

**DECISION
of the Fifth Board of Appeal
of 1 March 2023**

In case R 603/2022-5

Havanna S.A.

Avda. Santa Fé 3148
BGT Buenos Aires C1425
Argentina

Opponent / Appellant

represented by Despacho González-Bueno, S.L.P., Calle Gurtubay 4, 2º dcha. 28001,
Madrid, Spain

v

Soho Group Co., Ltd.

40 Sukhumvit Road Soi 11 (Chai Yot)
Klong Toey Nua, Wattana Bangkok 0110
Thailand

Applicant / Defendant

represented by Ufficio Brevetti Rapisardi S.r.l., Via Serbelloni, 12, 20122 Milano, Italy

APPEAL relating to Opposition Proceedings No B 3 121 805 (European Union trade
mark application No 18 202 908)

THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson), S. Rizzo (Rapporteur) and Ph. von Kapff
(Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 26 February 2020, Soho Group Co., Ltd. ('the applicant') sought to register the figurative mark



for the following list of services:

Class 43: Restaurant services; bar services; café services; services for providing food and drink.

- 2 The application was published on 16 March 2020.
- 3 On 19 May 2020, Havanna S.A. ('the opponent') filed an opposition against the registration of the published trade mark application for all the above services.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR.
- 5 The opposition was based on the European Union trade mark registration No 1 994 409



filed on 30 November 2000 and registered on 4 November 2009 for the following services:

Class 42: Providing of food and drink; cafes, cafeterias, snack-bars, catering services. The provision of alcoholic beverages, with the exception of beers, provided that it is not rum flavoured, is expressly excluded from the aforementioned services.

- 6 By decision of 10 February 2022 ('the contested decision'), the Opposition Division rejected the opposition in its entirety on the grounds that the documents submitted do not support use of the mark within the meaning of Articles 47(2) and (3) EUTMR. It gave, in particular, the following grounds for its decision:

Proof of use

- The opponent was required to prove that the trade mark on which the opposition is based was put to genuine use in the European Union from 26 February 2015 to 25 February 2020 inclusive. The evidence must show use of the trade mark for the services on which the opposition is based.
- The evidence to be taken into account is the following:
 - Annex 1: Three rental contracts partially translated in English within the opponent's submissions. These documents refer to the rental of two premises in 'Centro Comercial El Triangle' and 'Diagonal Mar Centro Comercial' both located in the centre of Barcelona, Spain. In the evidence provided it is reported that 'the premises covered by this contract will be used exclusively for the following activity: coffee shop (including the sale of coffee shop goods under the trade mark HAVANNA)' and that 'the aforementioned activity shall be carried out using the shop sign, trade name

and/or the following mark 'HAVANNA'. The contracts provided refer to the years 2008, 2009 and 2013.

- Annex 2: Extract of the corporate website of the two shopping centres mentioned in Annex 1 i.e. 'El Triangle' and 'Diagonal Mar'. The piece of evidence provided mentions, inter alia, that 'for Havanna, nothing is more important than the relationship between our brand and our clients. As we pride ourselves on both product and ambience we have decided to offer fresh and quality product and the warmth of our services at the Triangle Shopping Center in Barcelona' and that 'for Havanna, the most important thing is to establish and take care, above all, of the relationship between our brand and our client. It is from this premise of excellency, we have decided to offer the quality and freshness of our products and the warmth of our services in the Diagonal Mar Shopping Center in Barcelona'. In addition, the Opposition Division notices that in the corporate website of the two shopping centres the opponent's activities are indexed under 'stores' or 'cafes & eateries'. The documents bear the printing date of 5 April 2021.
- Annex 3: A wide range of images, most of them undated, displaying, inter alia, bars and cafeterias under the sign 'HAVANNA'. The documents provided also display a dated 12 February 2020 for the amount of EUR 251.30 in relation to food products issued by an activity called 'HAVANNA' placed in 'El Triangle Centro Comercial'. From the images provided it is possible to ascertain that the opponent's activity consists of bars/cafeterias services selling various kinds of food and beverages. This piece of evidence also contains three other receipts, one issued on 20 February 2020 (of EUR 534.33, however the name of the issuer and the goods or services sold are not indicated), one making reference to the period 24/06/2019-29/06/2019 (issued by 'Premium Brand España S.L.' for EUR 5 715.76, however the goods or services sold are not indicated) and the last issued outside the relevant time frame (i.e. between 22/06/2020 and 27/06/2020, at any rate the goods or services sold are not indicated).
- Annex 4: A series of printouts of websites, YouTube, Instagram, Facebook, Google and TripAdvisor displaying, inter alia, the trade mark 'HAVANNA' used in relation with services such as bars and cafeterias. Some of the images have been published within the relevant period such as, for instance in December 2016, March 2017 or May 2015. From the images provided it is possible to ascertain that the services consist of bars/cafeterias selling various kinds of food and beverages. Some documents also show the user's interactions to posts and reviews for the opponent's services.
- Annex 5: A series of receipts issued between 2015 and 2021 and making reference to the sale of various kinds of foodstuff and beverages such as 'coffee'; 'cappuccino'; 'sandwiches'; 'smoothies'; 'muffins'; 'soft drinks'; 'teas' and 'croissant' under the activity name 'HAVANNA'. The amounts in the receipts may vary from few euros to some dozens of euros for a total of approximately EUR 1 650. The documents provided also mention that

the location where the services are rendered are two commercial centres in Barcelona.

Assessment of genuine use

- Regarding the geographical scope of use, the evidence provided shows that the opponent operates in the market sector of bars and cafeterias owning two establishments placed in ‘El Triangle’ and ‘Diagonal Mar’ shopping centres, both located in the city centre of Barcelona, Spain, at few kilometers from each other.
- Use of an EUTM in a single Member State, or even in a single city in a Member State of the European Union, is sufficient to satisfy the criterion of territorial scope (07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782, § 81 and the case-law cited). However, it must be recalled that the Office must determine on a case-by-case basis whether the various indications and evidence can be combined for the purpose of assessing the genuine character of use.
- In the present case, the Office acknowledges that Barcelona is the second most populous municipality of Spain. However, the fact that the opponent’s activities were centred in two points of the Barcelona city centre is not per se sufficient to demonstrate that the mark covers a significant geographical extent in the European Union. Indeed, the opponent failed to corroborate the evidence with additional objective data capable to establish that the services it provides have geographical significance within the relevant territory.
- For instance, the opponent could have submitted information on the approximate number of visitors of the shopping centres where the activities are located or independent press articles and advertising material displaying that the activities provided by the opponent retain a commercially relevant presence within the relevant territory.
- Indeed, what matters in the evaluation of the place of use requirement, is the impact of use in the internal market and, more specifically, whether it is sufficient to maintain or create market share in that market for the services covered by the mark and whether it contributes to a commercially relevant presence of the services in that market (07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782, § 82).
- On the contrary, most of the evidence suggests that the opponent’s market share and its commercial presence is rather limited. Specifically, in Annex 4, all the promotional posts on Facebook, Instagram or YouTube have been published exclusively throughout the shopping centres’ corporate accounts and not by other means such as local newspaper or advertisement in local TV that would have allowed the Opposition Division to appreciate the degree of market penetration within the city of Barcelona. In any event, it is noted that the posts concerning the trade mark ‘HAVANNA’ used in relation with the relevant services have very limited users’ interactions e.g. 50 views (video on YouTube), 24 likes (Instagram post) or 78 likes (Facebook web page). Also,

the numbers of reviews on Google are very limited (178 and 296 respectively). In addition, in TripAdvisor there are only 12 reviews ranking the establishment in ‘Diagonal Mar’ at position 435 of 445 coffee houses in Barcelona.

- It follows that the data provided shows a rather limited commercially relevant presence, especially taking into account that the opponent’s services are provided within an urban area of around 4.8 million and in the fifth most visited city in Europe. It follows – from the evidence submitted – that the opponent’s bars and cafeterias are assumed to be normal establishments attracting local and perhaps occasional visiting customers.
- In order to evidence the extent of the use, the opponent provided in ‘Annex 5’ several receipts, most of them being issued within the relevant time frame and related to the sale of different kinds of foodstuff and beverages. The total amount is approximately EUR 1 650.
- Furthermore, in Annex 3 are present other receipts, most of them issued within the relevant period. Namely one of approximately EUR 250 for the sale of various foodstuff and another one of approximately EUR 530 (however, in the latter, the name of the company that issued the receipt and the product description is missing).
- In addition, the opponent provided a receipt for EUR 5 715 issued by ‘Premium Brand España S.L’ in which – according to the contracts provided in Annex 1 – appears the name of the opponent’s group. However, in this receipt there is no indication of the goods or services sold and under which trade mark.
- At any rate, such a low total amount of sales figures, over a period of five years in a country with a population of approximately 47 million inhabitants, and in one of its biggest cities, is quantitatively insignificant, in particular since bar services are used by millions of consumers on a daily basis.
- In this regard, it must be noted that low turnover and sales, in absolute terms, of services relating the offering of medium or low-priced products – such as in the present case – support the conclusion that use of the trade mark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient (04/09/2007, R 35/2007-2, DINKY, § 22). It is, therefore, always necessary to take the characteristics of the market in question into account (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 51).
- The smaller the commercial volume of the exploitation of the mark, the more necessary it is for the opposing party to produce additional evidence to dispel any doubts as to its genuineness (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 37).
- As a consequence, the very limited geographical use of the sign – in only two establishments in Barcelona – coupled with the lack of sufficient evidence

regarding the extent of use, leads to the conclusion that the opponent has failed to prove sufficient use of its earlier trade mark registration.

- Therefore, the opposition must be rejected pursuant to Article 47(2) EUTMR and Article 10(2) EUTMDR.
- 7 On 11 April 2022, the opponent filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 2 June 2022.
 - 8 In its response received on 3 August 2022, the applicant requested that the appeal be dismissed.
 - 9 On 20 September 2022, the opponent filed a reply.
 - 10 No rejoinder was filed by the applicant.

Submissions and arguments of the parties

- 11 The arguments raised in the statement of grounds may be summarised as follows:

Proof of use

- The opponent submitted the following additional proof of use of the earlier mark (annexes filed renumbered by the Board in order to avoid confusion with annexes filed under the same numbers before the Opposition Division):
 - Annex 6: Copy of the franchise renewal agreement between HVN Internacional, S.A. / Savaly, S.A. (franchisee of Havanna S.A.) and Premium Brand España, S.L. (operator of Havanna shops in Spain). This document is provided in Spanish and the most relevant parts are translated into English in the statement of grounds;
 - Annex 7: VAT returns filed by Premium Brand España, S.L. between 2015 and 2020. These returns include the profits obtained by the company in relation to cafés and bars (IAE heading 6732) and retail trade of all kinds of food and beverage products in establishments with a salesperson (IAE heading 6471). The document is provided in Spanish, which is the obligatory language for filing the tax return. Although the content is easily understandable, a small summary table is provided in English in the statement of grounds;
 - Annex 8: Statements of sales made in the HAVANNA establishment located in the Diagonal del Mar Shopping Centre, Barcelona, between 2015 and 2020 and a relevant English summary table;
 - Annex 9: Statements of sales made in the HAVANNA establishment located in the El Triangle Shopping Centre, Barcelona, between 2015 and 2020 and a relevant English summary table;

- Annex 10: Statement signed by Mr Pablo Villanueva Vescovo, in his capacity as director and representative of the company Tiendas Premium Brand Barcelona, S.L., and a relevant translation into English, in which he states that said company operates the HAVANNA premises referred to above, and no other commercial establishment.
 - Annex 11: Printouts concerning the HAVANNA café in Madrid.
- This evidence is complementary to the evidence already submitted and must therefore be admitted by the Board of Appeal, by virtue of the provisions of Article 27(4) EUTMDR.
 - This evidence, taken together with the evidence already provided in the opposition proceedings, amply proves the use of the earlier mark in Barcelona, Spain, which constitutes genuine and effective use in the territory of the European Union (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 50; 07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782; 06/03/2019, T-321/18, NOCUVANT/ NOCUTIL et al., EU:T:2019:139, § 43; 09/11/2016, T-716/15, REPRESENTACIÓN DEL HIERRO DEL BOCADO (fig.) / REPRESENTACIÓN DEL HIERRO DEL BOCADO (fig.) et al., EU:T:2016:649, § 42).
 - The supplementary evidence shows that the volume of revenue related to the operation of the ‘HAVANNA’ trade mark in the European Union is high, exceeding four million euros in the period between 2015 and 2020 (also taking into account that during 2020 the bar activities suffered prolonged closures due to the Covid-19 pandemic).
 - Notwithstanding the above, the function of the proof of use is not to analyse the business success acquired by the operation of a mark, but the attempt of its owner to position themselves in the market through the use of their mark, so that its use, even if it does not unlock great benefits for its owner, must be considered as genuine and real (15/09/2011, T-427/09, Centrotherm, EU:T:2011:480, § 26; 29/11/2018, C-340/17P, ALCOLOCK, EU:C:2018:965, § 90).
 - Accordingly, the evidence provided in the opposition proceedings and that submitted together with this brief is sufficient to demonstrate real and effective use of the opposing mark during the relevant period and in the relevant territory.

On the preparatory acts for the use of the Havana trade mark for the opening of a new establishment

- In January 2022 a new HAVANNA café was opened in Madrid, as can be seen in the information provided as Annex 11. This opening follows the franchise plan detailed in Annex 6.
- The opening of this establishment began to be prepared some time ago. In fact, the search for franchisees for the opening of a new establishment in Madrid

began in 2016. However, the Covid-19 pandemic and the serious economic problems derived from it prevented the opening of the establishment before January 2022.

- The preparatory acts described show the clear intention and action of the opponent to use its mark. These preparatory acts must also be considered as use of the trade mark (see Board of Appeal decision 03/05/2021, R 1647/2020-2, Aptis; as well as judgement 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; and 15/09/2017, T-276/16, Boswelan, EU:T:2017:611, § 37-38).

The applicability of Article 8(1)(b) EUTMR

- The opposing marks have obvious similarities, since the dominant element of the contested mark, HAVANA, is almost identical to the name of the earlier mark, HAVANNA.
- The only difference between the dominant elements of the marks is the elimination of one of the letters N which is repeated in the earlier mark. This elimination does not make any difference phonetically.
- All the services of the contested application fall within the general services of the earlier mark. When this happens, such goods must be considered identical to those of the earlier mark.
- The likelihood of confusion is clear, the close similarity between the signs and the identity between the services covered by the conflicting trade marks make the trade mark application unfit to coexist in the market with the earlier trade mark.
- The Board of Appeal decision 14/11/2013, R 55/2013-1, HAVANA CAFFE (fig.) / H HAVANNA (fig.) rejected the trade mark HAVANA CAFFE (fig.) due to an opposition based on the opponent's earlier mark.

12 The arguments raised in response may be summarised as follows:

- The proof of use submitted by the opponent is not sufficient to prove use of the earlier mark in the EU market as it is restricted to a limited geographical area and the extent of use is also limited.
- The Opposition Division gave examples of what might be useful documents that the opponent could submit. But the new documents submitted by the opponent as proof of use in the appeal proceedings, do not relate to the documents suggested by the Opposition Division.
- These documents do not merely supplement the relevant facts and evidence which have already been submitted in due time, as requested by Article 27(4) EUTMDR. The new evidence does not merely support, strengthen and/or clarify the evidence already filed before the Opposition Division. Moreover, none of the materials submitted before the Board of Appeal for the first time

shows any use of the mark. The additional materials should therefore not be taken into consideration. Additional evidence at a later stage is only admissible if it has not been produced in due time for valid reasons. In the present case, the opponent did not mention valid reasons.

- In view of the above, the evidence filed for the first time before the Board of Appeal should not be taken into account.
- However, also these documents, like the previous ones, are irrelevant and not sufficient to prove the use of the opponent's trade mark for the following reasons.
- The mere existence of a franchise agreement (Annex 6), not being corroborated by the submission of other documents, such as invoices, is not per se sufficient to demonstrate the use of the trade mark for the covered services because it does not show outward use of the mark. Annex 7 does not mention the trade mark 'HAVANNA' and therefore it is not useful. The VAT returns could refer to any product/service. Annexes 8 and 9 are irrelevant because they are just internal declarations not supported by evidence such as: Annex 10 emanates from the opponent itself and therefore has a very low probative value and it is not supported by evidence; Annex 6 is irrelevant as it refers to the opening of a new café in the year 2022 and therefore, outside of the relevant period.
- A preparatory activity can be considered intended for imminent use on the market only when acts have been carried out aimed at the relevant public of the products in question. Moreover, it is precisely in order to allow this type of preparatory activity that the European Union trade mark system provides for a five-year grace period. The *ratio legis* of the obligation of the effective use of a European Union trade mark excludes that the EUIPO register can be equated with a strategic and static deposit, designed to give an inactive owner a legal monopoly for an indefinite period.
- There is nothing in the documents on file to suggest that the opponent had difficulties in obtaining more convincing evidence on the genuine use of the earlier mark.
- In consideration of the above, the evidence submitted by the opponent is not suitable nor sufficient to prove use of the prior trade mark on which the opposition was grounded.
- As far as the comparison of the trade marks is concerned, the applicant reiterates its arguments mentioned in the reply to the opposition of 21 January 2021: the notable differences arising from the verbal and figurative elements of the marks under comparison are enough to counterbalance the similarities. The trade marks differ also visually and conceptually. Therefore, there is no likelihood of confusion for the consumers.

13 The arguments raised in reply by the opponent may be summarised as follows:

The supplementary character of the documents filed together with the appeal

- Annex 6 shows that the franchise agreement between the parties was renewed in 2018, with the current term running until December 2029. This document is complementary to the documentation already submitted, since it demonstrates the relationship between the trade mark owner and its franchises in Spain, about which abundant information was provided in the opposition proceedings.
- Annexes 7 to 9 contain relevant financial information about the profits earned at HAVANNA establishments. Annex 10 complements these documents by clarifying that the data shown in Annexes 7 to 9 refer exclusively to HAVANNA establishments.
- These documents clearly complement those submitted in the opposition proceedings, in particular Annex 5 to our brief of 7 April 2021 (purchase receipts). The financial documents submitted in the opposition proceedings were only exemplary, as only a few purchase receipts were submitted. This additional documentation shows the sales made in the HAVANNA establishments, including those shown on the receipts submitted in the opposition proceedings.
- Annex 11 refers to the opening of a new HAVANNA establishment in Madrid in 2022. This document is complementary to the documents submitted in opposition, as it unequivocally shows my client's commitment to expanding its establishments in Spain.
- It is therefore clear that the documents submitted in the appeal proceedings are complementary in nature to those submitted during the opposition proceedings.

Regarding the use of the earlier mark

- It is necessary to analyse all the documentation as a whole, and not taking each document individually.
- Ad far as Annex 6 is concerned, although it does not in itself prove use of the mark, must be analysed together with the other documents submitted. In particular, with the photographs and extracts from social media showing the existence of the establishments of the said franchise and the financial documents showing the sales that the said establishments, HAVANNA, have made during the relevant period. It is therefore clear that this document is relevant to demonstrate that the HAVANNA trade mark has been (and continues to be) used in the Spanish market on a continuous basis.
- In relation to Annex 7, the applicant considers that, as it does not directly cite the HAVANNA trade mark, this document, which contains VAT declarations of the company Premium Brand España, S.L., is not valid as proof of use.

- However, this document must be analysed in conjunction with the other documentation provided. In this regard, as mentioned in the affidavit provided as Annex 10, the company Tiendas Premium Brand Barcelona, S.L. operates the Spanish HAVANNA premises and no other commercial establishments. Therefore, these VAT returns relate exclusively to the operation of HAVANNA establishments in Spain and are clearly indicative of the turnover generated by the operation of the HAVANNA brand.
- As for Annexes 8 and 9, deemed irrelevant by the applicant, as they are not accompanied by other evidentiary material such as invoices, they must be analysed together with the other documents and not individually. These are declarations of sales in HAVANNA establishments which correspond exactly to the VAT declarations submitted as Annex 7. They are therefore undoubtedly valid and reliable.
- On the other hand, those documents cannot be supplemented by invoices, as suggested by the applicant. It should be recalled that these are establishments providing cafeteria services, so it is not usual for invoices to be issued to customers (but purchase receipts, a selection of which were submitted during the opposition proceedings).
- With regard to Annex 10, again the applicant considers that it is not relevant, since it is not accompanied by other documentation. However, it is necessary to analyse the documentation as a whole, which allows us to obtain a global vision of the real situation of the HAVANNA brand in the market. This affidavit must be analysed together with the other documentation, mainly the financial documentation provided. Once this exercise has been carried out, the relevance of the affidavit is clear.
- Therefore, having analysed the documentation during the opposition proceedings as a whole, as well as the additional documentation submitted in the appeal proceedings, it is clear that the earlier mark HAVANNA has been used in the relevant territory, during the relevant period, in relation to the services for which it is registered.

Regarding the preparatory acts for a new use of the earlier mark

- Preparatory acts leading to the use of a trade mark are also considered as valid use of the trade mark. It is obvious that the opening of a new commercial establishment is not something that can be done immediately, but requires thorough planning in terms of real estate, labour, logistics, etc. All this planning was delayed, all over the world and for all launches, due to the Covid-19 pandemic, from which we are still suffering the consequences and restrictions.
- It is clear that the opening of the new centre in Madrid in January 2022 is the result of preparatory actions that began some time ago, specifically in 2016, when they started looking for franchisees to carry out this project.

- This new HAVANNA establishment, whose opening is outside the relevant period, joins the two establishments opened in Barcelona, which shows my client's clear intention to maintain and expand its commercial presence in the European Union.

Reasons

- 14 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 15 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Admissibility of the evidence filed for the first time before the Board

- 16 Together with the statement of grounds of the appeal, the opponent submitted for the first time, further evidence (as specified in paragraph 11 above, Annexes 6 to 11) in response to the reasoning of the contested decision and to supplement the evidence submitted before the Opposition Division (Annexes 1 to 5), which was intended to show that the earlier mark had been genuinely used.
- 17 The applicant contested the admissibility of the additional evidence. It essentially argued that the additional evidence is 'not merely supplementing relevant facts and evidence which had already been submitted in due time' and that the opponent failed to provide valid reasons as to why said documents were not filed in due time before the Opposition Division.
- 18 It is, therefore, appropriate to examine whether this evidence can be considered as admissible.
- 19 As the Court has held, it results from the wording of Article 95(2) EUTMR that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time-limits to which such submission is subject under the provisions of the EUTMR. Moreover, the Office is in no way prohibited from taking account of facts and evidence that are submitted or produced late, that is to say, after the time-limit provided by the Regulation and, as the case may be, for the first time before the Board of Appeal (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 42; 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 22).
- 20 In stating that the latter 'may', in such a case, decide to disregard evidence, Article 95(2) EUTMR grants the Office broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 43; 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 23).
- 21 According to Article 27(4) EUTMDR, the Board may accept facts or evidence submitted for the first time before it only where those facts and evidence meet two

requirements. Firstly, it must be established that they are *prima facie* relevant for the outcome of the case. Secondly, it must be established that these facts and arguments have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence that had already been submitted in due time or are filed to contest the findings made or examined by the first instance of its own motion in the decision subject to appeal.

- 22 It follows that although Article 95(2) EUTMR and Article 27(4) EUTMDR grant the Board broad discretion to decide, while giving reasons for its decision, whether or not to take into account evidence submitted for the first time before it, there are clear limits to this discretion, which will be duly taken into account in the examination below.
- 23 The Board notes that the evidence submitted at the appeal stage is *prima facie* relevant to the outcome of the present case. In particular, the evidence in question reacts to the Opposition Division's findings (the assessment of the evidence of use of the earlier mark). This additional evidence only supplements and builds on the evidence submitted in the proceedings before the Opposition Division, and concerns use of the earlier mark. Furthermore, there is no evidence to suggest that the submission of further documents represents a delaying tactic or that the legal time-limits were deliberately being abused. Finally, the applicant has had a chance to examine this evidence and submitted its comments in this respect (see paragraph 12 above).
- 24 Taking into account all the above, the Board deems it equitable to exercise its discretion pursuant to Article 95(2) EUTMR and Article 27(4) EUTMDR and concludes that the additional evidence filed by the opponent for the first time at the appeal stage is admissible.
- 25 Nevertheless, the Board stresses that the *prima facie* relevance of the evidence filed for the first time before the Board does not imply that it is conclusive for the outcome of the present case.

Proof of use

- 26 Article 47(2) EUTMR provides that the applicant of an EUTM application may request proof that the earlier mark on which an opposition is based has been put to genuine use in the European Union where it is protected during the five years preceding the filing date of the trade mark application against which a notice of opposition has been given, provided that the earlier mark has, at that date, been registered for more than five years.
- 27 During the course of the opposition proceedings, in the form required by Article 10(1) EUTMDR and within the period stipulated by Article 8(2) EUTMDR, the applicant requested proof of use of the earlier mark.
- 28 Since the EUTM application was filed on 26 February 2020, and at that date the earlier mark had been registered for more than five years, the five-year period for proving use of the earlier mark extends from 26 February 2015 to 25 February 2020, inclusive, as correctly stated in the contested decision.

- 29 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 (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43; 05/10/2022, T-429/21, Aldiano, EU:T:2022:601, § 18; 02/03/2022, T-140/21, apo-discounter.de, EU:T:2022:110, § 17).
- 30 Moreover, the condition relating to genuine use of the trade mark requires that the mark, as protected in the relevant territory, is used publicly and outwardly (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; 05/02/2020, T-44/19, TC Touring Club, EU:T:2020:31, § 52).
- 31 The *ratio legis* for the requirement that a mark must have been put to genuine use in order to be protected under EU law is that EUIPO’s register cannot be regarded as a strategic and static depository granting an inactive proprietor a legal monopoly for an unlimited period. On the contrary, that register must faithfully reflect what companies actually use on the market to distinguish their goods and services in economic life (14/12/2022, T- 636/21, eurol LUBRICANTS (fig.) / Eurollubricants, EU:T:2022:804, § 30).
- 32 In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement that the earlier mark must have been put to genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks (29/11/2018, C-340/17 P, Alcolock EU:C:2018:965, § 90; 26/09/2013, C-609/11 P, Centrotherm, EU:C:2013:1449, § 72, 74; 14/12/2022, T- 636/21, eurol LUBRICANTS (fig.) / Eurollubricants, EU:T:2022:804, § 31; 16/11/2022, T- 512/21, Epsilon Technologies, EU:T:2022:710, § 70; 02/02/2016, T-171/13, Motobi B Pesaro, EU:T:2016:54, § 49).
- 33 When assessing whether use of a trade mark is genuine, regard must be had 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 on 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, EU:C:2012:816, § 29; 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; 30/01/2020, T-598/18, Brownie, EU:T:2020:22, § 32).
- 34 In order to examine, in a particular case, whether a trade mark has been put to genuine use, an overall assessment must be carried out which takes into account all the relevant factors of the particular case. That assessment implies certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under the trade mark may be compensated for by a high intensity or a certain consistency over time of the use of that trade mark or vice versa (01/12/2021, T-467/20, Zara, EU:T:2021:842, § 76).

- 35 In addition, the turnover and the volume of sales of goods marketed under the earlier mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the mark at issue need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a market share for the goods or services protected by the mark (05/10/2022, T-429/21, Aldiano, EU:T:2022:601, § 19; 01/12/2021, T-467/20, Zara, EU:T:2021:842, § 77; 02/02/2016, T-171/13, Motobi B Pesaro, EU:T:2016:54, § 72).
- 36 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 (23/03/2022, T-146/21, Deltatic / Delta, EU:T:2022:159, § 35; 23/09/2020, T-677/19, Syrena, EU:T:2020:424, § 44; 13/06/2019, T-398/18, Dermaepil, EU:T:2019:415, § 56).
- 37 According to Article 10(3) EUTMDR, evidence of use of a trade mark must concern the place, time, extent and nature of use of the trade mark.
- 38 Furthermore, Article 10(4) EUTMDR provides that 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.
- 39 An accumulation of evidence may allow the necessary facts to be established, even though none of those pieces of evidence, taken individually, would be capable of establishing the accuracy of those facts (05/10/2022, T-429/21, Aldiano, EU:T:2022:601, § 39; 22/11/2018, T-424/17, Fruit, EU:T:2018:824, § 35; 19/04/2013, T-454/11, Al bustan, EU:T:2013:206, § 36).
- 40 Thus, although the evidential value of an item of evidence is limited to the extent that, individually, it does not show with certainty whether, and how, the goods or services concerned were placed on the market, and although that item of evidence is therefore not in itself decisive, it may nevertheless be taken into account in the overall assessment as to whether the use is genuine. That is also the case, for example, where that evidence corroborates the other relevant factors of the present case (05/10/2022, T-429/21, Aldiano, EU:T:2022:601, § 39; 23/09/2015, T-426/13, Ainhua, EU:T:2015:669, § 53).

Time of use

- 41 As to the applicant's arguments related to undated evidence, the Board recalls that, in accordance with case-law, undated documents may, in certain cases, be used to establish such use during the reference period where they serve to confirm facts inferred from other items of evidence (07/07/2021, T-205/20, I-cosmetics, EU:T:2021:414, § 53-54; 30/01/2020, T-598/18, Brownie, EU:T:2020:22, § 41).

- 42 In this regard, the Board observes that most of the receipts submitted as Annex 5, as well as the franchise renewal agreement (Annex 6), the VAT returns (Annex 7) the statements of sales (Annexes 8 and 9) and the statement signed by Mr Pablo Villanueva Vescovo (Annex 10) bear dates in the relevant period.
- 43 The remaining evidence, which is undated or falls outside the relevant period, can nevertheless be taken into account in order to analyse that part of the evidence that does fall within the relevant period (25/04/2018, T-312/16, CHATKA / CHATKA (fig.), EU:T:2018:221, § 113; 16/06/2015, T-660/11, POLYTETRAFLON / TEFLON, EU:T:2015:387, § 54; 17/10/2018, R 307/2018-4, OLVI'S / OLVI COSMETICS; § 23).
- 44 It follows that at least part of the evidence submitted shows use of the earlier mark in the relevant period. The sufficiency of such evidence to establish genuine use of the earlier mark will depend on its assessment in conjunction with the other relevant factors discussed below.

Place of use

- 45 The territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors (19/12/2012, C-149/11, Leno, EU:C:2012:816, § 36).
- 46 Since the earlier mark at issue is an EUTM, use must be shown for the territory of the European Union.
- 47 Nonetheless, in order to assess whether there has been genuine use in the European Union, within the meaning of Article 18(1) EUTM it is necessary to disregard the territorial borders of the Member States (19/12/2012, C-149/11, Leno, EU:C:2012:816, § 44; 23/03/2022, T- 146/21, Deltatic / Delta, EU:T:2022:159, § 37). Whilst it is reasonable to expect that an EUTM should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market. It is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule can therefore not be laid down (19/12/2012, C-149/11, Leno, EU:C:2012:816, § 54-55).
- 48 Furthermore, it does not follow from Article 47(2) EUTMR that use of a mark can only be considered effective if it extends to a substantial part of the relevant territory (23/09/2020, T-737/19, MontiSierra, EU:T:2020:428, § 42) and, moreover, the territorial scope of the use is only one of several factors to be taken into account in the determination of whether it is genuine or not (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 76; 23/09/2020, T-737/19, MontiSierra, EU:T:2020:428, § 42). The Court of Justice has also confirmed that in certain circumstances, the market of goods or services for which an EUTM has been registered is in fact restricted to the territory of a single Member State (19/12/2012, C-149/11, Leno, EU:C:2012:816, § 50) and the General Court has held on

numerous occasions that use of an EUTM in a single Member State is sufficient to satisfy the criterion of territorial scope (07/11/2019, T-380/18, Intas, EU:T:2019:782, § 73-84).

- 49 In the present case, the evidence of use makes reference to two establishments (bars and cafeterias) placed in ‘El Triangle’ and ‘Diagonal Mar’ shopping centres, both located in the city centre of Barcelona, Spain.
- 50 Annex 11 also refers to another establishment located in the city centre of Madrid, Spain. However, the Board observes that evidence relating to this establishment is not clearly dated or, in any event, is dated a couple of years after the relevant period.
- 51 It follows that the evidence shows use of the mark in the relevant territory, that is, within the European Union.
- 52 However, the essential question the Board is asked to reply to is whether the use exclusively related to the city of Barcelona is sufficient to constitute genuine use in the EU.
- 53 The applicant argues that the use of the contested mark relates to a limited location in Spain and, consequently, the evidence is clearly insufficient to prove genuine use in the EU.
- 54 However, in the Board’s view, the nature of the services concerned must be taken into account. Requiring a bar/cafe/teria to have establishments in several cities or even in several Member States in order to establish proof of use in the European Union would imply that only very large bar/cafe/teria chains would be able to comply with the use requirement.
- 55 As correctly observed in the contested decision, it is a well-known fact that Barcelona is the second most populous municipality of Spain. With a population of 1.6 million within city limits, and an urban area of around 4.8 million people, it is one of the largest metropolises on the Mediterranean Sea as well as a known tourist destination.
- 56 The documentation provided shows that the opponent’s bar/cafe/terias are located inside shopping centres in busy business and/or tourist areas of the city centre and in proximity to major tourist sites, namely La Rambla, Plaça de Catalunya, Passeig de Gràcia and the Parc del Fòrum.
- 57 It follows from the above considerations that, in the case at hand, the evidence of use of the earlier EUTM in two establishments located in the city centre of Barcelona may be sufficient to constitute use in Spain and also in the European Union, depending on its assessment in conjunction with the other relevant factors, such as the extent of the use, as well as its frequency and regularity.

Nature of use

- 58 In the context of Article 10(3) EUTMDR, the expression ‘nature of use’ includes evidence (1) of the use of the sign as a trade mark in the course of trade, (2) of the

use of the mark as registered, or of a variation thereof according to Article 18(1), second subparagraph, point (a) EUTMR, and (3) of its use for the goods and services for which it is registered.

Use as a trade mark

- 59 The proof of use must establish a clear link between the use of the mark and the relevant goods and services. Genuine use requires that use is made as a trade mark in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43; 14/04/2016, T-20/15, *Piccolomini*, EU:T:2016:218, § 42).
- 60 The evidence of use in this case establishes a link between the earlier EUTM and the services in question in Class 43 by its use for the identification of the opponent's bar/cafeterias, which bear the name 'HAVANNA'.
- 61 The question, however, remains, whether such use qualifies as use of the mark in the form as registered, which will be examined below.

Use in the form as registered

- 62 Regarding the use of the mark as registered, it must be noted that, under Article 18(2)(a) EUTMR in conjunction with Article 47(2) EUTMR, proof of genuine use of an earlier EU trade mark which forms the basis of an opposition against an EU trade mark application also includes proof of use of the earlier mark in a form differing in elements which do not alter the distinctive character of that mark in the form in which it was registered (23/03/2022, T- 146/21, *Deltatic / Delta*, EU:T:2022:159, § 36; 05/02/2020, T-44/19, *TC Touring Club*, EU:T:2020:31, § 57).
- 63 Article 18(2)(a) EUTMR relates to a situation where the registered mark is used in a form which is slightly different from the form in which registration was made (23/09/2020, T-796/16, *Shape of a blade of grass in a bottle*, EU:T:2020:439, § 137). The purpose of this provision, which avoids imposing strict conformity between the form of the trade mark as used and the form in which the mark was registered, is to allow its proprietor, in the commercial exploitation of the sign, to make variations which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (27/02/2014, T-226/12, *Lidl*, EU:T:2014:98, § 49; 23/02/2006, T-194/03, *Bainbridge*, EU:T:2006:65, § 50).
- 64 A finding of an alteration of the mark as registered requires the assessment of the distinctive and dominant character of the altered elements, taking into account their intrinsic qualities as well as the relative position of the different elements in the configuration of the mark (23/09/2020, T-796/16, *Shape of a blade of grass in a bottle*, EU:T:2020:439, § 139; 24/09/2015, T-317/14, *Shape of a cooking stove*, EU:T:2015:689, § 32; 12/03/2014, T-381/12, *Palma Mulata*, EU:T:2014:119, § 30).

- 65 For the purposes of that finding, account must be taken of the inherent qualities and, in particular, the greater or lesser degree of distinctive character of the registered mark. The weaker the distinctive character, the easier it will be to alter it (23/09/2020, T-796/16, Shape of a blade of grass in a bottle, EU:T:2020:439, § 140; 28/02/2017, T-767/15, Representation of a sowing of light coloured fish on a dark background, EU:T:2017:122, § 22). Where a trade mark is extremely simple or, by analogy, has a low distinctive character, even minor alterations to that mark are capable of constituting significant variations (19/06/2019, T-307/17, Representation of three parallel stripes, EU:T:2019:427, § 72).
- 66 In the present case, the mark as registered



is a figurative mark in colours consisting of the word 'HAVANNA' in standard red capital letters, placed within a yellow rectangle and surmounted by a yellow coat of arms, inside which is a red capital letter 'H', larger than the element 'HAVANNA', and above which is a four-pronged crown in red and yellow.


- 67 In the documentation provided, the following signs are shown:

- a. **HAVANNA** (Annexes 1, 2, 3, 4, 5, 6, 8, 9, 10 and 11).

- b.  (Annexes 2 and 4).

- c.  (Annex 3).

- d.  (Annexes 3 and 4).

- e.  (Annex 3).



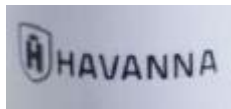
f. (Annex 3).



g. (Annexes 3 and 4).



h. (Annexes 3 and 4).



i. (Annex 4).



j. (Annex 11).

- 68 Verification of whether the distinctive character of the trade mark as registered has been altered requires an examination of the distinctive and dominant character of the elements added, based on the inherent characteristics of each of those elements and the relative position of the various elements in the arrangement of the trade mark.
- 69 As a preliminary remark, it must be emphasised and stressed that the evidence contains no items in which the earlier mark appears exactly as registered.
- 70 Firstly, as regards the verbal mark 'HAVANNA' which appears in the invoices, receipts, contracts, statements and online reviews, the Board considers that it is not usual for figurative marks to appear on such types of documents. Therefore, use of the sign as a word mark in such documents is common practice and does not affect the distinctive character of the sign.
- 71 Secondly, as regards the figurative signs under paragraphs 67.c and 67.i above, they differ from the sign as registered in the arrangement of the elements 'H' and 'HAVANNA', as well as in the colours and some details of the figurative elements. On the other hand, the signs maintain the word element 'HAVANNA' and the letter 'H' placed within a coat of arms.

- 72 Thirdly, as regards the figurative signs under paragraphs 67.b, 67.d, 67.g, 67.h and 67.j above, they consist of the word ‘HAVANNA’ alone, depicted in different colours and on different backgrounds.
- 73 Fourthly, concerning the figurative signs under paragraphs 67.e and 67.f above, they consists solely of the representation of the capital letter ‘H’ placed within a coat of arms and surmounted by a crown, albeit in the case of the sign under 67.f above with some differences with respect to how that figurative element appears in the mark as registered.
- 74 In the Board’s view, the distinctive character of the earlier mark as registered is essentially derived from its word element ‘HAVANNA’, which occupies an important position in the overall impression created by the mark. The large letter ‘H’, although visually relevant, will be perceived by the public as merely the initial letter of the distinctive element ‘HAVANNA’. On the other hand, the figurative elements of the coat of arms with the crown and the colours are merely ornamental and of fairly common use in trade.
- 75 The distinctiveness of the earlier EUTM must therefore be deemed to be largely dominated by the word ‘HAVANNA’.
- 76 From the evidence concerning the sign as used, it becomes immediately evident that the sign ‘HAVANNA’, depicted as



has been used by the opponent as a shop sign to identify its establishments in the ‘El Triangle’ and ‘Diagonal Mar’ shopping centres.

- 77 The overall impression of the marks, as used and as registered, is therefore dominated by the word ‘HAVANNA’.
- 78 Finally, the limited stylisation of the word ‘HAVANNA’, including its appearance in a different arrangement, will be perceived as decorative and not as indicating the commercial origin of the services (15/12/2009, T-412/08, Trubion, EU:T:2009:507, § 45; 27/10/2016, T-37/16, Caffè Nero, EU:T:2016:634, § 42).
- 79 In the Board’s view, the use of different typefaces when they are standard letters which reproduce the same terms, are minor differences that do not alter the distinctive character of the earlier EUTM as it was registered.
- 80 Against this background, the Board must conclude that the version in which the mark is used as shown under paragraphs 67.a, 67.b, 67.c, 67.d, 67.g, 67.h, 67.i and 67.j above, is an acceptable variation of the registered form which does not alter its distinctive character within the meaning of Article 18 EUTMR.

- 81 For the sake of completeness, the Board notes that some of the images submitted as Annex 3 show that the elements that make up the trade mark as registered (i.e. the word 'HAVANNA' and the 'H' in the coat of arms with the crown) are used together in the opponent's establishments, although not one right below the other, and both form part of the trade mark image conveyed by the bar/cafe/terias in question, as shown below:



Extent

- 82 As to the extent of use of the contested mark, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 71; 08/07/2004, T-334/01, Hipoviton, EU:T:2004:233, § 35; 23/09/2020, T-677/19, Syrena, EU:T:2020:424, § 45; 30/01/2020, T-598/18, Brownie, EU:T:2020:22, § 33).
- 83 The requirement for the extent of use does not mean that the opponent has to reveal the entire 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 (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 72). 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 the Office or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 25; 15/07/2015, T-215/13, λ, EU:T:2015:518, § 46).

- 84 Moreover, as stated above, the assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods or services marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa (23/09/2020, T-677/19, Syrena, EU:T:2020:424, § 43; 18/01/2011, T-382/08, Vogue, EU:T:2011:9, § 31; 08/08/2004, T-334/01, Hipoviton, EU:T:2004:223, § 37).
- 85 The Board observes that, except for the copy of the receipts issued between 2015 and 2021 and making reference to the sale of various kinds of foodstuff and beverages such as ‘coffee’, ‘cappuccino’, ‘sandwiches’, ‘smoothies’, ‘muffins’, ‘soft drinks’, ‘teas’ and ‘croissant’ under the name ‘HAVANNA’ (Annex 5 and part of the Annex 3), the amounts of which may vary from a few euros to dozens of euros totalling approximately EUR 2 000, there are no direct evidence of sales related to the provision of food and drink/cafés/bar/takeaway/catering services under the earlier EUTM. It must nonetheless be observed that the provision of traditional sales evidence, such as paper invoices, may not necessarily be functional when it comes to trade held in the relevant market sector.
- 86 The Board further observes that all the other documents relating to the commercial volume under the earlier mark consist essentially of statements made and signed by the opponent itself (Annexes 8, 9 and 10), without any other elements capable of corroborating the data contained in those declarations. Indeed, even in the case of the ‘VAT returns filed by Premium Brand España, S.L. between 2015 and 2020’ (Annex 7), the only way to link them to the use of the earlier mark is based on declarations of the opponent itself. According to settled case-law, affidavits made by a person who has a close connection with the party concerned, as in the present case, have a lesser evidentiary value than those made by a third party and that they cannot, in themselves, constitute sufficient evidence (11/12/2014, T-196/13, la nana, EU:T:2014:674, § 32 and case-law cited therein). Indeed, their content must be corroborated by the remaining evidence.
- 87 In the present case, an overall assessment of said statements together with the other evidence, such as the rental contracts (Annex 1) or the franchise agreements (Annex 6) does not provide the Board with objective and reliable indications as to the commercial volume of the use of the earlier trade mark.
- 88 Overall, the Board considers that the opponent’s statements, while indicating a quite considerable annual turnover over the entire relevant period for the type of services in question, nevertheless is not objectively corroborated by the remaining evidence submitted.
- 89 Concerning the websites and promotional posts on Facebook, Instagram or YouTube, the contested decision correctly observed that they have been published throughout the shopping centres’ corporate accounts and have very limited users

interactions. Also, the numbers of reviews on Google and TripAdvisor are very limited.

- 90 However, as stated above, the assessment of the evidence of use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 42).
- 91 As correctly stated in the contested decision, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the opposing party to produce additional evidence to dispel any doubts as to its genuineness (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 37).
- 92 In the present case, the Board observes that the receipts provided as Annex 5 (and, in part, as Annex 3) show that the opponent's two 'HAVANNA' bar/cafeterias have been open to the public continuously throughout the relevant period. These receipts provide consistent and objective information on the place of the service provision ('El Triangle' and 'Diagonal Mar' shopping centres, both located in the city centre of Barcelona, Spain), the dates of the service provision (dates scattered throughout the relevant five-year period) and the type of service (bars/cafeterias services selling various kinds of food and beverages).
- 93 In that regard, the Board recalls that the evidence should be examined in relation to the nature of the goods and/or services and the characteristics of the relevant market (30/04/2008, T-131/06, Sonia Rykiel, EU:T:2008:135, § 53). The evidence shows that the opponent operates in the market sector of bars and cafeterias, as correctly observed in the contested decision.
- 94 The Board acknowledge that, in the case of bar/cafeterias, only a small portion of customers request the provision of an invoice, while the vast majority are satisfied with the provision of a receipt.
- 95 The receipts submitted by the opponent, concerning the provision of different products provided by the bar/cafeteria, bear dates scattered throughout the relevant period and receipt numbers that are far apart, which allows for the consideration that this evidentiary material was submitted merely by way of example and does not represent the amount of actual commercial volume related to the earlier mark (19/09/2019, T-359/18, TRICOPID / TRICODIN (fig.), EU:T:2019:626, § 50).
- 96 In consideration of the fact that these are receipts issued by two bar/cafeterias, in which the provision of the corresponding services takes place in the establishments identified with the earlier mark (as can be seen in the images in Annex 3), the Board is persuaded that the sequential numbering of the receipts indicates that the copies provided by the opponent are only a sample of the total receipts issued in the relevant period in relation to the bar/cafeteria services provided in the opponent's establishments located in 'El Triangle' and 'Diagonal Mar' shopping centres.
- 97 In this regard, the Board points out that the condition as to the extent of use does not require the opponent to disclose the entire sales volume or turnover related to

the earlier mark and that the provision relating to the requirement of proof of use is not intended to assess commercial success, nor to control the economic strategy of an undertaking, nor to reserve trade mark protection solely to their quantitatively significant commercial exploitation (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 38). Where it meets a real commercial justification, even minimal use may suffice to establish the existence of actual use (19/09/2019, T-359/18, TRICOPID / TRICODIN (fig.), EU:T:2019:626, § 48).

- 98 Therefore, in the Board's view, an overall assessment of the evidence submitted with regard to place, time, extent and nature of use of the earlier mark indicates that the limited geographical use of the sign and the lack of objective evidence on a relevant commercial volume is counterbalanced by the fact that use of the earlier mark was very regular throughout the entire relevant period, which points to an actual and in-market use of the earlier mark.
- 99 In particular, the fact that the tickets appear to be continuous over time indicates that there has been an effort to maintain a market presence and excludes this use from being classified as token use or as artificial use intended solely for the maintenance of a trade mark registration.
- 100 In this regard, the Board further notes that the 'franchise renewal agreement' submitted by the opponent as Annex 6, as well as the documents concerning information relating to the opening (albeit after the relevant period) of a new bar/cafe/teria 'HAVANNA' in the city centre of Madrid (Annex 11), although *per se* not able to prove the use of the earlier mark in the relevant period, can corroborate that the use shown by the other evidence within the relevant period, far from being a token use or as artificial use intended solely for the maintenance of a trade mark registration, demonstrates the opponent's intention to maintain a market presence and that the opponent has made investments in order to expand its activity under the earlier mark.
- 101 Therefore, the Board considers that the evidence submitted by the opponent allows a safe conclusion to be drawn that it meets the scope of use requirement.

Use for the services for which it is registered

- 102 The remaining issue to be determined is whether the opponent has proved use of the earlier mark for all or part of the services on which the opposition is based, namely the following:

Class 42: Providing of food and drink; cafes, cafeterias, snack-bars, catering services. The provision of alcoholic beverages, with the exception of beers, provided that it is not rum flavoured, is expressly excluded from the aforementioned services.

- 103 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 subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category (26/03/2020, T-653/18, Georgio Armani le sac 11, EU:T:2020:121, § 35; 18/10/2016, T-367/14, Fruitfuls,

EU:T:2016:615, § 28). However, 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 subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to part of those goods or services affords protection only for the subcategory to which the goods or services for which the trade mark has actually been used belong (16/06/2010, T-487/08, Kremezin, EU:T:2010:237, § 56).

- 104 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods or services are not rendered unavailable, it must not, however, result in the proprietor of the trade mark being stripped of all protection for goods or services which, although not strictly identical to those in respect of which it has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. In that regard, it is in practice impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods or services concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories (18/10/2016, T-367/14, Fruitfuls, EU:T:2016:615, § 40; 14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 46).
- 105 Bearing in mind the above remarks, the Board will examine the evidence filed by the opponent.
- 106 The photographs of the opponent’s establishments in Annexes 3 and 4 show that the opponent’s mark is used on the shop signs, panels, tableware and other decorative elements of a typical bar/cafeteria in a shopping centre, which also sells some take-away food and drink products.
- 107 Moreover, the s submitted as Annex 5 make reference to the sale of various kinds of foodstuff and beverages such as coffee, cappuccino, paninis, sandwiches, smoothies, muffins, soft drinks, teas and croissants.
- 108 The above demonstrates, in the Board’s view, use of the earlier mark for providing of food and drink, cafes, cafeterias and snack-bars.
- 109 As for *catering services*, which are understood as the provision of food and beverages at a variety of social events (e.g. weddings, parties etc.), the opponent did not submit any evidence referring to these services.
- 110 Therefore, the Board considers that genuine use of the earlier mark has been demonstrated for only part of the relevant services, namely the following:

Class 42: *Providing of food and drink; cafes, cafeterias, snack-bars.*

Conclusion

- 111 Taking into account the documents submitted by the opponent as a whole, the Board finds that they provide sufficient and conclusive evidence of the time, place, nature and extent of the use of the earlier mark for *providing of food and drink; cafes, cafeterias, snack-bars* in Class 42, pursuant to Article 47(2) EUTMR and Article 10(2) and (3) EUTMDR.
- 112 The appeal is allowed and the contested decision, which rejected the opposition in its entirety based on the finding that proof of use of the earlier mark had not been shown, is partially annulled, in so far as it found that the opponent failed to prove sufficient use of its earlier EUTM registration No 1 994 409 in relation to *providing of food and drink; cafes, cafeterias, snack-bars* in Class 42.
- 113 *Providing of food and drink; cafes, cafeterias, snack-bars* in Class 42, are to be taken into consideration for the assessment of a likelihood of confusion pursuant to Article 8(1)(b) EUTMR.

Article 8(1)(b) EUTMR

- 114 Pursuant to Article 71(1), second sentence, EUTMR, the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
- 115 In view of the parties' legitimate interest that the case on the grounds of Article 8(1)(b) EUTMR must be decided in full by the Office's two instances, the Board deems it appropriate to remit the case for further prosecution to the Opposition Division in order to examine the opposition on these grounds taking into account the Board's findings as regards the genuine use of the earlier mark for *providing of food and drink; cafes, cafeterias, snack-bars* in Class 42, which are binding upon the Opposition Division.

Costs

- 116 The Board deems it equitable, pursuant to Article 109(3) EUTMR, that each party bears its own costs in the appeal proceedings.
- 117 As regards the costs of the opposition proceedings, these costs must be fixed by the Opposition Division in its forthcoming decision.

Order

On those grounds,

THE BOARD

hereby:

- 1. Partially annuls the contested decision, to the extent that it found that the opponent failed to prove sufficient use of its earlier EUTM registration No 1 994 409 in relation to *providing of food and drink; cafes, cafeterias, snack-bars* in Class 42;**
- 2. Remits the case to the Opposition Division for further prosecution;**
- 3. Orders the parties to bear their own costs of the appeal proceedings.**

Signed

V. Melgar

Signed

S. Rizzo

Signed

P. Von Kapff

Registrar:

Signed

p.o. E. Apaolaza
Alm

