

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

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

Part C

Opposition

Section 7

Proof of use

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Obsolete

1 Introduction

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 owner must put the mark to genuine use within a period of 5 years following its registration ([Article 18\(1\) EUTMR](#)). However, the owner has a 'grace period' of 5 years after registration, during which it cannot be required to demonstrate use of the mark in order to rely upon it — including in opposition proceedings before the Office. During the grace period, the mere formal registration gives the mark full protection. Once this period lapses, the owner may be required **to prove genuine use** of the earlier mark.

The reason behind the requirement that earlier marks must be 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 ⁽⁸⁰⁾([the Directive](#)), as implemented in the national law of the Member States.

[Article 18 EUTMR](#)

[Article 18 EUTMR](#) stipulates the basic substantive requirement for the obligation to use registered marks:

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

⁸⁰ [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](#)

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.

[Article 18\(1\)\(a\) EUTMR](#) states that use of the EU trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered constitutes use. This applies regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor. [Article 18\(1\)\(b\) EUTMR](#) states that affixing the EU trade mark to goods or to the packaging of goods in the Union also constitutes use, even when solely for export purposes.

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.

[Article 47\(2\) and \(3\) EUTMR](#)

The consequences of a lack of use in opposition proceedings are dealt with in [Article 47\(2\) and \(3\) 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.

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.

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](#), no request for proof of use can be made under [Article 47\(2\) or \(3\)](#) for any of the earlier marks relied on. The reason is that the earlier marks eligible under [Article 8\(3\) EUTMR](#) include both trade marks having effect in the EU **and** outside the EU, 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. In any event, it follows from the specific requirement under [Article 8\(3\) EUTMR](#) to establish a principal / agent relationship, that, in principle, the

earlier mark has normally been put to use by the applicant, under authorisation, and so on behalf, of the proprietor of the earlier mark.

[Article 10 EUTMDR](#) and [Article 24 EUTMIR](#)

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.

As regards language, the general rules relating to supporting documents to be used in written proceedings before the Office apply, as provided for in [Article 24 EUTMIR](#). As such, the evidence of use may be submitted in any official language of the European Union. Nevertheless, in accordance with [Article 10\(6\) EUTMDR](#), where the evidence submitted 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.

[The Directive](#)

[Articles 16\(1\), \(5\) and \(6\) of the Directive](#) contain provisions relating to trade marks having effect in a Member State substantially identical to [Article 18 EUTMR](#).

[Articles 16\(2\), \(3\) and \(4\) of the Directive](#) are relevant for the purposes of determining the grace period for non-use of trade marks having effect in a Member State.

This section of the Guidelines deals with the **substantive** aspects of proving genuine use. The **procedural** aspects of proof of use are dealt with in the Guidelines, [Part C, Opposition, Section 1, Opposition Proceedings, paragraph 5](#).

2 General principles and standard of proof

2.1 General principles

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);⁽⁸¹⁾
- 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**

⁸¹ The criterion of 'identity of origin' applies only to individual marks. As regards the essential function of collective and certification marks and the consequences for assessing genuine use, see [paragraph 6.1.1.2](#) below.

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).

Fast-track: 31/03/2023

2.2 Standard of proof

[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. However, not just any proven commercial exploitation can automatically be qualified as genuine use of the mark in question (17/07/2014, [C-141/13 P](#), Walzer Traum, EU:C:2014:2089, § 32). Use may still be insufficient even where commercial exploitation has been proven to a certain extent.

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 5 years preceding the date of filing or the date of priority of the EUTM application (see [paragraph 4](#) below) and use in the relevant territory (see [paragraph 3](#) below). ⁽⁸²⁾ 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 10.5](#) below.

⁸² Publication date of the contested EUTM application in the event of EUTM applications filed before 23/03/2016, see [paragraph 4.2](#) below.

3 Place of use

3.1 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 Marken*, 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).

3.2 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 Marken*, [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 (§ 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 Marken*, it is impossible to determine a priori and in the abstract what territorial scope should be applied in order to determine whether use of the mark is genuine or not (§ 55). Territorial scope is only one of several factors to be taken into account when assessing whether use of an EUTM is genuine. Furthermore,

a *de minimis* rule for establishing whether that factor is satisfied cannot be laid down (07/11/2019, [T-380/18](#), INTAS / INDAS (fig.) et al., EU:T:2019:782, § 80).

An EUTM need not be used in an extensive geographic area for use to be deemed genuine, since this will depend on the characteristics of the goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered (19/12/2012, [C-149/11](#), Onel / Omel, EU:C:2012:816, § 55; 07/11/2019, [T-380/18](#), INTAS / INDAS (fig.) et al., EU:T:2019:782 § 80).

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 (19/12/2012, [C-149/11](#), Onel / Omel, EU:C:2012:816, § 58).

Moreover, for use of an EUTM to be deemed genuine, the mark need not be used in a substantial part of the European Union. The possibility that it may have been used in the territory of only a single Member State must not be ruled out, since the borders of the Member States must be disregarded while the characteristics of the goods or services concerned must be taken into account (07/11/2019, [T-380/18](#), INTAS / INDAS (fig.) et al., EU:T:2019:782, § 80).

The General Court has held on numerous occasions that use of an EUTM in a single Member State (for example, in Germany, in Spain, or in the United Kingdom), or even in a single city in a Member State of the European Union, is sufficient to satisfy the criterion of territorial scope (07/11/2019, [T-380/18](#), INTAS / INDAS (fig.) et al., EU:T:2019:782, § 81 and the case-law cited).

For example, use of an EUTM in the United Kingdom (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](#), § 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](#), § 45-46)], the scale, frequency and regularity of use and the characteristics of the market concerned ([R 234/2012-2](#), § 52).

In other words, whether an EUTM has been used in one Member State or several is irrelevant. What matters is the impact of use in the internal market and, more specifically, whether it is sufficient to maintain or create market share in that market for the goods and services covered by the mark and whether it contributes to a commercially relevant presence of the goods and services in that market. Whether that use results in actual commercial success is not relevant (07/11/2019, [T-380/18](#), INTAS / INDAS (fig) et al., EU:T:2019:782, § 82).

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.

3.3 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 , 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.

3.4 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).

4 Time of use

Fast-track: 31/03/2023

4.1 **Contested EUTM applications and International registrations designating the EU filed on or after 23/03/2016**

If the earlier mark is subject to the use requirement at all (registered for not less than 5 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 5 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 5 years, but rather within the 5 years. The provisions on the use requirement do not require continuous use (16/12/2008, [T-86/07](#), *Deitech*, EU:T:2008:577, § 52).

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4.2 Contested EUTM applications and International registrations designating the EU filed before 23/03/2016

For contested EUTM applications and International registrations designating the EU filed before 23/03/2016, the regime for calculating the relevant period prior to the entry into force of [Amending Regulation \(EU\) 2015/2424](#) applies, according to which the 5-year period has to be computed backwards from the **date of publication** of the contested EUTM application. In the case of contested IRs designating the EU, the equivalent date is the date of first publication of the IR or its subsequent designation in the EUTM Bulletin (25/04/2018, [T-312/16](#), CHATKA / CHATKA (fig.), EU:T:2018:221, § 19-42).

5 Extent of use

5.1 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 5 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 (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 or a low volume of sales can be sufficient (22/10/2020, [C-720/18](#) & [C-721/18](#), Testarossa, ECLI:EU:C:2020:854, § 51-52). 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).

5.2 Examples of insufficient use

Case No	Comment
18/03/2015, T-250/13 , SMART WATER	The test sales of 15 000 water bottles are considered symbolic in the light of the size of the European market (paras 34-35).
16/07/2014, T-196/13 , NAMMU, 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. 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, EU:T:2013:22; confirmed 17/07/2014, C-141/13 P , 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.).

Case No	Comment
30/04/2008, T-131/06 , Sonia Sonia Rykiel, 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 , AMAZING ELASTIC PLASTIC II	500 plastic balloon kits given away as 'samples' free of charge cannot constitute genuine use.
20/04/2001, R 378/2000-1 , RINASCIMENTO/ 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 , GOLF WORLD (fig.9 / GOLF WORLD et al. (B 1 456 443 , Golf World)	As the only evidence of use for <i>printed matter</i> , 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, R 2132/2010-2 , 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 <i>alcoholic drinks (except beers)</i> 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.

Case No	Comment
07/07/2011, R 908/2010-2 , 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.
16/03/2011, R 820/2010-1 , 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, R 999/2010-1 , TAUTROPFEN CHARISMA (fig.) / CHARISMA	Eleven invoices showing that 13 units of <i>perfumery</i> 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, B 1 118 605 , 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 , Oregon	The Opposition Division found an invoice for 180 pairs of shoes as insufficient to prove genuine use.
30/01/2001, B 193 716 , 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.

5.3 Examples of sufficient use

Case No	Comment
16/11/2011, T-308/06 , Buffalo Milke, EU:T:2011:675	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 <i>shoe polish</i> , 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 <i>polishing cream</i> and <i>leather conditioner</i> . 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)
10/09/2008, T-325/06 , Capio, EU:T:2008:338	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 <i>oxygenators with integrated pump; controllers for integrated pump; regulating devices of air pressure for integrated pump; suction pumps; blood flow meters</i> in Class 10 (paras 48, 60).

Case No	Comment
<p>27/09/2007, T-418/03, La Mer, 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, T-191/07, Budweiser, 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, C-416/04 P , Vitafruit, 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, T-30/09 , Peerstorm, 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, 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, R 571/2009-1 , 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 <i>milk proteins for human consumption</i> . 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, R 1123/2010-4 , 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 <i>preservatives against deterioration of wood</i> in Class 2.
01/02/2011, B 1 563 066	An annual turnover of more than EUR 10 million over several years was claimed for <i>medical preparations</i> . 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, 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, 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.

6 Nature of use

The term 'nature of use' refers to:

- use of the mark in accordance with its essential function, in the course of trade ([paragraph 6.1](#) below);
- use of the mark as registered or of a variation thereof ([paragraph 6.2](#) below); and
- use of the mark in connection with the goods and services for which it is registered ([paragraph 6.3](#) below).

6.1 Use as a trade mark

6.1.1 Use of a mark in accordance with its function

6.1.1.1 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 or invoices relating to the goods and services in question constitutes direct evidence that the mark has been put to genuine use.

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, because it does not guarantee to consumers that the goods or services come from a single undertaking under the control of which the goods or services are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services (08/06/2017, [C-689/15](#), Cotton Flower, EU:C:2017:434, § 45).

2. Use as a **Geographical Indication (GI)**. The essential function of GIs 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 GI is contained within an individual mark that guarantees to consumers that the goods which it designates come from a single undertaking under the control of which those goods are manufactured and which is responsible for the quality of those goods, the opponent must submit proof of use as an individual mark (07/06/2018, [T-72/17](#), Steirisches Kürbiskernöl (fig.), EU:T:2018:335, § 52; 17/10/2019, [C-514/18 P](#), Steirisches Kürbiskernöl (fig.), EU:C:2019:878, § 37-43). Evidence of use as a GI (e.g. general statements of Regulatory Councils) cannot serve for proving use as an individual mark. For more information on geographical indications see [the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications \(Article 7\(1\)\(j\) EUTMR](#).

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.

1. **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** may, depending on how the sign appears on them, be suitable to support genuine use of the registered trade mark (06/11/2014, [T-463/12](#), MB, EU:T:2014:935, § 44-45). Simultaneous use of the company name and the trade mark on invoices may, when the two indications can be clearly distinguished, prove use of the sign as an indicator of the commercial origin of the services provided, irrespective of the fact that the invoices may also show other sub-brands (03/10/2019, [T-666/18](#), ad pepper (fig.), EU:T:2019:720, § 82-84).

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

2. 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.

6.1.1.2 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 7.3](#)) 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 (20/09/2017, [C-673/15 P & C-674/15 P & C-675/15 P & C-676/15 P](#), DARJEELING (fig.) / DARJEELING et al., EU:C:2017:702, § 63). The specific characteristic of collective marks is to indicate the **collective** commercial origin of the goods or services, that is to say to indicate that certain products or services come from a member of a certain 'collective', which is the proprietor of the collective mark, and not an **individual** commercial origin as is the case with individual marks. Therefore, unlike an individual mark, a collective mark does not have the function of indicating to consumers 'the identity of origin' of the goods or services in respect of which it is registered. Manufacturers, producers, suppliers or traders who are affiliated with

the association that is the proprietor of a collective mark do not have to form part of the same group of companies that manufacture or supply the goods or services under unitary control. In fact, they can be competitors, each of which uses, on the one hand, the collective mark indicating their affiliation with that association and, on the other, an individual mark indicating the identity of origin of their goods or services. However, like an individual mark, a collective mark must be used by the members of the association to create or preserve an outlet for the registered goods or services (12/12/2019, [C-143/19 P](#), EIN KREIS MIT ZWEI PFEILEN (fig.), EU:C:2019:1076).

The essential function of a **certification mark** is not to indicate **commercial** 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 thus certified. For the use of a certification mark to be considered genuine, it must be used in accordance with this essential function.

6.1.2 Use in the course of trade

6.1.2.1 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).

6.1.2.2 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 (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>	

6.1.2.3 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 — 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, EU:T:2010:298
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, EU:T:2009:156
The General Court found that the use of the sign <i>Schuhpark</i> 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 <i>Schuhpark</i> and the shoes. In other words, <i>Schuhpark</i> may well be a mark for the retail of shoes, but it was not used as a trade mark for goods (paras 31-32).	

6.1.2.4 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
M&P	06/11/2014, T-463/12 , MB, EU:T:2014:935
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 , STRATEGI / Stratégies, EU:T:2010:424
Where an earlier mark was registered for <i>business management</i> 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 <i>business management</i> 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).	

6.1.2.5 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 , Blumen Worldwide (fig.) / BLUME, LEOPOLDO 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.) / BIODANZA; confirmed 08/03/2012, T-298/10 , Biodanza, 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.

6.1.2.6 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; 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 www.cybereuskadi.com mentions that the opponent (‘designer of Skunkfunk’) “exports surf clothes worldwide and has a turnover of nearly 7 million euros per year” (para. 21).	

For further information regarding evidence originating from the Internet, please see the Guidelines, [Part C, Opposition, Section 5, Trade Marks with Reputation \(Article 8\(5\) EUTMR\), paragraph 3.1.4.4.](#)

6.2 Use of the mark as registered or of a variation thereof

When assessing genuine use of a trade mark, it must be taken into account that trade marks are used in a commercial context, on products, packaging, information and advertising materials, etc. They are normally used together with other product information, marketing messages, decorative elements and often with other marks (individual, collective or certification marks) or geographical indications and related symbols. Therefore, verifying whether the mark was used 'as registered' may prove to be a challenging exercise.

This section deals with (i) simultaneous use of independent marks and (ii) use in a different form that does not alter the distinctiveness of the mark as registered.

[Article 18\(1\)\(a\) EUTMR](#) provides that, apart from use of the mark in its registered form, use of the trade mark in a form differing in elements that do not alter the distinctive character of the mark as registered also constitutes 'use of the trade mark'. This applies regardless of whether the mark as used is also the subject of a separate trade mark registration of the proprietor.

The purpose of this provision is to allow the proprietor, in the commercial exploitation of the mark, to make variations in the mark 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). In accordance with the purpose of that provision, where the mark used in trade differs from the form in which it was registered, the difference must be such that the two can still be regarded as broadly equivalent.

Endeavouring to converge trade mark practices, the European Union Intellectual Property Network published a Common Communication on the Common Practice - the Use of a Trade Mark in a Form Differing from the One Registered ([CP8](#)) ⁽⁸³⁾. This section of the Guidelines is in line with CP8.

6.2.1 Use in the form as registered – simultaneous use of independent marks

Trade marks are often used together with other marks, for example, to indicate a house mark and a sub-brand. This constitutes use of a mark in the **same form** as registered, in parallel with, but independently from, other marks (simultaneous use of independent marks). This is different from use of a mark in a **different form** than the one registered (08/12/2005, [T-29/04](#), Cristal Castellblanch, EU:T:2005:438, § 33, 34; 06/11/2014, [T-463/12](#), MB, EU:T:2014:935, § 43). Consequently, in the case of simultaneous use of independent marks, the question of whether the distinctive character of the mark as registered has been altered does not even arise and [Article 18\(1\)\(a\) EUTMR](#) is not applicable. Accordingly, use of a mark without any


⁸³ Available at <https://www.tmdn.org/network/converging-practices>

modification, including simultaneous use with separate, independent marks, is covered by the first subparagraph of [Article 18\(1\) EUTMR](#), not by [Article 18\(1\)\(a\) EUTMR](#).



To establish simultaneous use, what has to be determined is whether the marks in question, despite being used together, remain **independent** from each other and whether they will be perceived in this way by the public. This is in contrast to where the public will instead perceive them as forming **a unit** and not as 'separate, independent marks'. In principle, a visual and/or conceptual **interaction** between the components that results in an inseparable unit would preclude those components from being perceived as 'separate, independent marks'. This requires a global assessment of various factors, such as:



- the intrinsic characteristics of the marks (dominant and distinctive elements; their respective position; use in a different size, typeface or colour; presence or absence of syntactical, grammatical or conceptual connections, etc.);
- the way the marks are presented in the evidence of use and the context of use (the business practices in the trade sector concerned, nature of the marks, i.e. company names, house marks, product-line identifiers, sub-brands etc.);
- specific evidence capable of establishing that the marks are perceived independently by the consumers.

A lack of evidence of the independent use and perception of the mark as registered does not preclude assessing the question of simultaneous use on the basis of the intrinsic characteristics of the marks and the general experience of trade practices in the relevant trade sector.

Mark as registered	Mark as used	Case No
YGAY		21/09/2010, T-546/08 , i Gai, EU:T:2010:404
The indication 'Marqués de Murrieta' refers to the winery responsible for the production and marketing of the wine, whereas 'YGAY' identifies the particular wine among the range of wines marketed by the manufacturer. The joint use of the words 'Marqués de Murrieta' and the earlier mark on the same medium does not affect the identification function of the earlier mark for the goods at issue. The joint use of several marks on product labels, particularly, those referring to the winery and the particular product, is a common commercial practice in the wine sector (paras 19-25).		

Mark as registered	Mark as used	Case No
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		13/09/2016, T-146/15 , DARSTELLUNG EINES VIELECKS (fig.), EU:T:2016:469
<p>The joint use of a figurative element and a word element on the same textile or clothing item does not undermine the identification function of the registered mark; it is not unusual in the clothing sector to juxtapose a figurative element with a word element referring to the designer or manufacturer, without the figurative element losing its autonomous identification function in the overall impression (paras 58-60).</p>		

Mark as registered	Mark as used	Case No
		Invented example (CP8)
<p>Relevant goods are <i>pharmaceuticals</i> in Class 5.</p> <p>The mark as registered, MAPALVAM, is used together with another distinctive mark, that is to say, house mark. In the pharmaceutical sector it is common that the product name appears together with the house mark. The mark as registered will be perceived independently in the mark as used.</p>		

Where a **distinctive word is superimposed** over the mark as registered consisting of a figurative element, pattern or a shape **of a low distinctive character**, it may prove difficult to determine whether it is a case of simultaneous use or of an alteration to the earlier mark. The question to be asked is whether the original mark is still perceived independently despite the superimposition of the distinctive word. If it is, it will be treated as simultaneous use. As stated in the judgment of 18/04/2013, [C-12/12](#), Colloseum Holding, EU:C:2013:253, § 35, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must **continue to be perceived as indicative of the origin of the product** at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1) of Regulation No 40/94. ⁽⁸⁴⁾ On the other hand, if it cannot be established that the original figurative, shape, pattern mark is perceived as an independent mark, this is not a scenario of

‘simultaneous use’ and the case must be assessed under the rules of alteration of distinctive character (see paragraph 6.2.2.1.2).



Conversely, where the mark as registered is a figurative or shape mark that is **not of a low distinctive character**, the superimposition of a distinctive word will normally not affect the capability of that figurative or shape mark to be perceived as an independent mark, as in the following examples of simultaneous use.

Mark as registered	Mark as used	Case No
		<p>10/10/2017, T-211/14 RENV., SHAPE OF AN OVEN (3D), EU:T:2017:715</p> <p>appeal dismissed, 23/01/2019, C-698/17 P, SHAPE OF AN OVEN (3D), EU:C:2019:48</p>

First, it must be noted that, the mark as registered diverges significantly from what is customary in the relevant sector with regard to both, its cylindrical shape and the mode of operation induced by that shape. In those circumstances, that mark was considered to have a high degree of distinctive character (paras 42 and 46). Second, the word ‘Bullerjan’ occupies a small part of the structure and is only visible when the structure is viewed from the front part of the combustion chamber. Finally, the panel on which the word mark is embossed is metallic in appearance like the whole structure so that it does not really stand out from the rest of the structure. That word mark is therefore less striking than the shape of the product itself. In those circumstances, the overall perception of the mark in question is not affected by the presence of the word mark ‘Bullerjan’. This is all the more notable since the combination between a three-dimensional form and an additional word mark is common in the sector in question. Consequently, and given the distinctiveness of the mark at issue, that word mark does not call into question the fact that the three-dimensional shape is sufficient, in itself, to determine the commercial origin of those products (para. 47).

Mark as registered	Mark as used	Case No
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⁸⁴ Article 15(1) of Regulation No 40/94 corresponded to [Article 18\(1\) EUTMR](#), first subparagraph, and not [Article 18\(1\)\(a\) EUTMR](#). The provision corresponding to [Article 18\(1\)\(a\) EUTMR](#) was Article 15(2)(a) in Regulation No 40/94.

		28/02/2019, T-459/18 , PEPERO original (fig.) / REPRÉSENTATION D'UN BATÔNNET (fig.), EU:T:2019:119
<p>On the basis of the evidence filed it was concluded that the mark as registered was used as a trade mark, namely, identifying the commercial origin of the goods at issue (paras 76, 94, 98). The superimposition of the mark 'MIKADO' does not alter the distinctive character of the shape mark as registered. In that regard, it should be noted that the mark 'MIKADO' partially covers the three-dimensional shape constituting the earlier mark both on the edge and the front of the packaging. However, the addition of this word will in no way prevent the consumer from perceiving the shape and colours of the earlier mark, the two ends of which remain visible and the relationship between the colours yellow and brown is clearly identifiable. In those circumstances, the 'MIKADO' mark appears as an independent element and not as forming a unit with the earlier mark (paras 99-100).</p>		

6.2.2 Use in a form different from the one registered

Where simultaneous use of independent marks is excluded, the difference in the mark as used must be assessed under [Article 18\(1\)\(a\) EUTMR](#) to determine whether it alters the distinctive character of the mark as registered. Essentially, what will be assessed is whether the mark as used constitutes an **acceptable or unacceptable 'variation'** of its registered form.

That assessment consists of two steps.

The **first step** is to clarify what is to be regarded as the distinctive character of the mark as registered by establishing **which elements contribute to the distinctive character** and to **what extent they do so** ('the distinctive essence of the mark'). This requires an assessment of the distinctive and visually dominant character **of the elements of the mark as registered** based on the intrinsic qualities of each, their relative position within the arrangement of the mark and their interactions.

The **second step** is to **identify the differences in the mark as used** and **evaluate the impact of the variations**. It should be established whether that distinctive essence of the mark as registered is present, missing or modified in the mark as used. This requires an assessment of the distinctive and dominant character **of the added, omitted or modified components in the mark as used**, based on the intrinsic qualities of each, their relative position within the arrangement of the mark and their interactions. There is interdependence between the strength of the distinctive character of a mark and the effect of any variation. Marks of a greater distinctive character may be less influenced by variations than marks of a limited distinctive character. Added or omitted elements are more likely to affect the distinctive character of marks of limited distinctive character (10/10/2018, [T-24/17](#), D-TACK / TACK et al., EU:T:2018:668, § 47

and the case-law cited therein). The practices of the relevant trade sector and the perception of the relevant public must also be taken into account.

The following paragraphs contain guidance and examples illustrating the impact of **additions** ([paragraph 6.2.2.1](#)), **omissions** ([paragraph 6.2.2.2](#)) and **modifications of other characteristics**, such as position or proportions ([paragraph 6.2.2.3](#)), depending on whether the mark as registered is of an **average** or a **low** degree of distinctive character. Although the mark as used may contain a **combination** of these variations, including an omission of an element and addition of another (replacement), the principles below may also serve as guidance for such cases.

6.2.2.1 Additions

6.2.2.1.1 Mark as registered distinctive to an average degree


The following main scenarios can be distinguished.

- Addition of a non-distinctive or weakly distinctive element
- Addition of a symbol or other orthographic character
- Addition of a distinctive (interacting) element

Addition of a non-distinctive or weakly distinctive element

In general, the addition of a non-distinctive or weakly distinctive element (be it a word or figurative element, including stylisation or colour) does not alter the distinctive character of the mark as registered, regardless of whether these elements are visually dominant or not.




Examples where the distinctive character is not altered:

Mark as registered	Mark as used	Case No
AINHOA	(i) AINHOA BIO (ii) AINHOA DELUXE (iii) 	23/09/2015, T-426/13 , AINHOA, EU:T:2015:669 appeal dismissed, 16/06/2016, C-611/15 P , AINHOA, EU:C:2016:463

G&S: Class 3

Territory: EU

Assessment: The additional elements, such as 'bio' or 'deluxe', are descriptive of the characteristics of the goods. The rectangle representing a cloudy sky positioned above the word element does not change the overall impression of the mark (paras 30-32) – acceptable variation.

Mark as registered	Mark as used	Case No
	(i)  (ii) 	29/04/2020, T-78/19 , green cycles (fig.), EU:T:2020:166

G&S: Classes 17, 20, 40 and 42

Territory: EU





Assessment: The additional elements 'solutions and products', 'plásticos Hidrosolubles s.l.', sometimes also preceded by the preposition 'by', are only minor additions as opposed to the expression 'green cycles', which constitutes the dominant element of the mark as used. The inversion of the colours of the mark as registered is not sufficient to affect the distinctive character of the mark as registered. The colours, blue, green and grey, are not particularly original or unusual in the registered and used forms of the mark (paras 68-69) – acceptable variation.

Mark as registered	Mark as used	Case No
		12/05/2016, T-322/14 and T-325/14 , MOBILE.DE, EU:T:2016:297 appeal dismissed, 28/02/2018, C-418/16P , mobile.de, EU:C:2018:128

G&S: Class 35

Territory: Bulgaria

Assessment: Affixing of the element '.bg' to the end of the mark does not alter the distinctive character of the mark as registered. Although this element conveys an additional message, the fact remains that it is commonly perceived as an indication of the top-level domain name associated with Bulgaria. This very common short territorial reference does not have any particular distinctive character. The marks at issue have their dominant word element in common, they also share the characteristics of their graphic configuration, such as the font and the framing, and they differ in secondary elements that are brief and not decisive as to their distinctive character (paras 57-58) – acceptable variation.

Mark as registered	Mark as used	Case No
	(i)  (ii)  (iii) 	15/10/2019, T-582/18 , X BOXER BARCELONA (fig.) / X (fig.) et al., EU:T:2019:747


G&S: Class 25





Territory: EU (evidence of use focusing on Germany, France and Italy)

Assessment: The word elements 'bionic', 'socks' and 'technology' occupy a secondary position in the marks as used because they are placed after the figurative element composed of the letter 'x' and the two arrows, which, taking into account its position and size, will attract more of the attention of the relevant public. Furthermore, the elements 'bionic', 'socks' and 'technology' are laudatory with regard to the products designated by the mark or descriptive of some of their characteristics. In particular, the term 'socks' is descriptive of the type of products concerned. The term 'bionic' will be perceived as a laudatory term, designating the fact of having powerful or exceptional capabilities, especially when used to denote sportswear. The term 'technology' will be seen as a reference to 'smart' sportswear with special features obtained through the use of technology that allow these garments to adapt to the ambient temperature or humidity (paras 45-48) – acceptable variation.

Mark as registered	Mark as used	Case No
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FLAMINAIRE	FLAMINAIRE	08/12/2015, T-583/14 , FLAMINAIRE / FLAMINAIRE, EU:T:2015:943
<p>G&S: Classes 16 and 34</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The marks as registered and used differ only in the stylisation of the upper-case letter 'A' and the use of a bold font. These differences do not alter the distinctive character of the mark as registered (para. 37) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
BROWNIES		30/01/2020, T-598/18 , BROWNIE / BROWNIE, Brownie (series mark), EU:T:2020:22
<p>G&S: Classes 6, 18, 25, 26, 28 and 41</p> <p><i>Territory:</i> United Kingdom</p> <p><i>Assessment:</i> The word 'brownies' is clearly legible in the form in which the mark was used. The figurative elements of the mark used do not play any significant role in the overall impression conveyed by the mark and have no inherent semantic content of their own which would lend the mark distinctive character or designate the goods concerned. Those figurative elements are limited to the presentation of the word 'brownies' in a yellow stylised font and the dot on the letter 'i' in the form of a flower and, sometimes, an uneven border (paras 65-67) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
	<p>(i) </p> <p>(ii) </p> <p>(iii) </p>	24/05/2012, T-152/11 , Mad, EU:T:2012:263

G&S: Class 25

Territory: EU

Assessment: The letters M, A, D are arranged in a particular way in the mark as registered. The use of different colour combinations in the forms in which the mark was used should be allowed, as long as the letters contrast against the background (paras 41 and 45) – acceptable variation.

Addition of a symbol or other orthographic character

Adding a punctuation mark (such as a dot or an exclamation mark), another orthographic character (such as an apostrophe, accent, hyphen or space) or other symbols (such as the plural or possessive symbol or the abbreviated company form), does not normally alter the distinctive character of the mark as registered.

However, if the new element changes the perception of the mark, for example by changing the meaning of the mark as registered, a different conclusion may be justified.

Examples where the distinctive character is not altered:

Mark as registered	Mark as used	Case No
CODICE	CÓDICE	16/12/2019, R 2539/2018-2 , Codicí banda nera / SHAPE OF A BLACK BOTTLE WITH AN ORANGE LABEL (3D) et al.
<p>G&S: Class 33</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The use of the accent does not alter the distinctive character of the mark as registered (para. 28) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
Tentation	Tentations	29/07/2008, R 1939/2007-1 , TEMPTATION FOR MEN YANBAL (fig.) / TENTATION

G&S: Class 3

Territory: Benelux, Germany, Italy, Portugal, Romania and Spain (evidence of use focusing on Spain)

Assessment: Merely adding 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, where the evidence of use focused. The trade mark in question will be perceived merely as being in its plural form as opposed to its singular form (para. 17) – acceptable variation.

Mark as registered	Mark as used	Case No
FOAMASTER	FOAMASTER®	04/07/2019, R 1808/2018-5 , Easy foam master / Foamaster et al.
<p>G&S: Class 1</p> <p><i>Territory:</i> Germany</p> <p><i>Assessment:</i> The use of the mark together with the registered trade mark symbol ® does not alter the distinctive character of the mark as registered (paras 52-53) – acceptable variation.</p>		


Example where the distinctive character is altered:


Mark as registered	Mark as used	Case No
MEXAVIT	MEXA-VIT C	30/03/2007, R 159/2005-4 , Metavit / MEXA-VIT C et al.
<p>G&S: Class 5</p> <p><i>Territory:</i> Austria</p> <p><i>Assessment:</i> The use of the mark with a different spelling and the addition of the letter 'C' alter the distinctive character of the mark as registered. This is because the letters 'VIT' are now seen as a descriptive element, 'VIT C', which refers to 'Vitamin C' – unacceptable variation.</p>		

Addition of a distinctive (interacting) element

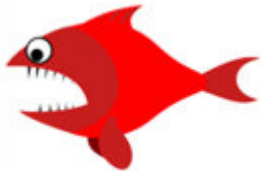
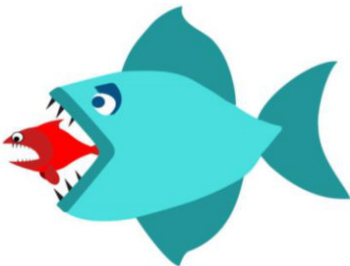
In principle, the addition of a distinctive element that **interacts** with the mark as registered in such a manner that it can no longer be perceived independently, but rather as **forming a unit** (thus excluding simultaneous use of several marks) alters the distinctive character of the mark as registered.

Examples where the distinctive character is altered:

Mark as registered	Mark as used	Case No
NN		28/06/2017, T-333/15 , NN / NN, EU:T:2017:444 appeal dismissed, 17/01/2018 C-536/17 P , EU:T:2018:14
<p>G&S: Class 36</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The word mark 'núñez i navarro' is always placed below a circle containing the letters 'nn' and occupies a central position. Moreover, the word element 'núñez i navarro' is much larger than the word mark 'nn', both in terms of width and the number of characters each contains. The letters 'nn' are very likely to be perceived as the initials of the surnames 'núñez' and 'navarro'. As surnames, these are not generic terms referring to the services in question and therefore have normal distinctive character. In the circumstances, the addition of the word element 'núñez i navarro' to the earlier mark changes its distinctive character (paras 43-46) – unacceptable variation.</p>		

Mark as registered	Mark as used	Case No
TACK		10/10/2018, T-24/17 , D-TACK / TACK et al., EU:T:2018:668
<p>G&S: Class 16</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The invoices did not contain any indication of the earlier word mark TACK as such; that reference was made instead to product names. The juxtaposition of the element 'ceys' could not be seen as an irrelevant or negligible addition to the element 'tack'. Furthermore, on the invoices and in the brochures and catalogues the elements 'tack' and 'ceys' appeared together as one single term or as a single eight-letter word element. The element 'tackceys' on the invoices, and in the text of the brochures and catalogues, will be perceived as an indivisible unit, the two words being conjoined. On the packaging and in the extracts from websites, brochures and the catalogues, the word 'tack' systematically appears in combination with the word 'ceys' and in a figurative manner. None of the items of evidence referred to above shows the earlier word mark TACK used in isolation or, at least, away from the element 'ceys' (paras 54-63) – unacceptable variation.</p>		

Mark as registered	Mark as used	Case No
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		Invented example (CP8)
<p>G&S: Class 25</p> <p><i>Assessment:</i> The mark as registered is used with a distinctive figurative element (a blue fish) in such a manner that a single unit and a new concept is created in the mark as used (the big fish eating the small one) – unacceptable variation.</p>		

6.2.2.1.2 Mark as registered distinctive to a low degree

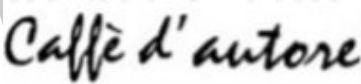
The following main scenarios can be distinguished.

- Addition of a non-distinctive or weakly distinctive element.
- Addition of a distinctive (interacting) element.


Addition of a non-distinctive or weakly distinctive element

When the mark as registered has a low degree of distinctive character, adding even a non-distinctive or weakly distinctive element may alter its distinctive character. Therefore, a case-by-case assessment is particularly important.

Examples where the distinctive character is altered:

Mark as registered	Mark as used	Case No
CAFFE D'AUTORE		14/12/2018, R 932/2018-5 , La migliore interprete del caffè d'autore / Caffè d'autore (fig.) et al.
<p>G&S: Class 11: <i>Electric coffee machines for use in bars</i></p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> In the mark as used the specific handwritten font style is the most distinctive element. This alters the distinctive character of the mark, as the use of this specific handwritten font style adds a distinctive element to the word mark which was not present in the form in which it was registered (paras 52-53) – unacceptable variation.</p>		

Mark as registered	Mark as used	Case No
	<p>(i) </p> <p>(ii) </p>	19/06/2019, T-307/17 , DEVICE OF THREE PARALLEL STRIPES (fig.), EU:T:2019:427
<p>G&S: Class 25</p> <p>Territory: EU</p> <p><i>Assessment:</i> The following considerations are made in the context of Article 7(3) EUTMR, applied by analogy to Article 18(1)(a) EUTMR (para. 58). The mark at issue is a purely figurative mark presenting very few characteristics. One of those characteristics is the use of three black stripes against a white background. That characteristic gives rise to a specific contrast between, on the one hand, the three black stripes and, on the other hand, the white background and the white spaces separating those stripes. In those circumstances, having regard, in particular, to the extreme simplicity of the mark at issue and the significance of the characteristic described above, the act of reversing the colour scheme, even if a sharp contrast between the three stripes and the background is preserved, cannot be described as an insignificant variation as compared to the registered form of the mark at issue. It follows that the use of the mark in the form of three white (or light) stripes against a black (or dark) background alters the distinctive character of the mark as registered (paras 76-78) – unacceptable variation.</p>		




Mark as registered	Mark as used	Case No
FLAVOUR AND AROMA		Invented example (CP8)

G&S: Class 31

Territory: English-speaking public

Assessment: The mark as registered has a low degree of distinctive character. The added element BAA-naa-NAA, which also has a low degree of distinctive character, is placed at the beginning and interacts with the mark as registered by creating a new concept – unacceptable variation.

Example where the distinctive character is not altered:

Mark as registered	Mark as used	Case No
	(i)  (ii) 	13/09/2016, T-146/15 , DARSTELLUNG EINES VIELECKS (fig.), EU:T:2016:469
<p>G&S: Classes 9, 24, 25 and 42</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The mere addition to the registered mark of a component lacking distinctive character, such as a circle, does not alter the distinctive character of the mark. The distinctive and dominant component of the mark as used is the element that constitutes the mark as registered, which remains clearly recognisable. Similarly, the use of the colour blue is not particularly original and does not alter the distinctive character of the mark as registered (paras 41-55) – acceptable variation.</p>		

Addition of a distinctive (interacting) element

The addition of a distinctive element to a mark that has a low degree of distinctive character generally results in an interaction between the two, such that the mark as registered will no longer be perceived independently. This alters the distinctive character of the mark as registered.

Example where the distinctive character is altered:

Mark as registered	Mark as used	Case No
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		<p>28/02/2017, T-766/15, REPRÉSENTATION DE SEMIS DE POISSONS DORÉS SUR FOND BLEU (fig.), EU:T:2017:123</p>
<p>G&S: Classes 29, 30 and 31</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The mark as registered, a pattern of golden fish seedlings on a blue background, has a low degree of distinctive character. The public will perceive this element as decorative or intended to serve as a background. The distinctive mark 'LABEYRIE' appears prominently in a central position on the packaging of the goods and superimposed over the mark as registered (paras 50-54, 59-60) – unacceptable variation.</p>		

6.2.2.2 Omissions

The omission of an element contributing to the distinctive character of the mark as registered is likely to alter its distinctive character.

6.2.2.2.1 Mark as registered distinctive to an average degree


The following main scenarios can be distinguished.

- Omission of a non-distinctive element
- Omission of a weakly distinctive element
- Omission of a symbol or other orthographic character
- Omission of a distinctive element

Omission of a non-distinctive element

Where the omitted element is non-distinctive, the distinctive character of the mark as registered will not be altered.

Examples where the distinctive character is not altered:

Mark as registered	Mark as used	Case No
	Diacol	24/01/2017, T-258/08 , DIACOR / DIACOL, EU:T:2017:22

G&S: Class 5

Territory: Portugal



Assessment: Omitting the word 'Portugal', which is descriptive of the origin of the goods, does not affect the distinctive character of the mark as registered (para. 38) – acceptable variation.

Mark as registered	Mark as used	Case No
		29/09/2011, T-415/09 , Fishbone, EU:T:2011:550 confirmed 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484

G&S: Class 25

Territory: Greece

Assessment: Omitting the slightly stylised word 'Beachwear', since it is descriptive of the kind of goods at issue, does not affect the distinctive character of the mark as registered (paras 62-63) – acceptable variation.

Mark as registered	Mark as used	Case No
		24/11/2005, T-135/04 , Online Bus, EU:T:2005:419

G&S: Classes 35, 40, 41 and 42



Territory: Germany

Assessment: The word elements 'Betreuungsverbund für Unternehmer und Selbständige e.V.' (meaning 'Association for the assistance of businessmen and the self-employed, registered association'), written in small characters and occupying a secondary position in the mark as registered, are descriptive of the services at issue. Omitting this element does not alter the distinctive character of the mark as registered (paras 36-37) – acceptable variation.

Omission of a weakly distinctive element

Where the omitted element has a low degree of distinctive character, the distinctive character of the mark as registered will normally not be altered. However, where that weakly distinctive element contributes significantly to the distinctive character of the mark as registered, is visually dominant or interacts with other elements, a different outcome may be justified. Therefore, a case-by-case assessment is particularly important.

Examples where the distinctive character is not altered:




Mark as registered	Mark as used	Case No
	(i) vieta (ii) 	10/12/2015, T-690/14 , Vieta, EU:T:2015:950

G&S: Class 9



Territory: EU

Assessment: The distinctive character of the mark is essentially derived from the word 'vieta' and not from the figurative elements. This word element is highly distinctive and occupies an important position in the overall impression created by the mark as registered, while the figurative elements have only a low degree of distinctive character and occupy a purely ancillary position in the overall impression. These 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 remaining figurative elements – the grey rectangles separating the letters of the word 'vieta' and the white rectangles 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) – acceptable variation.

Mark as registered	Mark as used	Case No
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	<p>(i)</p>  <p>(ii)</p> 	<p>14/12/2016, T-397/15, PAL (fig.), EU:T:2016:730</p>
<p>G&S: Class 7</p> <p>Territory: EU</p> <p><i>Assessment:</i> The figurative element of the mark as registered is essentially a frame highlighting the presence of the distinctive word element 'pal'. It will be perceived as being purely decorative. Omitting that element does not alter the distinctive character of the mark as registered (paras 32-38) – acceptable variation.</p>		

Example where the distinctive character is altered:

Mark as registered	Mark as used	Case No
		<p>Invented example (CP8)</p>
<p>G&S: Class 9</p> <p>Territory: English-speaking public</p> <p><i>Assessment:</i> The distinctive character of the mark as registered essentially derives from the combination of the verbal element 'BUBBLEKAT' and the other elements in the mark. Despite the low degree of distinctive character of the other elements, they interact and are visually dominant due to their size and prominent position. Omitting those elements alters the distinctive character of the mark as registered – unacceptable variation.</p>		



Omission of a symbol or other orthographic character

Omitting a punctuation mark, orthographic character (such as an apostrophe, accent, hyphen or space) or other symbols (such as the plural or possessive symbol or the abbreviated company form) does not normally alter the distinctive character of the mark as registered.

Examples where the distinctive character is not altered:

Mark as registered	Mark as used	Case No
Stöckert	(i) Stockert (ii) Stoeckert	22/04/2020, R 1061/2018-5 , STOCKERT medical solutions (fig.) / Stöckert
<p>G&S: Classes 9 and 10</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The element 'STOCKERT' is clearly the mark's dominant, most eye-catching element. The addition or deletion of the umlaut 'Ö' does not affect the distinctive character of the word element because the two small dots above the 'O' in the mark as registered are not a dominant or eye-catching element, although, when present, they will be noted, especially by the German-speaking public. Consequently, the suppression of an 'umlaut', or the conventional substitution of the letter 'ö' by the diphthong 'oe' are not considered to alter the distinctive character of the mark as registered (para. 55) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
PELASPAN-PAC	PELASPAN PAC	22/03/2013, R 1986/2011-4 , PELASPAN / PELASPAN et al.
<p>G&S: Class 17</p> <p><i>Territory:</i> Benelux</p> <p><i>Assessment:</i> The use of the mark as registered without the hyphen connecting the elements 'PELASPAN' and 'PAC' does not alter its distinctive character (para. 25) – acceptable variation.</p>		



Mark as registered	Mark as used	Case No
		29/04/2010, R 877/2009-1 , Kaiku Bifi actiVium (fig.) / Bi-Fi (fig.) et al.
<p>G&S: Class 29</p> <p><i>Territory:</i> Germany, Spain, France, Italy, Austria and Portugal</p> <p><i>Assessment:</i> 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 mark as registered is still based on the large black letters 'Bi Fi', the 'B' and 'F' being in upper case and the two 'i' letters in lower case, on a white background and outlined in silver. The orange background is merely the colour of the product packaging (para. 45) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
APALIA-ΑΠΑΛΙΑ	APALIA	15/09/2011, R 2001/2010-1 , APANI / ΑΡΑΛΙΑ-ΑΠΑΛΙΑ
<p>G&S: Class 30</p> <p><i>Territory:</i> Greece</p> <p><i>Assessment:</i> Omitting the transliteration of the term in Greek characters does not alter the distinctive character of the mark as registered – acceptable variation.</p>		



Omission of a distinctive element

Omitting a distinctive element, whether it be a word or a figurative element, usually alters the distinctive character of the mark as registered even when such elements are not dominant, provided they are not negligible.

Examples where the distinctive character is altered:


Mark as registered	Mark as used	Case No
		04/05/2012, R 562/2012-2 , LT LIGHT-TECNO (fig.) / LIGHT TECHNOLOGY (fig.) et al.
<p>G&S: Class 9</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The verbal elements 'light technology' have been omitted in the mark as used. Considering the importance in a composite mark of the verbal elements, by which the relevant public normally refer to such marks, the fact they are foreign words unlikely to be understood by the Spanish public and the way they are integrated into the figurative mark, omitting these word elements alters the distinctive character of the mark as registered (paras 27 and 32) – unacceptable variation.</p>		



Mark as registered	Mark as used	Case No
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 La Sabiduría del Sabor		21/01/2015, T-46/13 , KIT, EL SABOR DE NAVARRA, EU:T:2015:39
<p>G&S: Class 29</p> <p><i>Territory:</i> EU (evidence focusing on Spain)</p> <p><i>Assessment:</i> 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.</p> <p>The elements 'La Sabiduría del Sabor', given the meaning of the word 'Sabiduría' (wisdom) and the word 'sabor' (flavour), constitute a play on words and cannot be considered descriptive. It follows that the distinctiveness of the mark as registered comes essentially from the words 'La Sabiduría del Sabor' (paras 31-45) – unacceptable variation.</p>		



Mark as registered	Mark as used	Case No
FASHION TV	FASHION	13/05/2020, R 1221/2018-4 , Fashion TV
<p>G&S: Classes 32 and 33</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> For a line of beverages which is described in the evidence as 'a new brand of fashionable drinks', the word 'FASHION' alone has very little, if any, distinctive character at all. By contrast, the word 'TV' neither alludes to drinks nor to the notion of fashion. As such, the word element 'TV' constitutes not only a distinctive element, but the most distinctive element of the mark at hand (para. 34) – unacceptable variation.</p>		

Mark as registered	Mark as used	Case No
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	<p>ESCORPION</p>	<p>28/03/2007, R 1140/2006-2, SCORPIO / ESCORPION (fig.)</p>
<p>G&S: Classes 1, 3 and 4</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The mark as registered is strongly characterised by the presence of the figurative element. However, the documents submitted do not show any use of the figurative element contained in the mark as registered (paras 19-20) – unacceptable variation.</p>		

Mark as registered	Mark as used	Case No
		<p>31/03/2020, R 2111/2019-4, natek (fig.) / Natec Ingenieros (fig.)</p>
<p>G&S: Class 42</p> <p><i>Territory:</i> Spain</p> <p><i>Assessment:</i> The figurative device in the mark as registered will not be seen as purely ornamental or decorative. It is a very unique drawing combining various lines, shapes and colours which are visually quite eye-catching and endowed with personality and their own distinctive character. It has a certain degree of creativity and artistic imagination. It occupies nearly half of the mark. Consequently, it cannot be considered as negligible. Since the figurative element is visually dominant and is not negligible, omitting it alters the distinctive character of the mark as registered (paras 26-28) – unacceptable variation.</p>		

Mark as registered	Mark as used	Case No
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		<p>15/12/2015, T-83/14, ARTHUR & ASTON / Arthur, EU:T:2015:974</p> <p>appeal dismissed, 15/06/2016, C-94/16 P, ARTHUR & ASTON / Arthur, EU:C:2016:461</p>
<p>G&S: Class 25</p> <p>Territory: France</p> <p><i>Assessment:</i> The graphic element of the mark as registered, consisting of a stylised signature, disappears entirely from the mark as used and is replaced by a radically different graphic element which is very classical, symmetrical and static. The 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 abovementioned differences are not negligible and the marks cannot be regarded as being broadly equivalent within the meaning of the case-law (paras 22-24) – unacceptable variation.</p>		

6.2.2.2.2 Mark as registered distinctive to a low degree

The following main scenarios can be distinguished.

- Omission of a non-distinctive distinctive element
- Omission of a weakly distinctive element

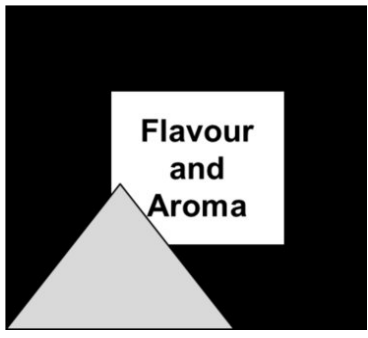
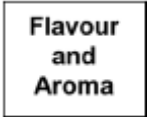
As a mark that has a low degree of distinctive character contains no elements of average distinctive character, the scenario of 'omission of a distinctive element' does not exist.

Omission of a non-distinctive element

When the mark as registered has a low degree of distinctive character and the omitted element is not distinctive, generally, the distinctive character of the mark as registered will not be altered. However, a different outcome may be justified in cases where the distinctive character of the mark as registered stems exclusively from the combination of non-distinctive elements.

Example where the distinctive character is altered:

Mark as registered	Mark as used	Case No
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		<p>Invented example (CP8)</p>
<p>G&S : Class 30</p> <p>Territory : English-speaking public</p> <p><i>Assessment:</i> The distinctive character of the mark as registered derives from the combination of simple geometric shapes and descriptive words. The combination of such elements renders the mark as a whole distinctive, such that the omission of part of those elements alters the distinctive character of the mark – unacceptable variation.</p>		

Omission of a weakly distinctive element

When the mark as registered has a low degree of distinctive character, the omission of a weakly distinctive element, may result in an alteration of the distinctive character of the mark as registered, particularly if the omitted element is visually dominant or in cases when the distinctive character of the mark as registered stems from the combination of elements with a low degree of distinctive character. Therefore, a case-by-case assessment is particularly important.



Examples where the distinctive character is altered:

Mark as registered	Mark as used	Case No
		<p>15/09/2015, T-483/12 , LOTTE (fig.) / KOALA SCHÖLLER (fig.), EU:T:2015:635</p>

G&S : Class 30

Territory : Germany

Assessment: The mark is registered as a figurative mark and not as a three-dimensional mark with a hexagonal shape. Neither does the mark include a representation of two equilateral hexagonal panels, joined respectively on one sixth on the upper side and one sixth on the lower side of the reproduction of that mark, indicating that when all the panels are folded, they can form a hexagonal box. The representations of the packaging, as shown by the evidence, do not reproduce the triple effect created by the image of the three rectangular panels, which characterises that mark. This alters the distinctive character of the mark as registered (paras 111-117) – unacceptable variation.

Mark as registered	Mark as used	Case No
		Invented example (CP8)
<p>G&S : Class 31</p> <p><i>Assessment</i> : The distinctive character of the sign as registered derives from a combination of non-distinctive and weakly distinctive elements, namely the word 'Bio' and the stylisation of the letter O resembling a cat. The combination of both elements renders the mark as a whole distinctive – unacceptable variation.</p>		


6.2.2.3 Modification of other characteristics

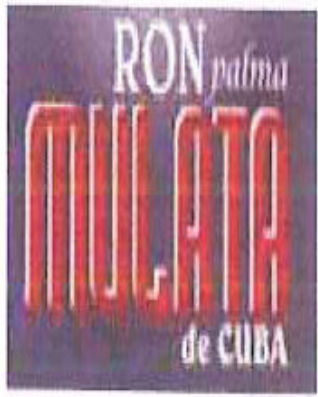
Changing the position or proportions of the elements of the mark as registered or switching between upper/lower case typeface, as long as it does not significantly depart from the usual way of writing, does not, in general, affect the distinctive character of the mark as registered.

However, irregular capitalisation or other additions that may influence how the elements are perceived (e.g. where the inverse order of the verbal elements leads to a different meaning or where a graphically highlighted part of the verbal element has a meaning of its own) may lead to a different conclusion.



Examples where the distinctive character is not altered:

Mark as registered	Mark as used	Case No
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DRINKFIT		12/12/2014, T-105/13 , TrinkFix, EU:T:2014:1070
<p>G&S: Class 29</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The labels on bottles of beverages are narrow, so it is not unusual for a word mark to be written on two lines. The addition of the semi-circular graphical element does not change the overall impression of the mark (paras 47 and 49) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
PALMA MULATA		12/03/2014, T-381/12 , EU:T:2014:119
<p>G&S: Class 33</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The different arrangement and proportions of the word elements 'PALMA' and 'MULATA' in the mark as used do not introduce a change such as to alter the distinctive character of the mark as registered (paras 34-36) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
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		<p>24/11/2005, T-135/04, Online Bus, EU:T:2005:419</p>
<p>G&S: Classes 35, 40, 41 and 42</p> <p>Territory: Germany</p> <p><i>Assessment:</i> Both the registered and the used form of the mark include 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. (para. 35) – acceptable variation.</p>		

Mark as registered	Mark as used	Case No
<p>AD-1841-TY</p>	<p>(i)</p>  <p>(ii)</p> 	<p>10/10/2017, T-233/15, 1841, EU:T:2017:714</p>

G&S: Class 25

Territory: France

Assessment: The three principal components of the mark as registered, namely the elements 'AD', '1841' and 'TY' are always present at the same time in the marks as used, although a certain difference in positioning and size and some specific stylisation may be noted. Moreover, they remain legible and identifiable in the forms used (paras 73-76) – acceptable variation.

Example where the distinctive character is altered:

Mark as registered	Mark as used	Case No
LOVE YOUNG	YOUNG LOVE	Invented example (CP8)
<p>G&S: Class 25</p> <p><i>Territory:</i> English-speaking public</p> <p><i>Assessment:</i> Although both verbal elements of the sign as registered are present in the mark as used, their use in an inverse order changes the meaning of the mark as registered – unacceptable variation.</p>		

6.3 Use in connection with the registered goods and services

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](#).

6.3.1 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	<i>Footwear.</i>	<i>Retail of footwear.</i>	Not OK (paras 47, 48).
13/05/2009, T-183/08 , Jello Schuhpark II	<i>Footwear.</i>	<i>Retail services regarding footwear.</i>	Not OK (para. 32)
08/11/2001, R 807/2000-3 , DEMARA / DEMAR Antibioticos, S.A.	<i>Pharmaceuticals, veterinary and disinfectant products.</i>	<i>Napkins and napkin pants for incontinence.</i>	Not OK, even though the specific goods might be distributed by pharmacies (paras 14, 16).

Case No	Registered G&S	Used G&S	Comment
03/10/2008, R 1533/2007-4 , Geo Madrid (fig.) / GEO	<i>Telecommunication services in Class 38.</i>	<i>Providing an internet shopping platform.</i>	Not OK (para. 16).
03/05/2004, R 68/2003-2 , SWEETIE / SWEETY	<i>Preserved, dried and cooked fruits and vegetables; concentrated citrus fruit and fruit extracts, preserves; sugar, biscuits, cakes, pastry and confectionery.</i>	<i>Dessert toppings that are strawberry, caramel or chocolate flavoured.</i>	Not OK (para. 20).
24/02/2010, R 1519/2008-1 , DADO / DODOT et al.	<i>Baby diapers of textile in Class 25.</i>	<i>Disposable diapers of paper and cellulose (Class 16).</i>	Not OK (para. 29).
18/06/2010, R 594/2009-2 , BANIF / BANIF (fig.)	<i>Administration, representation and general counsel in Class 35 Technical, economic and administrative projects in Class 42.</i>	<i>Administration of funds and personal assets or real estate affairs (Class 36).</i>	Not OK (para. 39).
31/05/2011, B 1 589 871	<i>Electric switches and 'parts of lamps'.</i>	<i>Apparatus for lighting.</i>	Not OK.
25/11/2002, B 253 494	<i>Education services.</i>	<i>Entertainment services.</i>	Not OK.
28/04/2011, B 1 259 136	<i>Transportation and distribution services in Class 39.</i>	<i>Home delivery of goods purchased in a retail store.</i>	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, R 1330/2011-4 , AF (fig.)	<i>Advertising, business management, business administration, office functions</i> in Class 35.	<i>Retail services.</i>	Not OK. If a trade mark is registered for the general indications in Class 35, but use is proven only for <i>retail services</i> 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).

6.3.2 Relevance of the classification

Although the Nice Classification was adopted for exclusively administrative purposes, its **class numbers and explanatory notes** may be relevant in order to determine the **nature and purpose** of the **goods or services** for which a trade mark is **registered** and for which **genuine use must be proven**. This is particularly the case where terms in the specification are general and may cover different goods or services (06/10/2021, [T-397/20](#), Juvederm, EU:T:2021:653, § 35).

For example, a trade mark is registered for '*bread*' in Class 30 and use is shown for '*soft pastries covered with icing or coated with chocolate*'. When it comes to deciding whether the latter products come within the term '*bread*', it is relevant that Class 30 contains a category for '*pastries*', to which those products belong for classification purposes, and another category '*bread*', to which they do not belong (01/09/2021, [T-697/20](#), Donas dulcesol / Dulcesol, EU:T:2021:526, § 38). Similarly, if a trade mark is registered for '*coffee based beverages*' in Class 30 and it is used for '*energy drinks flavoured with coffee*', this use cannot amount to genuine use of the former. This is because '*energy drinks*' are non-alcoholic beverages that fall within Class 32, whereas beverages with a coffee base, which are included in Class 30 and expressly excluded from Class 32, refer more to beverages in which coffee constitutes the predominant and characteristic element (10/11/2021, [T-758/20 & T-759/20](#), Monster, EU:T:2021:776, § 49).

The impact of classification is even more apparent when similar categories of goods or services have been **classified in different classes** because the **specific purpose differs**. For instance, '*footwear*' can be classified in several classes depending on the intended purpose: '*orthopaedic footwear*' in Class 10 and ordinary '*footwear*' in Class 25. In such cases, the class chosen can be crucial. If the mark is registered for '*footwear*' in Class 25, the class chosen indicates that these goods are ordinary

footwear. Consequently, if the evidence shows use for '*orthopedic footwear*' only, genuine use of the mark has not been proved.

Nevertheless, it can be that the term for which the mark is registered in accordance with the Nice Classification in force on the date of application of the mark **clearly** identifies goods or services that belong **to a different class** (06/10/2021, [T-372/20](#), Juvederm, EU:T:2021:652, § 56-57). In these exceptional cases, **the wording itself is decisive** to determine the actual scope of protection (see, to this effect, 06/10/2021, [T-397/20](#), Juvederm, EU:T:2021:653, § 45). For example, if '*orthopedic footwear*' is registered in Class 25 and the mark is used for orthopedic footwear (which clearly belongs to Class 10) genuine use would be shown. This is because the scope of protection of the specific term '*orthopedic footwear*' remains clear irrespective of the wrong class number (06/10/2021, [T-372/20](#), Juvederm, EU:T:2021:652, § 55, 62).

For more on the relevance of the Nice Classification see: [Part B, Examination, Section 3, Classification, paragraph 4.2.1, General principles](#) and [4.2.2 Influence of classification on the scope of protection](#); [Part C, Opposition, Section 2, Double identity and likelihood of confusion, Chapter 2, Comparison of goods and services, paragraph 1.2.3, Conclusions to be drawn from the structure of the Nice Classification](#).

6.3.3 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 6.3.4](#)).

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.

6.3.4 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.

6.3.4.1 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; see also 16/07/2020, [C-714/18 P](#), *tigha / TAIGA*, EU:C:2020:573, § 43.)

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 6.3.4.3](#) 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 6.3.4.3](#) 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 , (revocation)
<p>The proven use of a trade mark for:</p> <ul style="list-style-type: none"> • decorative lettering; • increased performance packages; • covers for storage compartments; • wheel sets and complete wheel sets for summer and winter; and • door sill cover plates <p>was considered sufficient proof of use for <i>motor vehicle and land vehicle parts</i> 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>	

In the case of a mark registered for a **broad category of goods and services that is not sufficiently clear and precise** to enable the competent authorities and economic operators, on that sole basis, to determine the scope of protection, it should be possible, in principle, to determine the precise scope through proof of use (29/01/2020, [C-371/18](#), SKY, EU:C:2020:45, § 68-70; 04/03/2020, [C-155/18 P](#), [C-156/18 P](#), [C-157/18 P](#) & [C-158/18 P](#), BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151, § 136). The general principles stated above apply. For further information on unclear and imprecise terms, see the Guidelines, [Part C, Opposition](#).

[Section 2, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services, paragraph 1.5.2.](#)

6.3.4.2 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; 16/07/2020, [C-714/18 P](#), tigha / TAIGA, EU:C: 2020:573, § 42).

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

6.3.4.3 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). If the goods or services concerned have several purposes, it is not possible to create, in a non-arbitrary manner, separate subcategories by considering in isolation each of those purposes (16/07/2020, [C-714/18 P](#), tigha / TAIGA, EU:C: 2020:573, § 51).

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

Earlier sign	Case No
<p>G&S: <i>polish for metals</i> in Class 3.</p> <p>Assessment of PoU: the earlier mark was registered for <i>polish for metals</i> in Class 3, but was actually used genuinely only for <i>magic cotton</i> (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 <i>polishing preparations</i>, 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 <i>polish for metals</i> was assumed.</p>	

Contested sign	Case No
PELLICO	15/06/2018, R 2595/2015-G , PELLICO (fig.) Revocation
<p>G&S: <i>footwear</i> in Class 25.</p> <p>Assessment of PoU: use has been proven for <i>women's footwear</i> only, which constitutes a sufficiently distinct subcategory within the broad category of <i>footwear</i>. The targeted consumer does not wish only to satisfy the needs of covering and protecting their own feet, but is looking specifically for ladies' shoes. Market realities also support such division: many shoe shops offer exclusively women's footwear or physically separate the women's footwear section from the rest (paras 32, 39-42).</p>	

Contested sign	Case No
Turbo	19/06/2007, R 378/2006-2 , TURBO Revocation
<p>G&S: <i>clothing</i> 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, for example t-shirts, Bermuda shorts, cycling shorts and female underwear (para. 21). Thus, the Board found that use of the contested mark had been proved for <i>clothing</i> (para. 22). The Board, moreover, found it almost impossible and certainly unduly onerous to impose on the proprietor of a registered EUTM for <i>clothing</i> the obligation to demonstrate use in all possible subcategories that could be endlessly subdivided by the applicant (para. 25).</p>	

Earlier sign	Case No
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	19/01/2009, R 1088/2008-2 , EPCOS (fig.) / E epco SISTEMAS (fig.); confirmed 15/12/2010, T-132/09 , Epcos, EU:T:2010:518
<p>G&S: <i>measuring apparatus and instruments</i> 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 <i>measuring apparatus and instruments</i> was a 'very wide' one, and determined, applying the criteria established in the <i>Aladin</i> judgment, that use had in fact only been shown for a subcategory of goods, namely: <i>measuring apparatus, all being for the measurement of temperature, pressure and level; parts for the aforesaid apparatus</i>. 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 Revocation
<p>G&S: <i>apparatus for heating, steam generating, refrigerating, drying, ventilating and water supply purposes</i> 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 <i>apparatus for heating</i> (insofar as an air-conditioning machine can also perform as a heater), <i>apparatus for refrigerating</i> (insofar as an air-conditioning machine, a fridge and a freezer can keep air/things cold), and <i>apparatus for ventilating</i> (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 <i>yachts and boats</i>. This would have further split the 'subcategories' and would amount to unjustified limitation (para. 28).</p> <p>Conclusion: use was considered proven for <i>apparatus for heating, refrigerating and ventilating</i>.</p>	

Contested sign	Case No
LOTUS	02/12/2008, R 1295/2007-4 , LOTUS Revocation

G&S: *outerwear and underwear, hosiery, corsets, neckties, braces, gloves, underclothes* in Class 25.

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).

Earlier sign	Case No
GRAF-SYTECO	16/12/2010, R 1113/2009-4 , GRAFSYSTEM / GRAF-SYTECO
<p>G&S: <i>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</i> in Class 9, <i>repair services</i> in Class 37 and <i>computer programming</i> 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 <i>hardware</i> 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 <i>recorded computer programs</i> 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 , HICELL (fig.) / HEMICELL

G&S: foodstuffs for animals in Class 31, and *animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31*.

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.

Contested sign	Case No
VIGOR	18/11/2015, T-361/13 , VIGOR / VIGAR
<p><i>G&S: all kinds of brushes and brush goods, for cleaning and hygiene purposes</i> 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	<i>Pharmaceutical preparations for respiratory illnesses.</i>	<i>Multi-dose dry powder inhalers containing corticoids, available only on prescription.</i>
23/09/2009, T-493/07 , Famoxin	<i>Pharmaceutical preparations for cardiovascular illnesses.</i>	<i>Pharmaceutical preparations with digoxin for human use for cardiovascular illnesses.</i>
16/06/2010, T-487/08 , Kremezin, EU:T:2010:237	<i>Pharmaceutical preparations for heart treatment.</i>	<i>Sterile solution of adenosine for use in the treatment of specific heart condition, for intravenous administration in hospitals.</i>
17/10/2006, T-483/04 , Galzin, EU:T:2006:323	<i>Calcium-based preparations.</i>	<i>Pharmaceutical preparations.</i>

6.3.5 Use of the mark on integral parts, aftersales services and second-hand market 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 **aftersales 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

G&S: fire extinguishers and associated products v components and after-sales services.

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.

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](#).

In the *Testarossa* judgment, the Court of Justice confirmed that, in principle, the subsequent **resale of second-hand goods** bearing the trade mark does not constitute genuine use (22/10/2020, [C-720/18 & C-721/18](#), *Testarossa*, EU:C:2020:854, § 55). However, it held that the resale of second-hand goods bearing the trade mark **by the proprietor** can be taken into account as evidence of use of that mark. The fact that the proprietor of the trade mark cannot prohibit third parties from using his trade mark in respect of goods already put on the market under that mark does not mean that he cannot use it himself in respect of such goods. If the proprietor of the trade mark concerned actually uses that mark, **in accordance with its essential function**, which is to guarantee the **identity of the origin** of the goods for which it was registered, when reselling second-hand goods, such use is capable of constituting 'genuine use' (22/10/2020, [C-720/18 & C-721/18](#), *Testarossa*, EU:C:2020:854, § 56-60).

6.3.6 Use for the sale of the manufacturer's own goods

Retail services in Class 35 are defined in the explanatory note of the Nice Classification as

... the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programmes.

It follows from that explanatory note that the concept of 'retail services' relates to **three essential characteristics**: firstly, the purpose of these services is the sale of goods to consumers; secondly, they are addressed to consumers with a view to enabling them to conveniently view and purchase the goods; and, thirdly, they are provided for the benefit of others (04/03/2020, [C-155/18 P](#), [C-156/18 P](#), [C-157/18 P](#) & [C-158/18 P](#), *BURLINGTON / BURLINGTON ARCADE et al.*, EU:C:2020:151, §

126). The '**others**' benefiting from the 'bringing together of a **variety** of goods' are the various manufacturers looking for an outlet for their goods.

The Court has held that the objective of retail trade is the sale of goods to consumers. This includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question, rather than with a competitor (07/07/2005, [C-418/02](#), Praktiker, EU:C:2005:425, § 34). For example, the concept of 'retail services' includes a shopping arcade's services aimed at consumers with a view to enabling them to conveniently view and purchase the goods, for the benefit of the businesses occupying the arcade concerned (04/03/2020, [C-155/18 P](#), [C-156/18 P](#), [C-157/18 P](#) & [C-158/18 P](#), BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151, § 130). The Court has confirmed that services can also be the subject of retail trade as there are situations in which a trader selects and offers an assortment of third-party services so that the consumer can choose among those services from a single point of contact (10/07/2014, [C-420/13](#), Netto Marken-Discount, EU:C:2014:2069, § 34).

In the same way that advertising one's own goods does not constitute use for advertising services in Class 35, there is no use for retail services in Class 35 where the manufacturer is merely selling its own goods from its shop or website. The sale by the manufacturer of its own goods is not an independent service but an activity covered by the protection conferred by registration for the **goods**. It would not be appropriate to equate the protection conferred by registration for goods in any of Classes 1 to 34 with that conferred by registration for Class 35 retail services. While manufacturers may provide ancillary services (such as maintaining an outlet with shop assistants, advertising, consultancy, after-sales services, etc.) in the course of the sale of their own goods, such activities fall within the concept of a remunerated 'service' only if they do not form an integral part of the offer for sale of the goods (10/07/2014, [C-421/13](#), Apple Store, EU:C:2014:2070, § 26). Consequently, if a manufacturer uses a trade mark in relation to activities that form an integral part of the offer for the sale of its own goods, there is no use for retail services of such goods in Class 35. This interpretation is also confirmed by the examples of (infringing) use provided in [Article 9\(3\) EUTMR](#).

Nor would such sales activity be in line with the definition of 'retail services' as provided in the explanatory note to the Nice Classification and interpreted by the Court, because it does not entail any benefit for third-party manufacturers. Therefore, an essential characteristic of retail services is missing.

Furthermore, genuine use must be consistent with the essential function of a trade mark. The trade mark used in relation to an outlet for the manufacturer's own goods serves to distinguish those **goods** from goods of other manufacturers but not to distinguish the **services** provided through that outlet from those provided through other outlets. Manufacturers selling their own goods from their own shops compete on the market of the **goods** they are selling but do not compete on the **retail services** market, which targets third-party manufacturers. Operating a shop **exclusively** for the

purpose of selling the manufacturer's own goods excludes offering competing goods from third-party manufacturers.

However, genuine use for retail services should not be denied if the opponent, when bringing together goods offered by third parties, includes, in addition to goods offered by other traders, goods that it itself manufactures.

7 Use by the proprietor or on its behalf

7.1 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.

7.2 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.

7.3 Use of collective and certification marks by authorised users

Collective marks are generally used not by the proprietor association but rather by its members. 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.

8 Irrelevance of unlawful 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.

9 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).

9.1 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 (14/05/2008, [R 855/2007-4](#), PAN AM, § 27; 09/07/2003, [T-156/01](#), Giorgio Aire, EU:T:2003:198, § 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.

9.2 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, <i>zootechnical digestibility enhancer (feed enzyme)</i> 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 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
The national [French cancellation] proceedings brought against the opposing trade mark cannot be acknowledged as a proper reason for non-use (para. 19).	
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).	

Earlier sign	Case No
MANPOWER	18/06/2010, R 997/2009-4 , MOON-POWER / MANPOWER

According to [Article 9 EUTMR](#) and [Article 5 of Directive 2008/95/EC](#), 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).

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).

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).

9.3 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).

9.4 *Force majeure*

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

9.5 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 5 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](#)).

10 Decision

10.1 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).

10.2 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 proof of use if it is irrelevant to 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 (10/02/2021, [T-117/20](#) , PANTHÉ (fig.) / P PANTHER (fig.) et al., EU:T:2021:81, § 64);
- 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.

10.3 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.

10.4 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 ⁽⁸⁵⁾. 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.

⁸⁵ 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, Opposition Proceedings, paragraph 4.4.4](#)).

10.5 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.

10.5.1 Genuine use accepted

Case No	Comment
17/02/2011, T-324/09 , Friboi, EU:T:2011:47	<p>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.</p>

Case No	Comment
02/05/2011, R 872/2010-4 , CERASIL / CERATOSIL	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.
29/11/2010, B 1 477 670	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.

Case No	Comment
<p>29/11/2010, R 919/2009-4, GELITE / GEHOLIT</p>	<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 <i>lacquer, lacquer paints, varnishes, paints; dispersions and emulsions to coat and repair surfaces</i> 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 (<i>soap, shampoo, deodorant (for feet and body), lotions, and cleaning items</i>). 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 <i>aerated water, aerated water with fruit taste and soda water</i>.</p>

10.5.2 Genuine use not accepted

Case No	Comment
18/01/2011, T-382/08 , Vogue, EU:T:2011:9	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.
19/09/2007, 1359 C; confirmed 09/09/2008, R 1764/2007-4 , PAN AM II	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.

Case No	Comment
<p>04/05/2010, R 966/2009-2, COAST / GREEN COAST (fig.) et al.</p>	<p>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 <i>clothing for men and women</i>, 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.</p>
<p>08/06/2010, R 1076/2009-2, EURO CERT (fig.)/ EUROCERT</p>	<p>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.</p>

Case No	Comment
01/09/2010, R 1525/2009-4 , OFFICEMATE / OFFICEMATE (fig.)	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.
12/12/2002, T-39/01 , HIWATT, EU:T:2002:316	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.