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Proving Use of Trademarks in TM5 Offices

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Topics

1. Introduction
2. Criteria for assessing genuine use
 - Place of use
 - Time of use
 - Extent of use
 - Nature of use
3. Justification of non-use



1. INTRODUCTION

FUNCTION OF PROOF OF USE

➤ EUTMR establishes the obligation to genuinely use a trade mark

- Principle:

Use is a necessary condition for maintaining and exercising the exclusive right.



1. INTRODUCTION

FUNCTION OF PROOF OF USE

DEFENCE



Opposition



Invalidity (cancellation)



Denial for protection for an earlier mark

ATTACK



Revocation (cancellation)



Revocation of a registered mark

Consequences of non-use

1. INTRODUCTION

CONCEPT OF 'GENUINE USE'

There is a 'genuine use', if a trade mark is used

- ✓ • in accordance with its essential function,
- in order to create or preserve a market share,
- and use is not token.

(C-40/01, Ansul (Minimax))



Use that is not merely token;
 Not to assess commercial success or the economic strategy.

Means of evidence

- Invoices or orders, delivery notes, shipping documents, export documents, etc.
- Declarations by the proprietor or its employees, printouts from its website
- Declarations by third parties, such as experts, by the Chamber of Commerce
- Catalogues, brochures, advertising materials, price lists, etc.
- Advertising materials, catalogues and brochures.
- Opinion polls
- Newspaper articles, etc.





**FORMAT OF
EVIDENCE**

Numbered annexes to submissions including an index with the relevant indications

Attention! CDs or physical items in 2 copies!

2. CRITERIA FOR ASSESSING GENUINE USE

WHAT needs to be proven?

Article 10(3) EUTMDR

The indications and evidence of use must establish:

- the place,
- the time,
- the extent and
- the nature of use of the trade mark

Use must be in respect of the goods or services for which the mark is registered.

Burden of proof

Genuine use of a trade mark has to be established by its owner.

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2. CRITERIA FOR ASSESSING GENUINE USE - PLACE OF USE



PLACE OF USE

WHERE genuine use should be proven?

- In the territory where they are protected (EUTMs in EU).

- What about **import, export and transit**?
 - Export → YES (Article 18(1), second subparagraph, point (b) EUTMR)
 - Import → CAN BE
 - Transit → NO

2. CRITERIA FOR ASSESSING GENUINE USE - PLACE OF USE



PLACE OF USE

How to check the place of use in the evidence?

Some useful hints:

- Language of documents
- Currency
- Addresses



An indication of the registered seat of the owner may be not sufficient.

FACTURA

VINS DUPRAT
Qual Piece Noyee
Chemin St. Bernard
BAYONNE, 64100
FRANCIA



PLACE OF USE

NUMERO FACTURA	FECHA	C.CLTE.	C.I.F. / D.N.I.	SU PROVEEDOR	N.PAG
11-100149	23/02/11	21014	FR79582720603		1

ARTICULO	DESCRIPCION	CANTIDAD	PRECIO	% DTO		IMPORTE
				Comerc.	Promoci.	
060100200 060100200	S/albaran 11-000622 DEL 23/02/11 S/Pedido DEL 23/02/11 Sidra refr EVA manzanas 75 cl corcho ba Sidra refr EVA manzanas 75 cl corcho ba 5 PALLETS EX WORKS EL CLIENTE RECOGE EN RHENUS IRUN	45 5	11,36			511,20



FORMA PAG TRANSFERENCIA	BASE IMPONIBLE	%	I.V.A.	% REC. EQUIVA
VENCOS.....24/04/11 IMP 511,20 EUR	511,20			
	511,20			
BANCO..... CTA. CTE.....		TOTAL FACTURA	EUR	511,20

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2. CRITERIA FOR ASSESSING GENUINE USE - TIME OF USE



TIME OF USE

During **WHAT PERIOD** genuine use should be proven?

➤ Calculation of the relevant time - *Opposition*

- 5 years prior to the filing or priority date of the contested EUTM application (IR or subsequent designation).



Relevant period: 15/12/2015 – 14/12/2020

2. CRITERIA FOR ASSESSING GENUINE USE - TIME OF USE



TIME OF USE

proven ?

During **WHAT PERIOD** genuine use should be

➤ Calculation of the relevant time – ***Cancellation (Invalidity)***

- 5 years preceding the date of application for declaration of invalidity
- 5 years preceding the date of the filing or priority date of the contested EUTM



2. CRITERIA FOR ASSESSING GENUINE USE - TIME OF USE



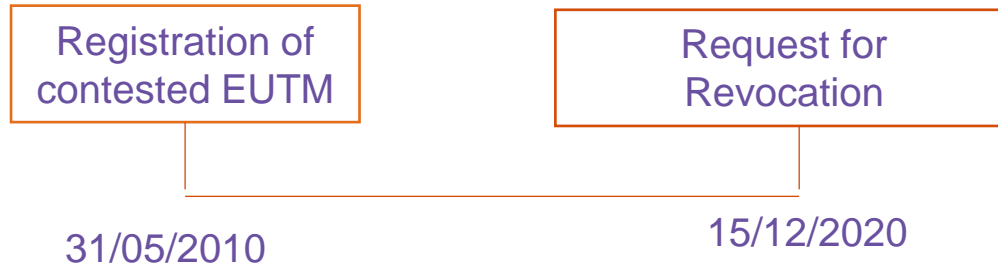
TIME OF USE

During **WHAT PERIOD** genuine use should be

proven?

➤ Calculation of the relevant time – **Cancellation (Revocation)**

- 5-year period preceding the date of the application for revocation



Relevant period: 15/12/2015 – 14/12/2020

2. CRITERIA FOR ASSESSING GENUINE USE - TIME OF USE



TIME OF USE

- Evidence dated outside the relevant period is, *in general*, immaterial,
→ *unless* it confirms use within the 5-year period, the proprietor's intentions.
- Undated evidence might be taken into consideration under certain circumstances.

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2. CRITERIA FOR ASSESSING GENUINE USE - EXTENT OF USE



EXTENT OF USE

- **Criteria:**
 - Commercial volume
 - Market characteristics, type of goods/services
 - Territorial scope (geographical dimension) of use
 - Duration and frequency of sales

- Interdependence between the factors!

- No *de minimis* rule!

2. CRITERIA FOR ASSESSING GENUINE USE - EXTENT OF USE

Examples

Genuine use



Meat: for EUR 44 988, over 4 years, in the EU/Spain (T-737/19 Montesierra)

17 invoices, in three different EU countries, in two different regions of Spain

Medical devices: 121 devices for EUR 19 900, over 3 years, in Finland (T-325/06 Capio)

2. CRITERIA FOR ASSESSING GENUINE USE - EXTENT OF USE

Examples



Not sufficient

Chocolate products: 3.6 kg of exclusive, handmade chocolate, over 22 months, in Germany (T-355/09 Walzer Traum)
sold only in one bakery/confectionery in one small German town

Coffee: for EUR 3 320, within five months, in the EU (T-220/18, Battistino)
7 invoices, small area in Italy, sold in limited quantities in a limited market, not expensive/luxury product

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2. CRITERIA FOR ASSESSING GENUINE USE - NATURE OF USE



NATURE OF USE

➤ **Three main aspects:**

1. Use as trade mark (in accordance with its essential function in the course of trade)
2. Use in a form which as registered or as a variant
3. Use for the goods and services for which it is registered

2. CRITERIA FOR ASSESSING GENUINE USE - NATURE OF USE



1. Use of the trade mark in accordance with its essential function in the course of trade

- **Use as a trade mark in accordance with its essential function**
 - Use as a certification mark, PGI/PDO → NO
 - Use as company, trade or shop name, a domain name → CAN BE
- **Use in the course of trade: publicly and for commercial purposes**
 - Use on promotional items → NO
 - Internal use within a company or group of companies → NO
 - Sales by a third party → YES

2. CRITERIA FOR ASSESSING GENUINE USE - NATURE OF USE



2. Use of the trade mark as registered or a variant thereof (Common Practice CP8)

Article 18 EUTMR

(...) use of the European Union 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 shall constitute use (...)

➤ **No strict identity** between the sign as registered and the sign as used is required.

Rationale: The owner should be able to adapt the sign to marketing and promotion requirements



→ Possible modifications: additions; omissions or other changes

2. CRITERIA FOR ASSESSING GENUINE USE - NATURE OF USE



2. Use of the trade mark as registered or a variant thereof (Common Practice CP8)

Examples: Use in a form other than registered

Mark registered as:	Mark used as:
	<i>Everyday Clothing Concept</i> 
BUBBLEKAT	BUBBLEKAT PARIS
GERIVAN	GERIVAN








2. CRITERIA FOR ASSESSING GENUINE USE - NATURE OF USE



2. Use of the trade mark as registered or a variant thereof (Common Practice CP8)

Examples: Use in a form other than registered

Mark registered as:	Mark used as:
	
	
	<p>BUBBLEKAT</p>



2. CRITERIA FOR ASSESSING GENUINE USE - NATURE OF USE



3. Use of the trade mark in relation to the goods / services

- Use can be for **all** or **some** of the goods/services
- **Use for all the goods/services**
 - use for several specific goods falling within a general category covered by the mark.

Example:

Registered for	Used for	Use accepted for
<i>Clothing</i>	<i>Skirts, trousers and t-shirts</i>	<i>Clothing</i>

2. CRITERIA FOR ASSESSING GENUINE USE - NATURE OF USE



3. Use of the trade mark in relation to the goods / services

➤ *Use for some of the goods/services*

- Trade mark registered for a broad category of goods/services
- Evidence shows use only for specific goods/services falling within this category

T-126/03, Aladin, § 45

- Identification of broad categories of goods/services
- Autonomous sub-categories

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3. JUSTIFICATION FOR NON-USE

PROPER REASONS FOR NON-USE

- Obstacles arising independently of the will of the trade mark proprietor



- A sufficiently direct relationship with trade mark



- Making use of trade mark impossible or unreasonable









More :

Guide to Proof of Use

<https://euipo.europa.eu/knowledge/enrol/index.php?id=3630>



Course details

-  Access:  Enrol
-  Duration: 400 min.
-  Language: EN
-  Level: Intermediate
-  Publication date: 19/07/2019
-  User rate: 5
-  Certificate: Yes



**Thank
You!**

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