

***GUIDELINES FOR EXAMINATION IN THE
OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET (TRADE MARKS AND
DESIGNS) ON COMMUNITY TRADE MARKS***

PART C

OPPOSITION

SECTION 6

PROOF OF USE

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1 General Considerations

1.1 Function of proof of use

Community legislation on trade marks establishes an ‘obligation’ for the owner of a registered trade mark to use that mark in a genuine manner. The obligation of use is not applicable immediately after registration of the earlier mark. Instead, the owner of a registered mark has a so-called ‘grace period’ of five years during which it is not necessary to demonstrate use of the mark in order to rely upon it – including in opposition proceedings before the Office. After this grace period, the owner may be required to demonstrate use of the earlier mark on the relevant goods and services. Before this period elapses, the mere formal registration gives the mark its full protection.

The reason behind the requirement that earlier marks can be required to demonstrate that they have been put to genuine use is to restrict the number of trade marks registered and protected and, consequently, the number of conflicts between them. This interpretation is supported by the eighth recital in the preamble to Directive 89/104, which explicitly refers to that objective (judgment of 12/03/2003, T-174/01, ‘Silk Cocoon’, para. 38).

When it comes to the requirement to prove use in opposition proceedings before the Office, it is important to bear in mind that the purpose of Article 42(2) and (3) CTMR is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to only large-scale commercial use of the marks (judgment of 08/07/2004, T-334/01, ‘Hipoviton’, para. 32 and judgment of 08/07/2004, T-203/02, ‘VITAFRUIT’, para. 38).

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

1.2 Legislative framework

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

1.2.1 CTMR and CTMIR

1.2.1.1 Article 15 CTMR – obligation to use registered marks

Article 15 CTMR stipulates the basic substantive requirement for the obligation to use registered marks and Article 15(1) CTMR reads:

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

In accordance with Article 15(1)(a) and (b) CTMR, the use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered and the affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes, also constitute use within the meaning of Article 15(1) CTMR.

In accordance with Article 15(2) CTMR, the use of the Community trade mark with the consent of the proprietor will be deemed to constitute use by the proprietor.

1.2.1.2 Article 42 CTMR – consequences of lack of use

The consequences of a lack of use in opposition proceedings are dealt with in Article 42(2) and (3) CTMR. According to Article 42(2) CTMR:

If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

In accordance with Article 42(3) CTMR:

Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.

There is no express provision in the CTMR that such forms of use as mentioned in Article 15(1) and (2) CTMR may also be regarded as use of earlier national trade marks. However, the concept of the obligation to use the registered mark is harmonised as a consequence of Article 10(2) and (3) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks ('Directive'). Hence, it is appropriate to apply Article 15(1) and (2) CTMR also to the use of earlier national trade marks.

Moreover, it results from the wording of Article 42(2) and (3) CTMR that proof of use can only be requested if the earlier right is a **CTM** or other **trade mark** having effect in the EU or an EU Member State, as defined in Article 8(2)(a) CTMR. Since oppositions brought under **Article 8(4) CTMR** cannot be based on either CTMs or other trade marks referred to in Article 8(2)(a) CTMR, the CTM applicant is not entitled to request proof of use for earlier rights relied upon in oppositions brought under this provision. Nevertheless, Article 8(4) CTMR requires the opponent to prove use in the course of trade of more than mere local significance for the earlier rights in question.

As for **Article 8(3) CTMR**, the Office's practice is that requests for proof of use of the earlier right cannot be made. The reason is that such earlier rights include both trade

marks having effect in the EU/EU Member States (CTMs, national trade marks, IRs) **and** national non-EU trade marks, requests for proof of use of the latter not being possible under the CTMR. It would be discriminatory to request proof of use for some countries' trade marks but not for others. Accordingly, and in view of the specific subject matter for protection under Article 8(3) CTMR, while the use or lack of use made of the earlier rights may have a bearing on arguments regarding the justification for applying for the CTMA, the opponent cannot be obliged to provide proof of use under Article 42(3) CTMR for any earlier rights thereby relied upon.

1.2.1.3 Rule 22 CTMIR – procedural rules, evidence and language

In accordance with Rule 22(2) CTMIR, where, pursuant to Article 42(2) or (3) CTMR, the opponent has to furnish proof of use or show that there are proper reasons for non-use, the Office will invite the opponent to provide the proof required within a period specified by the Office. If the opponent does not provide such proof before the time limit expires, the Office will reject the opposition.

In accordance with Rule 22(3) CTMIR, the indications and evidence required in order to furnish proof of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 4.

In accordance with Rule 22(4) CTMIR, the evidence must consist of written documents and in principle be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 78(1)(f) CTMR.

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

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

1.2.2 Trade Marks Directive and national law implementing the Directive

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

2 Substantive Law

2.1 Genuine use: the principles of the Court of Justice

Neither the CTMR nor the CTMIR defines what is to be regarded as 'genuine use'. However, the Court of Justice (the 'Court') has laid down several important principles as regards the interpretation of this term.

'Minimax' 2003 (judgment of 11/03/2003, C-40/01, 'Minimax'): the Court established the following principles:

- Genuine use means **actual** use of the mark (para. 35).
- Genuine use must, therefore, be understood to denote use that is **not merely token**, serving solely to preserve the rights conferred by the mark (para. 36).
- Genuine use must be consistent with the **essential function** of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling the latter, without any possibility of confusion, to distinguish the product or service from others which have another origin (para. 36).
- Genuine use entails use of the mark **on the market** for the goods or services protected by that mark and not just internal use by the undertaking concerned (para. 37).
- Genuine use must relate to **goods or services** already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (para. 37).
- When assessing whether there has been genuine use, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is **real**, in particular whether such use is viewed as warranted in the economic sector concerned to **maintain or create a share in the market** for the goods or services protected by the mark (para. 38).
- The circumstances of the case may, therefore, include giving consideration, inter alia, to the **nature** of the goods or services at issue, the **characteristics of the market** concerned and the scale and **frequency** of use of the mark (para. 39).
- Use need **not**, therefore, always be **quantitatively significant** for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (para. 39).

La Mer 2004 (order of 27/01/2004, C-259/02, 'Laboratoire de la mer'): the Court further elaborated the 'Minimax' criteria as follows:

- The question whether use is sufficient to preserve or create market share for those goods or services depends on several factors and on a case-by-case assessment. The **characteristics** of those goods and services, the **frequency or regularity** of the use of the mark, whether the mark is used for the purpose of marketing **all** the identical goods or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account (para. 22);
- Use of the mark by a single client which **imports** the goods for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (para. 24);

- A **de minimis** rule cannot be laid down (para. 25).

2.2 Genuine use: standard of proof applied by the Office

Article 42 CTMR requires *proof* of genuine use of the earlier mark. The proof must consist of **solid and objective evidence** of effective and efficient use (judgment of 18/01/2011, T-382/08, 'Vogue', para. 22). Making merely a prima facie case is not sufficient.

Moreover, the Office cannot determine *ex officio* the genuine use of earlier marks. Even proprietors of purportedly well-known marks must submit evidence to prove genuine use of the earlier mark(s).

The Office does not necessarily require a high threshold of proof of genuine use. The Court has indicated that it is not possible to prescribe, in the abstract, *what quantitative threshold should be chosen* in order to determine whether use was genuine or not, and accordingly there can be no objective *de minimis* rule to establish a priori the level of use needed in order for it to be 'genuine'. So, whilst a minimum extent of use must be shown, what exactly constitutes this minimum extent depends on the circumstances of each case. The general rule is that, when it serves a real commercial purpose, **even minimal use of the trade mark could be sufficient to establish genuine use**, depending on the goods and services, and the **relevant market** (judgment of 23/09/2009, T-409/07, 'Acopat', para. 35 and the quoted case-law; judgment of 02/02/2012, T-387/10, 'Arantax', para. 42).

In other words, if the evidence of use proves use that the Office considers to be, under the circumstances, more than serving solely to preserve the rights conferred by the mark, this will suffice. For instance, in some cases, relatively few sales might be sufficient to conclude that the use is not merely token, in particular with regard to expensive goods (decision of 04/09/2007, R 0035/2007-2, 'DINKY', para. 22). Nonetheless, even if inter alia a very modest amount of use can suffice in certain circumstances, proprietors should adduce comprehensive evidence of use.

In accordance with Rule 22(3) CTMIR, the indications and evidence required in order to provide proof of use must consist of indications concerning the **place, time, extent and nature of use** of the opponent's trade mark for the relevant goods and services.

These requirements for proof of use are **cumulative** (judgment of 05/10/2010, T-92/09, 'STRATEGI', para. 43). This means that the opponent is obliged not only to indicate but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the *entirety* of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (judgment of 17/02/2011, T-324/09, 'Friboi', para. 31).

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

Evidence of use may be of ***an indirect/circumstantial nature***, such as evidence about the share in the relevant market, the import of the relevant goods, the supply of the necessary raw material or packaging to the owner of the mark, or the expiry date of the relevant goods. Such indirect evidence can play a decisive role in the overall assessment of the evidence submitted. Its probative value has to be carefully assessed. For instance, the judgment of 08/07/2010, T-30/09, 'peerstorm', para. 42 *et seq.* found that catalogues in themselves could – under certain circumstances – be conclusive evidence of sufficient extent of use.

It is necessary to take into account ***the specific kind of the goods and services involved*** when assessing the probative value of the evidence submitted. For example, it may be common in a particular market sector for the samples of the goods and services themselves not to bear indications of the place, time, extent and nature of use. In these cases it is obviously not appropriate to disregard such evidence of use if indications in this respect can be found in the other evidence submitted.

Each of the materials submitted has to be carefully evaluated as to whether it really reflects use in the five years preceding the publication of the CTM application (see in this regard paragraph 2.5 below) or use in the relevant territory (see paragraph 2.4 below). In particular, the dates and place of use shown on orders, invoices and catalogues are carefully examined.

Material submitted ***without any indication of date of use*** may, in the context of an overall assessment, still be relevant and taken into consideration *in conjunction with other pieces* of evidence which are dated (judgment of 17/02/2011, T-324/09, 'Friboi', para. 33). This is the case in particular if it is common in a particular market sector for the samples of the goods and services themselves not to bear indications of time (decision of 05/09/2001, R 0608/2000-4, 'Palazzo', para. 16, noting that ice-cream menus are rarely dated).

For implementation of the abovementioned general principles in practice, see the examples in paragraph 3.7.4 below.

2.3 Nature of use: use as a mark in the course of trade

2.3.1 The term 'nature of use'

The required 'nature of use' of the sign refers to its use as a trade mark in the course of trade.

However, it is important to note that the expression 'nature of use' in the context of Rule 22(3) CTMIR further comprises the need for evidence of:

- the use of the mark as registered, or of a variation thereof according to Article 15(1)(a) CTMR (paragraph 2.7 below), and
- the use for the goods and services for which it is registered (paragraph 2.8 below).

2.3.2 Use as a mark

Articles 15 and 42(2) CTMR require proof of genuine use in connection with the goods or services in respect of which the trade mark is registered and which the opponent cites as justification for its opposition. Hence, the opponent has to show that the mark has been used as a trade mark on the market.

As a trade mark has, inter alia, the function to operate as a link between the goods and services and the person responsible for their marketing, the proof of use must establish a **clear link between the use of the mark and the relevant goods and services**. As clearly indicated in Rule 22(4) CTMIR, it is not necessary for the mark to be affixed to the goods themselves. A representation of the mark on packaging, catalogues, advertising material or invoices relating to the goods and services in question constitutes direct evidence that the mark has been put to genuine use (see also paragraph 2.3.3.2 below).

The **use of a sign as a business or trade name** cannot be regarded as trade mark use unless the relevant goods or services themselves are identified and offered on the market under this sign (judgment of 13/04/2011, T-209/09, 'Adler Capital', paras 55, 56). In general, this is not the case when the business name is merely used as a shop sign (except when proving use for retail services), or appears on the back of a catalogue or as an incidental indication on a label (judgment of 18/01/2011, T-382/08, 'Vogue', para. 47).

Genuine use requires that use is made as a *trade mark*:

- not for purely illustrative purposes or on purely promotional goods or services.
- in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered (judgment of 11/03/2003, C-40/01, 'Minimax', para. 43).
- Therefore, the following are not suitable to support genuine use of the trade mark: The use of the sign as a *company name* or *trade name*, because the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a *company name* is to identify a company, whereas the purpose of a *trade name* or a *shop name* is to designate a business which is being run. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being run, such use cannot be considered as being 'in relation to goods or services' (judgment of 11/09/2007, C-17/06, 'Céline', para. 21; judgment of 13/05/2009, T-183/08, 'Jello Schuhpark II', paras 31, 32).

The use of a company name/trade name can be regarded as use 'in relation to goods' where:

- a party *affixes the sign* constituting its company name, trade name or shop name to the goods or,
- even though the sign is not affixed, that party uses that sign in such a way that a *link is established* between the company, trade or shop name and the goods or services (judgment of 11/09/2007, C-17/06, 'Céline', paras 21-23).

Provided that either of these two conditions is met, the fact that a word element is used as the company's trade name does not preclude its use as a mark to designate goods or services (judgment of 30/11/2009, T-353/07, 'Coloris', para. 38).

Depending on the circumstances, the following may be suitable to support genuine use of the registered trade mark:

- The presentation of the business name at the top of *order forms or invoices*, depending on how the sign appears on them. However, mere use of a business name at the top of invoices without a clear reference to specific products/services is not enough.
- Use of a sign as a *domain name or as part of a domain name* primarily identifies the owner of the site (e.g. www.trademark.com). However, depending on the circumstances, such use may also be use of a registered mark (which presupposes that it connects to a site on which the goods and services appear).

2.3.3 Public use in the course of trade

2.3.3.1 Public use vs internal use

The use must be public, i.e. it must be external and apparent to actual or potential customers of the goods or services. Use in the private sphere or purely internal use within a company or a group of companies does not amount to genuine use (judgment of 09/12/2008, C-442/07, 'Verein Radetzky-Orden', para. 22; judgment of 11/03/2003, C-40/01, 'Minimax', para. 37).

The mark must be used **publicly and outwardly** in the context of commercial activity with a view to economic advantage for the purpose of ensuring an outlet for the goods and services which it represents (judgment of 12/03/2003 T-174/01, 'Silk Cocoon', para. 39, judgment of 30/04/2008, T-131/06, 'Sonia Sonia Rykiel', para. 38). -

Relevant evidence can validly come from a **distribution company** forming part of a group. Distribution is a method of business organisation which is common in the course of trade and implies use of the mark which cannot be regarded as purely internal use by a group of companies, since the mark is also used outwardly and publicly (judgment of 17/02/2011, T-324/09, 'Friboi', para. 32).

Use of the mark must **relate to goods or services** already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way. Mere preparation to use the mark – such as the printing of labels, producing of containers, etc. – is internal use and, therefore, not use in the course of trade for the present purposes (judgment of 11/03/2003, C-40/01, 'Minimax', para. 37).

2.3.3.2 Commercial activity vs promotional activity

Where the mark is protected for **not-for-profit enterprises** for their goods or services, and the mark has been used, the fact that there is no profit motive behind the use is irrelevant: 'The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services' (judgment of 09/12/2008, C-442/07, 'Verein Radetzky-Orden', para. 17).

Goods and services offered **free of charge** may constitute genuine use when they are offered commercially, i.e. with the intention of creating or maintaining an outlet for those goods or services in the EU, as opposed to the goods or services of other undertakings, and therefore of competing with them (judgment of 09/09/2011, T-289/09, 'Omnicare Clinical Research', paras 67, 68).

Mere use of the mark on **promotional material for other goods** cannot normally be considered as sufficient (indirect) evidence of use within the meaning of trade mark law for the type of promotional items on which the mark is or has been used. For example, giving away articles of clothing such as T-shirts and baseball caps at promotional events with the purpose of marketing a certain other product, such as a drink, cannot be considered as genuine use of the mark at issue for clothing.

The Office practice concerning 'genuine use' with regard to promotional articles has been confirmed by the Court:

Earlier sign	Case No
WELLNESS	C-495/07 (preliminary ruling)
<p>The opponent owned the mark 'WELLNESS' in Classes 25 and 32. In the context of selling its 'WELLNESS' clothing, it also used the mark to designate an alcohol-free drink, which was handed out in small bottles as a gift along with the clothing sold. No drinks were sold separately under the 'WELLNESS' mark.</p> <p>The Court held that, where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter, the mark loses its commercial <i>raison d'être</i> for the promotional goods and cannot be considered to have been genuinely used on the market for goods in that class (para. 22).</p>	

2.3.4 Use in relation to goods or services

2.3.4.1 Use in relation to goods

Trade marks have traditionally been used on goods (printed on the goods, on labels, etc.) or their packaging. However, showing use on goods or their packaging is not the only way of proving use in relation to goods. It is sufficient, if there is a proper connection between the mark and the goods, that the mark is used 'in relation to' the goods or services, such as on brochures, flyers, stickers, signs inside places of sale, etc.

Earlier sign	Case No
Schuhpark	T-183/08
<p>The GC found that the use of the sign <i>Schuhpark</i> for footwear on advertisements, bags and invoices was not meant to identify the origin of the shoes (which bore their own mark or no mark at all) but rather the company name or trade name of the shoe retailer. This was considered insufficient to establish a link between the sign <i>Schuhpark</i> and the shoes. In other words, <i>Schuhpark</i> may well be a mark for the retail of shoes, but it was not used as a trade mark for goods (paras 31, 32).</p>	

When the opponent sells its goods only through catalogues (mail-order sales) or the internet, the mark may not always appear on the packaging or even on the goods themselves. In such cases use on the (internet) pages where the goods are presented

– provided it is otherwise genuine in terms of time, place, extent and nature (see paragraph 2.3.4.4.) – will generally be considered sufficient. The owner of the mark will not have to provide proof that the mark actually appeared on the goods themselves.

It is only under extraordinary circumstances that **catalogues** may in themselves be conclusive evidence of a non-negligible extent of use:

Earlier sign	Case No
PETER STORM	T-30/09
The GC accepted that catalogues could substantiate the extent of use of a mark in circumstances in which 'a large number of items designated by the trade mark 'Peter Storm' were offered in the catalogues and those items were available in more than 240 shops in the United Kingdom for a significant part of the relevant period. Those factors support the conclusion that the extent of its use was fairly significant' (para. 43; see also paras 38–45).	

Earlier sign	Case No
CATAMARAN	R 0566/2010-2
The Board concluded that, despite the fact that the evidence did not comprise invoices, the sales catalogues (spring/summer 2001 to autumn/winter 2006) combined with the different samples of clothing items and the affidavit (with sales figures) represented sufficient evidence of the extent of use of the earlier trade marks (paras 31, 32).	

2.3.4.2 Use in relation to services

Marks cannot be directly used 'on' services. Therefore, as regards marks registered for services, their use will generally be on business papers, in advertising, or in some other way directly or indirectly related to the services. Where the use on such items demonstrates genuine use, such use will be sufficient.

Earlier sign	Case No
STRATEGIES	T-92/09
Where an earlier mark was registered in respect of 'business management' services and used as the title of business magazines, the GC did not exclude that such use be considered genuine in respect of the services in question. This could be the case if it is shown that the magazine provides support for the supply of the 'business management' services, i.e. if these services are provided through the medium of a magazine. The fact that there is no 'direct bilateral link' between the publisher and the recipient of the services does not impair such a finding of genuine use. This is because the magazine is not distributed free of charge, which could give credibility to the claim that the payment of the price of the magazine constitutes remuneration for the service provided.	

2.3.4.3 Use in advertising

Trade marks fulfil their function of indicating the commercial origin of goods or services and symbols of the goodwill of their owner not only when they are actually used on or in relation to goods or services, but also when they are used in advertising. In fact, the advertising or market communication function of trade marks is one of their most important functions.

Therefore, use in advertising will generally be considered as amounting to genuine use:

- if the volume of advertising is sufficient to constitute genuine public use of the mark and
- if a relation can be established between the mark and the goods or services for which the mark is registered.

The Court confirmed this approach in the ‘Minimax’ case, where it held that use of the mark must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, *particularly in the form of advertising campaigns* (judgment of 11/03/2003, C-40/01, ‘Minimax’, para. 37).

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

Earlier sign	Case No
BLUME	R 0681/2001-1
<p>Services: services of a publishing company in Class 41.</p> <p>The Board confirmed that the evidence (consisting of catalogues, press notes and advertisements) read in conjunction was enough to prove genuine use of the trade mark.</p> <p>‘Although the order record and the receipt of the bank account do not provide any information on how and to what extent the mark was used in Spain, the remaining documents, namely the catalogues, press notes and advertisements, when read in conjunction, demonstrate that during the relevant period, the opponent has published in Spain books and magazines under the trade mark BLUME. Even if the opponent does not provide any invoices, orders or sales figures, there is some reason to assume that it advertised its books and magazines, promoted and sold them under the trade mark BLUME. Although the advertising documents and the press notes were identified and dated by the opponent, the trade mark BLUME is always mentioned in the press notes and on the cover page of the quoted books. In addition, the text is in the Spanish language and the price mentioned in pesetas. When read together with the catalogues, these press notes demonstrate that they refer to some of the books expressly quoted in the catalogues ...’ (para. 23).</p>	

Earlier sign	Case No
BIODANZA	R 1149/2009-2 (confirmed by T-298/10)
<p>G&S: Class 16 and 41.</p> <p>The Board rejected the Opposition Division’s finding that the evidence (only advertisements) proved genuine use.</p> <p>It follows clearly from the finding of the contested decision that the evidence of use submitted by the opponent consists solely of advertisements that can prove only that the opponent advertised a yearly ‘BIODANZA’ festival during the whole of the relevant period and workshops on both a regular and irregular basis from 2002.</p> <p>However, contrary to the finding of the contested decision, such advertisements cannot provide proof of their distribution to a potential German clientele. Nor can they prove the extent of any distribution or the number of sales or contracts made for the services protected by the mark. The mere existence of advertisements could, at most, make it probable or credible that the services advertised under the earlier mark were sold or, at least, offered for sale within the relevant territory, but it cannot prove this, as was unduly supposed by the contested decision.</p>	

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

Advertising in advance of the actual marketing of goods and services – if with a view to establishing a market for the goods or services – will generally be considered to constitute genuine use.

Whether mere advertising, without any current or future plans to actually market goods or services, constitutes genuine use appears doubtful. As in most other situations, the outcome will depend on the circumstances of each case. For example, where the goods or services are available abroad, such as holiday accommodation or particular products, advertising alone may be sufficient to amount to genuine use.

2.3.4.4 Use on the internet

The standard applied when assessing evidence in the form of print-outs from the internet is no stricter than when evaluating other forms of evidence. Consequently, the presence of the trade mark on websites can show *inter alia* the nature of its use or the fact that products or services bearing the mark have been offered to the public. However, the mere presence of a trade mark on a website is, of itself, not sufficient to prove genuine use unless the website also shows the place, time and extent of use or unless this information is otherwise provided.

Earlier sign	Case No
SHARP	R 1809/2010-4
The opponent submitted 'extracts from the opponent's websites for different countries'. The Board considered that 'simple print-outs from a company's own Internet page is not able to prove use of a mark for certain goods without complementary information as to the actual use of the Internet site by potential and relevant consumers or complementary advertising and sales figures regarding the different goods, photos of the goods with the corresponding mark etc.' (para. 33).	

Earlier sign	Case No
WALZERTRAUUM	T-355/09 (appeal pending under C-141/13 P)
The opponent, a bakery, who owns the German trade mark 'WALZERTRAUUM' for goods in Class 30, in order to prove the extent of use of its mark, submitted evidence regarding an advertising brochure published on the Internet, which gives general information about its working methods, the ingredients used for its products and the product range, including its 'WALZERTRAUUM' chocolate. The goods could, however, not be ordered online on the web page. For this reason the GC held that a connection between the website and the number of items sold could not be established (para. 47).	

In particular, the value in terms of evidence of internet extracts can be strengthened by submitting evidence that the specific website has been visited and, in particular, that orders for the relevant goods and services have been made through the website by a certain number of customers in the relevant period. For instance, useful evidence in this regard could be records that are generally kept when operating a business web page, for example records relating to the hits attained at various points in time or, in some cases, the countries from which the web page has been accessed.

As to the *relevant period*, information on the internet or in online databases is considered to be of the date on which the information was posted. Internet websites often contain highly relevant information. Certain information may even be available only on the internet from such websites. This includes, for example, online catalogues that are not available in printed format.

The nature of the internet can make it difficult to establish the actual date on which information was in fact made available to the public. For instance, not all web pages mention when they were published. In addition, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records which enable members of the public to establish precisely what was published when.

In this context, the date of use on the internet will be considered reliable in particular where:

- the website time-stamps each entry and thus provides information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or
- indexing dates are given to the web page by search engines (e.g. from the Google™ cache); or
- a screenshot of a web page bears a given date.

The evidence submitted must show that the online transactions were *connected with the goods or services* designated by the mark.

Earlier sign	Case No
ANTAX	T-387/10
The opponent has submitted, inter alia, internet extracts from the home pages of several tax consultancies using the opposing mark. The GC considered that the indications on the internet pages allowed the reader to establish a link between the trade mark and the services provided (paras 39, 40).	

Whereas the *nature of the mark* and, to a certain extent, the *time* (as seen above) and *place* are less complex elements to prove, the *extent of the use* presents more difficulties if only evidence of internet use is provided. It should be taken into account that transactions on the internet tend to eliminate most of the ‘traditional’ evidence of sales such as invoices, turnover, taxation documents, etc. New ‘electronic’ evidence tends to substitute them, or has already substituted them, as certified means of payment, orders and confirmations thereof, registrations of safe transactions, etc.

Earlier sign	Case No
Skunk funk (fig.)	R 1464/2010-2
‘[E]xcerpts from third parties’ websites, despite having been printed out on 10 June 2008, contain consumers’ comments about ‘SKUNKFUNK’ clothes and shops dated within the relevant period. In particular, as regards the relevant territory, the documents show various comments made by consumers in Spain and dated December 2004 and February-March-April-May-July 2007. Moreover, as the Opposition Division pointed out, a blog comment (dated 4 March 2007) on the Internet page www.cybereuskadi.com mentions that the opponent (‘designer of Skunkfunk’) ‘exports surf clothes worldwide and has a turnover of nearly 7 million euros per year.’ (para. 21).	

2.4 Place of use

2.4.1 Use on the 'domestic' market

Trade marks must be used in the territory where they are protected (European Union for CTMs, the territory of the Member State for national marks or Benelux for Benelux marks and the territories of the relevant countries for international registrations).

As the Court held in 'Leno Merken' 'the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not' (judgment of 19/12/2012, C-149/11, 'Leno Merken', para. 30). The Court further indicated that use of the mark in non-EU territories cannot be taken into account (para. 38).

In view of the globalisation of trade, an indication of the registered seat of the owner of the mark may not be regarded as sufficient indication that the use has taken place in that particular country. Even though Article 15(1)(b) CTMR stipulates that the affixing of the trade mark to goods or to the packaging thereof in the European Union solely for export purposes is considered as use of the mark, mere indication of the opponent's seat as such does not constitute evidence of such acts. On the other hand, the fact that clients who have their seats outside the relevant territory are listed in the documents for proving use of the earlier mark is in itself not sufficient to rule out that services (e.g. promotion services) may actually have been rendered in the relevant territory for the benefit of these companies located in other territories (decision of 09/06/2010, R 0952/2009-1, 'Global Tabacos', para. 16).

2.4.2 CTMs: use in the European Union¹

If the earlier mark is a Community mark, it must be used 'in the Community' (Articles 15(1) and 42(2) CTMR). Following 'Leno Merken', Article 15(1) CTMR must be interpreted as meaning that the territorial borders of the Member States should be disregarded when assessing whether a CTM has been put to 'genuine use' in the Community (para. 44).

In territorial terms and in view of the unitary character of the CTM, the appropriate approach is not that of political boundaries but of market(s). Moreover, one of the aims pursued by the CTM system is to be open to businesses of all kinds and sizes. Therefore, the size of an undertaking is not a relevant factor to establish genuine use.

As the Court indicated in 'Leno Merken', it is impossible to determine a priori and in the abstract what territorial scope should be applied in order to determine whether the use of the mark is genuine or not (para. 55). All the relevant facts and circumstances must be taken into account, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and scale of the use as well as its frequency and regularity (para. 58).

~~[Amended on 02/05/2013.](#)~~

The Office must determine on a case-by-case basis whether the various indications and evidence can be combined for the purpose of assessing the genuine character of use, the geographical dimension of which is only one of the aspects to be considered.

In any event, it must be underlined that the European requirements or standards for genuine use are applicable (i.e. the conditions of Article 15 CTMR) and not the national standards or practices applied to CTMs.

2.4.3 National marks: use in the relevant member state

If the earlier mark is a national mark with effect in one of the Member States of the European Union, the mark must have been genuinely used in the country where it is protected (Article 42(3) CTMR). Use in a part of the Member State, provided it is genuine, may be considered sufficient:

Case No	Earlier trade mark	Comment
C-416/04 P	VITAFRUT	Use considered sufficient, even though the earlier Spanish mark was not present in a substantial part of the territory of Spain, given that the evidence referred to the sale of everyday consumer goods (concentrated fruit juices) to only a single customer in Spain (para. 60, 66 and 76).

2.4.4 Use in import and export trade

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

Case No	Earlier trade mark	Comment
-		
R 0602/2009-2	RED BARON	The Board indicated that sales in Austria and Great Britain from the Netherlands also constituted genuine use within the meaning of Article 15(1)(b) CTMR (para. 42).

The mark has to be used in the relevant market – that is, the geographical area where it is registered. Evidence that only relates to the **import** of the goods in the relevant area may, depending on the circumstances of the case, suffice as proof of use in this area (see by analogy judgment of 09/07/2010, T-430/08, ‘Grain Millers’, paras 33, 40 *et seq.* regarding the proof of use in the course of trade of a sign on the basis of imports from Romania to Germany).

The Court has held that **transit**, which consists in transporting goods lawfully manufactured in a Member State to a non-member country by passing through one or more Member States, does not involve any marketing of the goods in question and is therefore not liable to infringe the specific subject matter of the trade mark (regarding the transit through France of goods originating in Spain and destined for Poland, see judgment of 23/10/2003, C-115/02, ‘Rioglass and Transremar’, para. 27 and judgment of 09/11/2006, C-281/05, ‘Diesel’, para. 19). Therefore, mere transit through a Member State cannot constitute genuine use of the earlier mark in that territory.

2.5 Time of use

2.5.1 Earlier mark registered for not less than five years

In accordance with Article 42(2) CTMR, the obligation to provide proof of use requires that the earlier registered mark has, at the date of publication of the CTM application, been registered for not less than five years.

For oppositions filed against international registrations designating the EU, the opponent's mark is under use obligation if at the beginning of the opposition period, namely six months after the date of the first re-publication of the international registration, it has been registered for not less than five years.

2.5.1.1 CTMs

The decisive date for establishing whether a trade mark has been registered for not less than five years at the time of publication of the contested application is, according to Article 15 and Article 42(2) CTMR, the registration date of the earlier CTM. If five years or more have elapsed between the registration date of the earlier CTM and the date of publication of the CTM application (or in the case of a contested IR, six months after the date of the first re-publication of the IR), the applicant (or in the case of a contested IR, the holder) is entitled to request proof of use.

2.5.1.2 National marks

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

In view of these differing national proceedings, Article 10(1) of the Directive (which is the equivalent of Article 42 CTMR) refers, as concerns the use requirement for national marks, to the period of *'five years following the date of the completion of the registration procedure'*.

The date of the completion of the registration procedure (Article 10(1) of Directive 2008/95) that serves for calculating the starting point for the obligation of use for national and international registrations (Article 42(2) and (3) CTMR) is determined by each Member State according to their own procedural rules (judgment of 14/06/2007, C-246/05, 'Le Chef de Cuisine', paras 26-28).

The owner of a mark is not expected to make genuine use of the mark in spite of examination or opposition proceedings pending against it, before the five-year grace period mentioned. This is in harmony with the approach towards earlier CTMs, since the registration date of a CTM, which is mentioned in Article 42(2) CTMR as the decisive date for the beginning of the grace period, is always the date of completion of the registration procedure. Furthermore, this interpretation keeps the use requirement under the CTMR in line with the relevant national laws (decision of 06/05/2004, R 0463/2003-1, 'Wrap House', para. 19; decision of 18/06/2010, R 0236/2008-4, 'RENO').

The completion of the registration procedure occurs after a pre-registration opposition or in some Member States even after completion of a post-registration opposition. The exact relevant dates are those published in the OHIM Brochure 'National Law Relating to the CTM', Chapter 12, page 169: http://oami.europa.eu/en/office/diff/pdf/National_la_w.pdf.

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

2.5.1.3 International registrations designating a Member State

Under Article 5(2)(a) and (b) of the Madrid Protocol, the Designated Offices have a period of 12 or 18 months from the date of notification of the designation to issue provisional refusals.

Where the Member State has not been designated in the international application but in a subsequent designation, the 12 or 18 months start from the date the subsequent designation was notified to the Designated Offices.

Member States which use the **12-month deadline** to issue a provisional refusal under the Protocol when acting as a designated party are: Benelux, Czech Republic, Germany, Spain, France, Latvia, Hungary, Austria, Portugal, Romania and Slovenia.

Member States which have opted for the **18-month deadline** to issue a provisional refusal under the Protocol when acting as a designated party are: Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden and the United Kingdom.

The applicable deadline (12 or 18 months) for Bulgaria, Italy, Cyprus, Poland and Slovakia when acting as a designated party depends on whether (i) such country was designated or subsequently designated before or after 01/09/2008 and (ii) the Office of origin is bound by both the Agreement and the Protocol (deadline: 12 months) or only the Protocol (deadline: 18 months).

See overview table below:

Designated country ²	Country of origin	Deadline to issue a refusal
<i>Benelux, Czech Republic, Germany, Spain, France, Latvia, Hungary, Austria, Portugal, Romania and Slovenia,</i> (Contracting EU parties bound by both the Agreement and the Protocol)	<i>All contracting parties</i> [Status 15/01/2013: 89 Member States] ³ (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	12 months
<i>Denmark, Estonia, Ireland, Greece, Lithuania, Finland, Sweden, UK</i> (Contracting EU parties bound by the Protocol only)	<i>All contracting parties</i> [Status 15/01/2013: 89 Member States] (Irrespective of whether they are bound by both the Agreement and the Protocol or the	18 months

² Malta is not part of the Madrid System.

³ For the full list of all Member States to the Madrid Agreement and to the Madrid Protocol see: http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf

	Protocol only)	
<i>Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated before 01/09/2008⁴</i> (Contracting EU parties bound by both the Agreement and the Protocol which have opted for an extended deadline)	<i>All contracting parties</i> [Status 15/01/2013: 89 Member States] (Irrespective of whether they are bound by both the Agreement and the Protocol or the Protocol only)	18 months
<i>Bulgaria, Italy, Cyprus, Poland, Slovakia; if designated or subsequently designated on or after 01/09/2008</i> (Contracting EU parties bound by both the Agreement and the Protocol which have opted for an extended deadline)	<i>Contracting parties bound by both the Agreement and the Protocol</i> [Status 15/01/2013: 55 Member States]	12 months
	<i>Contracting parties bound by the Protocol only</i> [Status 15/01/2013: 33 Member States]	18 months

The Office will, on its own motion, apply the 12-month or 18-month deadline according to the above rules. Deadlines are calculated by adding the relevant periods to the date of notification from which the time limit to notify the refusal starts, indicated by INID code 580 on the ROMARIN extract (i.e. not the date of international registration or subsequent designation) (Rule 18(1)(a)(iii) and Rule 18(2)(a) of the Common Regulations).

Only when it is decisive for determining whether the earlier mark is subject to the proof of use obligation is it for the opponent to claim a date that is later (e.g. when a provisional refusal has been lifted after these dates or if the designated country opted for a period even longer than 18 months for notifying a refusal based on an opposition pursuant to Article 5(2)(c) of the Protocol) and for the applicant or holder to claim a date that is earlier than these dates (e.g. when a Statement of Grant of Protection has been issued before these dates) and to provide the Office with conclusive documentation thereof.

In particular, the Court has confirmed, in relation to an earlier international registration designating Germany, that the date on which an earlier international registration is deemed to have been 'registered' has to be established in accordance with the German law giving effect to the earlier right, and not by reference to the date of registration with the International Bureau of WIPO. Under German trade mark law, if protection for an internationally registered trade mark is provisionally refused but subsequently granted, the registration is regarded as having taken place on the date of receipt by the International Bureau of WIPO of the final notification that protection has been granted. Proper application of Article 42(2) and (3) CTMR and of Article 4(1) of the Madrid Agreement cannot lead to a breach of the principle of non-discrimination (order of 16/09/2010, C-559/08 P, 'Atoz', paras 44, 53-56).

2.5.1.4 International registrations designating the European Union

For international registrations designating the European Union, Article 160 CTMR provides that:

⁴ The date of entry into force of Article 9sexies(1)(b) of the Protocol, which rendered inoperative any declaration under Article 5(2)(b) or (c) of the Protocol (extension of the time limit for notifying a provisional refusal) between Contracting Parties bound by both the Agreement and the Protocol.

For the purposes of applying Article 15(1), Article 42(2), Article 51(1)(a) and Article 57(2), the date of publication pursuant to Article 152(2) shall take the place of the date of registration for the purpose of establishing the date as from which the mark which is the subject of an international registration designating the EU must be put to genuine use in the Community.

As from that publication the international registration has the same effects as a registered CTM pursuant to Article 151(2) CTMR.

2.5.2 Relevant time frame

If the earlier mark is subject to the use requirement at all (registered for not less than five years), the actual period for which use must be shown can simply be computed backwards from the publication date.

For example, if the contested CTM application was published on 15/06/2012 and the earlier mark was registered on 01/04/2000, the opponent would have to prove genuine use of its mark within the period beginning on 15/06/2007 and ending on 14/06/2012.

For oppositions filed against international registrations designating the EU, the opponent's mark is under the use obligation if, at the beginning of the opposition period (which is six months after the date of the first re-publication of the international registration), it has been registered for not less than five years. For example, if the contested international registration was published on 15/06/2009 and the earlier mark was registered on 01/04/1996, the opponent would have to prove genuine use of its mark within the period beginning on 15/12/2004 and ending on 14/12/2009.

In the event that the European Union has not been designated in the international application but in a subsequent designation, the 18 months start from the date that the subsequent designation was notified to the OHIM. See decision of 20/12/2010, R 0215/2010-4 'Purgator':

From the day of the subsequent designation of the European Community, an international registration has the same effect as the application for a Community trade mark, against which opposition can be raised. Publication of the date of the subsequent designation will take the place of publication of the application of the Community trade mark (Article 152 CTMR). In the present case, publication of the date of the subsequent designation of the European Community took place on 8 October 2007. At this point, the earlier trade marks with a registration date of 14/06/2005 had not yet been registered for five years and was not subject to a requirement of use.

Any use or non-use before or after the last five years is in general immaterial. Evidence referring to use made outside this time frame is disregarded, unless it constitutes conclusive indirect proof that the mark must have been put to genuine use also during the relevant time. The Court held in this context that circumstances subsequent to the relevant point of time may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time (order of 27/01/2004, C-259/02, 'Laboratoire la mer', para. 31).

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

The use need not have been made throughout the period of five years, but rather within the five years. The provisions on the use requirement do not require continuous use (judgment of 16/12/2008, T-86/07, 'Deitech', para. 52).

2.5.3 Summary

Earlier mark	Calculation of the beginning of the 5-year period (grace period)
CTM	Date of registration
National mark	By default, date of registration or of completion of registration proceedings if proven by opponent.
IR designating Member States	By default, 12 or 18 months after the date of notification from which the time limit to notify the refusal starts (INID code 580). Can be earlier or later if proven by parties.
IR designating the EU	Date of the second re-publication of the EU designation in part M.3. of the Bulletin.

Contested mark	Calculation of the 5-year period to prove genuine use of opposing mark (relevant time)
CTMA	5 years counted back from date of publication of the CTMA in Part A of the CTM Bulletin.
IR designating the EU	5 years counted back from date of re-publication of the IR (or the subsequent designation of the EU) in part M.1. of the CTM Bulletin + 6 months (corresponding to beginning of opposition period. Second date published under INID code 441).

2.6 Extent of use

2.6.1 Criteria

In this regard, it has to be evaluated whether, in view of the market situation in the particular industry or trade concerned, it can be deduced from the material submitted that **the owner has seriously tried to acquire a commercial position in the relevant market**. The trade mark has to be used for goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (judgment of 11/03/2003, C-40/01, 'Minimax', para. 37). This does not mean that the opponent has to reveal the total volume of sales or turnover figures.

Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the **commercial volume** of all the acts of use on the one hand and the **duration** of the period in which those acts of use occurred as well as the **frequency** of those acts on the other (judgment of 08/07/2004, T-334/01, 'Hipoviton', para. 35).

The assessment entails a *degree of interdependence between the factors* taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa (judgment of 08/07/2004, T-203/02, 'VITAFRUIT', para. 42).

Under certain circumstances, even *circumstantial evidence* such as catalogues featuring the trade mark, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment (judgment of 08/07/2010, T-30/09, 'peerstorm', para. 42 *et seq.*).

Use does not have to be made during a minimum period of time to qualify as 'genuine'. In particular, *use does not have to be continuous* during the relevant period five years. It is sufficient if the use had been made at the very beginning or end of the period, provided that this use was genuine (judgment of 16/12/2008, T-86/07, 'Deitech').

The exact *decisive threshold* proving genuine use cannot be defined out of context. The turnover and volume of sales of the product must always be assessed in relation to all the other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. Use need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market (judgment of 11/03/2003, C-40/01, 'Minimax', para. 39; judgment of 08/07/2004, T-203/02, 'Vitafruit', para. 42).

Low turnover and sales, in absolute terms, of a medium- or low-priced product might support the conclusion that use of the trade mark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient (decision of 04/09/2007, R 0035/2007-2, 'Dinky', para. 22). It is, therefore, always necessary to take the characteristics of the market in question into account (judgment of 08/07/2004, T-334/01, 'Hipoviton', para. 51).

A *de minimis* rule cannot be laid down. Use of the mark by a single client, which imports the products for which the mark is registered, can be sufficient to demonstrate that such use is genuine if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (order of 27/01/2004, C-259/02, 'Laboratoire de la mer', para. 24 *et seq.*).

It is irrelevant that the use has been made with the same customer, as long as the trade mark is used publicly and outwardly and not solely within the undertaking which owns the earlier trade mark or within a distribution network owned or controlled by that undertaking (judgment of 08/07/2004, T-203/02, 'VITAFRUIT', para. 50).

However, 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 possible doubts as to its genuineness (judgment of 08/07/2004, T-334/01, 'Hipoviton', para. 37).

Concerning the ratio between the turnover generated by the sales of products under the earlier mark and the applicant's annual turnover, it should be noted that the degree of diversification of the activities of undertakings operating in one and the same market varies. Moreover, the obligation to produce evidence of genuine use of an earlier trade mark is not designed to monitor the commercial strategy of an undertaking. It may be economically and objectively justified for an undertaking to market a product or a range of products even if their share in the annual turnover of the undertaking in question is minimal (judgment of 08/07/2004, T-334/01, 'Hipoviton' para. 49).

Special circumstances, for example lower sales figures during the initial marketing phase of a product, could be of relevance when assessing the genuineness of the use (judgment of 08/07/2004, T-334/01, 'Hipoviton', para. 53).

2.6.2 Examples of insufficient use

Case No	Comment
'WALZERTRAUM', paras 32 ff. (appeal pending C-141/13 P)	The opponent, a German bakery located in a city of 18,000 inhabitants, proved constant monthly sales of approximately 3.6 kg of exclusive, handmade chocolates over a period of 22 months. Despite being advertised on a web page accessible throughout the world, the chocolates could only be ordered and bought in the opponent's bakery. In view of the territorial and quantitative limits, the GC considered that use had not been sufficiently proven.
Judgment of 30/04/2008, T-131/06, 'SONIA SONIA RYKIEL'	54 units of women's slips and 31 units of petticoats were sold over a period of 13 months, for a total sum of EUR 432. The GC considered these modest quantities with regard to the relevant market (everyday consumption goods, sold at a very reasonable price) to be insufficient.
Decision of 27/02/2009, R 0249/2008-4 – 'AMAZING ELASTIC PLASTIC II'	500 plastic balloon kits given away as 'samples' free of charge cannot constitute genuine use.
Decision of 20/04/2001, R 0378/2000-1 – 'Renacimiento'	The Board of Appeal confirmed the decision of the Opposition Division that the submission of one bill of lading showing the delivery of 40 packages of sherry is insufficient to prove genuine use.
Decision of 09/02/2012, R 0239/2011-1 – 'GOLF WORLD' (B 1 456 443, Golf World)	As the only evidence of use for <i>printed matter</i> , the opponent submitted evidence which proved 14 subscribers for a magazine in Sweden. The OD held that this is insufficient to prove genuine use in Sweden, particularly taking account of the fact that magazines are not high-priced articles.
R 2132/2010-2, – 'SUSURRO (fig.)'	Nine invoices concerning the sale of wine in 2005, 2006, 2007 and 2008 showing that over a period of 36 months goods marketed under the earlier mark and worth EUR 4 286.36 were sold, as well as an undated sample of a product label were not considered as sufficient proof of genuine use of a Spanish trade mark registered for 'alcoholic drinks (except beers)' in Class 33. The evidence showed that the sales of wine had been made in a small, very provincial, part of Spain. For a country with over 40 million inhabitants, the amount sold of a relatively cheap wine was found to be too small to create or preserve an outlet for goods (wine) that are consumed in large quantities by the average Spanish consumer.
Decision of 07/07/2011, R 0908/2010-2 – 'ALFA-REN'	Table of sales figures for ALFACALCIDOL products in Lithuania between 2005 and 2008, indicating products sold by Teva Corp. under the trade mark 'ALPHA D3' (source: IMS health database, Lithuania); an undated copy of packaging for a product 'ALPHA D3' (undated); and a copy of an advertisement for 'ALPHA D3' products sold in Lithuania (not translated) were found insufficient to show genuine use of the mark in Lithuania. It could not be seen from the evidence submitted whether the marked goods were actually distributed and, if so, the quantities involved.
Decision of 16/03/2011, R 0820/2010-1 – 'BE YOU'	Sales of goods with profits below EUR 200 during the 9-month period of use were not considered sufficient proof of genuine use of the opposing mark in respect of the goods in Class 14.
Decision 06/04/2011, R 0999/2010-1 – 'TAUTROPFEN CHARISMA (fig.)'	Eleven invoices showing that 13 units of 'perfumery' goods were sold in Spain between 2003 and 2005, for a total amount of EUR 84.63, were deemed as insufficient proof of genuine use of the sign. Account has been taken of the fact that the goods were intended for daily use and available at a very affordable price.

Case No	Comment
Decisión of 27/10/2008, B 1 118 605, 'Viña la Rosa'	Photocopies of three independent wine guides mentioning the opponent's trade mark (without further explanation as to the volume, edition, publisher, etc.) were not considered sufficient to prove use for wines.
Decision of 21/06/1999, B 70 716, 'Oregon'	The Opposition Division found an invoice for 180 pairs of shoes as insufficient to prove genuine use.
Decision of 30/01/2001, B 193 716, 'Lynx'	As evidence of use the opponent filed two invoices for a total amount of 122 items of clothing and four undated labels with no indication of what goods they were to be affixed to. The Opposition Division considered them insufficient.

2.6.3 Examples of sufficient use

Case No	Comment
Judgment of 16/11/2011, T-308/06, 'BUFFALO MILE Automotive Polishing Products, para. 68	Nine invoices dated between April 2001 and March 2002 representing sales of around EUR 1 600 (with a turnover figure barely above EUR 1 000 000 per year) and showing that items were delivered to different customers in small quantities (12, 24, 36, 48, 60, 72 or 144 pieces), for widely-used products like shoe polish, in the largest European market, Germany, with approximately 80 million potential consumers, were deemed as providing evidence of use that objectively is such as to create or preserve an outlet for polishing cream and leather conditioner. Furthermore, the volume of sales, in relation to the period and frequency of use, was deemed to be significant enough not to be concluded as merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. Confirmed by the GC.
Judgment of 10/09/2008, T-325/06, 'CAPIO', paras 48, 60	Evidence (invoices, lists of sales) proving that the intervener sold 4 hollow-fibre oxygenators with detachable hard-shell reservoirs in Finland in 1998, 105 in 1999 and 12 in 2001, for a total amount of EUR 19 901.76, was deemed sufficient proof of genuine use of the CTM registered for 'oxygenators with integrated pump; controllers for integrated pump; regulating devices of air pressure for integrated pump; suction pumps; blood flow meters', in Class 10.
Judgment of 27/09/2007, T-418/03, 'LA MER', paras 87-90	Ten invoices over a period of 33 months, regarding several product ranges, the packaging of which bears the trade mark concerned, with numbers very far apart (22 214 for the invoice of 3 January 1995, 24 085 for that of 4 May 1995, 24 135 for that of 10 May 1995 and 31 348 for that of 26 March 1997), showing that the sales were made to different persons, were deemed as permitting the inference that they had been submitted merely by way of illustration of total sales but not as showing that the trade mark was used publicly and outwardly rather than solely within the undertaking that owned the earlier trade mark or within a distribution network owned or controlled by that undertaking. Nevertheless, the sales effected, while not considerable, were deemed as constituting use that objectively was such as to create or preserve an outlet for the products concerned and entailing a volume of sales that, in relation to the period and frequency of use, was not so low as to allow the conclusion that the use was merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark.

Case No	Comment
Judgment of 25/03/2009, T-191/07, 'BUDWEISER'	The Board of Appeal (decision of 20/03/2007, R 0299/2006-2 – 'BUDWEISER/earlier international word mark BUDWEISER', para. 26) found, essentially, that the documents presented to it during the administrative proceedings – invoices proving the sale of beer in France amounting to more than 40 000 litres between October 1997 and April 1999, 23 invoices issued in Austria between 1993 and 2000 to a single buyer in Austria, and 14 invoices issued in Germany between 1993 and 1997 – were sufficient to demonstrate the extent of use of the earlier international word mark BUDWEISER (IR No 238 203) in those countries. The Board's findings were confirmed by the GC.
Judgment of 11/05/2006, C-416/04 P, 'Vitafruit', paras 68-77	Evidence of the sale to a single customer in Spain of concentrated fruit juices during a period of eleven and a half months with a total volume of sales of EUR 4 800, corresponding to the sale of 293 cases of 12 items each, was considered sufficient use of the earlier Spanish trade mark.
Judgment of 08/07/2010, T-30/09, 'peerstorm', paras 42, 43	As evidence of use, the opponent (merely) provided several catalogues for end consumers, featuring the relevant trade mark on clothing articles. The Court held that '...it is true that those catalogues provide no information on the quantity of goods actually sold by the intervener under the trade mark PETER STORM. However, it is necessary to take into account ... the fact that a large number of items designated by the trade mark PETER STORM were offered in the catalogues and that those items were available in more than 240 shops in the United Kingdom for a significant part of the relevant period. Those factors support the conclusion, in the context of a global assessment ... that the extent of its use was fairly significant.'
Decision of 04/09/2007, R 0035/2007-2 – 'DINKY'	The sale of approximately 1 000 miniature toy vehicles was considered sufficient extent of use in light of the products being sold mainly to collectors at a high price in a particular market.
Decision of 11/10/2010, R 0571/2009-1 – 'VitAmour'	The sale of 500 kg of milk proteins for a total value of EUR 11 000 was considered sufficient to prove genuine use for <i>milk proteins for human consumption</i> . In view of the nature of the products, which are not consumer goods but ingredients for use by the food processing industry, the amount and values shown did demonstrate a market presence above the threshold required.
Decision of 27/07/2011, R 1123/2010-4 – 'Duracryl'	Eleven invoices made out to different undertakings in various regions of Spain, showing that the proprietor of the mark sold, in the relevant period and under the mark, 311 containers of the product, in different sizes, for a net amount of EUR 2 684, were deemed sufficient to prove genuine use of a mark registered for 'preservatives against deterioration of wood' in Class 2.
Decision of 01/02/2011, B 1 563 066	An annual turnover of more than EUR 10 million over several years was claimed for medical preparations. The corresponding invoices (one per relevant year) only proved actual sales of about EUR 20 per year. In an overall assessment, and in the context of further material submitted such as price lists, a sworn statement, packaging and advertising material, the Office found this sufficient to prove genuine use.
Decision of 26/01/2001, B 150 039	The Opposition Division regarded evidence of sales for around 2 000 furry toy animals in a high-priced market sector as sufficient.
Decision of 18/06/2001, B 167 488	The opponent submitted one invoice referring to the sale of one high-precision laser cutting machine for FRF 565 000, a catalogue describing its performance and some photographs depicting the product. The Opposition Division considered them as sufficient evidence taking into account the nature of the product, the specific market and its considerably high price.

2.7 Use of the mark in forms different from the one registered

2.7.1 Introduction

Article 15 CTMR states that use of the mark in a form different from the one registered still constitutes use of the trade mark as long as the differing elements do not alter the distinctive character of the trade mark.

The purpose of this provision is to allow its proprietor to make variations in the sign which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (judgment of 23/02/2006, T-194/03, 'Bainbridge', para. 50).

The General Court (the 'GC') further mentioned that strict conformity between the sign as used and the sign registered is not necessary. However, the difference must be in negligible elements and the signs as used and registered must be broadly equivalent (judgment of 23/02/2006, T-194/03, 'Bainbridge', para. 50).

In order to decide whether the sign as used and the sign as registered are broadly equivalent, it must first be established which elements are negligible. The GC has developed criteria for doing so in several judgments.

Paragraph 2.7.2 will deal with these criteria. Paragraph 2.7.3 will describe Office practice in relation to the 'variation' of marks, 'additions' of elements to marks and 'omissions' of elements of marks.

Finally, it should be noted that, in order to establish use of the trade mark for the purposes of Article 15(1)(a) CTMR, the proprietor of a registered trade mark is not precluded from relying on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, **even if that different form is itself registered as a trade mark** (judgment of 25/10/2012, C-553/11, 'Rintisch', para. 30).

2.7.2 Criteria of the Court

In brief, the test developed by the Court consists of first determining what the distinctive and dominant elements of the registered sign are and then verifying if they are also present in the sign as used.

The GC has held that:

the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (judgment of 24/11/2005, T-135/04, 'Online Bus', para. 36).

With regard to **additions**:

- Several signs may be used simultaneously without altering the distinctive character of the registered sign (judgment of 08/12/2005, T-29/04, 'Cristal Castellblanch', para. 34).
- If the addition is not distinctive, is weak and/or is not dominant, it does not alter the distinctive character of the registered trade mark (judgment of 30/11/2009, T-353/07, 'Coloris', paras 29-33 *et seq.*, judgment of 10/06/2010, T-482/08, 'Atlas Transport', paras 36 *et seq.*).

With regard to **omissions**:

- If the omitted element is in a secondary position and not distinctive, its omission does not alter the distinctive character of the trade mark (judgment of 24/11/2005, T-135/04, 'Online Bus', para. 37).

2.7.3 Office practice

In general, it has to be assessed whether the use of the mark constitutes an acceptable or unacceptable 'variation' of its registered form.

Therefore, there are two questions to be answered. Firstly, it must be clarified what is to be regarded as the distinctive character of the mark as registered⁵. Secondly, it must be evaluated whether the mark as used alters this distinctive character. These questions have to be answered on a case-by-case basis.

There is *interdependence* between the strength of the distinctive character of a mark and the effect of alterations. Marks of strong distinctive character may be less influenced by changes than marks of limited distinctiveness. Adding elements to or omitting elements from the mark are more likely to affect the distinctive character of marks of limited distinctiveness.

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

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

The following sections contain a number of practical guidelines for assessing whether additions (paragraph 2.7.3.1), omissions (paragraph 2.7.3.2) and alterations (paragraph 2.7.3.3) in the form of the sign as used alter the distinctive character of the registered trade mark.

⁵ See The Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 4, Distinctiveness.

2.7.3.1 Additions

As indicated above, with regard to additions, (i) several signs may be used simultaneously without altering the distinctive character of the registered sign and (ii) if the addition is non-distinctive or weak and/or not dominant, it does not alter the distinctive character of the registered trade mark.

The following sections provide examples of these two types of scenarios:

- use of several signs simultaneously;
- additions of other verbal elements;
- additions of figurative elements.

Use of several marks or signs simultaneously

It is quite common in some market areas for goods and services to bear not only their individual mark, but also the mark of the business or product group ('house mark'). In these cases, the registered mark is not used in a different form, but the two independent marks are validly used at the same time.

There is no legal precept in the Community trade mark system which obliges the opponent to provide evidence of the earlier mark alone when genuine use is required within the meaning of Article 42 CTMR. Two or more trade marks may be used together in an autonomous way, with or without the company name, without altering the distinctive character of the earlier registered trade mark.

The Court has confirmed that the condition of genuine use of a registered trade may be satisfied both where it has been used as part of another composite mark or where it is used in conjunction with another mark, even if the combination of marks is itself registered as a trade mark (judgment of 18/04/2013, C-12/12, 'SM JEANS/LEVI'S', para. 36.)

Registered form	Actual use	Case No
CRISTAL	  	T-29/04

'In the present case the mark CRISTAL appears clearly four times on the neck of the bottle marketed by the intervener and twice on the main label, accompanied by the symbol ®. On the neck, that mark is separate from the other elements. In addition, the mark CRISTAL appears alone on the boxes in which bottles of the mark CRISTAL are marketed. Equally, on the invoices produced by the intervener reference is made to the term 'cristal' with the mention '1990 coffret'. It should be noted that the mark CRISTAL thus identifies the product marketed by the intervener' (para. 35).

'As regards the mention 'Louis Roederer' on the main label, it merely indicates the name of the manufacturer's company, which may provide a direct link between one or more product lines and a specific undertaking. The same reasoning applies to the group of letters 'lr' which represents the initials of the intervener's name. As pointed out by OHIM, joint use of those elements on the same bottle does not undermine the function of the mark CRISTAL as a means of identifying the products at issue' (para. 36).

'Furthermore, OHIM's finding that the use of the word mark together with the geographical indication 'Champagne' cannot be considered to be an addition capable of altering the distinctive character of the trade mark when used for champagne must be endorsed. In the wine sector the consumer is often particularly interested in the precise geographical origin of the product and the identity of the wine producer, since the reputation of such products often depends on whether the wine is produced in a certain geographical region by a certain winery' (para. 37).

'In those circumstances it must be held that the use of the word mark CRISTAL together with other indications is irrelevant and that the Board of Appeal did not infringe Article 15(2)(a) of Regulation No 40/94, Article 43(2) and (3) thereof, or Rule 22(2) of the implementing regulation' (para. 38).

Registered form	Actual use	Case No
L.114	Lehning L114	T-77/10 and T-78/10
<p>L.114 is a French trade mark registered for 'pharmaceutical products' in Class 5.</p> <p>The Court found that:</p> <ol style="list-style-type: none"> 1) the missing full-stop between the capital letter 'L' and the number 114 constituted a minor difference which did not deprive earlier mark L.114 of its distinctive character (para. 53). 2) the fact that earlier mark 'L.114' was used together with the house mark 'Lehning' was insignificant and did not alter its distinctive character within the meaning of Article 15(1)(a) CTMR (para. 53). 		

Registered form	Actual use	Case No
YGAY	YGAY together with a number of other verbal and figurative elements	R 1695/2007-1 (confirmed by T-546/08)
<p>In the Board's decision (confirmed by the Court in T-546/08, paras 19, 20) it was pointed out that the trade</p>		

mark YGAY appears in many photographs on both the label and the box in which the bottle is sold. On the labels, the trade mark in question is separated from the other elements. On some labels, it appears on its own, beneath the phrase MARQUES DE MURRIETA, written in large bold letters. On others, the phrase BODEGAS MARQUES DE MURRIETA is written in small letters in the upper part, while the elements CASTILLO YGAY are written in large, stylised letters across the label. The trade mark YGAY also appears on its own or together with the phrase CASTILLO YGAY on the boxes in which the bottles are sold. Reference is also made, on the invoices submitted by the opponent, to the trade mark YGAY, along with general information such as the year of production and origin, etc. It follows, therefore, that the sign YGAY functions as the trade mark identifying the goods, 'wine', sold by the opponent (para. 15).

The mention of MARQUES DE MURRIETA in this context might merely be an indication of the name of the manufacturer's company or the vineyard that produces and sells the wine, which might provide a direct link between one or more product lines and a specific undertaking (see Court of First Instance (CFI) judgment of 08/12/2005, T-29/04, 'Cristal Castellblanch', para. 36) (para. 16).

However, the opponent **must provide evidence** that the additional sign is in fact an independent mark or sign, which refers, for instance, to the company mark, the manufacturer, etc.

Registered form	Actual use	Case No
MINUTO	DUBOIS MINUTO	R 0206/2000-3
<p>The Board of Appeal regarded the presentation of the two words as the use of two separate marks, since the evidence submitted by the opponent showed that one of them was an old brand of the opponent with its own identity and that this mark was present on the market with a number of accompanying signs, as is common practice in the labelling of the specific products (wine).</p> <p>'DUBOIS' and 'MINUTO' are separate marks which are affixed together in the concrete product, as is common practice in the labelling of wine products (name of the winery and name of the product). As regards Spanish brands see for example 'TORRES' - 'Sangre de Toro', 'TORRES' - 'Acqua d'Or'. When asking for 'MINUTO' wine, the relevant consumer will be aware that such wine is included within the line of products 'DUBOIS', however, 'MINUTO' will be perceived as a trade mark of its own, even if it may appear next to the sign 'DUBOIS' in the invoices, brochures and/or product labels' (para. 18).</p>		


On the other hand, the genuineness of use could be put into doubt in cases where the registered mark might be perceived as a **mere decorative element** due to additional, very dominant, use of other marks.

Furthermore, use is deemed to be of one **composite mark**, rather than two or more marks, where the different elements appear as a **'unitary whole'**. This is the case where they are actually merged together.

Addition of other verbal elements

In principle, a difference in words or even letters constitutes an alteration of the distinctive character of the mark. However, in the following three paragraphs a number of situations are described where additions are acceptable. The fourth paragraph provides examples of unacceptable additions.

Additions of non-dominant elements

Registered form	Actual use	Case No
COLORIS		T-353/07
<p>The GC confirmed that the use of the mark <i>Coloris</i> with additional word elements such as 'global coloring concept' or 'gcc' did not alter its distinctive character because the additional elements were merely used together with the mark <i>Coloris</i> and <u>positioned below it</u> and were of such a size that they were <u>not predominant</u> in that mark.</p> <p>The same finding applies with even greater force to the additional words (global coloring concept) as <i>they are words with a general meaning and the word 'coloring' refers to the goods concerned and, consequently, has a certain descriptive character.</i></p>		

Additions with generic or descriptive meaning

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

For example:

Registered form	Actual use	Case No
FANTASIA	FANTASIA 2000	R 1335/2006-2
<p>'It is clear from the evidence (in particular, from the <i>Film Journal International</i> article) that 'Fantasia 2000' is a new version of the original Walt Disney film 'Fantasia' produced in 1940, created in the spirit of the original: a sequence of animated scenes set to classical music. Hence, the number '2000' is merely a reference to the new edition of the film and as such, it does not constitute an alteration which would preclude, in itself, that title from being taken into account as proof of use of the word 'Fantasia' protected by the earlier registration, in accordance with Article 15(2)(a) CTMR' (para. 22).</p>		

Other acceptable additions


The addition of **insignificant prepositions** does not alter distinctive character:

Registered form	Actual use	Case No
CASTILLO DE PERELADA	CASTILLO PERELADA	B 103 046
<p>It is not considered that absence of use of the word 'de' affects the distinctive character of the trade mark.</p>		

In the same way, the use of **plural or singular forms** or vice versa ,does not alter distinctive character:

Registered form	Actual use	Case No
Tentation	Tentations	R 1939/2007-1
<p>'In the present case, and after examination of the evidence submitted, which focuses essentially on the Spanish market, the Board is of the opinion that use of the registered trade mark 'TENTATION' through use of the sign 'TENTATIONS' does not alter the distinctive character of the original registered trade mark. Specifically, the mere addition of the letter 'S' to the end of the trade mark neither substantially alters the visual appearance or pronunciation of the registered trade mark nor creates a different conceptual impression on the Spanish market. The trade mark in question will be perceived merely as being in the plural instead of the singular. Therefore, this change does not alter the distinctive character of the sign' (para. 17).</p>		

The addition of the '**type of enterprise**' is also acceptable:

Registered form	Actual use	Case No
	<p>The used form contained the logo plus the words 'SOCIEDAD LIMITADA' (in small letters) underneath the term 'SISTEMAS' and/or the 'E' device with the words 'epco SISTEMAS, S.L.' in bold</p>	<p>R 1088/2008-2 Confirmed by T-132/09</p>
<p>'...these signs are not, as the applicant seems to suggest, significant alterations of the distinctive character of the earlier mark as registered' (para. 24).</p>		


Unacceptable additions


Registered form	Actual use	Case No
Captain	Captain Birds Eye	R 0089/2000-1
<p>'It cannot be considered ... that the use of CAPTAIN BIRDS EYE constitutes use of the mark CAPTAIN in a form which does not alter the distinctive character of the mark as registered, since the two signs appear essentially different' (para. 20).</p>		

Registered form	Actual use	Case No
ECO	ECOORD-ECO, ECOCOM-ECO, ECOSEM-ECO	R 0634/2009-4
<p>'The opponent relies further on a set of 75 invoices, in which not the opponent's mark as such is indicated but the terms ECOORD-ECO, ECOSEM-ECO and ECOCOM-ECO. None of these constitutes the form as registered. ... The opponent's argument that the terms ECOORD, ECOSEM and ECOCOM are negligible, descriptive terms cannot be accepted. It is irrelevant if it was the intention of the opponent to place descriptive elements in front of its trade mark. The decisive point is whether the consumers perceive these additional elements as mere descriptive prefixes or rather as genuine, distinctive elements ... The terms as such have no meaning in Italian and the explanations provided by the opponent in solving the rather complex acronyms cannot be regarded as self-explanatory for the Italian consumers. They appear to be fanciful and distinctive, forming an integral part of the marks' (paras 17-20).</p> <p>'Finally, the terms used in the invoices have different prefixes and are three times longer than the original mark. Moreover, the combinations used, ECOORD, ECOSEM and ECOCOM, have their own distinctive character and they are placed at the beginnings of the marks, to which the consumer pays generally more attention. For these reasons, the use of the terms ECOORD-ECO, ECOSEM-ECO and ECOCOM-ECO cannot be regarded as a slightly different use of the earlier mark' (para. 21).</p>		

Addition of figurative elements

In cases where the figurative element plays only a minor role, the distinctive character of the sign as registered is not affected.

Registered form	Actual use	Case No
BIONSEN		R 1236/2007-2
<p>'Moreover, this material shows that the respondent's products also contain other elements, in particular a Japanese character within a small circle, which is depicted either above or below the word 'BIONSEN' (para. 19).'</p> <p>'However, in the present case, the combination of the stylized form of the word 'BIONSEN' and the Japanese character, independently of whether it is above or under the word 'BIONSEN', constitutes at the most use which differs from the form in which it was registered only in negligible elements. The word 'BIONSEN' as used is merely a slight and banal stylization of the word 'BIONSEN'. As to the addition of the figurative element in the form of a circular element with a Japanese character, this will hardly be noticed by the average consumer due to its relatively small size and position, either under or on the right side above the word 'BIONSEN' (para. 23).</p>		

Registered form	Actual use	Case No
BLUME	Sign used in connection with the following figurative element: 	R 0681/2001-1
<p>'As regards the trade mark BLUME No 1 518 211, the Opposition Division correctly held that the addition of the figurative element ... does not alter the distinctive character of the trade mark BLUME since the word 'BLUME' is separated from the device element, which is clearly legible and written in block letters' (para. 22).</p>		



On the other hand the addition of a figurative element can *alter* the distinctive character of a mark if this figurative element is not seen as a mere decorative element but is *dominant and distinctive in the overall impression of the mark*.

2.7.3.2 Omissions

When considering 'omissions' of elements of a mark in its used form, care has to be taken to check that the distinctive character of the mark has not been altered.

If the omitted element is in a **secondary position and not distinctive**, its omission does not alter the mark (judgment of 24/11/2005, T-135/04, 'Online Bus').



Omissions of non-dominant elements

Registered form	Actual use	Case No
		T-135/04
<p>The GC considered that both the registered form of the earlier mark and the form used included the word 'BUS' and the figurative element of 'three interlaced triangles'. The presentation of the elements is not particularly original or unusual in either form. The variation in them does not affect the distinctive character of the trade mark. As regards the omission of 'Betreuungsverbund für Unternehmer und Selbständige e.V.', the latter was 'a string of words, written in small characters and occupying a secondary position, at the bottom of the sign. Its meaning (Association for the assistance of businessmen and the self-employed, registered association) refers to the services in question. Therefore, in the light of the descriptive content of that element and its accessory position in the presentation of the sign, it must be held that it is not distinctive ... It follows from the foregoing that the form used of the earlier trade mark used does not contain any differences such as to alter the distinctive character of that trade mark' (paras 34 <i>et seq.</i>).</p>		

Omissions of generic or descriptive elements

Where a registered mark contains a **generic** indication of the product or **descriptive** term, and this term is omitted in the used form of the sign, such use will be considered as use of the registered mark.

Omissions which are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, in general constitute use of an acceptable variant.

Registered form	Actual use	Case No ⁶
		T-415/09 (confirmed by C-621/11 P)
<p>The Board considered that although in <i>some pieces</i> of evidence the earlier mark did not include the word 'beachwear' <i>this does not alter the distinctiveness of the earlier mark because it is plainly descriptive of the nature of the goods</i> ('T-shirts, beachwear'). The GC held: 'In the present case, the earlier mark is a composite mark, representing a ship's wheel, that is to say, a sign with a rounded shape. In the centre of the sign there is a fish skeleton, at the top of which is written the term 'fishbone', and at the bottom the term 'beachwear'. ... [A]lthough the use of the earlier mark varies in certain items of evidence and is used in a form different from that under which it was registered, in the sense that the sign does not include the term 'beachwear', such a fact does not affect its distinctive character. The term 'beachwear', which means 'beach clothing' in English, is descriptive of the nature of the goods covered by the earlier mark [emphasis added]. That descriptive character is obvious in the case of the 'beach clothing' covered by the earlier mark, but also in the case of 't-shirts', for which the term 'beachwear' will immediately be perceived as meaning that it refers to a t-shirt to be worn in casual situations, for example, on the beach in summer. Consumers will thus understand that term as</p>		

⁶ Amended on 02/06/2014.



designating the type of goods and will not perceive it as an indication of their commercial origin. The fact that the term 'beachwear' is written in a more fanciful font than that of the term 'fishbone', which is written in ordinary capital letters, cannot alter such an assessment. Furthermore, the font of the term 'beachwear' cannot be regarded as uncommon, since it comprises printed lower-case characters. As for the horizontal position of the term 'beachwear' in the earlier mark, which runs in a perpendicular sense across the bottom of a ship's wheel, it is no more graphically incisive than that of the term 'fishbone' which, also written horizontally, follows the rounded shape of that wheel' (paras 62-63).

Other acceptable omissions

The omission of **insignificant prepositions** does not alter the distinctive character:

Registered form	Actual use	Case No
CASTILLO DE PERELADA	CASTILLO PERELADA	B 103 046
It is not considered that absence of use of the word 'de' affects the distinctive character of the trade mark.		

There are instances where the earlier sign is composed of a distinctive verbal element (or several) and a figurative element (or several), with the latter perceived by the relevant public as banal. Such banal elements are considered non-distinctive, and their omission does not change the distinctive character of the sign. Therefore, it is important to establish which elements influence the distinctive character of the mark and how consumers will perceive them.

Registered form	Actual use	Case No
	CHLOREX	R 0579/2008-2
<p>OD: 'In all the evidence submitted (advertising pamphlets, invoices), the trade mark "CHLOREX" is used as a word mark. The earlier French trade mark is a figurative mark "  ", formed by the word "CHLOREX" on top of a figurative element. This figurative element is formed by two test tubes included in a triangle ... The figurative elements of the mark do not significantly dominate the verbal element of the mark. Therefore the documents presented as the proof of use of the earlier mark as a word mark can be accepted as the use of the mark according to Article 15 (2)(a) CTMR, as the omissions of the figurative elements do not affect the distinctive character of the mark, which is dominated by the verbal element.'</p> <p>The Board: 'As the contested decision found, in all the evidence submitted (advertising pamphlets, invoices) by the opponent as proof of use of the earlier marks, the trade mark 'CHLOREX' is used only as a word mark. The contested decision found that this use was sufficient to prove the use of the figurative earlier mark No 1 634 632, the only one taken into account by the contested decision, which is challenged by the applicant only on the ground that the omission of the figurative element alters the distinctive character of this mark. This objection must be rejected for the reasons given by the contested decision to which the Board refers' (para. 23).</p>		


The omission of the **transliteration of a term** is generally considered as an acceptable alteration.


Registered form	Actual use	Case No
ΑΡΑΛΙΑ-ΑΠΑΛΙΑ	APALIA	R 2001/2010-1
The omission of the transliteration of the term in Greek characters does not alter the distinctive character		

of the mark as the form used contains the term APALIA, which is distinctive and dominant.

Unacceptable omissions


In principle, a difference in **words or even letters** constitutes an alteration of the distinctive character of the mark.

Registered form	Actual use	Case No
TONY HAWK	HAWK 	B 1 034 208
<p>'[T]he absence of the word element 'TONY' in the first two marks significantly alters the distinctive character of the registered earlier mark 'TONY HAWK'. Therefore, these marks shall be perceived as separate marks and their use cannot be considered as the use of the word mark 'TONY HAWK'.</p>		

Registered form	Actual use	Case No
 (in Spain)	Figurative (without 'Light Technology' or only with the term 'Light' and other verbal elements) or in word form	R 1625/2008-4 (appeal T-143/10 did not refer to the Spanish trade marks)
<p>'In the present case, the Board has been able to verify that none of the items of proof of use supplied reproduces the earlier Spanish signs in the form in which they were registered, since either the mark is represented in its purely visual form, that is, without the expression 'light technology', or the visual element is accompanied only by the term 'Light' and other word elements or the expression 'LT Light-Technology', which is also in the form of a word lacking the visual element which obviously characterises the earlier Spanish marks on which the opposition is based ... Under these circumstances, and in view of the fact that the modifications made to the representation of earlier marks modify their distinctive character, it is considered that, in any case, the proof submitted does not demonstrate use of the Spanish marks on which the opposition is based' (paras 15, 16).</p>		

Registered form	Actual use	Case No
SP LA SPOSA	LA SPOSA LA SPOSA COLLECTION	R 1566/2008-4
<p>'The earlier trade mark is registered as 'SP LA SPOSA'. The documents submitted as proof of use refer only to female wedding dresses. The element 'LA SPOSA' is a common term, which will be understood by the Italian and Spanish public as 'the bride' and has a weak distinctive character for the goods in issue, namely wedding dresses. The opponent itself, in its price list 'tarifa de precios' which is drafted in various official languages of the EC, translated this term into the respective languages; underneath the term 'LA SPOSA', the terms 'novia' are mentioned in the Portuguese version of the list, 'bride' in the English version, 'Braut' in the German version, and so on. This shows that even the respondent itself understands the term 'LA SPOSA' as a reference to the consumer targeted, namely the bride' (para. 18).</p> <p>'Therefore the element 'SP' at the beginning of the earlier mark is a distinctive element and cannot be disregarded. This element cannot be neglected, first and foremost as it is placed at the beginning of the mark. Also, it is meaningless and distinctive on its own, in all the languages of the European Community' (para. 19).</p> <p>'[T]he omission of the letter 'SP' in the word 'LA SPOSA' or 'LA SPOSA COLLECTION' is not an acceptable variation of the earlier mark but a significant modification to the distinctive character of the mark. The documents submitted by the respondent are insufficient to prove that the mark 'SP LA SPOSA' has been put to genuine use' (para. 26).</p>		

In cases where the **figurative element** is the dominant or distinctive element and not merely decorative or banal, its omission can alter the distinctive character of the sign.

Registered form	Actual use	Case No
	ESCORPION	R 1140/2006-2
<p>'The earlier trade marks are strongly characterised by the presence of the figurative element. However, the documents submitted during the opposition proceedings and, even if they were to be taking into account, the appeal proceedings, do not show any use of the figurative element contained in the earlier trade marks' (para. 19).</p> <p>'Therefore, the Office considers that the alteration of the opponent's trade mark appearing in the way it is currently used is not an acceptable alteration and consequently use of the registered mark is not shown. The opponent has not complied with the requirements of Article 43(2) and (3) CTMR and thus the opposition must be rejected, as far as it was based on the Spanish trade mark registrations' (para. 20).</p>		


2.7.3.3 Other alterations


Acceptable alterations


Word marks

Word marks are considered used as registered regardless of typeface, use of upper/lower case or colour. It would not be correct to analyse this type of use from the perspective of whether distinctive character is altered. However, a **very particular typeface** (highly stylised) may lead to a different conclusion.

Changing the **letter size** or switching between **upper/lower case** is customary when using word marks. Therefore, such use is considered use of the registered mark.

Registered form	Actual use	Case No
MILENARIO		R 0289/2008-4
<p>The Board confirmed OD's views that use of the word mark 'MILENARIO' written in stylised bold characters did not affect the distinctive character of the mark, as the word 'MILENARIO' was considered to be the dominant element of the mark registered for 'sparkly wines and liquors' in Class 33 (para. 13).</p>		

Registered form	Actual use	Case No
AMYCOR		R 1344/2008-2
<p>Representation of the word mark, registered for 'pharmaceutical and sanitary preparations; plasters; materials for dressings; fungicides; disinfectants' covered by the earlier trade mark in Class 5, in a stylised form together with figurative elements was not considered as substantially changing the distinctive character of the word trade mark 'AMYCOR' as registered.</p>		

Registered form	Actual use	Case No
THE ECONOMIST		R 0056/2011-4
<p>'The applicant's argument that the proof of use is insufficient because it refers to the device mark ... and not to the word mark 'THE ECONOMIST' fails. First, the submitted evidence refers to both earlier marks (<i>i.e.</i> the word mark and the device mark). Furthermore, use of the earlier device mark constitutes use of the earlier word mark. In this respect it should be noted that word marks are considered used as registered, also if the typeface is different (this may be different if the typeface is a very particular one), if there is a usual change in the letter size or a usual change between lower-case and capital letters, if used in a specific colour or if used in combination with generic additions. Use of the word 'THE ECONOMIST' in a standard typeface, with the usual use of capitals at the beginning of the words 'The' and 'Economist', in a white colour on a contrasting background is considered use, not only of the earlier device mark but of the earlier word mark as well' (para. 14).</p>		

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

Registered form	Actual use	Case No
BIOTEX	(various)	R 0812/2000-1
<p>'The mark, as shown in those documents, has been variously depicted in the following styles:</p> <ul style="list-style-type: none"> – The word BIOTEX in white block capitals on a dark background in advertisements. – Reference in newspaper articles to the word BIOTEX in plain typeface. – The word BIOTEX in white block capitals with the top-most point of the letter 'l' in darker colouring. – The word BIOTEX in plain block white capitals on the labels and packaging of detergent products. – The word BIOTEX in plain typeface on shipping invoices. – The word BIOTEX in white upper and lower cases block letters on a darker background incorporating a figurative 'wave' device' (para. 14). <p>'The evidence of use shows the mark has remained, in spite of various stylistic changes, essentially BIOTEX. The letters forming the mark have in general been mere block capitals, lacking anything fanciful. Sometimes the capitals are plain and two-dimensional, at other times they are shadowed to give the impression of being three-dimensional. Sometimes the letter 'l' has a different colour tip. The Board considers these variations minimal and routine and that they demonstrate a practice that is commonplace not only in the particular business field of relevance here, but in other fields also. The Board does not consider that these variations invalidate use of the mark BIOTEX and therefore the contested decision must be annulled at this point' (para. 17).</p>		



Registered form	Actual use	Case No
SILVER	<i>Word SILVER written in white capital letters on a red banner which overlaps a golden circle which contains other word elements</i>	B 61 368
<p>'The actual use of the trade mark which can be seen on the beer pack, the newspaper extract and on the calendar is not the use of the registered <i>word</i> mark SILVER, but of the <i>colour device</i> mark, namely a beer label with the word SILVER written in white capital letters in a red banner which overlaps a golden circle which contains the word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg". This does not automatically mean that the mark was not used as registered. Each case must be looked at on its own merits. In this case, the Office finds that the mark SILVER is the actual trade mark. The appearance of the other word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg" and the figurative element is only secondary to the mark SILVER. It is also clear from the marketing study, the newspaper extract and the invoices that the actual trade mark is SILVER. The Office finds that the use of the word SILVER is so dominant in the figurative mark that it fulfils the requirements of having been used as registered.'</p>		



Figurative marks⁷

Using a **purely figurative mark** (without word elements) in a form other than registered generally constitutes an unacceptable alteration.



As regards specifically **alterations in colour**, the main question that needs to be addressed is whether the mark as used alters the distinctive character of the registered mark, i.e. whether use of the mark in colour, while being registered in black and white or greyscale (and vice versa) constitutes an alteration of the registered form. The Office and a number of Trade Mark Offices of the European Union have agreed on a common practice under the European Trade Mark and Designs Network whereby a change only in colour does not alter the distinctive character of the trade mark as long as:

- the word /figurative elements coincide and are the main distinctive elements;
- the contrast of shades is respected;
- colour or combination of colours does not have distinctive character in itself;
- colour is not one of the main contributors to the overall distinctiveness of the sign.

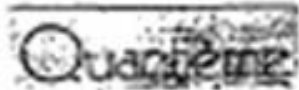

Registered form	Actual use	Comment
		T-152/11
<p>The Court took the view that, if no colour is claimed in the application, the use of different colour combinations 'must be allowed, as long as the letters contrast against the background.' The Court also noted that the letters M, A, D were arranged in a particular way in the CTM. Accordingly, representations of the sign which do not alter the arrangement of the letters, or the contrast of colour, constitute genuine use (paras 41 and 45).</p>		

Registered form	Actual use	Case No
		R 1479/2010-2
<p>The word element was considered to be the dominant feature of the figurative mark, since it was in a central position and in large letters. It was considered that the distinctive character was not changed (para. 15).</p>		



⁷ Amended on 02/06/2014.

Registered form	Actual use	Case No
		R 0877/2009-1
<p>'The orange background is the colour of packaging of the products. The mark is used in black on a white background, outlined in silver similar to the earlier registered mark. The typeface has been slightly modernised and the small hyphen between 'Bi' and 'Fi' has been deleted. Nevertheless, these may be considered as minor changes which do not alter the distinctive character of the mark in the form in which it is registered in the sense of Article 15(1)(a) CTMR. The typeface has been modernised but the letters keep their rounded shape and the deletion of the hyphen may pass unnoticed. The distinctive character of the earlier mark is still based on the large black letters 'Bi Fi', the 'B' and 'F' being in capital letters and the two 'i' letters in lower case, on a white background and outlined in silver' (para. 45).</p>		

In the case of **composite marks** (i.e. marks composed of word and figurative elements), **changes to certain figurative elements** *do not* normally affect the distinctive character of the marks.

Registered form	Actual use	Case No
		T-147/03 (C-171/06 P dismissed)
<p>'[T]he only elements which differentiate the earlier national mark, as it was registered, from the sign used by the applicant are the stylisation of the letter 'q', suggesting the face of a watch, and the use of capital letters to write the verbal element of the earlier national mark ... In the first place, although it is true that the stylisation of the letter 'q' is more pronounced in the representation of the sign used than in that of the earlier national mark, the distinctive character of the earlier mark is still based on the entire verbal element of that mark. In any case, since the stylisation of the letter 'q' suggests, as has just been said, the face of a watch, it is not particularly distinctive for goods in Class 14, the only goods for which the applicant has furnished proof of use of the earlier mark. In the second place, as regards the use of capital letters, it suffices to note that that is not at all original and also does not alter the distinctive character of the earlier national mark ... It follows that the proof furnished by the applicant which refers to the sign reproduced in paragraph 10 above for the Class 14 goods 'watches and watch bands or straps' could legitimately be taken into account by the Board of Appeal for the purposes of assessing whether the applicant had shown genuine use of the earlier national mark' (paras 28-30).</p>		

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

Registered form	Actual use	Case No
		R 0864/2000-3
<p>The abovementioned deviation from the registered form of the mark does not affect the distinctiveness of the opponent's registration. Firstly, the use of another kind of script does not influence the role and position of the word 'WEEKEND' in the earlier mark. The word is still represented in two parts (WEEK and END, one above the other) and the size of the letters is not significantly changed. Secondly, the clover device is still placed between the parts 'WEEK' and 'END', and thus its impact on the overall impression of the earlier mark is not affected. Thirdly, the horse/chariot devices are mostly an indication as to whether that particular issue of the newspaper is about horse or chariot races. Hence, this addition will be perceived by the public as purely descriptive matter.</p>		

The Board confirmed OD's decision.

This is also the case where the dominant elements remain unchanged (see T-135/04, 'Online bus' above).

3D marks

The use of a 3D mark in varying sizes usually amounts to use of the mark as registered. The addition of a word/figurative element to such a mark does not generally alter the distinctive character of the sign.



Colour marks

Colour marks are marks consisting of one or more colours *per se*. Where the mark is a colour combination, the registration must indicate the proportion of each colour and specify how they will appear.

Colour marks must be used with the colours as registered. Insignificant variations in the colour shade and strength will not alter distinctive character.

Where a colour combination is registered without specifying the respective proportions, use in **varying proportions** will not affect distinctive character. The case is different when particular proportions were claimed and these are substantially altered in the variant as used.




Where a colour or colour combination is registered, use in combination with a **distinctive or descriptive word** will not affect distinctive character. See, by analogy, the Court judgment below regarding the proof of acquired distinctiveness of a mark (examination):

Registered form	Actual use	Case No
	(with word mark John Deere)	T-137/08 (AG case)
<p>'The colours covered by the application for registration were designated using the Munsell system as: 9.47 GY3.57/7.45 (green) and 5.06 Y7.63/10.66 (yellow). The arrangement is described as being 'green for the vehicle body and yellow for the wheels', as is shown by a picture attached to the application and reproduced below  (para. 3).</p> <p>'It follows from the above that, although it is true that the disputed mark was used and promoted in conjunction <u>with the word mark John Deere</u> [underlining added] and that the intervener's advertising expenditure in the European Union was presented as a whole and not individually for each country, the applicant is wrong to claim that it was not proved to the required legal standard that the intervener had used the combination of the colours green and yellow on its goods as a trade mark and that the market penetration of its goods had been deep and long-lasting in all the Member States of the European Union as at 1 April 1996' (para. 46).</p>		



Unacceptable alterations

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

Registered form	Actual use	Case No
MEXAVIT	MEXA-VIT C	R 0159/2005-4
In this case the use of the mark in a different spelling and the addition of the letter 'C' alter the distinctive character of the registered sign, because the letters 'VIT' are now seen as a descriptive element, namely 'VIT C' (which refers to 'Vitamin C').		

Registered form	Actual use	Case No
		R 2066/2010-4
<p>'[T]he 'NOVEDADES' catalogues dated 2004-2009 consistently show the mark  LLOYD'S and only this version. This does not constitute use of the mark [as registered] (with or without colour) as admissible under Article 15 (1) (a) CTMR. The mere fact that both marks include a word element LLOYD'S is not enough for that purpose, also the figurative elements of the earlier mark must appear in the form as used. The form as used is in a different font, lacks the single letter L at the end and surrounded by an orbital device, and lacks the circular or orbital device around the word 'LLOYD'S'. In other words, all its figurative elements are missing in the form as used. On top, the form as used contains the conspicuous device of a flying bird with a long beak. The omission of all the figurative elements of the mark as registered and the addition of another figurative element does alter, in the form as used, the distinctive character of the mark and is much more than a mere variation or modernization' (para. 35).</p>		

Alteration of a sign made in a dominant position

Registered form	Actual use	Case No
		R 0275/2006-2
<p>'The Board concurs with the CTM Proprietor in that the sign [actually used] cannot be considered merely as a slight variation of the earlier mark ... as registered. Regardless of the fact that the signs have the word element 'HYBRIS' in common, the additional figurative element – an inverted letter 'y' in peculiarly shaped brackets – cannot be considered as a 'negligible element'. The figurative element at issue is rather unusual and eye-catching. It is not a mere decorative element. Further, it occupies the prominent first position within the sign as used and forms an integral part thereof. It will not be neglected in the overall impression created by the sign' (para. 23).</p>		

2.8 Use for the goods or services for which the mark is registered

In accordance with Article 15 CTMR, the mark must be used for the goods or services for which it is registered in order to be enforceable. In accordance with the first sentence of Article 42(2) CTMR, the earlier registered mark must have been put to genuine use in connection with the goods or services in respect of which it is registered and which the opponent cites as justification for its opposition. The third sentence of

Article 42(2) CTMR stipulates that if the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it will, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

As the GC stated in the ‘Aladin’ case:

[The provisions of Article 42 CTMR] allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a **limitation on the rights** which the proprietor of the earlier trade mark gains from his registration ..., and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to **extend his range of goods or services**, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him. That is particularly so when, as here, the goods and services for which the trade mark has been registered form a sufficiently narrowly-defined category ...

(See judgment of 14/07/2005, T-126/03, ‘Aladin’, para. 51, emphasis added.)

The analysis of genuine use must in principle extend to all of the registered goods and/or services on which the opposition is based and for which the CTM applicant has made an explicit request for proof of use. However, in situations where it is clear that likelihood of confusion can be established on the basis of *some* of the earlier goods and/or services, the Office’s analysis of genuine use need not extend to all the earlier goods and/or services but instead may focus on only those goods and/or services sufficient for establishing identity/similarity to the contested goods and/or services.

In other words, since likelihood of confusion can be established on the basis of a finding of genuine use for some of the earlier goods and/or services, it is unnecessary to examine the evidence of use filed by the opponent with respect to the remaining earlier goods and/or services.

The following sections include a number of guidelines to help establish whether the earlier trade mark has been effectively used for the registered goods and services. For further details see the Guidelines concerning Opposition, Part 2.2, Comparison of goods and services and in particular the practice regarding the use of all the general indications in the class heading, and the Manual concerning Examination, Part B.3, Classification of Goods and services.

2.8.1 Comparison between goods/services used and specification of goods/services

It must always be carefully assessed whether the goods and services for which the mark has been used fall within the category of the registered goods and services.

Examples:

Case No	Registered G&S	Used G&S	Comment
T-382/08 VOGUE	<i>Footwear</i>	Retail of footwear	Not OK (paras 47, 48)

Case No	Registered G&S	Used G&S	Comment
T-183/08 SCHUHPARK	<i>Footwear</i>	Retail services regarding footwear	Not OK (para. 32)
R 0807/2000-3 – Demara	<i>Pharmaceuticals, veterinary and disinfectant products</i>	Napkins and napkin pants for incontinence	Not OK, even though the specific goods might be distributed by pharmacies (paras 14-16)
R 1533/2007-4 – GEO MADRID	<i>Telecommunication services in Class 38</i>	Providing an internet shopping platform	Not OK (para. 16)
R 0068/2003-2 – Sweetie	<i>Preserved, dried and cooked fruits and vegetables; concentrated citrus fruit and fruit extracts, preserves; sugar, biscuits, cakes, pastry and confectionery</i>	Dessert toppings that are strawberry, caramel or chocolate flavoured	Not OK (para. 20)
R 1519/2008-1 – DODOT et al	<i>Baby diapers of textile in Class 25</i>	Disposable diapers of paper and cellulose (Class 16)	Not OK (para. 29)
R 0594/2009-2 – BANIF	<i>Administration, representation and general counsel in Class 35 Technical, economic and administrative projects in Class 42</i>	Administration of funds and personal assets or real estate affairs (Class 36)	Not OK (para. 39)
B 1 589 871 OXIL	<i>Electric switches and 'parts of lamps'</i>	Apparatus for lighting	Not OK
B 253 494 CAI/Kay	<i>Education services</i>	Entertainment services	Not OK
B 1 259 136, LUPA	<i>Transportation and distribution services in Class 39</i>	Home delivery of goods purchased in a retail store	Not OK as the registered services are provided by specialist transport companies whose business is not the provision of other services, while the home delivery of goods purchased in a retail store is just an additional auxiliary service integrated in retail services
R1330/2011-4 – AF (fig)	<i>Advertising, business management, business administration, office functions in Class 35</i>	Retail services.	Not OK. If a trade mark is registered for the general indications in Class 35, but use is proven only for 'retail services' for particular goods, this cannot amount to valid proof of use for any of the specific indications of Class 35 or the class heading as a whole (para. 25 by analogy).

2.8.2 Relevance of the classification

It is relevant to establish whether the specific goods or services for which a mark has been used fall under any *general indication* listed in the *class heading* of a particular class of goods or services, and if so, which.

For instance, in Class 25, the class heading is 'clothing, footwear, and headgear' and each of these three items constitutes a 'general indication'. Whereas, in general,

classification does not serve more than administrative purposes, it is relevant, in order to assess the nature of the use, to establish whether the goods for which a mark has been used fall under the general indication of 'clothing', 'footwear' or 'headgear'.

This is apparent when similar categories of goods have been classified differently for certain reasons. For instance, shoes have been classified in various classes according to their intended purpose: 'orthopaedic shoes' in Class 10 and 'ordinary' shoes in Class 25. It must be established, according to the evidence provided, to which kind of shoes the use relates.

2.8.3 Use and registration for general indications in 'class headings'

Where a mark is registered under *all or part of* the general indications listed in the class heading of a particular class and where it has been used for several goods or services that are properly classified in the same class under one of these *general indications*, the mark will be considered as having been used for that specific *general indication*.

Example: The earlier mark is registered for *clothing, footwear, headgear* in Class 25. The evidence relates to 'skirts', 'trousers' and 'T-shirts'.

Conclusion: The mark has been used for *clothing*.

On the other hand, when a mark is registered for only *part of the general indications* listed in the class heading of a particular class but has been used only for goods or services which fall under *another* general indication of that same class, the mark will not be considered as having been used for the registered goods or services (see also paragraph 2.8.4 below).

Example: The earlier mark is registered for *clothing* in Class 25. The evidence relates to 'boots' only.

Conclusion: The mark has not been used for the goods for which it is registered.

2.8.4 Use for sub-categories of goods/services and similar goods/services

This part deals with the extent of protection granted where there is use for sub-categories of goods and of 'similar' goods (or services).

In general, it is not appropriate to accept proof of use for 'different' but somehow 'linked' goods or services as automatically covering registered goods and services. In particular, the concept of **similarity of goods and services is not a valid consideration** within this context. The third sentence of Article 42(2) CTMR does not provide any exception in this regard.

Example: The earlier mark is registered for *clothing* in Class 25. The evidence relates to 'boots' only.

Conclusion: The mark has not been used for the goods for which it is registered.

2.8.4.1 Earlier mark registered for broad category of goods/services

In Aladin, the GC held:

if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong.

(See judgment of 14/07/2005, T-126/03, 'Aladin', para. 45.)

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

The GC further pointed out, on the one hand, that it is necessary to interpret the last sentence of Article 42(2) CTMR as seeking to deny a trade mark extensive protection if it has only been used in relation to part of the goods or services for which it is registered merely because it has been registered for a wide range of goods or services. Therefore, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark is registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services for which genuine use has actually been established (para. 44).

On the other hand, it is not necessary for the opponent to file evidence of all the commercial variations of similar goods or services but merely of those goods or services which are sufficiently distinct to constitute coherent categories or sub-categories (para. 46). The underlying reason is that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration

Thus, protection is available **only** for the sub-category or sub-categories to which the used goods or services belong if:

1. a trade mark had been registered for a **category** of goods or services:
 - (a) which is sufficiently broad to cover a number of sub-categories other than in an arbitrary manner;
 - (b) that are capable of being perceived as being independent from each other;

and

2. it can be shown that the mark has been genuinely used in relation to only **part** of the initial broad specification.

Appropriate reasoning should be given for defining the sub-categories and, on the basis of the evidence submitted by the opponent, it must be explained whether use has been shown in relation to only **part** of the initial broad specification/sub-category(ies). See examples in paragraph 2.8.4.3 below.

This is especially important in the case of trade marks registered for 'pharmaceutical preparations', which are usually used only for one kind of medicine for treating a certain disease (see the examples pharmaceutical preparations in paragraph 2.8.4.3 below).

On the other hand, the use for a whole category has to be accepted if there are examples of different kinds of products belonging to this category and there is no other sub-category which covers the different products.

Contested sign	Case No
CARRERA	R 0260/2009-4 (revocation)
<p>The proven use of a trade mark for:</p> <ul style="list-style-type: none"> • decorative lettering • increased performance packages • covers for storage compartments • wheel sets and complete wheel sets for summer and winter • door sill cover plates <p>was considered sufficient proof of use for 'motor vehicle and land vehicle parts' overall, for which the mark was registered. The main arguments were that it was used for numerous different motor vehicle parts and the goods for which use had been proven thus covered a wide spectrum of motor vehicle parts: elements of the chassis, the bodywork, the engine, the interior design and decorative elements.</p>	

2.8.4.2 Earlier mark registered for precisely specified goods/services

In contrast, proof of genuine use of the mark for some of the specified goods or services necessarily covers the **entire category** if:

- (1) a trade mark has been registered for goods or services **specified** in a relatively precise manner so that
- (2) it is not possible, without any artificiality, to make any significant sub-divisions within the category concerned (see judgment of 14/07/2005, T-126/03, 'Aladin', para. 45).


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

2.8.4.3 Examples

In order to define adequate sub-categories of general **indications**, the **criterion of the purpose or intended use of the product or service** in question is of fundamental importance, as consumers do employ this criterion before making a purchase (judgment of 13/02/2007, T-256/04, 'Respicur', paras 29, 30; judgment of 23/09/2009, T-493/07, 'Famoxin', para. 37). Other applicable criteria for defining adequate sub-categories could be the characteristics of the product or service, for instance the nature of the product or service or the target consumer of the product or service.

Earlier sign	Case No
ALADIN	T-126/03
<p>G&S: Polish for metals in Class 3.</p> <p><i>Assessment of PoU:</i> The earlier mark was registered for 'polish for metals' in Class 3, but was actually used genuinely only for 'magic cotton' (a product for polishing metals consisting of cotton impregnated with a polishing agent). The Court held that 'polish for metals', which in itself is already a sub-category of the class heading term 'polishing preparations', is sufficiently precise and narrowly defined in terms of the function and intended purpose of the claimed goods. No further sub-category can be established without being artificial, and thus, use for the entire category of 'polish for metals' was assumed.</p>	

Contested sign	Case No
Turbo	R 0378/2006-2 Revocation
<p>G&S: Clothing in Class 25.</p> <p><i>Assessment of PoU:</i> the Board found that, in addition to swimwear, other types of clothing were referred to in the invoices and could be found in the catalogues. Thus, the Board found that use of the contested mark had been proved for 'clothing' (para. 22). The Board moreover found it almost impossible and certainly unduly onerous to impose on the proprietor of a registered CTM for 'clothing' the obligation to demonstrate use in all possible sub-categories that could be endlessly sub-divided by the applicant (para. 25).</p>	

Earlier sign	Case No
	R 1088/2008-2 (confirmed by T-132/09)
<p>G&S: Measuring apparatus and instruments in Class 9.</p> <p><i>Assessment of PoU:</i> The mark was used for apparatus and parts thereof for the measurement of temperature, pressure and level. The contested decision considered that the original specification of the earlier mark for 'measuring apparatus and instruments' was a 'very wide' one, and determined, applying the criteria established in the Aladin judgment, that use had in fact only been shown for a sub-category of goods, namely: 'measuring apparatus, all being for the measurement of temperature, pressure and level; parts for the aforesaid apparatus'. The Board found that approach to be a reasonable one in the circumstances of the case and endorsed the reasoning and findings of the contested decision in this regard (para. 29).</p>	

Contested sign	Case No
ICEBERG	R 1166/2008-1 Revocation
<p>G&S: Apparatus for heating, steam generating, refrigerating, drying, ventilating and water supply purposes in Class 11.</p> <p><i>Assessment of PoU:</i> The Board concluded that the trade mark use was only proven for fridges, freezers and air-conditioning modules for yachts and boats (para. 26). These goods were included in the sub-categories 'apparatus for heating' (insofar as an air-conditioning machine can also perform as a heater), 'apparatus for refrigerating' (insofar as an air-conditioning machine, a fridge and a freezer can keep air/things cold), and 'apparatus for ventilating' (insofar as an air-conditioning machine, a fridge and a freezer all include ventilation circuits) for which the mark was registered. Therefore, the Board thought it should remain registered for those sub-categories (para. 27). However, the Board did not consider it appropriate to limit the scope of protection of the trade mark to 'yachts and boats'. This would have further split the 'sub-categories' and would amount to unjustified limitation (para. 28). Conclusion: use was considered proven for 'apparatus for heating, refrigerating and ventilating'.</p>	

Contested sign	Case No
LOTUS	R 1295/2007-4 Revocation
<p>G&S: Outerwear and underwear, hosiery, corsets, neckties, braces, gloves, underclothes in Class 25.</p> <p><i>Assessment of PoU:</i> No evidence was submitted in respect of the goods 'corsets, neckties, braces'. None of the pieces of evidence submitted mentions these goods or refers to them. Use must be demonstrated for all goods or services in respect of which the trade mark is registered. The trade mark is registered for 'outerwear and underwear', but also for specific products within this category – inter alia 'corsets, neckties, braces'. Use for other goods is not sufficient to maintain protection under trade mark law for these goods, even if these other goods also fall under the category 'outerwear and underwear'. The Invalidity Division, however, considered use to be sufficient, because according to the principles of the Aladin judgment (see judgment of 14/07/2005, T-126/03) the 'corsets, neckties, braces' fall under the generic term of 'outerwear and underwear'. While this is indeed true, this question is subordinate to examining whether the goods used can be subsumed under the claimed term at all. This is not the case for 'corsets, neckties, braces'. If alongside the broad generic term the trade mark also explicitly claims specific goods covered by the generic term, it must also have been used for these specific goods in order to remain registered for them (para. 25).</p>	

Earlier sign	Case No
GRAF-SYTECO	R 1113/2009-4
<p>G&S: Electric instruments (included in Class 9); optical, weighing, measuring, signalling and checking (supervision) instruments; data processing equipment and computers, in particular for operating, monitoring and checking machines, installations, vehicles and buildings; recorded computer programs; electronic counters in Class 9, repair services in Class 37 and computer programming in Class 42.</p> <p><i>Assessment of PoU:</i> The devices which the opponent has proven to have placed on the market fall under the wording of <i>hardware</i> as specified in Class 9. This is, however, a vast category, especially considering the massive development and high specialisation taking place in this field, which can be divided into sub-categories according to the actual goods produced. In the present case the goods must be limited to the automotive industry. As the opponent is obliged to provide a legal guarantee to clients, it can be considered that it has also proven use of the service relating to repair of the hardware in question (Class 37). The Board also found that recorded computer programs in Class 9 were a very broad category and had to be limited to the actual field of activity of the opponent (paras 30, 31). No evidence was submitted for Class 42.</p>	

Earlier sign	Case No
HEMICELL	R 0155/2010-2
<p>G&S: Foodstuffs for animals in Class 31, and animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31.</p> <p><i>Assessment of PoU:</i> The contested decision erred in considering that the earlier mark had been put to genuine use for '<i>foodstuffs for animals</i>' in Class 31, and '<i>animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31</i>', since this finding is contrary to the findings of the Court in ALADIN. The reason given by the contested decision is not acceptable because it should have been tested whether or not the category of goods covered by the earlier mark was susceptible of being divided into independent sub-categories and whether the goods for which use of the earlier mark had been proven could be classified in one of those. Therefore, the Board considers that the earlier CTM is, for the purposes of examination of the opposition, deemed to be registered in respect of '<i>additives for animal feed</i>' only in Class 31.</p>	

Pharmaceutical preparations

In a number of cases, the Court had to define adequate sub-categories for *pharmaceutical preparations* in Class 5. It held that the purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. Thus, the *therapeutic indication* is the key for defining the relevant sub-category of

pharmaceutical products. Other criteria (such as dosage form, active ingredients, whether it is sold on prescription or over the counter) are irrelevant in this regard.

The following sub-categories for *pharmaceutical preparations* were assumed to be adequate by the Court:

Case No	Adequate	Non-adequate
T-256/04 'RESPICUR'	<i>Pharmaceutical preparations for respiratory illnesses</i>	<i>Multi-dose dry powder inhalers containing corticoids, available only on prescription</i>
T-493/07 'FAMOXIN'	<i>Pharmaceutical preparations for cardiovascular illnesses</i>	<i>Pharmaceutical preparations with digoxin for human use for cardiovascular illnesses</i>
T-487/08 'KREMIZIN'	<i>Pharmaceutical preparations for heart treatment</i>	<i>Sterile solution of adenosine for use in the treatment of specific heart condition, for intravenous administration in hospitals</i>
T-483/04 'GALZIN'	<i>Calcium-based preparations</i>	<i>Pharmaceutical preparations</i>

2.8.5 Use of the mark as regards integral parts and after-sales services of the registered goods

In the 'Minimax' judgment, the Court held that, in certain circumstances, use of the mark may be considered genuine also for 'registered' goods that had been sold at one time and were no longer available (judgment of 11/03/2003, C-40/01, 'Minimax', para. 40 *et seq.*).

- This may apply where the proprietor of the trade mark under which such goods had been put on the market **sells parts** that are integral to the make-up or structure of the goods previously sold.
- The same may apply where the trade mark proprietor makes actual use of the mark for **after-sales services**, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

Sign	Case No
Minimax	C-40/01
G&S: fire extinguishers and associated products vs. components and after-sales services.	
<p><i>Assessment of PoU:</i> The authorisation for the fire extinguishers sold by Ansul under the Minimax trade mark expired in the 80's. Since then, Ansul has not been selling fire extinguishers under that mark. However, Ansul nonetheless sold component parts and extinguishing substances for fire extinguishers bearing the mark to undertakings with responsibility for maintaining them. During the same period it also maintained, checked and repaired equipment bearing the Minimax mark itself, used the mark on invoices relating to those services and affixed stickers bearing the mark and strips bearing the words 'Gebruiksklaar Minimax' (Ready for use Minimax) to the equipment. Ansul also sold these stickers and strips to undertakings that maintain fire extinguishers.</p>	

However, this finding of the Court should be interpreted **strictly** and applied only in very exceptional cases. In 'Minimax', the Court accepted use for goods other than those registered, which runs counter to the general rule laid down in Article 42(2) CTMR.

2.9 Use by the proprietor or on its behalf

2.9.1 Use by the proprietor

According to Articles 42(2) and 15(1) CTMR, it is in general the owner who has to put the earlier registered mark to genuine use. These provisions also cover use of the mark by the previous owner during its ownership (decision of 10/12/1999, case B 74 494).

2.9.2 Use by authorised third parties

According to Article 15(2) CTMR, use of the mark with the consent of the proprietor is deemed to constitute use by the proprietor. This means that the owner must have given its consent **prior** to the use of the mark by the third party. Acceptance later is insufficient.

A typical case of use by third parties is use made by **licensees**. Use by companies **economically related** to the trade mark proprietor, such as members of the same group of companies (affiliates, subsidiaries, etc.) is similarly to be considered as authorised use. Where goods are produced by the trade mark proprietor (or with its consent), but subsequently placed on the market by **distributors** at wholesale or retail level, this is to be considered as use of the mark (judgment of 17/02/2011, T-324/09, 'Friboi', para. 32 and judgment of 16/11/2011, T-308/06, 'Buffalo Milke', para. 73).

At the **evidence** stage it is *prima facie* sufficient that the opponent only submits evidence that a third party has used the mark. The Office infers from such use, combined with the opponent's ability to present evidence of it, that the opponent has given prior consent.

This position of the Office was confirmed by judgment of 08/07/2004, T-203/02, 'VITAFRUIT', para. 25 (and confirmed by the Court in C-416/04 P). The Court pointed out that it was unlikely that the proprietor of a trade mark would be in a position to submit evidence that the mark had been used against its wishes. There was all the more reason to **rely on that presumption**, given that the applicant did not dispute the opponent's consent.

However, if there are **doubts** on the part of the Office or, in general, in cases where the applicant explicitly contests the opponent's consent, the burden is on the opponent to submit further evidence that it gave its consent prior to use of the mark. In such cases the Office gives the opponent a further period of two months for the submission of such evidence.

2.9.3 Use of collective marks

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

According to Article 70 CTMR, use by (at least) one authorised person satisfies the user requirement, provided use is otherwise genuine.

The specific characteristic of collective trade marks is that their main objective is not to indicate that the goods or services originate from a specific source but that they originate from a certain region and/or comply with certain characteristics or qualities

(‘geographical and complementary indications of origin or quality’). This different function has to be taken into account when evaluating the proof of use in accordance with Article 68(3) CTMR.

Mere lists of persons authorised to use the collective mark and lists of products that are certified under the collective mark are generally not sufficient on their own to prove any genuine use (decision of 25/05/2009, B 1 155 904, see also decision of 24/02/2009, R 0970/2008-2 – ‘NFB’).

2.10 Legal use

Whether a mark has been used in a way that satisfies the use requirements of Articles 15 and 42 CTMR requires a factual finding of genuine use. Use will be ‘genuine’ in this context even if the user violates legal provisions.

Use that is **deceptive** within the meaning of Article 7(1)(g) or Article 51(1)(c) CTMR or under provisions of national law remains ‘genuine’ for the purpose of asserting earlier marks in opposition proceedings. The sanctions for deceptive use are invalidation or revocation, as the case may be, or a prohibition of use (provided for pursuant to Article 110(2) CTMR).

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

2.11 Justification of non-use

According to Article 42(2) CTMR, the opponent may alternatively prove that there are justifiable reasons for non-use of its earlier registered mark. These reasons cover, as mentioned in the second sentence of Article 19(1) of the TRIPS agreement, circumstances arising independently of the will of the owner of the trade mark that constitute an obstacle to the use of the trade mark.

As an exception to the obligation of use, the concept of proper reasons for non-use is to be interpreted rather narrowly.

‘Bureaucratic obstacles’ as such, which arise **independently of the will** of the trade mark proprietor, are not sufficient, unless they have a **direct relationship** with the mark, so much so that the use of the trade mark depends on successful completion of the administrative action concerned. However, the criterion of a direct relationship does not necessarily imply that use of the trade mark is impossible; it might suffice that use is **unreasonable**. It must be assessed on a case-by-case basis whether a change in the undertaking’s strategy to circumvent the obstacle under consideration would make use of the mark unreasonable. Thus, for example, the proprietor of a mark cannot reasonably be required to change its corporate strategy and sell its goods in its competitors’ sales outlets (judgment of 14/06/2007, C-246/05, ‘Le Chef de Cuisine’, para. 52).

2.11.1 Business risks

The concept of proper reasons must be considered to refer to circumstances arising independently of the will of the owner that make use of the mark impossible or unreasonable, rather than to circumstances associated with commercial difficulties it is experiencing (decision of 14/05/0008, R 0855/2007-4 – ‘PAN AM’, para. 27; judgment of 09/07/2003, T-162/01, ‘GIORGI’, para. 41).

Thus, financial difficulties encountered by a company as a result of an economic recession or due to its own financial problems are not considered to constitute proper reasons for non-use within the meaning of Article 42(2) CTMR as these kinds of difficulties constitute a natural part of running a business.

2.11.2 Government or Court intervention

Import restrictions or other government requirements are two examples of proper reasons for non-use that are explicitly mentioned in the second sentence of Article 19(1) of the TRIPS agreement.

Import restrictions include a trade embargo affecting the goods protected by the mark.

Other *government requirements* can be a State monopoly, which impedes any kind of use, or a State prohibition of the sale of goods for reasons of health or national defence. Typical cases in this respect are regulatory procedures such as:

- clinical trials and authorisation for new medicines (decision of 18/04/2007, R 0155/2006-1 – ‘LEVENIA’); or
- the authorisation of a Food Safety Authority, which the owner has to obtain before offering the relevant goods and services on the market.

Earlier sign	Case No
HEMICELL	R 0155/2010-2
The evidence filed by the opponent duly shows that use of the earlier marks for a food additive, namely, ‘zootechnical digestibility enhancer (feed enzyme)’ was conditional upon prior authorisation, to be issued by the European Food Safety Authority following an application filed before that body. Such a requirement is to be deemed a government requirement in the sense of Article 19(1) of TRIPS.	

With regard to Court proceedings or interim injunctions the following must be differentiated:

On the one hand, the mere threat of litigation or a pending cancellation action against the earlier mark should, in general, not exempt the opponent from the obligation to use its trade mark in the course of trade. It is up to the opponent, being the attacking party in opposition proceedings, to conduct an adequate risk assessment of its chances to prevail in the litigation proceedings and to draw the appropriate conclusions from this evaluation as to whether or not to continue with use of its mark (see decision of 18/02/2013, R 1101/2011-2 – ‘SMART WATER’, para. 40).

Earlier sign	Case No
HUGO BOSS	R 0764/2009-4
The national [French cancellation] proceedings brought against the opposing trade mark cannot be	

acknowledged as a proper reason for non-use (para. 19).

The fact remains that proper reasons for non-use are only those outside the sphere and influence of the trade mark proprietor, for instance national authorisation requirements or import restrictions. These are neutral with regard to the trade mark to be used; they concern not the trade mark but the goods and services that the proprietor wishes to use. Such national authorisation requirements or import restrictions apply to the type or properties of the product to which the trade mark is affixed, and cannot be circumvented by choosing a different trade mark. In the present case, conversely, the trade mark proprietor could have readily manufactured cigarettes in France or imported them into France if it had chosen a different trade mark (para. 25).

Earlier sign	Case No
MANPOWER	R 0997/2009-4

According to Article 9 CTMR and Article 5 of the Trade Marks Directive, the trade marks of third parties must not be infringed. The requirement not to infringe trade marks applies to any person using a name in the course of trade, regardless of whether it has itself applied for or been granted trade mark protection for that name. A person refraining from such infringements is acting not for 'proper reasons' but as ordered by law. Hence even refraining from use that would otherwise infringe a right is not a proper reason (decision of the Boards of Appeal of 09/03/2010, R 0764/2009-4 – 'HUGO BOSS/BOSS', para. 22) (para. 27).

Nor is use in such instances 'unreasonable'. Persons who, as trade mark proprietors, are threatened with proceedings or an interim injunction if they start using it, must consider the prospects of the action against them succeeding and can either capitulate (not start using the trade mark) or defend themselves against the complaint. In any event they have to accept the decision of the independent courts, which may be in expedited proceedings. Nor, pending a decision at final instance, can they object that they must be protected by the fact that, until that decision becomes final, uncertainty is to be recognised as a proper reason for non-use. In fact, the issue of what should happen in the period between the filing of an action or the application for an interim injunction and the conclusive final decision is again to be left to the courts, in that they take decisions that are not yet final on provisional enforceability. The defendant is not entitled to ignore those decisions and be put in a position as if there were no courts (para. 28).

On the other hand, for example, an interim injunction or a restraining court order in insolvency proceedings, imposing a general prohibition of transfers or disposals on the trade mark owner, can be a proper reason for non-use because it obliges the opponent to refrain from using its mark in the course of trade. Use of the mark contrary to such a court order would make the trade mark owner liable to damage claims (decision of 11/12/2007, R 0077/2006-1, – 'Miss Intercontinental', para. 51).

2.11.3 Defensive registrations

The GC has clarified that the existence of a national provision recognising what are known as 'defensive' registrations (i.e. of signs not intended to be used in trade on account of their purely defensive function in relation to another sign which is being commercially exploited) cannot constitute a proper reason for non-use of an earlier trade mark invoked as a basis of an opposition (judgment of 23/02/2006, T-194/03, 'Bainbridge', para. 46).

2.11.4 Force majeure

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

2.11.5 Consequences of justification of non-use

The existence of justified reasons does not mean that non-use during the period concerned is treated as equivalent to actual use, which would result in a new grace period beginning after the end of the period of justified non-use.

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

In addition, the length of time during which justified reasons existed may be significant. Reasons for non-use existing during only part of the five-year-period before publication of the CTM application may not always be considered justification for setting the proof-of-use requirement aside. In this context, the period of time during which these reasons were pertinent and the elapse of time since they no longer applied are of particular importance (decision of 01/07/1999, B 2 255).

3 Procedure

3.1 Request by the applicant

According to Article 42(2) CTMR, use of the earlier mark needs be shown – and only be shown – if the applicant requests proof of use. The institution of proof of use is, therefore, designed in opposition proceedings as a *defence plea of the applicant*.

The Office may neither inform the applicant that he could request proof of use nor invite him to do so. In view of the Office's impartial status in opposition proceedings it is left to the parties to provide the factual basis and to argue and defend their respective positions (see second sentence of Article 76(1) CTMR).

Article 42(2) CTMR is not applicable when the opponent, on its own motion, submits material relating to use of the invoked earlier mark (see paragraph 3.1.2. below for an exception to this rule). As long as the CTM applicant does not request proof of use, the issue of genuine use will not be addressed by the Office *ex officio*. In such cases, in principle, it is even irrelevant that the evidence produced by the opponent might demonstrate only a particular type or manner of use, or use which is limited to only part of the goods or services for which the earlier mark is registered.

The request to furnish proof of use is only valid if the earlier mark is under the use requirement at all, i.e. if it had been registered for not less than five years (for details see paragraph 2.5.1 above).

3.1.1 Time of request

Pursuant to Rule 22(1) CTMIR, the request for proof of use pursuant to Article 42(2) CTMR shall be admissible only if the applicant submits such a request within the period specify by the Office. The request for proof of use must be made within the first time limit for the applicant to reply to the opposition under Rule 20(2) CTMIR.

If the request for proof of use is submitted during the cooling-off period or during the two-month period given to the opponent for filing or amending facts, evidence and arguments, it is forwarded to the opponent without delay.

3.1.2 Request must be explicit, unambiguous and unconditional

The applicant's request is a formal declaration with important procedural consequences.

Therefore, it has to be *explicit and unambiguous*. In general, the request for proof of use must be expressed in positive wording. As use or non-use can be an issue in manifold constellations (for example, to invoke or deny a higher degree of distinctiveness of the earlier mark), mere observations or remarks by the applicant in respect of the (lack of) use of the opponent's mark are not sufficiently explicit and do not constitute a valid request for proof of genuine use (judgment of 16/03/2005, T-112/03, 'Flexi Air').

Examples:

Sufficiently explicit and unambiguous request:

- 'I request the opponent to submit proof of use...';
- 'I invite the Office to set a time limit for the opponent to prove use...';
- 'Use of the earlier mark is hereby contested...';
- 'Use of the earlier mark is disputed in accordance with Article 42 CTMR.';
- 'The applicant raises the objection of non-use.' (decision of 05/08/2010, R 1347/2009-1 – 'CONT@XT').

Not sufficiently explicit and unambiguous request:

- 'The opponent has used its mark only for ...';
- 'The opponent has not used its mark for ...';
- 'There is no evidence that the opponent has ever used his mark ...';
- '[T]he opponents' earlier registrations cannot be "validly asserted against the CTM Application...", since "...no information or evidence of use ... has been provided..." (decision of 22/09/2008, B 1 120 973).

An implicit request is accepted as an exception to the above rule, when the opponent spontaneously sends evidence of use before the applicant's first opportunity to file arguments and, in its first reply, the applicant challenges the evidence of use filed by the opponent (judgment of 12/06/2009, T-450/07, 'Pickwick COLOUR GROUP'). In such a case, there can be no mistake as to the nature of the exchange, and the Office should consider that a request for proof of use has been made and give the opponent a deadline for completing the evidence. In the event that proceedings have been closed and the existence of a request for proof of use is found out only when a decision has

be taken, the examiner should re-open the proceedings and give the opponent a deadline for completing the evidence.

In all events, the request has to be *unconditional*. Phrases such as 'if the opponent does not limit its goods/services in Classes 'X' or 'Y', we demand proof of use', 'if the Office does not reject the opposition because of lack of likelihood of confusion, we request proof of use' or 'if considered appropriate by the Office, the opponent is invited to file proof of use of its trade mark' present conditional or auxiliary claims, which are not valid requests for proof of use (decision of 26/05/2010, R 1333/2008-4 – 'RFID SOLUTIONS').

3.1.3 Applicant's interest to deal with proof of use first

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

If, however, the request is completely invalid, the Office will close proceedings without granting the applicant a further opportunity to submit observations (see paragraph 3.1.5 below).

3.1.4 Reaction if request is invalid

If the request is invalid on any of the above grounds or if the requirements of Article 42(2) and (3) CTMR are not met, the Office nevertheless forwards the applicant's request to the opponent but advises both parties of the invalidity of the request.

The Office will immediately terminate the proceedings if the request is completely invalid and not accompanied by any observations by the applicant. However, the Office can extend the time limit established in Rule 20(2) CTMIR if such an invalid request was received before expiry of the time limit set for the applicant but was not dealt with by the Office until after expiry thereof. Because refusal of the request for proof of use after expiry of the time limit will disproportionately harm the interests of the applicant, the Office extends the time limit by the number of days that were left when the party submitted its request. This practice is based on the rules of fair administration.

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

3.2 Express invitation by the Office

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

use (decision of 28/02/2011, R 0016/2010-4, 'COLORPLUS', para. 20; decision of 19/09/2000, R 0733/1999-1, 'Affinité/Affinage').

In cases where the request for proof of use arrives during the cooling-off period and is communicated to the opponent during that period, the deadline for submitting proof of use will coincide with the deadline for providing initial or additional facts, evidence and arguments. The time limit will be extended automatically if the cooling-off period is extended.

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

3.3 Reaction from the opponent: providing proof of use

3.3.1 Time limit for providing proof of use⁸

The Office gives the opponent two months to submit proof of use. The opponent may request an extension of the deadline in accordance with Rule 71 CTMIR. The common practice on extensions is applicable to these requests⁹.

Rule 22(2) CTMIR expressly states that the Office will reject the opposition if the opposing party does not provide proof of use before the time limit expires.

Two scenarios are to be differentiated:

- The opponent has not submitted **any or no relevant evidence** within the time limit: the submission of relevant evidence of proof of use for the first time after the expiry of the time limit results in rejection of the opposition **without the Office having any discretionary powers**. In that regard the Court has held that Rule 22(2) CTMIR is an essentially procedural provision and that it is apparent from the wording of that provision that when no proof of use of the mark concerned is submitted within the time limit set by OHIM, the opposition must automatically be rejected (judgment of 18/07/2013, C-621/11 P, 'Fishbone', paras 28 and 29).
- The opponent has submitted **relevant evidence** within the time limit and presents **additional** evidence after the time limit has expired: in such a case, where the additional evidence merely strengthens and clarifies the prior relevant evidence submitted within the time limit, and provided the opponent does not abuse the time-limits set by knowingly employing delaying tactics or by demonstrating manifest negligence, the Office may take into account the evidence submitted out of time as a result of an **objective, reasonable exercise of the discretion** conferred on it by Article 76(2) CTMR (judgment of 29/11/2011, T-415/09, 'Fishbone', para. 31; confirmed by judgment of 18/07/2013, C-621/11 P, 'Fishbone', paras 28, 30). The Court made it clear that, *mutatis mutandis*, the same considerations apply to revocation proceedings (judgment of 26/09/2013, C-610/11 P, 'Centrotherm', para. 110 applying Rule 40(5) CTMIR).

⁸ Amended on 02/06/2014.

⁹ See The Guidelines, Part C, Opposition, Section 1, Procedural Matters, paragraph 6.2.1, Extension of time limits in opposition proceedings.

The Office shall duly motivate why it rejects or takes into account ‘additional evidence’ in the decision. General statements such as ‘the evidence is not relevant’ or ‘the opponent has not justified why the additional evidence has been submitted after the expiry of the time limit’ will not suffice (judgment of 26/09/2013, C-621/11 P, ‘Centrotherm’, para. 111).

As regards the exercise of that discretion taking such facts and evidence into account, it is particularly likely to be justified where the Office considers, first, that the material produced late is, on the face of it, likely to be relevant to the outcome of the opposition and, second, that the stage of the proceedings at which that late submission takes place and the circumstances surrounding it do not preclude such matters being taken into account (judgment of 13/03/2007, C-29/05 P ‘ARCOL/CAPOL’, para. 44).

3.3.2 Means of evidence

3.3.2.1 Principles

The evidence of use must be provided in a structured manner.

Article 76(1) CTMR provides that ‘...in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties ...’ The filing of evidence must be sufficiently clear and precise to enable the other party to exercise its right of defence and the Office to perform its examination, without reference to extraneous or supportive information.

Essentially, the Office is prevented from making the case for one or other party and cannot take the place of the opponent, or its counsel, by itself trying to locate and identify among the documents on file the information that it might regard as supporting proof of use. This means that the Office should not seek to improve the presentation of any party’s evidence. Responsibility for putting evidence in order rests with the party. Failure to do so leaves open the possibility that some evidence may not be taken into account.

In terms of format and content of evidence submitted, the Office recommends that the following be taken into account as key aspects of a structured presentation:

1. The corresponding **file number** (CTM, Opposition, Cancellation, and Appeal) should be included at the top of all correspondence.
2. A separate communication for documents with Proof of Use should be provided. Nevertheless, if correspondence includes urgent issues such as a request for limitation, suspension, extension of time, withdrawal, etc., indication of this should also be included on the front page.
3. The total **number of pages** of correspondence should be stated. **Page numbering** of annexes is equally important.
4. The Office strongly recommends that the opponent does **not exceed a maximum of 110 pages** in its correspondence.

5. If the documentation is sent in different packages, an **indication of the number of packages** is recommended.
6. If a large amount of documentation is submitted by fax in different batches, an indication of the total number of pages, number of batches and identification of the pages contained in each batch is recommended.
7. Use plain **DIN-A4** sheets in preference to other formats or devices for all the documents submitted **including separators** between annexes or enclosures, as they can also be scanned.
8. Physical specimens, containers, packaging, etc. should not be sent. Instead, a picture should be taken of them, which should be printed (if relevant in colour, if not in black and white) and sent as a document.
9. Original documents or items sent to the Office should not be stapled, bound or placed in folders.
10. **The second copy** for forwarding to the other party should be **clearly identified**.
11. If the original is submitted to the Office only by fax, **no second fax copy** should be sent.
12. The front page should clearly indicate whether the correspondence submitted contains **colour elements** of relevance to the file.
13. A second set of colour elements should be included for sending to the other party.

These recommendations are also sent to the opponent together with the Office's communication of the applicant's request for proof of use.

According to Rule 22(4) CTMIR, the evidence is to be filed in accordance with Rules 79 and 79a and, in principle, is confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 78(1)(f) CTMIR. Rule 22(4) CTMIR also allows market surveys and quotations of the mark in lists and publications of associations of the relevant profession as suitable means of evidence (decisions of 14/03/2011, B 1 582 579, and of 18/06/2010, B 1 316 134).

Price lists and catalogues are examples of 'material stemming directly from the party itself'. A company's 'annual report and accounts' would also come under that heading.

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

The requirement of proof of use always raises the question of the *probative value* of the submitted material. The evidence must at least have a certain degree of reliability. As a general rule, the Office considers material produced by third parties as being of a higher probative value than material produced by the owner himself or by its representative. Reference of the opponent to internal print-outs or hypothetical surveys or orders is particularly problematic. However, where material must regularly be

produced for use by the public and/or authorities according to statutory rules, for instance, company law and/or Stock Exchange Regulations, and where it may be assumed that such material is subject to certain official verification, its probative value is certainly higher than ordinary 'personal' material produced by the opponent (see also under 3.3.2.3 'Declarations').

3.3.2.2 References

The opponent may avail itself of findings of national offices and courts in parallel proceedings. Although the Office is not bound by findings of the national offices and courts, such decisions must be taken into account and may influence the Office's decision. It is important for the Office to have the possibility of considering the kind of evidence that led to the relevant decision at national level. The Office takes into account the different procedural and substantive requirements that may exist before the respective national body (decisions of 25/08/2003, R 1132/2000-4 – 'VANETTA', para. 16, and of 18/10/2000, R 0550/1999-3 – 'DUKE', para. 23).

The opponent may wish to refer to material filed as proof of use in previous proceedings before the Office (confirmed by the GC in 'ELS' quoted above). The Office accepts such references on condition that the opponent clearly identifies the material referred to and the proceedings in which it was filed. If the reference does not sufficiently identify the relevant material, the Office requires the opponent to clearly specify the material referred to or to file it (decision of 30/11/2010, B 1 080 300). See further details on the conditions for identifying the relevant material in The Guidelines Concerning Proceedings Before the Office, Part C, Opposition, Section 1: Procedural Matters.

The onus of providing proof of use is on the opponent and not on the Office or the applicant. Therefore, a mere indication of the website where the Office can find further information is insufficient, as this does not provide the Office with sufficient indications about place, nature, time and extent of use (decision of 31/10/2001, B 260 192).

3.3.2.3 Declarations

Whereas the means of evidence listed, such as packages, labels, price lists, catalogues, invoices, photographs and newspaper advertisements, do not present any particular problems, it is necessary to consider in some detail declarations as referred to in Article 78(1)(f) CTMR.

The opposing party is not obliged to submit an affidavit concerning the sales made under the earlier trade mark. It is up to the opposing party to select the form of evidence that it considers suitable for the purpose of establishing that the earlier trade mark was put to genuine use during the relevant period (judgment of 08/07/2004, T-203/02, 'VITAFRUIT', para. 37).

Distinction between admissibility and relevance (probative value)

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

As far as *admissibility* is concerned, Rule 22(4) CTMIR expressly mentions written statements referred to in Article 78(1)(f) CTMR as admissible means of proof of use. Article 78(1)(f) CTMR cites means of giving evidence, amongst which are sworn or affirmed written statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. Therefore, it has to be evaluated whether the statement submitted constitutes a statement within the sense of Article 78(1)(f) CTMR. Only in cases where the statements have not been sworn or affirmed is it necessary to consider the rules of law of the national jurisdiction as to the effects of a written statement (judgment of 07/06/2005, T-303/03, 'SALVITA', para. 40). In cases of doubt as to whether a statement has been sworn or affirmed, it is up to the opponent to submit evidence in this regard.

Article 78(1)(f) CTMR does not specify by whom these statements should be signed so that there is no reason to consider that statements signed by the parties to the proceedings themselves are not covered by this provision (judgment of 16/12/2008, T-86/07, 'DEITECH-DEI-tex', para. 46).

With regard to *probative value*, neither the CTMR nor the CTMIR supports the conclusion that the evidential value of items of evidence of use of the mark, including affirmations, must be assessed in the light of the national law of a Member State. Irrespective of the position under national law, the evidential value of an affidavit is relative, i.e. its contents have to be assessed freely (judgment of 28/03/2012, T-214/08, 'OUTBURST', para. 33). The probative value of a statement depends first and foremost on the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (judgment of 07/06/2005, T-303/03, 'SALVITA', para. 42).

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

Declarations by the proprietor or its employees

Statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by personal interests in the matter (decision of 11/01/2011, R 0490/2010-4 – 'BOTODERM', para. 34; decisions of 27/10/2009, B 1 086 240 and of 31/08/2010, B 1 568 610).

However, this does not mean that such statements are totally devoid of all probative value (judgment of 28/03/2012, T-214/08, 'OUTBURST', para. 30). Generalisation should be avoided, since the exact value of such statements always depends on its concrete form and content. Statements including detailed and concrete information have a higher probative value than very general and abstractly drafted statements.

The final outcome depends on the overall assessment of the evidence in each individual case. In general, further material is necessary for establishing evidence of use, since such statements have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources. Therefore, the probative strength of the further material submitted is very important. An assessment should be made of whether the content of the affidavit is sufficiently supported by the further material (or vice versa). The fact that the national

office concerned may adopt a certain practice in assessing such kind of evidence of use does not mean that it is applicable in the proceedings concerning Community trade marks (judgment of 07/06/2005, T-303/03, 'Salvita', paras 41 *et seq.*).

A change of ownership that took place after the date of publication of the CTM application may render declarations made by the new owners void as the latter generally do not have any direct knowledge as a basis for making declarations concerning use of the mark by the previous owner (decision of 17/06/2004, R 0016/2004-1 – 'Reporter').

Nevertheless, in the case of a transfer or other succession in title, any new owner may rely on use within the grace period concerned by their predecessor(s). Use made by the predecessor may be evidenced by the predecessor and by all other reliable means, for instance, information from business records if the predecessor is not available.

Declarations by third parties

Statements (such as e.g. surveys) drawn up *by an independent source*, for example by experts, professional organisations, Chambers of Commerce, suppliers, customers or business partners of the opponent, are given more probative weight (see decision of 19/01/2011, R 1595/2008-2 – 'FINCONSUMO', para. 9(ii); decision of 30/03/2010, R 0665/2009-1 – 'EUROCERT', para. 11 and decision of 12/08/2010, B 1 575 615).

This practice is in line with the case-law of the Court of Justice in the 'Chiemsee' judgment (judgment of 04/05/1999, joined cases C-108/1997 and C-109/1997), where the Court gave some indications of appropriate evidence proving the acquired distinctiveness of a mark in the market place. Although acquisition of distinctiveness is not per se the same as genuine use, the former does comprise elements of evidence of use of a sign on the market. Consequently, case-law relating to these can be used by analogy.

Statements drawn up by the parties themselves are 'third party evidence' whereas all other evidence, such as opinion polls, statements from Chambers of Commerce, or from professional organisations or from experts, originates from third parties.

3.4 Reaction from the applicant

3.4.1 Forwarding of evidence

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

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

3.4.2 Insufficient proof of use

However, the Office may close the proceedings immediately if insufficient proof of use or no evidence at all has been filed within the time limit given and all the earlier rights of the opposition are affected. The rationale behind this practice is to avoid the

continuation of the proceedings when their outcome is already known, that is, the rejection of the opposition for lack of proof of use (principle of economy and good administration of proceedings). The Office does so only in cases where the evidence submitted is *clearly* insufficient to constitute proof of genuine use.

In cases where the evidence might suffice, it is forwarded to the applicant giving the party two months to file its observations. The Office must not indicate to the opponent that the sufficiency of the evidence is doubtful, or even invite the opponent to file further evidence in such cases. Such acts would be against the impartial position of the Office in adversarial proceedings (decision of 01/08/2007, R 0201/2006-4 – ‘OCB/O.C.B.’, para. 19).

3.4.3 No reaction from applicant

If the applicant does not react within this time limit, the Office will give a decision on the basis of the evidence before it. The fact that the applicant does not reply does not mean that it accepts the submitted evidence as sufficient proof of use (judgment of 07/06/2005, T-303/03, ‘Salvita’, para. 79).

3.4.4 Formal withdrawal of the request

Where the applicant reacts to the proof of use by formally withdrawing its request for proof of use, the issue will no longer be relevant. As it is the applicant who sets in motion the respective procedure, the applicant logically is in a position to bring an end to this part of the proceedings by formally withdrawing its request (decision of 21/04/2004, R 0174/2003-2 – ‘Sonnengarten’, para. 23).

3.5 Further reaction from the opponent¹⁰

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

The Board of Appeal has regarded failure to allow the opponent to comment in such a case as a substantial procedural violation (decision of 28/02/2011, R 16/2010-4 – ‘COLORPLUS’, para. 20).

For further details on the submission of additional evidence, see paragraph 3.3.1 above.

3.6 Languages in proof of use proceedings

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

¹⁰ Amended on 02/06/2014.

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

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

On the other hand, the applicant has the right to be informed about the content of the evidence filed in order to be capable of defending its interests. It is absolutely necessary that the applicant is able to assess the content of the evidence of use submitted by the opponent. In this regard, the nature of the documents submitted has to be taken into account. For example, it might be considered that 'standard' invoices and samples of packaging do not require a translation in order to be understood by the applicant (judgment of 15/12/2010, T-132/09, 'EPCOS', paras 51 *et seq.*; decisions of 30/04/2008, R 1630/2006-2 – 'DIACOR', paras 46 *et seq.* (under appeal T-258/08) and of 15/09/2008, R 1404/2007-2 – 'FAY', paras 26 *et seq.*).

If the applicant explicitly requests a translation of the evidence in the language of the proceedings, the Office, in principle, will require a translation from the opponent. However, a rejection of such a request is feasible where it appears that the applicant's request, in view of the self-explanatory character of the submitted evidence, is exaggerated or even abusive.

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

3.7 Decision

3.7.1 Competence of the Office

The Office makes its own evaluation of the evidence of use submitted. This means that the probative value of the evidence submitted is evaluated independently of the observations submitted by the applicant in this respect. Assessment of the relevance, pertinence, conclusiveness and efficacy of evidence lies within the discretion and power of judgment of the Office, not the parties, and falls outside the adversarial principle which governs *inter partes* proceedings (decisions of 01/08/2007, R 201/2006-4 – 'OCB', para. 19 and of 14/11/2000, R 823/1999-3 – 'SIDOL').

A declaration by the applicant concluding that use has been proved does not, therefore, have any effect on the Office's findings. The request for proof of use is a defence plea by the applicant. However, once the defence plea has been raised by the applicant, it is solely up to the Office to carry out the subsequent procedure and evaluate whether the evidence submitted by the opponent is to be regarded as of

sufficient probative value. However, the applicant does have the possibility of formally withdrawing the request for proof of use (see paragraph 3.4.4 above).

This is not contrary to Article 76(1) CTMR, which stipulates that in *inter partes* proceedings the Office is restricted in its examination to the facts, evidence and arguments provided by the parties and the relief sought. However, although the Office is bound by the facts, evidence and arguments provided by the parties, it is not bound by the legal value that the parties may give thereto. Hence, the parties may agree as to which facts have been proved or not, but may not determine whether or not these facts are sufficient to establish genuine use (decisions of 01/08/2007, R 0201/2006-4 – ‘OCB’, para. 19, and of 14/11/2000, R 0823/1999-3 – ‘SIDOL’, para. 20; and also decision of 13/03/2001, R 0068/2000-2 – ‘NOVEX PHARMA’).

3.7.2 Need for taking a decision

A decision on fulfilment of the obligation of having genuinely used the registered mark is not always necessary. The question of proof of use is not to be considered as a preliminary question that always has to be examined first when taking a decision on substance. Neither Article 42(2) CTMR nor Rule 22(1) CTMIR indicates this to be the case.

When **proof of use** of the earlier rights has been requested by the applicant, the Office will also examine whether, and to what extent, use has been proved for the earlier marks, provided this is relevant for the outcome of the decision in question:

- If there are earlier rights that were not subject to the obligation of use and which lead to a conclusion of likelihood of confusion, there is no need to assess the proof of use provided for the other earlier rights.
- Additionally, if the signs or the goods and services for which the earlier mark is registered are dissimilar to those of the contested trade mark, or if there is no likelihood of confusion between the signs, there is no need to enter into the question of proof of use.

3.7.3 Overall assessment of the evidence presented

As stated in more detail above (see paragraph 2.2 above), the Office has to evaluate the evidence submitted with regard to place, time, extent and nature of use in an *overall assessment*. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (judgment of 17/02/2011, T-324/09, ‘Friboi’, para. 31).

The *principle of interdependence* applies, meaning that weak evidence with regard to one relevant factor (e.g. low sales volume) might be compensated by solid evidence with regard to another factor (e.g. continuous use over a long period of time).

All the circumstances of the specific case have to be taken into account *in conjunction with each other* in order to determine whether the mark in question has been genuinely used. The particular circumstances can include e.g. the specific features of the goods/services in question (e.g. low/high-priced; mass products vs. special products) or the particular market or business area.

Indirect/circumstantial evidence, under certain conditions even on its own, can also be suitable for proving genuine use.

As the Office does not assess commercial success, even minimal use (but not mere token or internal use) can be sufficient to be deemed 'genuine', as long as it is viewed as warranted in the economic sector concerned to maintain or acquire a share in the market.

The decision indicates what evidence was filed. However, in general, only the evidence relevant for the conclusion is mentioned. If the evidence is found convincing, it suffices for the Office to indicate those documents that were used to come to this conclusion and why. If an opposition is rejected because the proof of use was not sufficient, likelihood of confusion is not to be addressed.

3.7.4 Examples

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

3.7.4.1 Genuine use accepted

Case No	Comment
Judgment of 17/02/2011, T-324/09, 'Friboi'	The opponent (Fribo Foods Ltd.) submitted several invoices relating to large quantities of goods, addressed to its distribution company (Plusfood Ltd.), which belongs to the same group (Plusfood Group). It is not disputed that the distribution company put the products on the market later. Furthermore, the opponent presented undated brochures , a press clip and three price lists . With regard to the 'internal' invoices, the Court held that the chain producer-distributor-market was a common method of business organisation, which could not be regarded as purely internal use. The undated brochures had to be seen in conjunction with other dated evidence such as invoices and price lists and, therefore, might still be taken into consideration. The Court accepted genuine use and stressed that an overall assessment implied that all the relevant factors be viewed as a whole and not in isolation.
Decision of 02/05/2011, R 0872/2010-4, 'CERASIL'	The opponent submitted inter alia about 50 invoices , not in the language of proceedings. The names of the addressees as well as the quantities sold were blacked out. The Boards held that standard invoices containing the usual information (date, indication of seller's and buyer's name/address, product concerned, price paid) did not require a translation. Even though the names of the addressees and the quantities sold were blacked out, the invoices nevertheless confirmed the sale of 'CERATOSIL' products, measured in kilograms, to companies throughout the relevant territory during the relevant period. Together with the remaining evidence (brochures, affidavit, articles, photographs), this was considered sufficient to prove genuine use.
Decision of 29/11/2010, B 1 477 670	The opponent, who was active in the field of vehicle maintenance and the management of businesses associated with buying and selling vehicles, provided several Annual Reports giving a general overview of its overall commercial and financial activities. The OD found that these reports, by themselves, did not provide sufficient information on actual use for the majority of services claimed. However, in conjunction with advertisements and publicity displaying the mark in question for particular services, the OD concluded that the evidence as a whole provided sufficient indications as to the scope, nature, period and place of use for these services.

Decision of 29/11/2010, R 0919/2009-4 – 'GELITE'	The documents submitted by the appellant show use of the trade mark in relation to 'coating materials based on artificial resin (base, intermediate and top coatings) and industrial lacquers'. The attached labels show use of the trade mark for various base, primer and top coatings. This information coincides with the attached price lists . The associated technical information sheets describe these goods as corrosion coatings based on artificial resin, which are offered for sale in various colours. The attached invoices show that these goods were supplied to various customers in Germany. Although the turnover figures stated in the written declaration in relation to the period from 2002 to 2007 do not expressly refer to Germany, it must be concluded that they were obtained at least in part also in Germany. Consequently, the earlier mark is deemed to be used for the goods 'lacquer, lacquer paints, varnishes, paints; dispersions and emulsions to coat and repair surfaces' because it is not possible to create any further sub-categories for these goods.
Decision of 20/04/2010, R 0878/2009-2 – 'SOLEA'	The solemn declaration refers to high sales figures (over EUR 100 million) for marked products from 2004 to 2006 and attaches internet extracts of pictures of the products sold during the relevant period (soap, shampoo, deodorant (for feet and body), lotions, and cleaning items). Although the internet extracts bear a copyright date of 2008, the credibility of what the declaration affirms is reinforced by the judgment of the State Court of Mannheim, a copy of which had been adduced previously by the opponent in order to demonstrate the enhanced distinctiveness of the earlier mark and which referred to the market share enjoyed by products bearing the opponent's mark for ladies' face care products (6.2%), caring lotions (6.3%), shower soaps and shampoos (6.1%) and men's face care and shaving products (7.9%). Moreover, the judgment states that according to a GfK study one fifth of German citizens purchase at least one BALEA product per annum. Reference is also made to two further studies that demonstrate that the brand is well known in Germany. Thus, proof of use for the mark has been demonstrated sufficiently for the products on which the opposition is based.
Decision of 25/03/2010, R 1752/2008-1 – 'ULUDAG'	The evidence provided to substantiate use of the earlier Danish trade mark appears to be sufficient. The Board is satisfied that the invoice provided shows place and time of use, as it proves the sale to a Danish company of 2 200 cartons of products within the relevant date. The labels filed show use on soft drinks bearing the mark as represented on the registration certificate. As to the question whether proof consisting of one single invoice is sufficient in terms of extent of use, in the Board's view, the content of that invoice, in the context of the remaining pieces of evidence, serves to conclude that the use made of the mark in Denmark is sufficient and genuine in connection with 'aerated water, aerated water with fruit taste and soda water'.

3.7.4.2 Genuine use not accepted

Case No	Comment
Judgment of 18/01/2011, T-382/08, 'VOGUE'	The opponent submitted a declaration from the opponent's managing partner and 15 footwear manufacturers ('footwear has been produced for the opponent under the trade mark VOGUE over a number of X years'), 35 photographs of VOGUE footwear models, photographs of stores and 670 invoices issued to the opponent by footwear manufacturers. The Court held that the declarations did not provide sufficient evidence concerning the extent, place and time of use. The invoices concerned the sale of footwear <u>to</u> the opponent, not the sale of footwear to end consumers and, therefore, were not suitable for proving external use. Mere presumptions and suppositions ('highly unlikely', 'unreasonable to think', '... which probably explains the absence of invoices ...', 'reasonable to assume', etc.) cannot replace solid evidence. Therefore, genuine use was denied.
Decision of 19/09/2007, 1359 C (confirmed by R 1764/2007-4)	The owner of the mark owned a US-based airline, operating solely in the US. The fact that flights could also be booked via internet from the European Union could not alter the fact that the actual services of transportation (Class 39) were rendered exclusively outside the relevant territory. Furthermore, the lists

	<p>submitted of passengers with addresses in the European Union could not prove that the flights had actually been booked from Europe. Finally, the website was exclusively written in English, the prices were announced in US dollars and the relevant telephone and fax numbers were from within the US. Therefore, genuine use in the relevant territory was denied.</p>
<p>Decision of 04/05/2010, R 0966/2009-2 – 'COAST'</p>	<p>There are no special circumstances which might justify a finding that the catalogues submitted by the opponent, on their own or in combination with the website and magazine extracts, prove the extent of use of any of the earlier signs for any of the G&S involved. Although the evidence submitted shows use of the earlier sign in connection with '<i>clothing for men and women</i>', the opponent did not produce any evidence whatsoever indicating the commercial volume of the exploitation of this sign to show that such use was genuine.</p>
<p>Decision of 08/06/2010, R 1076/2009-2 – 'EURO CERT'</p>	<p>It is well established in the case-law that a declaration, even if sworn or affirmed in accordance with the law under which it is rendered, must be corroborated by independent evidence. The declaration in this case, drawn up by an employee of the opponent's company, contains an outline of the nature of the relevant services, but only general statements concerning trade activities. It contains no detailed sales or advertising figures or other data that might show the extent and use of the mark. Furthermore, a mere three invoices with important financial data blanked out and a list of clients can hardly be considered corroborative evidence. Therefore, no genuine use of the earlier mark has been demonstrated.</p>
<p>Decision of 01/09/2010, R 1525/2009-4 – 'OFFICEMATE'</p>	<p>The spreadsheets with turnover figures and the Analysis and Review reports concerning sales figures are documents drawn up by or commissioned by the appellant itself and, therefore, have less probative value. None of the evidence filed contains any clear indication concerning the place of use of the earlier mark. The spreadsheets and the Analysis and Review Reports, which contain data compiled on the total value of estimated sales (in SEK) between the years 2003 to 2007, contain no information on where the sales took place. There is no reference to the territory of the European Union, where the earlier trade mark is registered. The invoices do not cover any sales of goods made by the appellant. Therefore, the evidence submitted is clearly insufficient to prove the genuine use of the earlier mark.</p>
<p>Judgment of 12/12/2002, T-39/01, 'HIWATT'</p>	<p>A catalogue showing the mark on three different models of amplifiers (but not indicating place, time or extent), a catalogue of the Frankfurt International trade fair showing that a company called HIWATT Amplification International exhibited at that fair (but not indicating any use of the trade mark) and a copy of the 1997 HIWATT Amplification Catalogue showing the mark on different models of amplifiers (but not indicating place or extent of use) were not considered sufficient to prove genuine use, principally because of lack of extent of use.</p>