legal provisions | Quotation of the relevant legal provisions   | Summary / Comments   |
|--------------|---------------------------|--|--|
| Romania      | Article 46(1)(a) RO- TML  | ... during five consecutive years, following the date of entry (i.e. of the mark) in the Trade Marks Register, the mark was not put to genuine use in Romania for the goods or services for which it was registered .... | Date of entry of the mark in the Trade Marks Register.<br><br>Comment: the Romanian TM Law does not explicitly define 'the date of entry in the Register' or 'the registration date' of the mark, terms which are used interchangeably in the Law. In any case, please note that the relevant date is shown on the extracts from the official database of the RO Office under INID code 151 (registration date). |
| Slovakia     | Section 34(1) SK-TML      | ... if the trade mark was not put in genuine use in Slovakia for the goods and services for which it has been registered for a continuous period of five years ...   | Date of entry of the mark in the Register of trade marks.  |
| Slovenia     | Article 120(1) SL-IP ACT  | ... within a continuous period of five years from the date of entry of the right in the register.  | Date of entry of the mark in the Register of trade marks.  |

| Member State   | Relevant legal provisions     | Quotation of the relevant legal provisions   | Summary / Comments  |
|----------------|-------------------------------|--|---|
| Spain          | Article 39 ES-TML             | ... five years following the publication, the proprietor of the trade mark has not put the trade mark to genuine use in Spain for the registered goods and services or if within a continuous period of five years the trade mark has not been put to genuine use. | Date of publication of the registration.  |
| Sweden         | Chapter 3, paragraph 2 SE-TML | Within a period of five years following the date of the completion of the registration Procedure.  | Where no opposition has been lodged:<br><br>3 months after the publication of the registration (post-registration opposition procedure).<br><br>Where an opposition has been lodged:<br><br>on the date where the decision on the opposition becomes final. |
| United Kingdom | Section 46(1)(a), (b) UK-TML  | ... within a period of five years following the date of completion of the registration procedure ...   | Date of entry of the mark in the Register of Trade marks.   |