

Use of a trade mark in a form differing from the one registered

Luca RAMPINI
Legal Practice Service, ICLAD, EUIPO

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Structure of the presentation

- I. Introduction: the requirement of establishing a ‘genuine use’
- II. Use of the mark in a different form than registered
- III. Recent case law on Article 18(1)(a) EUTMR

I. Introduction: the requirement of establishing a 'genuine use'

1. Rationale
2. Procedural aspects
3. Substantive criteria to be assessed

2. Procedural aspects

- No examination of use *ex officio*
- Means of defence:
 - Applicant for EUTM in opposition proceedings (Art 47(2) EUTMR)
 - EUTM proprietor in cancellation proceedings (Art 64(2) EUTMR)
- Means of attack:
 - Applicant for revocation of EUTM (Art 58(1)(a) EUTMR)
- Burden of proof: proprietor of TM
- Objects of requirement to establish use: EUTMs and national marks

3. Substantive criteria to be assessed

Article 10(3) EUTMDR

- Factors: indications concerning place, time, extent and nature of use for the
g/s in respect of which the trade mark is registered
- Place, extent and time: overall assessment on case-by-case basis
case law allows some flexibility: threshold of token use (*T-203/02, Vitafruit*)
- Use for g/s: partial use possible (Art 47(2), 58(2), 64(2) EUTMR)
- **Nature of use**

II. Use of the mark in different form than registered

Article 18(1) EUTMR

- Trade marks are to be used in the same form in which they are registered
- [S]hall also constitute use ... use of the EU trade mark [and by analogy also of national trade mark] ,

in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered ...

regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor

II. Use of the mark in different form than registered

1. Main principles relating to the application of Art 18(1)(a) EUTMR
2. Typical situations of alteration to be assessed

1. Rationale of the requirement of 'genuine use'

- Principle: no protection for trade marks which have not been used

- 'Ratio':
 - monopoly conferred by TM only justified by its effective use on the market
 - conflicts between TMs only acceptable where economically justified (effective functioning of the TMs on the market)

(AG Colomer, C-40/01, Ansul (Minimax), EU:C:2002:412, § 42: TM registers have to faithfully reflect market reality ≠ no simple repositories of signs)

1. Main principles of Art 18(1)(a) EUTMR

- **No strict identity** between the sign as registered and the sign as used
- **Rationale:** The owner should be able to adapt the sign to marketing and promotion requirements (*C-252/12, Specsavers*)
- Signs '**broadly equivalent**' differing only in 'insignificant respects' or 'negligible elements' (*T-194/03, Brainbridge*)
- Implies a **direct comparison** of sign as registered and sign as used
- **Reference point:** mark as registered and not mark as used

1. Main principles of Art 18(1)(a) EUTMR

TEST: do differences alter distinctive character of sign as registered?

- Assessment of ***distinctive character*** in the **registered mark**

- Assessment of the ***distinctive*** or ***dominant*** character of the ***components added***:
 - Intrinsic qualities
 - Relative position within the mark

- ***Interdependence*** between the strength of the distinctive character of the mark and the effect of alterations

2. Typical situations of alteration under Art 18(1)(a) EUTMR

- Additions
- Omissions
- Other alterations

Use of several marks simultaneously

2. Additions

T-426/13

AINHOA

Use which does not alter the
distinctive character

Registered form

AINHOA BIO

AINHOA LUXE

AINHOA MINERAL



Used form

Class 3: Cosmetics

2. Omissions

T-46/13



Registered form



Used form

Class 25: T-shirts, beachwear

Use which does not alter the
distinctive character

2. Other alterations

T 514/10

FRUIT

Registered form

FRUIT OF THE LOOM

Used form

Class 25

Use which does alter the
distinctive character

2. Additions

T-489/13



Registered form



Used form

Class 33: Wines

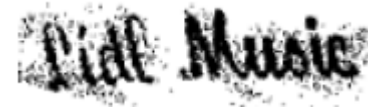
Use which does not alter the
distinctive character

2. Omissions

T-225/12



Registered form



Used form

Class 15: Musical instruments

Use which does not alter the
distinctive character

2. Omissions

T-46/13

Use which does alter the
distinctive character



La Sabiduría del Sabor

Registered form



Used form

Class 29: Foodstuffs

Class 33: Liqueurs from Navarra

- 'Sabores de Navarra' means 'tastes/flavours of Navarra'
- 'La subiduría del sabor' means 'the wisdom of flavour'

2. Other alterations

- Typeface, size, change in upper/lower case, colours

R-1344/2008-2

Use which does not alter the distinctive character

AMYCOR

Registered form



Used form

T-690/14

Class 5: Pharmaceuticals



Registered form



Used form

Class 9: Recording discs, loudspeakers, etc.

2. Other alterations

T-83/14



Registered form



Used form

Class 25: Clothing

Use which does alter the
distinctive character

2. Other alterations

T-204/12

VILA VITA PARC

vila vita hotel & ferien-dorf Pannonia

Registered form

Used form

Class 39: Transport, travel
arrangement

Class 43: Provision of food and drink; temporary accommodation

Use which does alter the
distinctive character

2. Other alterations

R 2041/2013-4



Use which does not alter the
distinctive character



Used form

Class 25: Clothing

Change in colour(s): Common Practice EUIPO and national offices (2014)

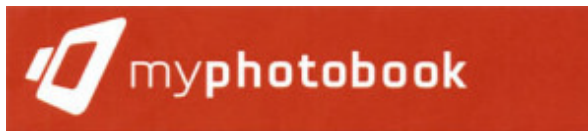
No alteration of trade mark's distinctive character only if:

- the main and distinctive word /figurative elements coincide
- the contrast of shades is respected
- (combination of) colour(s) not distinctive in itself
- colour is not one of the main contributors to the mark's overall distinctiveness

2. Other alterations

R 2041/2013-2

Use which alter the
distinctive character



Registered form



Used form

Class 9: Data carriers
Class 16: Books

T-105/13

As registered

DRINKFIT

As used



Use which does not alter the
distinctive character

- **Cl. 32**

2. Mark used together with other signs or indications

- simultaneous use of house mark and product mark (T-29/04, Cristal)



- special case of **superposition** of word elements on purely figurative marks (C-12/12, Colloseum)



Use which does not alter the distinctive character

III. Recent case law on Art 18(1)(a) EUTMR

T-766/15



Registered form



Used form

Use which does alter the
distinctive character

Classes 29, 30, 31

III. Recent case law on Art 18(1)(a) EUTMR

T-233/15

AD-1841-TY

Use which does not alter the
distinctive character

Registered form



Used form

Class 25: Clothing

III. Recent case law on Art 18(1)(a) EUTMR

T-146/15



Registered form



Used form

Use which does not alter the
distinctive character

Classes 3, 5, 9, 24, 25, 42

III. Recent case law on Art 18(1)(a) EUTMR

T-333/15

NN



NÚÑEZ I NAVARRO

Oficinas Centrales
Comte d' Urgell, 230 - 08036 Barcelona
Teléfono 933.636.950 - Fax 934.107.099



Registered form

Used form

Use which does alter the
distinctive character

Class 36

Thank you for your attention



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Thank you