TM5/INTA Seventh Joint Workshop
Proving Use of Trademarks in TM5 Offices

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EUIPO
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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
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)

 ATTACK

Revocation (cancellation)

Consequences of non-use

Denial for protection for an earlier mark

Revocation of a registered mark
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.

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

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

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 Piec Noyee
Chemin St. Bernard
BAYONNE, 64100
FRANCIA

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<thead>
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<th>FECHA</th>
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<th>C.I.F. / D.N.I.</th>
<th>SU PROVEEDOR</th>
<th>N.PAG</th>
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<td>EX WORKS</td>
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<td>RHENUS IRUN</td>
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<tr>
<th>FORMA PAG</th>
<th>TRANSFERENCIA</th>
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<th>% REC. EQUIVA</th>
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</tr>
<tr>
<td>BANCO</td>
<td></td>
<td>511,20</td>
<td></td>
<td></td>
</tr>
<tr>
<td>CTA. CTE.</td>
<td></td>
<td>TOTAL FACTURA EUR 511,20</td>
<td></td>
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</tr>
</tbody>
</table>
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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).

<table>
<thead>
<tr>
<th>Registration of earlier TM</th>
<th>Filing/priority date of contested EUTM application</th>
</tr>
</thead>
<tbody>
<tr>
<td>31/05/2010</td>
<td>15/12/2020</td>
</tr>
</tbody>
</table>

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

**Registration of earlier TM**

31/05/2004

**Filing/priority date of contested EUTM**

31/05/2011

**Request for declaration of invalidity**

01/06/2017

2nd relevant period

01/06/2006 – 31/05/2011

1st relevant period

01/06/2012 – 31/05/2017
2. CRITERIA FOR ASSESSING GENUINE 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

Registration of contested EUTM: 31/05/2010

Request for Revocation: 15/12/2020

Relevant period: 15/12/2015 – 14/12/2020
2. CRITERIA FOR ASSESSING GENUINE 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

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

**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**

**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 produc
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3. Justification of non-use
2. CRITERIA FOR ASSESSING GENUINE 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

<table>
<thead>
<tr>
<th>Mark registered as:</th>
<th>Mark used as:</th>
</tr>
</thead>
<tbody>
<tr>
<td>BUBBLEKAT</td>
<td>BUBBLEKAT PARIS</td>
</tr>
<tr>
<td>GERIVAN</td>
<td>GERIVAN</td>
</tr>
</tbody>
</table>
### 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

<table>
<thead>
<tr>
<th>Mark registered as:</th>
<th>Mark used as:</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image1" alt="GERIVAN" /></td>
<td><img src="image2" alt="GERIVAN" /></td>
</tr>
<tr>
<td><img src="image3" alt="Dolphin" /></td>
<td><img src="image4" alt="Dolphin" /></td>
</tr>
<tr>
<td><img src="image5" alt="BUBBLEKAT" /></td>
<td><img src="image6" alt="BUBBLEKAT" /></td>
</tr>
</tbody>
</table>

Note: The images of the marks are placeholders for actual images.
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:**

<table>
<thead>
<tr>
<th>Registered for</th>
<th>Used for</th>
<th>Use accepted for</th>
</tr>
</thead>
<tbody>
<tr>
<td>Clothing</td>
<td>Skirts, trousers and t-shirts</td>
<td>Clothing</td>
</tr>
</tbody>
</table>
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

Thank You!

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www.inta.org