

***OPPOSITION GUIDELINES***

***PART 6***

***PROOF OF USE***

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## Part 6: Requirement of use in opposition proceedings

### I. GENERAL CONSIDERATIONS

#### 1. Function of proof of use

Community legislation on trade marks establishes an “obligation” for the owner of a registered trade mark to use that mark in a genuine manner. The obligation of use is not applicable immediately after registration of the earlier mark. Instead, the owner of a registered mark has a so-called “grace period” of five years to put the relevant goods and services under this mark on the market. Before this period elapses, the mere formal registration gives the mark its full protection.

The ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market. That interpretation is supported by the eighth recital in the preamble to Directive 89/104 which explicitly refers to that objective.

Judgment of the CFI, Case T-174/01, *Silk Cocoon/COCOON*, paragraph 38

However, the purpose of Article 43(2) and (3) CTMR is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks.

Judgments of the CFI, Case T-334/01, *HIPPOVIT/HIPOVITON*, paragraph 32 and Case T-203/02, *VITAFRUT/VITAFRUIT*, paragraph 38

The Office does not inquire *ex officio* whether the earlier mark has been used or not. Such examination takes place only when the CTM applicant makes a request for proof of use. The request of the applicant, under the condition that the legal requirements are met, triggers the procedural and substantive consequences laid down in the CTMR and the CTMIR.

#### 2. Legislative framework

The legislative framework consists of provisions in the CTMR, in the CTMIR, and in the Trade Marks Directive as implemented in the national law of the Member States.

##### 2.1. CTMR and CTMIR

###### 2.1.1. Article 15 CTMR

Article 15 CTMR stipulates the basic substantive requirement for the obligation to use registered marks.

Article 15(1) CTMR reads:

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

Article 15(2), (3) CTMR stipulates forms of use which also constitute use of the Community trade mark in accordance with Article 15(1) CTMR.

According to Article 15(2)(a) and (b) CTMR, the use of the Community 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 and the affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes, also constitute use within the meaning of Article 15(1) CTMR.

According to Article 15(3), the use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

#### *2.1.2. Article 43 CTMR*

The various possible consequences of a lack of use are dealt with in the specific provisions of the different proceedings. Article 43(2) and (3) CTMR contain the respective provisions for opposition proceedings.

According to Article 43(2) CTMR,

If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community 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 Community 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 Community trade mark has been used in relation to part only 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.

According to Article 43(3) CTMR,

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 Community.

There is no express provision in the CTMR that such forms of use as mentioned in Article 15(2) and (3) CTMR may also be regarded as use of earlier national trade marks. However, the concept of the obligation to use the registered mark is harmonised as a consequence of Article 10(2) and (3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ("Directive"). Hence, it is appropriate to apply Article 15(2) and (3) CTMR to the use of earlier national trade marks.

### *2.1.3. Rule 22 CTMIR*

Rule 22 CTMIR lays down the procedural rules to follow and deals with evidence to be submitted and the applicable language regime.

According to Rule 22(2) CTMIR, where, pursuant to Article 43(2) or (3) CTMR, the opponent has to furnish proof of use or show that there are proper reasons for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opponent does not provide such proof before the time limit expires, the Office shall reject the opposition.

According to Rule 22(3) CTMIR, the indications and evidence required in order to furnish proof of use shall 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 3.

According to Rule 22(4) CTMIR, the evidence shall consist of written documents and shall in principle be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) CTMR.

According to Rule 22(5) CTMIR, a request for proof of use may be made with or without submitting at the same time observations on the grounds on which the opposition is based. Such observations may be filed together with the observations in reply to the proof of use.

According to Rule 22(6) CTMIR, where the evidence supplied pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opponent to submit a translation of that evidence in that language, within a period specified by the Office.

## *2.2. Trade Marks Directive and national law implementing the Directive*

Article 10 of the Directive contains provisions identical to Article 15 CTMR, with “use in the Community” being replaced by “use in the Member State”.

Articles 11 and 12 of the Directive deal with procedure under national law. They are of no relevance in the present context.

## II. SUBSTANTIVE LAW

### 1. Genuine use: The principles of the Court of Justice

Neither the CTMR nor the CTMIR defines what is to be regarded as “genuine use”. The Court of Justice, in the context of Article 10(3) TMD, has in the meantime however laid down several important principles as regards the interpretation of this term.

#### **Sunrider-Vitafruit (II) 2006**

(a) Preliminary remark: Since the ECJ has confirmed the CFI in full, and since most of the respective findings of the CFI are not or not directly repeated in the ECJ decision, reference is still made to Vitafruit, CFI T-203/02.

(b) In the Vitafruit (II) case of 11 May 2006, C-416/05 P., the ECJ summarised as follows (nrs. 70 – 72):

- (As) is apparent from the case-law of the Court of Justice, there is genuine use of a trade mark where the mark is used 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, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark in the course of trade is real, particularly 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, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see, regarding Article 10(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), a provision which is identical to Article 15(1) of Regulation No 40/94, *Ansul*, paragraph 43, and order in *La Mer Technology*, paragraph 27).
- The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The

characteristics of those goods and services, the frequency or regularity of the use of the trade 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 of use which the proprietor is able to provide, are among the factors which may be taken into account (see, to that effect, order in *La Mer Technology*, paragraph 22).

- It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).

#### **La Mer 2004**

In the *La Mer* case, of 27 January 2004, C-259/02, the Court of Justice further elaborated the *Ansul* criteria as follows:

- The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account (nr. 22);
- 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 (nr. 24);
- A *de minimis* rule cannot be laid down (nr. 25).

#### **Ansul 2003**

In the *Ansul* case of 11 March 2003, C-40/01, the ECJ established the following principles:

- Genuine use means actual use of the mark (nr. 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 (nr. 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 him, without any possibility of confusion, to distinguish the product or service from others which have another origin (nr. 36);
- Genuine use entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned (nr. 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 (nr. 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 (nr. 38);
- The circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark (nr. 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 service concerned on the corresponding market (nr. 39).

## 2. Nature of use – use as a mark in the course of trade

### 2.1. *The term “nature of use”*

The required “nature of use” of the sign is its use as a trade mark in the course of trade. However, it is important to note that the expression “nature of use” in the context of Rule 22 (3) CTMIR further comprises the need for evidence of the use of the mark as registered, or of a variation thereof according to Article 18 (2) (a) CTMR (point II.6. below), and of its use for the goods and services for which it is registered (point II.7. below).

### 2.2. *Use as a mark*

Articles 15 and 43(2) CTMR require proof of genuine use in connection with the goods or services in respect of which the trade mark is registered and which the opponent cites as justification for his 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 to operate 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. It is not necessary for the mark to be affixed on the products themselves. A representation of the mark on the packaging, catalogues, advertising material or invoices relating to the goods and services in question may be sufficient (see below point II.2.3.2.).

#### 122/2001 ATLANTIC / ATLANTIC RICHFIELD (EN)

The use of a sign as a business or trade name cannot be regarded as trade mark use, unless the relevant goods or services themselves are identified and offered on the market under this sign. In general, this is not the case when the business name is merely used as a shop sign (137/1999 FILELLA / fixella (DE)), or *on the back* of a catalogue (298/1999 APOMED / APOMEDICA (EN)) or of a label (586/1999 ARKO / AKA (EN)).

The presentation of the business name at the top of order forms or invoices might present use as the registered trade mark depending on how the sign appears on them.

#### 1063/2001 ANASTASIA / ANASTASIA (EN)

Similarly, the use of a trade name (that is also registered as a trade mark) on the packaging of goods, on letterheads or in advertising in connection with goods or services may constitute use as a trade mark.

A trade mark used as a title of a mail order catalogue does not constitute use within the terms of Article 43(2) CTMR for the goods which are offered for sale within that catalogue.

#### 3086/2000 KALEIDOSCOPE / Le Kaleidophone (EN)

Use of a sign as a domain name or as part of a domain name primarily identifies the owner of the site. Depending on the circumstances, such use may also be use of a service mark or trade mark.

### 2.3. *Use in the course of trade*

The mark in order to be protected must be used in the course of trade.

The meaning of “in the course of trade” for use purposes is not the same as the meaning of that term for infringement purposes. For example, the mere stocking of goods constitutes infringement if it is done with the view of offering for sale or bringing on the market. Such use is however not “public” use in the sense required in the present context.

“Course of trade” means in the context of an ongoing business. Where the mark is protected for non-for-profit enterprises for their goods or services, and

the mark has been used, the fact that there is no profit motive behind the use is irrelevant.

### 2.3.1. *Public use*

The use must be public, i.e., it must be 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 is not use in the course of trade.

Court of Justice in “ANSUL” (Judgment of 11 March 2003 in case C-40/01 Ansul BV vs. Ajax Brandbeveiliging BV), paragraph 37

Preparation of use – such as the printing of labels, producing of containers, etc. - is internal use and thus not use in the course of trade for present purposes, unless preparations are already under way to secure customers, particularly in the form of advertising campaigns (see below point II.2.3.3.).

Court of Justice in “ANSUL” (Judgment of 11 March 2003 in case C-40/01 Ansul BV vs. Ajax Brandbeveiliging BV), paragraph 37

### 2.3.2. *Use in relation to goods or services: labels, price lists, invoices, catalogues and other business papers*

Trade marks have traditionally been used on goods (printed on the goods, on labels, etc.) or their packaging. However, the use on goods or their packaging is not essential. It is sufficient if there is a proper connection between the marks and the goods.

As regards services, marks cannot be directly used “on” services. Therefore, as regards service marks, their use will generally be on business papers, in advertising, or in any other direct or indirect relation to the services. Thus, trade marks and service marks are often used not only – or not at all – on the goods themselves, but on items related to them, such as price lists, invoices or similar business papers. Where the use on such items demonstrates genuine use, such use will be sufficient.

It is generally considered sufficient if the mark is used “in relation to” the goods or services, such as on brochures, flyers, stickers, signs in the interior of places of sale, etc. While such use may generally be sufficient, this does not mean that such use will always be found to satisfy the requirement of genuine use (see below point III.7. as regards the evaluation of evidence).

When goods are sold *only by catalogues (mail-order sales)* – or through the Internet – the mark may not always also be on the goods themselves as they are shipped to the customer. Such use – provided it is otherwise genuine – will generally be considered sufficient. In such a situation the owner of the mark will not have to provide proof that the mark actually appeared on the goods themselves.

Mere use of the mark on promotional material *for other goods* cannot be considered as sufficient (indirect) evidence of use for the items 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 product, such as a drink, cannot be considered as genuine use of a mark for clothing.

374/2001 MALIBU (fig) / fig (EN)

### 2.3.3. *Use in advertising*

Trade marks fulfil their function as indicating commercial origin of goods or services and symbols of the goodwill of their owner not only when they are actually used on or in relation to goods or services, but also when they are used in advertising. In fact, the advertising 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 respective goods or services for which the mark is registered.

The ECJ confirmed this approach in its decision “ANSUL” where it held that use of the mark must relate to goods or services already marketed or about to be marketed and for which preparation by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (Judgment of 11 March 2003 in case C-40/01 Ansul BV vs. Ajax Brandbeveiliging BV, par. 37).

However, the outcome in a particular case will depend very much on the individual circumstances. It is particularly important in this context that the submitted evidence gives a clear indication of the extent of use (volume and period of distribution of advertising material).

209/2001 CRITTELS / SEA CRITTELS (FR); 1445/2001 BLUME-LEOPOLDO BLUME / BLUMEN WORLDWIDE (EN)

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

Advertising in advance of the actual marketing of goods and services – if genuine and with a view of 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 will constitute 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 vacation places or particular products, advertising alone may be sufficient to amount to genuine use.

#### *2.3.4. Use on the Internet*

The mere presence of the mark on a website shows nothing more than that the website is accessible. This is in itself not sufficient to prove genuine use.

2621/2001 ADVANCE /ADVANCE (EN); 209/2001 CRITTELS / SEA CRITTELS (FR)

This may be different in cases where concrete evidence is submitted that the specific web-site has been visited and, in particular, orders for the relevant goods and services have been effected by a certain number of customers in the relevant period.

1513/1999 BEROL / TEROL (EN)

The evidence submitted must show that the on-line transactions were connected with the goods or services designated by the mark. Whereas the nature of the mark and, to a certain extent, the time and place are the less complex elements to prove, the extent of the use presents more difficulties. 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, or has already substituted, them as certified means of payment, requests and their confirmations, registrations of safe transactions etc.

### 3. Place of use

#### *3.1. Use on the “domestic” market*

Trade marks must be used in the territory where they are protected (European Community for CTMs, the territory of the Member States in case of national marks).

The Court of First Instance held that genuine use means that the mark must be present in a “substantial part” of the territory where it is protected (T-39/01, HIWATT / HIWATT, paragraph 37). However, even a use in a quite limited area of the relevant territory might prove to be sufficient, provided it is to be considered as genuine, taking into account all the relevant factors of the specific case.

In view of the globalisation of trade, the 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 15(2)(b) CTMR stipulates that the affixing of the trade mark to goods or to the packaging thereof in the Community solely for export purposes is considered as use of the mark, the mere indication of the opponent’s seat as such does not constitute evidence of such acts.

827/2000 Marco / MARCA (EN)

### 3.2. *CTMs: Use in the European Community*

If the earlier mark is a Community mark, it must be used “in the Community” (Article 15(1) and Article 43(2) CTMR).

Genuineness use may be found also when the mark has been used in only one part of the Community, such as in a single Member State or in a part thereof. Any other rule would discriminate between small and big enterprises, and thus be contrary to the aim pursued by the CTM system which should be open to businesses of all kinds and sizes.

The sufficiency of use in only a part of the Community is reflected in the Joint Statements by the Council and the Commission entered in the minutes of the Council meeting at which the CTMR was adopted (Joint Statements by the Council and the Commission of 20.10.1995, No B. 10 to 15, OJ OHIM 1996, 615). According to these statements, “*The Council and the Commission consider that use which is genuine within the meaning of Article 15 in one country constitutes genuine use in the Community*”. While these statements only have an interpretative value and are not legally binding, they have been applied by Office.

It must, however, be underlined that it is the European requirements or standards which must be complied with and not the national standards. It may be that European quantity standards could be higher than the respective national criteria in some cases.

### 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 43(3) CTMR). Use in a part of the Member State, provided it is genuine, will be considered as sufficient.

### 3.4. *Use in import and export trade*

The mark has to be used in the relevant market, that is the geographical area where it is registered. Evidence that only relates to the importation of the goods in the relevant area may, depending on the circumstances of the case, suffice as proof of use in this area.

802/1999 MILES / MORE MILES (EN)

According to Article 15(2)(b) CTMR, the affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes also constitutes use within the meaning of Article 15(1) CTMR.

## 4. Time of use

#### 4.1. *Registered for more than five years*

According to Article 43(2) CTMR, the obligation to provide proof of use requires that the earlier registered mark, at the date of publication of the CTM application, has been registered for not less than five years.

The opponent is therefore under no obligation to prove use of his registered mark when the five-year period has not terminated at the time of publication of the CTM application. There is no obligation of proof of use at a later stage in cases where that period ends after the publication of the CTM application, but before the end of the opposition proceedings.

##### 4.1.1. *CTMs*

The decisive date for the beginning of the period of five years is, according to Article 15 and Article 43(2) CTMR, the registration of the earlier CTM.

##### 4.1.2. *National marks*

As regards national marks, it is necessary to determine the date that is equivalent to the registration date for CTMs. In interpreting this term, it should be taken into account that there are national trade mark systems which have an opposition procedure *after* registration.

In view of these differing national proceedings, Article 10 (1) of the Directive refers, as concerns the use requirement for national marks, to the period of “*five years following completion of the registration proceedings*”. The Joint Statements by the Council and the Commission, entered in the minutes of the Council Meeting on which the Directive was adopted, point 9 (published in OJ OHIM 1996, 607), state: “*The Council and the Commission consider that the Member States may decide that the date of publication of the completion of the registration procedure marks the beginning of the five-year period.*” Consequently, term “*registration*” is to be interpreted as the “*date of completion of the registration proceedings*” as defined by national law. The owner of the respective mark is not expected to invest in a use of his mark in spite of examination or opposition proceedings pending against it. This is in harmony with the approach towards earlier CTMs, since the registration date of a CTM, which is mentioned in Article 43(2) CTMR as the decisive date for the beginning of the grace period, is always the date of completion of the registration procedure as well. Furthermore, this interpretation keeps the use requirement under the CTMR in line with the relevant national laws.

R 776/2000-1 NATUROME / NATUROMA (EN), R 429/2003-1 wrap house / HOUSE OF WRAPS, R 459/2003-2 BEAGLE 2 / EAGLE

The completion of the registration procedure arises after a pre-registration opposition, or in some Member States even after completion of a post-registration opposition. The exact relevant dates are those published in the OHIM Brochure “National Law Relating to the CTM”, Chapter 12.

Where the national registration date dates back to the filing date, is immaterial.

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

#### *4.1.3. International registrations designating a Member State*

Under Article 5(2) of the Madrid Agreement, the Designated Offices have a period of 12 months after the entry of the mark in the International Register to issue a (provisional) refusal of protection. Under Article 5 (2)(a) and (b) of the Madrid Protocol, that period is 12 months or 18 months from the date when the notification of the designation (in an international registration or a subsequent designation has been received by the Designated Office. Under Article 5 (2)(c) of the Madrid Protocol that date may even be later under particular circumstances.

R 0561/2004-2 XS / IXS

Where (provisional) refusals have been issued under these provisions, the registration proceedings will be considered as terminated only once the respective proceedings have been finally concluded and a final notice has been sent to WIPO by the Designated Office.

The Office will on its own motion apply the one year for international registrations governed by the Madrid Agreement or 18 months for international registrations governed by the Madrid Protocol and designating a Member State that has opted for an 18 months refusal period. It is for the parties to claim any date that is later than these dates. The date can be earlier than the 18 months for those countries who have opted for the system of Statements of Grant of Protection (Rule 17 (6) of the Common Regulations).

#### *4.1.4. International registrations designating the European Community*

For international registrations designating the European Community, Article 155 CTMR clearly provides: *“For the purposes of applying Article 15(1), Article 43(2), Article 50(1)(a) and Article 56(2), the date of publication pursuant to Article 147(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the European Community must be put to genuine use in the Community.”*

That publication will take place when the international registration has, pursuant to Article 146 (2) CTMR, the same effects as a registered CTM, that is,

- once a Second Statement of Grant of Protection has been sent pursuant to Rule 116 (2),
- after 18 months if a provisional refusal was issued but later withdrawn,
- once a final notice is sent to WIPO pursuant to Rule 113 (2) (a) or Rule 115 (5) (a), (6) CTMIR that the mark is protected.

#### *4.2. Relevant timeframe*

If the earlier mark is subject to the use requirement at all (registered for more than five years), the actual period for which use must be shown can simply be computed backwards from the publication date.

For example, if the contested CTM application was published on 15.6 2003 and the earlier mark was registered on 1.4.1996, the opponent would have to prove genuine use of his mark within the period beginning on 15.6 1998 and ending on 14.6 2003.

Any use or non-use before or after the last five years is in general immaterial. Evidence referring to use made outside this timeframe is disregarded, unless the specific evidence entails conclusive indirect proof that the mark must have been put to genuine use as well during the relevant time. Also the Court of Justice 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

Court of Justice in “LA MER” (Judgment of 27 January 2004 in case C-259/02 La Mer Technology Inc. vs. Laboratoires Goemar SA), paragraph 31

Where a mark has not been genuinely used for more than five years before the publication date, the fact that there may be remaining goodwill or knowledge of the mark in the mind of the trade or customers does not “save” the mark.

The use need not have been made throughout the period of five years, but rather within the five years. The provisions on the use requirement do not mandate a continuous use.

## *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 submitted material that the owner has seriously tried to acquire a commercial position in the relevant market. This does not mean that the opponent has to reveal the total volume of sales or turnover figures. It is sufficient to submit

evidence, which proves that the minimum threshold for a finding of “genuine” use has been passed.

Concerning the extent of the 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, and the frequency of those acts, on the other.

Court of First Instance, Case T-334/01, HIPPOVIT/HIPOVITON, paragraph 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.

Court of First Instance, Case T-203/02, VITAFRUIT/VITAFRUT, paragraph 42

Use does however not have to be made during a minimum period of time to qualify as “genuine”. In particular, use does not have to be continuous during the relevant period five years. It is sufficient if the use had been made at the very beginning or end of the period, provided that this use was genuine.

R 362/1999-1 HERVALIA / HERBAPURA (EN), R 821/1999-3 RENOLIN / RENTOLIN (EN), R 786/2000-1 PARABOOT / PARAWET (EN)

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 service concerned on the corresponding market.

Court of Justice in “ANSUL” (Judgment of 11 March 2003 in case C-40/01 Ansul BV vs. Ajax Brandbeveiliging BV), paragraph 39, Court of First Instance, Case T-203/02, VITAFRUIT/VITAFRUT, paragraph 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. It is however always necessary to take the characteristics of the market in question into account.

Court of First Instance, Case T-334/01, HIPPOVIT/HIPOVITON, paragraph 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.

Court of Justice in “LA MER” (Judgment of 27 January 2004 in case C-259/02 La Mer Technology Inc. vs. Laboratoires Goemar SA), paragraphs 24 and 25

It is irrelevant that the use has been made with the same customer, as long as the trade mark is used publicly and outwardly and not solely within the undertaking which owns the earlier trade mark or within a distribution network owned or controlled by that undertaking.

Court of First Instance, Case T-203/02, VITAFRUIT/VITAFRUT, paragraph 50

However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.

Court of First Instance, Case T-334/01, HIPPOVIT/HIPOVITON, paragraph 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.

Court of First Instance, Case T-334/01, HIPPOVIT/HIPOVITON, paragraph 49

Special circumstances, as for example lower sales figures during the initial marketing phase of a product, could be of relevance when assessing the genuineness of the use.

Court of First Instance, Case T-334/01, HIPPOVIT/HIPOVITON, paragraph 53

## *5.2. Examples of insufficient use*

391/1999 HOREGON / OREGON (EN): The Opposition Division found an invoice for 180 pairs of shoes as insufficient to prove genuine use.

208/2001 LYS MINNESOTA / LYNX (fig) (EN): As evidence of use the opponent filed 2 invoices for a total amount of 122 items of clothing and 4 undated labels with no indication of what goods they were to be affixed to. The Opposition Division considered them insufficient to prove genuine use.

R 378/2000-1 RENACIMIENTO (FIG) / RINASCIMENTO (EN): 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.

R 578/2000 HIPOVITON / HIPPOVIT (DE): The Board of Appeal confirmed this finding of the Opposition Division considering evidence of 450 packages of animal food as insufficient to prove genuine use. The CFI (T-334/01) however annulled the decision, as the Board had not taken into account all the relevant factors of the case.

### 5.3. *Examples of sufficient use*

1825/2000 VITAFRUIT / VITAFRUT (EN): The Opposition Division considered the continuous sale of fruit juice during a period of eleven and a half months with a total volume of sales of 4800 € as sufficient. The finding has been confirmed by the Board of Appeal (R 1046/2000-1) and by the Court of First Instance (T-203/02).

129/2001 TREFF / TOP-TREFF (DE): The Opposition Division regarded evidence of sales for around 2 000 furry toy animals in the high-priced market sector as sufficient to prove genuine use.

1390/2001 FOCUS / FOCUS DYNAMICS (FR): 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.

R 196/2002-4 TAZZA D'ORO / PLAZZA D'ORO (EN): A total volume of sales of 360 kg coffee was considered sufficient evidence to show the extent to which the earlier mark was used.

## 6. Use in different forms to the mark as registered

### 6.1. *Principle: Relevance of the Register*

Pursuant to Articles 15 and 43 CTMR, the mark must be used as registered. Therefore, the register (Community or national) is the starting point of the analysis.

Where the mark is actually used as registered, there is no room for inquiring whether the actually used form is a variation of the mark as registered which will be taken into account only if the distinctive character is not affected (Article 15(2)(a) CTMR). Thus, it is necessary to determine first both the factors which do not amount to a variation of the mark (point II.6.2.) and the dividing line between the use of various marks and the use of the registered mark in a variation (point II.6.3.) before evaluating the admissibility of variations of the mark as registered under Article 15 (2) (a) CTMR (point II.6.4.).

### 6.2. *Use of the mark as registered*

### 6.2.1. *Use as registered – word marks*

Word marks are marks consisting of letters, numbers and other signs reproduced in the standard typeface used by the respective office. This means that as regards these marks no particular figurative element or appearance is claimed.

#### 6.2.1.1. *Use of word marks in different type face*

Word marks are considered used as registered if the typeface is different. It would not be correct to analyse this type of use under the aspect of whether the distinctive character is altered.

This may be different however if the typeface is a particular one, such as particular script typefaces, so that the overall appearance of the word mark is changed to that of a figurative mark.

#### 6.2.1.2. *Use of word marks in different size letters (capitals and small letters)*

Changing the letter size or changing between small and capital letters is customary when using word marks. Therefore, such use is considered use of the registered mark.

However, where the mark is registered with an unusual spelling – such as capital letters in the middle, unusual initial small letter, etc. – and the used form does not have the same appearance (or *vice versa*), such use will be analysed under the variation rule (Article 15(2)(a) CTMR).

#### 6.2.1.3. *Use of word marks in colour*

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

The Board of Appeal did not find the distinctive character of the word mark “BIOTEX” altered, in spite of various stylistic changes, such as shadows giving the impression of being three-dimensional and a different colour tip of the letter ‘l’. The Board considers these variations minimal and routine.

R 812/2000-1 BIOTEK / BIOTEX (EN)

#### 6.2.1.4. *Use of word marks with generic or descriptive additions*

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

### 6.2.2. *Use as registered – figurative marks*

Using a figurative mark registered in black and white in colour constitutes use of the registered mark, unless it changes the overall impression of the mark (as to figurative marks with colour elements see below point II.6.4.4).

Similarly, adding word elements to a figurative mark will generally not result in a variant of the figurative mark, if such word elements are descriptive or generic indications or another (word) marks.

### 6.2.3. *Use as registered – 3D marks*

3D marks are of different types. Some 3D marks are objects used as marks (such as figurines on the outside of cars). They are often used in varying sizes, and such variations usually amount to use of the registered mark.

Some 3D marks consist exclusively of the shape of goods or their packaging, such as bottles or other containers. In the course of trade it is customary that such shapes are also marked with word marks or descriptive indications, or that bottles or containers also carry labels. These marks are generally considered to have been used as registered.

### 6.2.4. *Use as registered – colour marks*

Colour marks must be distinguished from figurative marks composed of one or more colours. Colour marks are marks consisting of one or more colours as such. Where the mark is a colour combination, the registration may or may not indicate a particular distribution or proportion of the various colours.

In the course of trade it is customary that colours or colour combinations are used on the product packaging but in combination with a distinctive word mark and descriptive indications on the packaging. These marks are generally considered to have been used as registered, provided the colour or colours remain prominently visible.

### 6.3. *Use of more than one mark*

In each case it has to be carefully evaluated whether the added or omitted elements represent a change to the mark or depict another mark. It is quite common in some market areas that the goods and services bear not only their individual mark, but also the mark of the business or product group (house mark). In these cases the registered mark is not used in a different form, but the two independent marks are validly used at the same time.

802/1999 Miles / More Miles (EN), 1378/2000 TERRY / MERRY (EN).

The Board of Appeal considered the genuineness of use put into doubt in cases where the mark, due to additional, very dominant use of other marks, might be perceived as a mere decorative element.

R 833/1999-1 NIKE F.I.T. / NIKE (fig) (ES), R 880/1999-1 NIKE TRIAX SERIES / NIKE (fig) (ES), R 16/2000-1 NIKE / NIKE (fig) (ES), R 19/2000-1 NIKE TOWN / NIKE (fig) (ES), R 73/2000-1 NIKE (fig) / NIKE (fig) (ES), (the cases are pending before the CFI)

The Board of Appeal regarded the presentation of the two words as the use of two separate marks, since the evidence submitted by the opponent showed that one of them is an old brand of the opponent with its own identity, and that this mark is present on the market with a number of accompanying signs, as it is common practice in the labelling of the specific products (wine).

R 206/2000-3 MINU' / MINUTO (EN)

The addition of another word does not alter the distinctive character of a mark when the added word will be perceived as another registered mark because of the double use of the symbol “®”.

REGISTERED FORM	CURRENT USE	Decision No
CLASSIC	NESCAFÉ® CLASSIC®	1317/2001 (EN)

This situation is to be distinguished from cases where the symbol “®” is only depicted once after the various word elements. In such cases, this indication could be perceived as referring to the combination as a whole.

1391/2001 BIO / lo Bio (EN)

There is no use of two-or-more marks, but use of one composite mark where the different elements appear as a “unitary whole”. This is the case where they are actually merged together. However, as always, each case has to be assessed on its own merits. The customs in the specific market sector might play a decisive role in the evaluation.

3477/2002 IL PORTALE / PORTALE (EN) (making reference to the decision of the Board of Appeal R 206/2000-3 MINU' / MINUTO), 3484/2002 CARGOBULL / CARGOMAX (EN)

In the cases 616/2001 BIO / bio garantie (fig) (FR) and 1391/2001 BIO / lo Bio (EN), the Opposition Division held that each of the following signs



(616/2001)



(1391/2001)

form up one composite mark whose added elements affect the distinctive character of the registered mark (the word “BIO”). However, by reversing the

decision 616/2001 of the Opposition Division, the Board of Appeal held in decision R 389/2001-4 that in that case the word “BIO” identifies the specific good whereas the word “DANONE” identifies the producing enterprise. In view of the merely descriptive character of the further element “con bifidus activo”, the Board considered the use of the registered word mark “BIO” for the respective goods as proved.

#### 6.4. *Acceptable and unacceptable variations*

##### 6.4.1. *Standards for determining the admissibility of a variant*

According to Article 15(2)(a) CTMR, the use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, shall also constitute use of the registered trade mark. This means that differences between the form in which the mark is used on the market and the registered form are acceptable as long as the *distinctive character* of the mark is not altered.

It is important to note that in cases where Article 15(2)(a) CTMR applies, the later comparison of signs (under Article 8(1)(b) or 8(5) CTMR) has to be made between the CTM application and the earlier mark in its *registered* form.

An absolute obligation of use of the mark in the form in which it was registered would ignore the reality of the market, in particular the constant evolution in the marketing of products and the needs of trade mark owners to adapt the use of their mark in the new contexts. On the other hand, the modifications in the use must not alter the distinctive character of the mark.

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

There is interdependence between the strength of the distinctive character of a mark and the effect of alterations. Marks of strong distinctive character may be less influenced by changes than marks of limited distinctiveness. On the other hand, additional or omitted elements in the mark are more likely to affect the distinctive character of marks of limited distinctiveness.

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

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

While it may be tempting to inquire into the perceptions of the public when determining whether the distinctive character is altered, this approach

neglects that the public is aware only of the mark as used, and not as registered, so that there is no proper basis of comparison. Thus, the perception of the public is not relevant in this context.

One line of inquiry may be to ask whether the mark as used, in comparison to the mark opposed, confers the same or in any event no greater protection than the mark as registered. Where only the mark as used is in conflict with the opposed mark, but not the mark as registered, the use of the mark should not be considered as having the same distinctive character.

*As a rule of thumb*, the OD has developed the following criteria for evaluating whether Article 15(2)(a) CTMR applies:

#### *6.4.2. Variations of letters and words*

In general, a difference in letters or even words constitutes an alteration of the distinctive character of the mark (*see however as regards generic or descriptive additions point 6.2.1.4. above*). The following changes have been considered as altering the distinctive character of a mark:

<i>REGISTERED FORM</i>	<i>CURRENT USE (not accepted)</i>	<i>Decision No</i>
THE WARRIORS	WARRIORBELL	165/1999 (EN)
		237/1999 (EN) (omission of the word MAXOR)
BONOLI	BONOLIVA	2996/2000 (FR)
CANNON	ITT CANNON	1611/2001, confirmed by R 930/2001-2 (EN)

The Board of Appeal considered that the use of the words “CAPTAIN BIRDS EYE” did not constitute use of the earlier mark “CAPTAIN” (R 89/2000-1 EL CAPITAN PESCANOVA / CAPTAIN (EN)). However, the Board of Appeal decided in R 1000/2001-2 BUDWEISER / BUDWEISER BUDVAR (EN) that the use of the word mark BUDWEISER in conjunction with the word BUDVAR and with figurative elements did not alter its distinctive character. In the parallel cases R 447, 451, 453 /2002-2 (Anheuser) (Busch) Bud / BIT the Board of Appeal held that, even though the figurative sign “BITburger” appeared on the relevant goods, the use of the earlier mark “BIT” was proven; as it was shown that the opponent had frequently made use of the word “BIT” alone in catalogues, advertisements and events.

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

<i>REGISTERED FORM</i>	<i>CURRENT USE</i>	<i>Decision No</i>
CASTILLO DE PERELADA	CASTILLO PERELADA (omission of “DE”)	1714/2001 (EN)

#### 6.4.3. Variations of figurative marks and elements

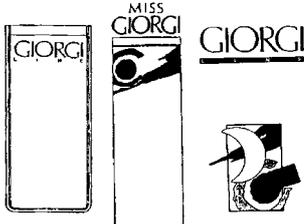
As regards additions, omissions or changes of figurative elements, there is a tendency to consider that such alterations *do not* affect the distinctive character of marks *that also contain word elements*.

REGISTERED FORM	CURRENT USE	Decision No
COMPUTERVISION		609/1999 (EN)
		1944/2000 and 1586/2003, confirmed by Board of Appeal, R 519/2003-2 (EN)

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

REGISTERED FORM	CURRENT USE	Decision No
		<i>for horse race journals</i> 1308/2000 (EN)
FILDOR		<i>for threads and textiles</i> 682/2001 (EN)

However, the change in a figurative element *alters* the distinctive character of a mark if this figurative element is *dominant in the overall impression of the mark*. As regards marks with both word and figurative elements, an obvious difference in a dominant figurative element leads to an alteration of its distinctive character, even if the word element remains unchanged.

REGISTERED FORM	CURRENT USE	Decision No
TACK		295/1999 (EN)
		206/2000 (EN)
		484/2001 (FR)
	NIKE	R 833/1999-1 NIKE F.I.T. / NIKE (fig) (ES), R 880/1999-1 NIKE TRIAX SERIES / NIKE (fig) (ES), R 16/2000-1 NIKE / NIKE (fig) (ES), R 19/2000-1 NIKE TOWN / NIKE (fig) (ES), R 73/2000-1 NIKE (fig) / NIKE (fig) (ES), (the cases are pending before the CFI)
	<p>(3 forms of use:)</p> 	Court of First Instance, T-156/01, GIORGI / GIORGIO AIRE, paragraph 44

The use of a merely figurative mark *in an inverse sense* does not alter its distinctive character.

<i>REGISTERED FORM</i>	<i>CURRENT USE</i>	<i>Decision No</i>
		1835/2000 (EN)

#### 6.4.4. Variations of colours

For colour marks to be considered as used they must be used with the colours as registered. Insignificant variations in the colour shade and strength will not alter the distinctive character. When colour marks are used only in black and white, this will not constitute use of the mark.

Where a colour combination is registered, use in varying proportions does not affect the distinctive character. This will be different when particular proportions were claimed and these are substantially altered in the variant as used.

As regards figurative marks with colour elements the use of (different) colours is not to be regarded as an alteration of the distinctive character of the mark, unless the presentation of the colour is a dominant element in the overall impression of the mark.

242/2000 SILVER / SILVER COLA (EN), 1044/2000 CAFES EL CRIOLLO / Criollo Rico (EN)

#### 7. Use for the goods or services for which the mark is registered

According to Article 15 CTMR, the mark must be used for the goods or services for which it is registered in order to be enforceable. According to the first sentence of Article 43(2) CTMR, 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 his opposition. The second sentence of Article 43(2) CTMR stipulates that if the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

This provision 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 are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration and 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.

Court of First Instance, Case T-126/03, ALADIN/ALADDIN, paragraph 51

### *7.1. Comparison of use with specification*

It must always be carefully assessed whether the goods and services, for which the mark has been used, really fall within the category as listed for the mark.

Examples:

1088/2000 EN DEMARA / DEMAR ANTIBIOTICOS, S.A. (EN), confirmed by BoA in R 807/2000-3: The use relating to “napkins and napkin pants for incontinence” does not constitute use for the registered goods “pharmaceuticals, veterinary and disinfectant products”, even though the specific goods might be distributed by pharmacies.

1196/2001 PIZZA DEL ARTE / VELARTE (EN): The use of the mark for “ready-to-eat pizzas and pasta meals” is not covered by the term “preparations made of cereals” and consequently, even though these goods can be considered as similar, no proof of use has been submitted for “preparations made of cereals” .

3412/2002 CAI / Kay (EN): The evidence of use for “entertainment services” was not regarded as proof that the earlier mark has been use for “education services”

R 68/2003-2 SWEETIE / SWEETY (EN): The use for “dessert toppings that are strawberry, caramel or chocolate flavoured” does not amount to prove use for the goods for which the mark is registered, namely “preserved, dried and cooked fruits and vegetables; concentrated citrus fruit and fruit extracts, preserves; sugars, biscuits, cakes, pasty and confectionary”.

R 124/2003-4 VERTEX / VERTEL Bial Portugal (EN): The general and ambiguous indication of the goods in the evidence submitted was not regarded as sufficient to prove to use for the specific goods mentioned in the list of goods of the earlier right. The material filed should have been of such a nature as to unambiguously indicate not only that use was made in relation to pharmaceutical specialities, but also to indicate the kind of speciality concerned.

### *7.2. Relevance of the classification*

It is of relevance into which particular class the goods or services for which a mark has been used fall.

Where a mark has been used for goods falling clearly into a particular class such as orthopaedic shoes (class 10), but the mark is registered for shoes

generally (in class 25), the fact that the common generic term is “shoes” does not mean that the mark has been used for the registered goods (in class 25).

### 7.3. Use and registration for “class headings”

Where a mark is registered for all the general indications of the class headings of a particular class and has been used for goods or services that are properly classified in the same class, the mark will be considered used for the specific goods or services.

On the other hand, when a mark is registered for some of the general indications of the class headings of a particular class but has been used for goods or services which fall under another one of the class headings of that same class, the mark will not be considered used for the registered goods or services.

### 7.4. Generic/general terms in classification

In general, it is not appropriate to treat the proof of use for particular goods or services as covering further goods and services which are listed in the registration of the earlier mark. It should be noted that, in particular, the reference to the concept of similarity of goods and services is no valid consideration in this context. The second sentence of Article 43(2) CTMR does not provide any exception in this regard.

1153/1999 VITABIT / Vitallift (DE), 3078/2000 CARIBBEAN CLUB / CARIBBEAN TWIST (EN)

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

The Court of First Instance pointed out in this context in its decision “ALADIN” that it is necessary to interpret the last sentence of Article 43(2) CTMR as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services.

Thus, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has actually been established.

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 relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Court of First Instance, T-126/03, ALADIN/ALLADIN, paragraphs 44, 45

#### 7.5. *Use as regards integral parts and after-sales services*

The Court of Justice held in its decision in “ANSUL” that use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available. That may apply where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold. The same may be true where the trade mark proprietor makes actual use of the mark for after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

Court of Justice, C-40/01 Ansul BV vs. Ajax Brandbeveiliging BV, paragraphs 49ff

This finding of the Court of Justice should be interpreted narrowly and be only applied in very exceptional cases, since it accepts, contrary to the general rule as laid down in Article 43(2) CTMR, the use for different goods and service as use for the goods and service as registered.

#### 8. Use by the proprietor or on his behalf

##### 8.1. *Use by proprietor*

According to Articles 43(2) and 15(1) CTMR, it is in general the owner who has to put the earlier registered mark to genuine use. These provisions cover also the use of the mark by the previous owner during his ownership.

1426/1999 QUINTA DE VENTOZELO / VINHO DO PORTO (EN)

##### 8.2. *Use by authorised third parties*

According to Article 15(3) CTMR, the use of the mark with the consent of the proprietor shall be deemed to constitute use by the proprietor. This means that the owner must have given his consent prior to the use of the mark by the third party. A later acceptance 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. Where the goods are produced by the trade mark proprietor (or with his consent), but subsequently placed on the market by distributors at the wholesale or retail level, this is to be considered as use of the mark.

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 proof of it, that the use has been made with the opponent's prior consent.

R 733/1999-1 AFFINAGE / AFFINITE (EN), R 756/1999-2 DOC & TORS / DOCTORS (EN)

This position of the Office was confirmed by the Court of First Instance in the decision "VITAFRUT / VITAFRUIT" (T-203/02, paragraphs 25, 26). The Court pointed out that it is unlikely that the proprietor of a trade mark would be in a position to submit proof that the mark had been used against his 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 there are doubts on the part of the Office 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 he gave his consent prior to the use of the mark. In such cases the Office gives the opponent a further period of two months for the submission of such evidence.

### 8.3. Use of collective marks

Collective marks are generally used not by the proprietor but by the members of the collective.

According to Article 68 CTMR, use by (at least) one authorised person satisfies the user requirement, provided it is otherwise genuine.

The specific characteristic of collective trade marks is that their main objective is not to indicate the origin of the goods or services but to indicate that the goods or services bearing this mark comply with certain characteristics or qualities. This different function has to be taken into account when evaluating the necessary proof of use in accordance with Article 64(3) CTMR.

In a specific case, it was therefore considered that a list showing the persons authorised to use the mark, i.e. manufacturers, producers, suppliers of services etc was sufficient *per se* for proving the extent of use. Further requirements as to the effective use of the collective trade mark by the authorised persons, i.e. documents showing the collective mark on the products or invoices proving effective sale of products bearing the collective mark, were not regarded necessary.

1392/2001 NF(fig) / MF(fig) (FR)

## 9. Legal use

Whether a mark has been used in a manner satisfying the user requirement of Articles 15 and 43 CTMR requires a factual finding of genuine use. The use will be “genuine” in this context even though the user may violate legal provisions.

Where the use is deceptive use within the meaning of Article 7 (1)(g) or Article 50 (1)(c) CTMR or under provisions of national law does not affect the finding of “genuine” use for purposes of asserting earlier marks in an 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 106 (2) CTMR).

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

## 10. Justification of non-use

According to Article 43(2) CTMR, the opponent may alternatively prove that there are justifiable reasons for non-use of his 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 which constitute an obstacle to the use of the trade mark.

### 10.1. *Business risks*

The concept of proper reasons must be considered to refer essentially to circumstances unconnected with the trade mark owner which prohibit him from using the mark, rather than to circumstances associated with the commercial difficulties he is experiencing.

Court of First Instance, T-156/01, GIORGI / GIORGIO AIRE, paragraph 41

Thus, financial difficulties encountered by a company as a result of an economic recession or due to its own financial problems, such as insolvency proceedings, bankruptcy or temporary stoppage of activities etc, are not considered to constitute proper reasons for non-use within the meaning of Article 43(2) CTMR. These kinds of difficulties constitute a natural part of running a business.

120/2001 Ecros(fig) / ERCROS (EN)

### 10.2. *Government 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, which the owner has to pass before offering the relevant goods and services on the market.

1507/2001 DIADUR / VIADUR (EN) (for pharmaceuticals)

### 10.3. *Force majeure*

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

### 10.4. *Consequences of justification of non-use*

The existence of justified reasons does not have the result that non-use during such period is treated as equivalent to actual use which would have the consequence that a new grace period begins after the end of the justified reasons.

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

In addition, the length of time during which justified reasons existed may be significant. If such reasons for non-use only existed during a part of the five-year-period before publication of the CTM application, this may not always be considered as justifiable 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.

421/1999 I-c-zym / CERZYME (EN)

## III. PROCEDURE

### 1. Request by the applicant

According to Article 43 (2) CTMR, use of the earlier mark needs be shown – and only be shown – if the applicant requests proof of use. The institution of proof of use is therefore designed as a *defence plea of the applicant*.

The Office may neither inform the applicant that he may request proof of use nor invite him to do so. In view of its impartial status in opposition proceedings, the Office is not allowed to suggest to one of the parties that a

specific procedural tool is at his disposal or otherwise instruct or advise the parties. It is a general principle in adversarial proceedings before the Office that it is left to the parties to argue and defend their respective positions as they see fit (see second part of Article 74(1) CTMR).

As use or non-use can be an issue in manifold constellations (for example, to invoke or deny a higher degree of distinctiveness of the earlier mark), merely discussing the use or non-use of the opponent's mark does not constitute a valid request for proof of use.

Article 43(2) CTMR is not applicable when one of the parties submits some kind of evidence of use of the claimed earlier mark on its own initiative. In such cases it is irrelevant that the evidence produced might only demonstrate a particular type or manner of use, or a use which is limited to some of the goods or services for which the earlier mark is registered.

#### 1.1. *Obligation of use*

The request to furnish proof of use is only valid if the earlier mark is under the use requirement at all, ie if it is registered for more than five years. See in detail under II. 4.1, above.

#### 1.2. *Time of request*

Pursuant to (new) Rule 22 (1), the request for proof of use must be made within the first time limit for the applicant to reply to the opposition under Rule 20 (2).

#### 1.3. *Request must be explicit, unambiguous, unconditional*

The request of the applicant is a declaration of formal character and has important procedural and consequences.

Therefore, the request has to be *explicit and unambiguous*. In general, the request of use has to be expressed in a positive wording (“*I request ...*”; “*I invite the Office to set a time limit for the opponent to prove use ...*”, etc). Mere observations or remarks by the applicant in respect of the use of the opponent's mark (such as “*the opponent has used his marks only for ...*”, “*there is no evidence that the opponent has ever used his mark ...*”, etc) are not explicit enough and invalid.

1078/2001 XEPIN / XENID (FR)

Furthermore, the request has to be *unconditional*. Phrases such as “*if the opponent does not limit his goods/services in classes ‘X’ or ‘Y,’ we demand proof of use*”, “*if the Office does not reject the opposition because of lack of likelihood of confusion we request proof of use*” or “*if somehow considered by the Office, the opponent is invited to file proof of use of his trade mark*” present conditional or auxiliary claims and are not treated as a request for proof of use.

## 412/2001 PANEL Y PERFIL / HOMEPANEL (EN)

### *1.4. Applicant's interest to deal with proof of use first*

Under new Rule 22 (5) CTMIR, the applicant may limit his first observations to requesting proof of use. He must then reply to the opposition in his second observations, namely when he will be given the opportunity to reply to the proof of use submitted. He may also do so if only one earlier right is subject to the use requirement, as the applicant should not be obliged to split his observations.

If the request is however completely invalid, the Office will close the proceedings, without granting the applicant a further opportunity to submit observations (point 1.5.).

### *1.5. Reaction if request is invalid*

If the request is invalid on any of the above grounds or if the requirements of Article 43(2)(3) CTMR are not met, the Office nevertheless forwards the applicant's request to the opponent but advises both parties of the invalidity of the request.

The Office will close immediately the proceedings, if the request is completely invalid and not accompanied by observations of the applicant.

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

## 2. Express invitation by the Office

If the applicant's request for proof of use is valid, the Office gives the opponent two months to submit proof of use or show that there are proper reasons for non-use. Deciding about the use in spite of the absence of an explicit invitation by the Office to submit proof of use constitutes a substantive procedural violation, even if the applicant's request is clear, the opponent understands it and submits the requested evidence of use.

## R 733/1999-1 AFFINITÉ / AFFINAGE (EN)

If the request for proof of use already arrives during the cooling off period or during the two months period given to the opponent for submitting for the first time or adding facts, evidence and arguments, the request is forwarded to the opponent without delay.

In cases where the request for proof of use arrives during the cooling off period and is communicated to the opponent during that period, the deadline for submitting proof of use will coincide with the deadline for providing for the

first time or adding facts, evidence and arguments. The time limit will be extended automatically if the cooling off period is extended.

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

### 3. Reaction of the opponent – providing proof of use

#### 3.1. *Time limit for providing proof of use*

The Office gives the opponent two months in which he may submit proof of use. The opponent may request an extension of the deadline in accordance with Rule 71 CTMIR (see in detail below).

The deadline specified by the Office precludes the acceptance of evidence submitted after the deadline. Any material received by the Office after expiry of the deadline will not be taken into account, regardless of whether the applicant objects or not.

This is now expressly laid down in Rules 19 (4), 22 (2) CTMIR and corresponds to previous case-law.

R 853/2000-1 PRINCESS DIANA / PRINCE (EN) Court of First Instance, T-388/00, “ILS / ELS”, paragraph 30

The opponent may request an extension of the deadline in accordance with Rule 71 CTMIR. Such a request has to be signed and must be received by the Office before the expiry of the deadline. Moreover, a justification must be given for the extension of the deadline. Mere standard phrases do not suffice in this regard (for example: “*the opponent is not available*”, “*we have not received instructions from our client yet*”, “*further time is needed to collect the evidence required*”, “*in view of the holiday season*” etc). The opponent has to explain specifically the special circumstances of the case which result in his inability to submit the evidence within the given period of time.

According to Rule 71(2) CTMIR, the Office may, if it wishes, make the extension of the deadline subject to the agreement of the applicant. In current practice, the time extension is granted in such cases unilaterally without first seeking the agreement of the applicant.

#### 3.2. *Means of evidence*

##### 3.2.1. *Principle*

According to Rule 22(4) CTMIR, the evidence shall be filed in accordance with Rules 79 and 79a and shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists,

catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f) CTMR. Rule 22(4) CTMIR also allows market surveys and quotations of the mark in lists and publications of associations of the relevant profession as suitable means of evidence.

89/1999 Bilatin / VIRACTIN (DE), 892/1999 QUANTOR / KONTOR 7 (EN)

Rule 22(4) CTMIR is to be read in conjunction with Rule 79a CTMIR. This means that material that cannot be scanned or photocopied (such as CDs, physical items) cannot be taken into account unless it is submitted in two copies so that it can be forwarded to the other party.

The requirement of proof of use always raises the question about the *probative value* of the submitted material. The pieces of evidence submitted must have at least a degree of reliability. The Office considers materials produced by third parties in general as of a higher probative value than materials produced by the owner or his representative. The reference of the opponent to internal print-outs or hypothetical surveys or orders are particularly problematic.

### 3.2.2. References

The opponent may avail himself of findings of national offices and courts in parallel proceedings. Although the Office is not bound by findings of the national offices and courts, such decisions must be taken into account and may influence the decision of the Office. It is important for the Office to have the possibility of considering the kind of evidence that led to the relevant decision at the national level. The Office takes into account different procedural and substantive requirements that may exist before the respective national body.

694/2000 Buss / BOSS (DE), 389/1999 DUKE / DUKE (EN) (confirmed by the Third Board of Appeal, R 550/1999-3), 1016/2000 DUKE / DUKE UNIVERSITY (EN).

The opponent may wish to refer to material filed as proof of use in previous opposition proceedings before the Office. This was confirmed by the Court of First Instance in its judgment “ILS / ELS” (T-388/00, paragraph 31). The Office accepts such references as valid under the condition that the opponent clearly identifies the materials he refers to and the proceedings in which they were filed. If the reference does not sufficiently identify the relevant material, the Office requires the opponent to clearly specify the material referred to or to file the material again.

The onus of providing proof of use is on the opponent and not on the Office or the applicant. Therefore, a mere indication of the web site where the Office can find further information is insufficient.

2621/2001 ADVANCE /ADVANCE (EN)

### 3.2.3. *Declarations*

Whereas the means of evidence listed, such as as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, do not present any particular problems, it is necessary to treat in some detail declarations as referred to in Article 76 (1)(f) CTMR.

The opposing party is not obliged to submit an affidavit concerning the sales made under the earlier trade mark. It is left to the opposing party to select the form of evidence which he considers suitable for the purpose of establishing that the earlier trade mark was put to genuine use during the relevant period.

Court of First Instance, T-203/02, VITAFRUIT/VITAFRUT, paragraph 37

#### 3.2.3.1. *Distinction between admissibility and relevance (probative value)*

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

As far as the *admissibility* is concerned, Rule 22(4) CTMIR expressly mentions written statements referred to in Article 76(1)(f) CTMR as admissible means of proof of use. Article 76(1)(f) CTMR cites means of giving evidence, amongst which are sworn or affirmed written statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. Therefore, it has to be evaluated whether the statement submitted constitutes a statement within the sense of Article 76(1)(f) CTMR. In cases of doubt, it is up to the opponent to submit evidence in this regard.

Article 76(1)(f) CTMR does not specify by whom these statements should be signed so that there is no reason for considering that statements signed by the parties to the proceedings themselves are not covered by this provision.

As far as the *probative value* of this kind of evidence is concerned, the Office makes a distinction between statements drawn up by the interested parties themselves or their employees and statements drawn up by an independent source.

#### 3.2.3.2. *Declarations by the proprietor or his employees*

Statements drawn up *by the interested parties themselves or their employees* are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter.

827/2000 Marco / MARCA (EN), R 990/2002-1 VELVET / VELVELITH (EN)

This does however not mean that such statements do not have any probative value at all. Any generalisation should be avoided, since the exact value of

such statements always depends on its concrete form and content. Statements including detailed and concrete information have a higher probative value than very general and abstractly drafted statements.

The final outcome depends on the overall assessment of the evidence in each individual case. In general, further material is necessary for establishing evidence of use, since such statements have to be considered as having less probative value in comparison to physical evidence (labels, packaging, ...) or to evidence originating from independent sources. Very important is therefore the probative strength of the further material submitted. It should be evaluated whether the content of the affidavit is sufficiently supported by the further material (or *vice versa*). The fact that the respective national office may have a certain practice in assessing such kind of evidence of use does not mean that it is applicable in the proceedings concerning Community trade marks.

Court of First Instance, Case T-303/03, Salvita/SOLEVITA, paragraphs 41ff

A change of ownership which took place after the date of publication of the CTM application may render the declarations made by the new owners already void of evidential value, as these new owners do in general not have any direct knowledge to make declarations concerning the use of the mark made by the previous owner.

R 16/2004-1 REPORTER / REPORTER (EN)

### 3.2.2.3. *Declarations by third parties*

Statements drawn up *by an independent source*, for example by experts, professional organisations, Chambers of Commerce, suppliers, customers or business partners of the opponent, are given more probative weight.

868/2000 NEWTON FRUITS / NEWTONS (EN)

It should be noted that this practice is in line with the case law of the Court of Justice in the “Chiemsee” judgment (C-108/1997 and 109/1997, OJ OHIM 1999, 1054), where the ECJ gave some indications as to the appropriate evidence proving the acquired distinctiveness of a mark. Statements drawn up by the parties themselves are not included among the suggested evidence. On the contrary, all the other suggested evidence, such as opinion polls, statements from Chambers of Commerce, or from professional organisations or from experts, originates from third parties.

## 4. Reaction of the applicant

### 4.1. *Forwarding of the evidence*

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

The Office in general gives the applicant two months to file his observations in reply to the evidence of use (and to the opposition).

#### *4.2. Insufficient proof of use*

However, the Office may close the proceedings immediately if insufficient proof of use has been filed within the deadline given and all the earlier rights of the opposition are affected. The rationale behind this practice is to avoid the continuation of the proceedings when their outcome is already known, that is, the rejection of the opposition for lack of proof of use (principle of economy and good administration of the proceedings). The Office does so only in cases where the evidence submitted is *clearly* insufficient to constitute proof of use.

In cases where the evidence might suffice, it will be forwarded to the applicant giving him two months to file his observations. The Office must not indicate to the opponent that the sufficiency of the evidence is doubtful, or even invite the opponent to file further evidence in such cases. Such acts would be against the impartial position of the Office in adversarial proceedings.

694/2000 Buss / BOSS (DE), 1920/2001 AGRITEC / ACRITEX (EN)

#### *4.3. No reaction of applicant*

If the applicant does not react within this time limit, the Office will give a decision on the basis of the evidence before it.

The fact that the applicant does not reply does not mean that he accepts the submitted evidence as sufficient proof of use.

Court of First Instance, Case T-303/03, Salvita/SOLEVITA, paragraph 79

#### *4.4. Formal withdrawal of request*

Where the applicant replies to the proof of use by formally withdrawing his request for proof of use, the issue of use will no longer be relevant. As it is the applicant who sets in motion the proof of use, the applicant is also able to bring an end to this part of the proceedings by formally withdrawing his request.

R 174/2003-2 SONNENGARTEN / SOMMERGARTEN (DE)

### **5. Further reaction by the opponent**

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

The Board of Appeal regarded the failure to allow the opponent to comment in such a case as a substantial procedural violation (second sentence of Article 73 CTMR).

R 733/1999-1 AFFINAGE / AFFINITÉ (EN)

Confirmations or new declarations of the opponent in his observations in reply referring to the use of the mark cannot be taken into account. This is because they are submitted after the deadline to furnish the requested proof of use. The Board of Appeal held that the confirmation made by the opponent's representatives in his observations in reply constitute a unilateral affirmation of the opponent himself and as such could not constitute an objective means of proof.

R 326/1999-1 ROSETA / Rosetta (EN)

However, additional evidence is taken into consideration where new factors emerge, even if such evidence is adduced after the expiry of the time limit.

Court of First Instance, Case T-334/01, HIPPOVIT/HIPOVITON, paragraph 56

6. Languages in proof of use proceedings

According to Rule 22(6) CTMIR, where the evidence supplied pursuant to paragraphs 1, 2 and 3 is not in the language of the opposition proceedings, the Office may require the opponent to submit a translation of that evidence in that language, within a period specified by the Office.

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

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

On the other hand, the applicant has the right to be informed about the content of the evidence filed in order to be capable of defending his interests. It is absolutely necessary that the applicant is able to assess the content of the evidence of use submitted by the opponent. In this regard, the nature of the submitted documents has to be taken into account. For example, it might be considered that "standard" invoices and samples of packaging do not require a translation in order to be understood by the applicant.

379/2000, CYCLAX / CYCLE (EN), 532/2001 TRIVASTAN / NOVASTAN (FR), 2308/2001 TRAVATAN / TRIVASTAN (FR)

If the applicant explicitly requests a translation of the evidence in the language of the proceedings, in principle, the Office will require a translation from the opponent. However, a rejection of such a request is feasible in cases where it

appears that the applicant's request, in view of the self-explanatory character of the submitted evidence, is exaggerated or even abusive.

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

## 7. Decision: Assessment of the evidence – standard of proof

### 7.1. Competence of the Office

The Office makes its own evaluation of the evidence of use submitted. This means that the probative value of the evidence submitted is evaluated independently of the observations of the applicant submitted in this respect. The assessment as to the relevance, pertinence, conclusiveness and efficacy of evidence stays within the discretion and power of judgment of the Office, and not with the parties, and falls outside the adversarial principle which governs *inter partes* proceedings.

694/2000 Buss / BOSS (DE), R 823/1999 – SIDOLIN / SIDOL (EN)

A declaration by the applicant concluding that use has been proved does not therefore have any effect on the finding of the Office. The request for proof of use is a defence plea of the applicant. However, once the defence plea has been raised by the applicant, it is solely up to the Office to carry out the following procedure and to evaluate whether the evidence submitted by the opponent is to be regarded as of sufficient probative value. However, the applicant has the possibility of withdrawing formally the request for proof of use (see above point III.4.4.)

This is not contrary to Article 74(1) CTMR 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. This provision is binding on the Office only as regards the facts, evidence and arguments that form the basis of its decision and does not extend to the legal evaluation of the same. 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.

1196/2001 PIZZA DEL ARTE / VELARTE (EN), R 823/1999-3 SIDOL / SIDOLIN (EN), R 641/2000-3 Silk Cocoon / COCOON (EN), R 53/2000-3 CONDOR / CONDOR (EN) (different however R 68/2000-2, MOBEC / NOVEX PHARMA (EN))

## 7.2. *The standard of proof*

The CTM Regulation requires *proof* of genuine use of the earlier mark. Therefore the evidence submitted by the opponent must consist of proof, i.e. substantial evidence that the mark has been put to genuine use. Making merely a *prima facie* case is not sufficient.

The Court of First Instance has held that 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.

Court of First Instance, T-39/01, HIWATT/HIWATT, paragraph 47, and T-356/02 Krafft/VITAKRAFT, paragraph 28

The Office does however not require an excessively high threshold of proof of genuine use. The required standard of evidence has to be in harmony with the function of opposition proceedings, which have to balance the need of expeditious proceedings with a fair resolution of conflicts.

## 7.3. *Nature, place, time and extent: overall assessment*

According to Rule 22(3) CTMIR, the indication and evidence required in order to provide proof of use shall consist of indications concerning 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*. 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.

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

The indication and proof may be *of an indirect/circumstantial nature*, such as evidence about the share in the relevant market, the import of the relevant goods, the supply of the necessary raw material 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.

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 respect of the particular market sector that the samples of these goods and services themselves do not bear indications in

respect of some of the four aspects mentioned in Rule 22(3) CTMIR. In these cases it is obviously not appropriate to disregard such evidence of use if indications in this respect can be found in the further material submitted.

Proof as to the “nature of the use” must show that the sign has been used a) *as a trade mark in the course of trade*, b) *as registered*, or in a variation thereof according to Article 15(2)(a) CTMR and c) *for the goods or services for which it is registered* (see point II.2.1.). It is necessary that the opponent submit evidence *depicting the representation of the mark* as it has been used in the market. Appropriate evidence is, apart from the products themselves, labels, packaging, price lists, catalogues or advertisements showing the mark and the designated goods. A mere reference to the mark in invoices or declarations, without showing the exact representation of the mark as used in the market, is insufficient in this respect.

Each of the submitted materials has to be carefully evaluated as to whether it really reflects the use during the five years preceding the publication of the CTM application (see in this regard point II.4.). In particular, the dates shown on orders, invoices and catalogues are carefully examined. Material submitted *without any indication of the date of its use* can in general not be taken into account. However, undated evidence may become relevant in the overall assessment of the evidence submitted. This is in particular the case if the opponent indicates the relevant date or if it is common in respect of the particular market sector that the samples of these goods and services themselves do not bear indications in respect of time.

R 608/2000-4 PALAZZO / HELADERIA PALAZZO (EN) (noting that ice-cream menus are rarely dated).

#### 7.4. Examples

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

348/1999 LINDE BOOM / LINDENER (EN): The opponent filed mainly circumstantial evidence. The circumstantial evidence consisted of a Royal award that the opponent had received outside the relevant five-year period. The long history and tradition of the “LINDEBOOM” Brewery going back to 1902 was also taken into account. The Opposition Division accepted the evidence as sufficient. The Board of Appeal (R 380/1999-2) shared this view stating that it would be very unlikely for the opponent upon receiving such a prestigious distinction to fail to usefully exploit it.

759/1999 MERITENE / MERTINA (EN): The evidence submitted consisted of a catalogue presenting the goods, price lists for 2 years, labels and advertisements. The Opposition Division considered the evidence as insufficient, since it did not contain any information on the extent of use. On the contrary, the Board of Appeal (R 743/1999-1) held that the information

contained in the catalogue (products offered on the market) and the price lists (sales conditions) gives a reliable indication of the extent of use of the mark.

878/1999 RENOLIN / RENTOLIN (EN): The opponent submitted four invoices for industrial oils, lubricants and conservation waxes for a total amount of DEM 2 200, a statutory declaration from the Head of the Legal Department of the opponent's company, labels and a brochure explaining the opponent's products. The Opposition Division considered the evidence as inadequate. The Board of Appeal (R 821/1999-3) confirmed the decision only in respect of conservation waxes. Concerning the industrial oil and lubricants, the Board considered that the labels and the brochure, which corroborate the description on the pre-numbered invoices, together point to genuine use. The Board also took into account, as circumstantial evidence, the invoices' numbers which, for fiscal and accounting purposes, must be arranged sequentially. It considered that all the "missing" invoices were issued for the same products.

1205/1999 HIWATT / HIWATT (EN): A catalogue showing the mark on 3 different models of amplifiers (not indicating place, time and extent), a catalogue of the International trade fair of Frankfurt showing that a company called HIWATT Amplification International exhibited at that fair (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 (not indicating place or extent of use) were not considered sufficient to prove genuine use, principally because of lack of extent of use. The Board of Appeal (R 116/2000-1) and the Court of First Instance (T-39/01) confirmed this decision.

317/2000 Krafft /VITAKRAFT (EN): The Opposition Division considered the submission of partially dated catalogues showing the respective products under the mark as insufficient, as the extent and time of use of the earlier marks cannot be inferred from the material. This was confirmed by the Board of Appeal (R 506/2000-4) and by the Court of First Instance (T-356/02). The Court stated in paragraph 34 of its decision that the catalogues submitted establish neither the fact that they were distributed to a potential Spanish clientele, nor the extent of any distribution, nor the number of sales made of goods protected by the mark. The opponent has provided no indication supported by evidence to enable any useful conclusions to be drawn in that regard. The mere existence of those catalogues could, at most, make it probable or credible that goods protected by the earlier marks were sold or, at least, offered for sale within the relevant territory, but it cannot prove that fact.

694/2000 Buss / BOSS (DE): The opponent submitted an affidavit of the opponent's manager and a series of undated labels and pages of catalogues. The Opposition Division regarded the proof of use as insufficient, in particular as regards the time and extent of use. The Board of Appeal confirmed this finding (R 643/2000-1).

719/2000 COCOON / Silk Cocoon (EN): To prove the use of his mark for clothing the opponent submitted extracts taken from the mail order catalogue "LA REDOUTE", dated 1997 and 1998, claiming that this catalogue is notoriously known in Europe and is distributed to millions of clients. The

Opposition Division found that the information contained in these catalogues proves the time, place and nature of the use of the mark but does not establish the actual extent of use. The Board of Appeal (R 641/2000-3) concluded that the material provided by the opponent was indeed very succinct but just reached the necessary minimum standard of proof of use. The Board mainly took into account the special circumstances of the case and especially the obvious notoriety of the mail order catalogue “LA REDOUTE” in which the COCOON products were shown. In that regard, the Board, in particular, found it sufficient that the opponent had stated that both himself and his catalogue were clearly well known in the field of mail-order sales, that several million copies of that catalogue are distributed in many European countries, such as France, and that the applicant had not contested those facts. The Court of First Instance (T-174/01) annulled the decision of the Board holding that the Board was obliged to indicate to the party concerned that it intended to take into account that fact in order that the party be in a position to evaluate the usefulness, if any, of submitting substantive observations on that fact.

1164/2000 PARABOOT / PARAWET (EN): The Opposition Division accepted genuine use in France, Germany, Italy and the Benelux countries, since the catalogues submitted by the opponent (even if many of them were undated) showed a link with the invoices and it could be reasonably assumed that they refer to a time period corresponding to the period of the invoices. With regard to Spain, the OD considered 2 invoices as insufficient to prove genuine use. The Board of Appeal (R 786/2000-1) confirmed these conclusions.

441/2001 COLETTE KOMBI / COLETTE (EN): The opponent submitted invoices, price lists, catalogues and packaging. The Opposition Division considered them as insufficient to prove genuine use taking into account that the invoices referred to a period other than the relevant one, the packaging and the brochures did not give any indication of the extent and time of use, and the price lists did not give information on the extent of use. Reversing the decision of the Opposition Division, the Board of Appeal (R 418/2001-1) regarded the submitted evidence – catalogues and price lists – as sufficient circumstantial evidence of the use of the mark.

868/2002 Salvita / SOLEVITA (DE): The opponent furnished an affidavit of the opponent’s manager as regards the turnover during the relevant period. This affidavit was only accompanied by an internal list of articles and undated copies of packages. The Opposition Division considered the evidence as insufficient, as only the declaration made by an interested party gave an indication as to the extent of use. This finding was confirmed both by the Board of Appeal (R408-2002-1) and by the Court of First Instance (T-303/03).

3224/2002 LANDMARK / LANDMARK (EN): The opponent submitted various leaflets showing a variety of grocery products all sold under different trade marks. The earlier mark featured underneath the shop name on the first and last page and in the footer. The Opposition Division found this insufficient holding that this evidence gives the impression that the opponent’s earlier mark has been used as a name for a retail store rather than for the actual

goods. Even if it could be argued that the opponent's mark has been used on the goods pictured in the submitted materials, since these goods have been put on sale in the shop featuring this name, the submitted evidence does not show the extent of use.

1586/2003 tiffany / TIFFANY & CO (EN), confirmed by Board of Appeal, R 519/2003-2 (EN) (and parallel case: 1944/2000 tiffany / TIFFANY & CO. (EN)): Whether or not a mere submission of catalogues is enough to prove genuine use depends on the impression given by and the information contained in the catalogues. In the present case the three catalogues, which appear to have been professionally produced, contain numerous pictures of a wide range of different product patterns and designs. They contain an indication of time which falls inside the five year period preceding the publication of the application and of place, namely France; this is obvious from the edition, content, language and the reference to the seat of the issuing undertaking and their regional departments, all domiciled in France. In the brochures, references are also made to the market position of the opposing mark in hypermarkets. Therefore, the relevant catalogues contain sufficient indications concerning the place, time, nature and extent of use to show that there has been a genuine use for the relevant goods.

659/2004 Pickwick COLOUR GROUP / PIC OUIIC, confirmed by Board of Appeal, R 335/2004-1 (EN): The proof of use filed (statement of the official chamber of commerce, undated advertisements, undated catalogue, undated photos showing shops selling goods bearing another mark, washing instructions, price lists and invoices without mentioning the signs, five invoices, advertisements, first pages of several undated concessionaire agreements) shows that the opponent had the intention of creating a franchising network. A certain amount of preparatory work was carried out but there is no proof of genuine use of the mark. The dated material relates to franchisees rather than to the end users.

971/2004 Chicken Bag / CHICKENGAR, confirmed by Board of Appeal, R 429/2004-1 (EN): The evidence submitted by the opponent (two labels, a catalogue, copies of invoices and statements in writing) does not contain objective, unambiguous and concrete information regarding the kind, extent and nature of use.

1506/2004 Berik / Berri, confirmed by Board of Appeal, R 565/2004-1 (EN): The Certificate issued by the official Chamber of Commerce and several declarations submitted by the opponent do not contain any information on either the nature or the extent of use of the signs. No invoices, figures on turnover or sample labels were filed.

#### *7.5. Need for decision*

A decision on the fulfilment of the obligation of having genuinely used the registered mark is not always necessary. The question of proof of use is not to be considered as a preliminary question that always has to be examined first when taking a decision on substance. Neither Article 43(2) CTMR nor Rule

22(1) give any indication in this regard. Therefore, in some cases it may be advisable to give priority to the examination of the grounds of opposition. In particular, this is the case where the sufficiency of the proof of use is doubtful and the opposition must be rejected anyway because the requirements of the raised grounds of opposition are clearly not met.