

**DECISION**  
**of the Fourth Board of Appeal**  
**of 27 April 2021**

In case R 1599/2020-4

**Hotel Cipriani S.P.A**

Giudecca 10  
30133 Venice  
Italy

Cancellation Applicant / Appellant

represented by Bird & Bird LLP, Avenue Louise 235, 1050 Bruxelles, Belgium

v

**Altunis - Trading, Gestão e Serviços, Sociedade Unipessoal, Lda.**

Avenida Arriaga n° 73, 1° andar, sala 113  
9000-060 Funchal (Madeira)  
Portugal

EUTM Proprietor / Defendant

represented by Disain IP, Calle Catedrático Abelardo Rigual, 10 - Bl. 1, Esc. 1, 5° B,  
03540 Alicante, Spain

APPEAL relating to Cancellation Proceedings No 32 103 C (European Union trade  
mark registration No 683 250)

**THE FOURTH BOARD OF APPEAL**

composed of D. Schennen (Chairman), L. Marijnissen (Rapporteur) and C. Bartos  
(Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 On 9 January 2002, pursuant to an application filed on 21 November 1997, one of the predecessors-in-title of Altunis - Trading, Gestão e Serviços, Sociedade Unipessoal, Lda. ('the EUTM proprietor') obtained the registration of European Union trade mark No 683 250 of the figurative mark




for goods in Classes 29 and 30, including the following:

Class 29 - Edible oils;

Class 30 - Rice; preparations made from cereals, bread; vinegar.

- 2 On 24 January 2019, Hotel Cipriani S.P.A ('the cancellation applicant') filed an application for declaration of revocation of the registered mark in its entirety based on Article 58(1)(a) EUTMR, claiming that the contested trade mark had not been put to genuine use for a continuous period of five years.
- 3 After being invited to do so, within the time-period set by the Office the EUTM proprietor filed the following evidence to prove the genuine use of the contested EUTM:

- Annex 1: Affidavits of retailers from Spain, Germany and Portugal;
- Annex 2: 955 pages of invoices issued by Cipriani Industria S.p.A. and Cipriani Industria Srl to different retailers in 16 EU Member States (Austria, Spain, the UK, Ireland, Estonia, France, Germany, Greece, Denmark, Latvia, Malta, Portugal, Romania, Slovakia, Luxembourg and Sweden) as well as in

Switzerland, and dated throughout 2014 up to 2019. The sign  is depicted on the top of each invoice;

- Annex 3: Catalogues, leaflets and invoices in relation to printing those, in English, German and Italian, from 2014 to 2018;
- Annex 4: Sanitary authorisations, dated 22/04/2003, giving authorisation to Cipriani Industria Srl for the production and packaging of dry egg pasta and

wholesale of food products, wines and spirits and dated 06/04/2005 giving authorisation for the activity of packaging biscuits and pastry products;

- Annex 5: A statutory declaration signed by the director of the EUTM proprietor and of Cipriani Industria S.p.A. , dated May 2019, stating that his companies have been using the contested EUTM since the mid-1980s for various food products (different types of pastas and also olive oils, vinegar, rice, sauces and panettones). He includes annual turnover figures in respect of these goods for the years 2014–2019 in 23 EU Member States (per country and per year). The annex also includes a 28 pages ‘Listing of worldwide Cipriani trade marks in Classes 29 and 30’;
  - Annex 6: A license declaration, dated 29/05/2013, issued by the EUTM proprietor’s director in which he states that the proprietor’s company is owned by Cipriani International Group SA and explains the business connections with other Cipriani companies, including Cipriani Industria Srl. The EUTM proprietor licensed the right to use the Cipriani trade marks to its related companies.
- 4 On 16 June 2020, the Cancellation Division upheld the application for revocation and revoked the contested EUTM as from 24 January 2019 for all the contested goods except for ‘edible oils’ in Class 29 and ‘rice; preparations made from cereals, bread; vinegar’ in Class 30, for which the contested EUTM remained registered. Each party was ordered to bear its own costs.
  - 5 The Cancellation Division reasoned that the evidence filed concerned only the goods ‘edible oils’ in Class 29 and ‘rice; preparations made from cereals, bread; vinegar’ in Class 30, and that genuine use for these goods had been proven during the relevant period (24 January 2014 to 23 January 2019 inclusive). The large amount of invoices, directed to customers in almost all the Member States of the European Union, was dated throughout the relevant period and, being regarded as samples of sales, sales volumes and quantities of sold goods, were far from being merely token. Even though sales figures in the affidavits were not broken down by individual goods, they listed the purchased goods and the names of the companies that made the statements could be matched with the invoices. The invoices and catalogues showed use of the contested mark as registered in spite of minor variations and additions, that did not alter the distinctive character of the mark.
  - 6 Even though the specification of the registered goods in Class 30 ‘preparations made from cereals, bread’ was broad, the evidence showed use of a wide spectrum and variety of goods, such as many different types of pasta and focaccia. The EUTM proprietor was not expected to prove use in relation to all conceivable variations of the goods concerned. Also in order to respect the legitimate interest of the EUTM proprietor to extend its range of goods in the future, the evidence submitted was considered to be sufficient to show use for this broad specification of goods. For the same reason the evidence submitted relating to olive oil was considered to be sufficient to prove genuine use for the registered goods in Class 29 ‘edible oils’. For all the other goods, however, the evidence submitted did not suffice to prove genuine use.

### **Submissions and arguments of the parties**

- 7 On 31 July 2020, the cancellation applicant filed a notice of appeal against the contested decision, followed by a statement of grounds of appeal on 14 October 2020. It requests that the Board annul the contested decision to the extent that it did not revoke the contested EUTM, uphold the application for revocation in its entirety, and award costs in its favour.
- 8 In essence, it argues that the Cancellation Division mistakenly assessed the evidence, failing to take into account that neither the invoices nor the catalogues showed the contested mark as registered. Only four of the submitted 954 pages of invoices showed the contested mark as registered. The EUTM proprietor has not provided any evidence that the cut-off picture on the invoices did in fact display the contested mark as registered. The four invoices submitted which do show the contested mark do not relate to the relevant goods, but only to 'pasta'. Even for 'pasta' the small volume referred to in the invoices would be insufficient to maintain the registration for these goods. Also a large part of the submitted catalogues and leaflets does not show the contested mark as registered. From the images depicted in the contested decision, it is not clear to which products they relate. In the catalogues products are labelled in different ways, often without the word 'CIPRIANI' which alters the distinctive character of the sign, and which does not show the contested mark as registered. In particular, for the goods 'vinegar' and 'panettone' entirely different logos have been used. The limited examples of 'rice' packaging have an entirely different logo or the logo is differently composed.
- 9 Moreover, the contested decision erred in its assessment of the extent of use. Insofar, the size and value of the food and beverage market within the European Union has to be taken into account. The conclusion of the Cancellation Division that the submitted invoices were mere samples of sales is not supported by the EUTM proprietor's evidence. The proven sales of oil and vinegar are low compared with the other goods, considering the overall size of the food market in the European Union and that the products are mass products. For none of the goods for which the Cancellation Division accepted genuine use, clear sales figures have been provided and the invoiced amounts are very low (for olive oil, rice, panettone, focaccia, biscotti less than 100 units of less than EUR 500, respectively; for vinegar less than 120 units per invoice). For the registered goods 'preparations made from cereals' the evidence only relates to 'pasta' which is not covered by the specification. Therefore, regardless of the number of invoices submitted, the invoices do not establish sufficient extent of use for these goods nor do they show the contested mark as registered.
- 10 Moreover, it argues that even if the goods 'pasta, focaccia, panettone and biscotti' are covered by the category of 'preparations made from cereals', the broad specification cannot be maintained. Focaccia and panettone are both types of bread which constitutes a separate class heading. 'Preparations made from cereals' is a very broad term which covers a wide range of products, such as breakfast cereals or a wide range of snack foods. 'Pasta' constitutes a separate sub-category. 'Biscotti' are biscuits. Therefore, genuine use is at most shown for 'pasta and biscuits'. Also with regard to 'edible oils', the evidence only relates to

olive oils whereas ‘edible oils’ also cover palm oil, sunflower oil, coconut oil for example and animal-based oils like butter and lard. Therefore, genuine use could at most be accepted for ‘olive oils’. For vinegar, no genuine use at all has been shown.

- 11 In its reply, the EUTM proprietor requests that the Board dismiss the appeal and order the cancellation applicant to bear the costs. It endorses the contested decision that genuine use of the contested mark has been proven for the goods ‘edible oils’ in Class 29 and ‘rice; preparations made from cereals, bread; vinegar’ in Class 30. The submitted invoices show the contested mark at the top of the invoices as registered. As far as there are some changes in the logo they respond to the normal development for marketing reasons and are minimal. The same is true for the catalogues which show the contested mark as registered or in a way not altering the distinctive character of the sign (e.g. p. 19 *et seq.* and p. 28, 29 of Annex 3).
- 12 The more than 800 invoices (Annex 2), the affidavits of retailers (Annex 1) and turnover figures in 23 EU Member States provided in the affidavit (Annex 5) show regular, frequent and long-term use. The large amount of invoices which contrary to the cancellation applicant’s statements show significant sales of the products should be sufficient to prove genuine use.
- 13 ‘Pasta, panettone; focaccia; biscotti’ fall all under the broader specification ‘preparations made from cereals’ and ‘bread’. Therefore, genuine use has been proven for both specifications, in particular considering that the application had been filed in 2002 under the 7th edition of the Nice Classification.

### **Reasons**

- 14 The appeal is not well founded. Genuine use of the contested mark has been proven by the EUTM proprietor for the goods ‘edible oils’ in Class 29 and ‘rice; preparations made from cereals, bread; vinegar’ in Class 30 for which the Cancellation Division rejected the application for revocation.

### *Scope of the appeal*

- 15 The contested decision maintained the EUTM registration only for the goods ‘edible oils’ in Class 29 and ‘rice; preparations made from cereals, bread; vinegar’ in Class 30. The appeal filed by the cancellation applicant is limited to these goods and seeks the revocation of the contested EUTM also for these goods.
- 16 No appeal was filed by the EUTM proprietor against the revocation for all the remaining goods. The decision to revoke the contested EUTM for these goods as from 24 January 2019 has become final. The scope of the present appeal proceedings is limited to the goods as referred to in the previous paragraph.

*Article 58(1)(a) EUTMR*

- 17 Pursuant to Article 58(1)(a) EUTMR, the rights of the proprietor of a European Union trade mark shall be declared revoked on application to the Office if, within a continuous period of five years preceding the date of filing of the request for revocation, the trade mark has not been put to genuine use in the European Union in connection with the goods or services in respect of which it is registered.
- 18 According to Article 19(1) EUTMDR in conjunction with Article 10(3) EUTMDR as applicable in the case at hand, the indications and evidence of use shall establish the place, time, extent and nature of use of the contested mark for the contested goods. The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspapers, advertisements, and statements in writing as referred to in Article 97(1)(f) EUTMR.
- 19 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 (07/11/2018, T-380/18, Intas, EU:T:2019:782, § 52).
- 20 In order to assess whether a trade mark has been put to genuine use in a particular case, an overall assessment of the documents in the file must be carried out, taking account of all the relevant factors in the case. In such an assessment, regard must be made to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark 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 (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 29; 27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 27; 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37).
- 21 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 (12/12/2002, T-39/01, Hiwatt, EU:T:2002:316, § 47; 13/06/2019, T-398/18, Dermaepil, EU:T:2019:415, § 56).
- 22 It is not required that each item of evidence contains information about all four elements to which proof of genuine use must relate, namely place, time, nature and extent of use. Thus, items of evidence taken together may establish the necessary facts, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 61; 24/05/2012, T-152/11, Mad, EU:T:2012:263, § 33, 34).

- 23 The contested mark was registered on 9 January 2002. Since the application for revocation was filed on 24 January 2019, the Board has to examine whether the EUTM proprietor had proven genuine use of the contested mark for the goods which are under appeal, namely ‘edible oils’ in Class 29 and ‘rice; preparations made from cereals, bread; vinegar’ in Class 30, during the five-year period preceding the filing date of the application for a declaration of revocation, that is, from 24 January 2014 until 23 January 2019 inclusive.
- 24 The documents provided by the EUTM proprietor within the time-limit set by the Cancellation Division as Annexes 1 to 6 (see paragraph 3 above) consist mainly of affidavits from retailers and from the EUTM proprietor, a large amount of invoices, product brochures, sanitary authorisations and a license declaration. Taking into account as a whole, as correctly considered by the contested decision, they are sufficient to prove genuine use of the contested trade mark for ‘edible oils’ in Class 29 and ‘rice; preparations made from cereals, bread; vinegar’ in Class 30 in the European Union.
- 25 The submitted evidence shows that the EUTM proprietor used the contested trade mark during the relevant period in the European Union for, inter alia, different kinds of pasta, olive oil and vinegar, rice, panettone and focaccia. Contrary to the arguments of the cancellation applicant, the vast amount of invoices, directed to retailers throughout Europe, shows continuous and significant sales of these products. The extensive use of the contested mark for different kinds of pasta has not been contested by the cancellation applicant. For olive oil, rice, panettone, focaccia and biscotti it argues that less than 100 units amounting to less than EUR 500 per invoice, respectively, have been proven and for vinegar less than 120 units per invoice which, as it argues, is not sufficient considering the size and value of the food and beverage market within the European Union. The Board does not agree with this argumentation. On the contrary, the invoices show continuous sales of these goods for a substantial amount. The Board refers to the following invoices, which are merely exemplary:
- Panettone:  
Invoice No 124-15-102 of 19/11/2015 to COMERCIAL C.B.G. S.A./Spain shows sales of 174 pieces of ‘PANETTONE CIPRIANI 1000 G in LATTA’ for an amount of EUR 2.869,26 (Annex 2.2);
  - Rice:  
Invoices No 77-15-102 and No 78-15-102 of 16/07/2015 and 20/07/2015 to LA MERCANTILE SCARDOVI GmbH in Austria for a quantity of 24 units of rice (‘RISO VIALONE NANO CIPRIANI G 1000’) of an amount of EUR 117,42 each;  
Invoice No 37-15-102 of 10/04/2015 to the same customer for 84 items of the same product for an amount of EUR 410,97 (Annex 2.2);
  - Focaccia:

Invoice No 16-18-102 of 02/02/2018 to FORTNUM & MASON /UK of 72 pieces ‘FOCACCIA DOLCE CIPRIANI 1000 G IN LATTA’ for an amount of EUR 1.231,20 (Annex 2.3);

- Olive oil:

Invoice No 1/18/000021 of 05/02/2018 to SELVER/Estonia of 168 units of ‘OLIO CIPRIANI BIOLOGICO ITALIANO LT. 0,5’ of an amount of EUR 1.043,28;

Invoice No 175-17-102 of 01/09/2017 to the same customer of 144 units of the same product of an amount of EUR 894,24;

Invoice No 31-16-102 of 24/03/2016 to the same customer of 120 units of the same product of an amount of EUR 635,90 (Annex 2.4);

- Vinegar:

Invoice No 1/18/000021 of 05/02/2018 to SELVER/Estonia of 120 units of ‘ACETO DI VINO ROSSO CIPRIANI 0,50 L’ of an amount of EUR 486,00 (Annex 2.4).

- 26 The invoices do not only prove sales of often more than 100 units of more than EUR 500 for olive oil, rice, panettone, focaccia and vinegar, but they do document, above all, continuous sales for these goods during the entire period from January 2014 to January 2019. Therefore, even assuming a large size and value of the food and beverage market within the European Union for which in any case the cancellation applicant did not provide any evidence, there is no doubt that there was genuine and not merely token use for these goods. In this respect the Board notes that the purpose of the requirement for genuine use is not to assess the commercial success of the undertaking in question (08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 43).
- 27 Even though the turnover figures of the statutory declaration issued by the director of the EUTM proprietor (Annex 5) and by several retailers (Annex 1) are not split into single products, the declarations confirm extensive use in particular for pasta and also olive oil, vinegar, rice, sauces and panettone during the relevant period in many Member States of the European Union.
- 28 All the submitted invoices depict the contested mark as registered at the top left of the invoice header. Moreover, they also indicate the most distinctive word element of the sign ‘CIPRIANI’ in the product description, see for example the invoice of 19 November 2015 to COMERCIAL C.B.G. S.A./Spain ‘PANETTONE CIPRIANI’ (Annex 2.2). As far as the cancellation applicant argues that for the goods ‘vinegar’ and ‘panettone’ as well as for the ‘rice’ packaging entirely different logos have been used, the Board notes that the submitted leaflets and catalogues (Annex 3.1) do not only show sufficient examples where the contested mark is depicted in its registered form on the catalogue pages, but also on the products themselves, for example for rice packaging: brochure, CIPRIANI FOOD, under CIPRIANI RICE, p.116, 117 of Annex 3.1; for pasta p. 113 *et seq.*; for oil p. 24, for oil and vinegar p. 89; for panettone p. 91; and for focaccia p. 125 and 126 of Annex 3.1. Therefore, even though some of the products depicted in the catalogues and brochures show the

contested mark in a slightly different composition as the figurative element and with the word element separated, there is also enough evidence that proves that the products are marketed with the contested figurative mark in its registered form.

- 29 Also use of the contested mark by the EUTM proprietor has been shown. The invoices are issued by CIPRIANI Industria Srl and CIPRIANI Industria S.p.A.. According to the submitted declaration of the director of the EUTM proprietor (Annex 6), the EUTM proprietor has licensed the contested trade mark to the other Cipriani companies. Use by licensees is considered to be use of the mark with the consent of the proprietor in compliance with Article 18(2) EUTMR and it is deemed to constitute use by the proprietor.
- 30 Pursuant to Article 58(2) EUTMR, in cases of partial use, the mark shall only be declared to be revoked for the goods or services for which there is a ground for revocation. If the trade mark is registered in respect of a homogenous category of goods or services within which it is not possible to make any significant sub-division, consumers will associate all the goods or services belonging to that category with the earlier mark. Where the EUTM proprietor has adduced proof of genuine use for part of the goods or services in that category, it therefore must be maintained for the entire category. The relevant criteria to be taken into account for the purpose of identifying a coherent subcategory are the purpose and intended use of the goods or services at issue (22/10/2020, C-720/18 and C-721/18, testarossa, EU:C:2020:854, § 37, 40).
- 31 In Class 29, the submitted evidence shows genuine use of the contested mark for 'olive oil'. Olive oil is covered by the broader specification 'edible oils' in Class 29, for which the contested mark is registered. It is true that this category encompasses a range of edible oils that may vary in their vegetable origin such as palm oil, sunflower oil or coconut oil as argued by the cancellation applicant. However, animal-based fats like butter and lard are not covered by edible oils as assumed by the cancellation applicant but constitute a separate class heading of edible fats. Edible oils are all intended to satisfy the same needs of consumers, reason for which it is not possible to make any significant sub-divisions. Therefore, genuine use has been proven for the registered goods 'edible oils' in Class 29.
- 32 In Class 30, genuine use has been proven for the goods under appeal 'rice' and 'vinegar'.
- 33 As to the other registered goods 'preparations made from cereals, bread' in Class 30, the evidence submitted by the EUTM proprietor shows genuine use of the contested mark for many different kinds of pasta, panettone and focaccia. First, it has to be noted that the different kinds of pasta for which the EUTM proprietor used the contested mark are covered by the class heading of 'preparations made from cereals'. The class heading of Class 30 at the filing date of the contested mark in 2002 (7th ed. of Nice Classification) was 'coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice'. Therefore, at the

time of filing of the contested mark 'pasta' was not a separate class heading. As the contested mark has been used for 'pasta' that is properly classified in Class 30 under the general indication 'preparations made from cereals', it is considered as having been used for 'preparations made from cereals'. In case of 'preparations made from cereals', it is almost impossible and certainly unduly onerous to place on the EUTM proprietor the obligation to demonstrate use in any possible subcategories that could endlessly be subdivided. Moreover, genuine use of the contested mark has also been shown for 'focaccia', 'a type of flat Italian bread made with yeast and olive oil and flavoured with herbs' ([www.lexico.com/definition/focaccia](http://www.lexico.com/definition/focaccia)) and 'panettone', 'a rich Italian bread made with eggs, fruit, and butter and typically eaten at Christmas' ([www.lexico.com/definition/panettone](http://www.lexico.com/definition/panettone)), products which could be equally qualified under 'preparations made from cereals' or 'bread'. Therefore, genuine use of the contested mark has correctly been accepted by the contested decision also for 'preparations made from cereals, bread'.

34 Accordingly, the appeal shall be dismissed.

### **Costs**

- 35 In the appeal proceedings the cancellation applicant ('the appellant') is the losing party within the meaning of Article 109(1) EUTMR and must bear the costs. The Cancellation Division correctly decided that each party shall bear its own costs in the cancellation proceedings.
- 36 In accordance with Article 109(1), (7) EUTMR and Article 18(1)(c)(iii) EUTMR, the Board fixes the amount of representation costs to be paid by the appellant to the EUTM proprietor ('the defendant') with respect to appeal proceedings at EUR 550. No costs are to be fixed for the cancellation proceedings.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the appellant to bear the costs of the appeal proceedings, which are fixed at EUR 550.**

Signed

D. Schennen

Signed

L. Marijnissen

Signed

C. Bartos

Registrar:

Signed

p.o. P. Nafz

