



Promoting Intellectual
Property Rights in the
ASEAN Region

PROOF OF USE

Francesca Cangeri Serrano 19-20/10/2022



Funded by the European Union



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Function of proof of use

European Union legislation on trade marks establishes an obligation for the owner of a registered trade mark **to use** that mark in a genuine manner. The owner must put the mark to genuine use within a period of 5 years following its registration.

The owner has a 'grace period' of 5 years after registration, during which it cannot be required to demonstrate use of the mark.

The reason behind the requirement that earlier marks must be put to genuine use is to restrict the number of trade marks registered and protected and, consequently, the number of conflicts between them.

Characteristics of the request

- ❑ **Article 10(1) EUTMDR**
 - Unconditional - not admissible 'if the Office considers it appropriate, we invite...'
 - Explicit and unambiguous – positive wording. Not admissible “there is no evidence that the opponent has ever used its TM”

- ❑ **Article 10(2) EUTMDR**
 - In a separate document - The request must be separate from other submissions (separate sheet). If merged into observations (even though separate paragraph) is not ok

- ❑ **References to evidence in other files→**

We refer to the invoices that were submitted to the Office on 11/01/2014 in opposition proceedings B 1 234 567, together with exhibits 1 to 4, consisting of 20 pages.

Example

Means of evidence

Article 10(4) EUTMDR provides a non-exhaustive list of examples of use

The most common means of evidence received

Affidavits and
declarations

Opinion polls

Invoices

Marketing
materials

Others means of evidence

Evidence
from internet

Social media

Annual reports
and accounts

Catalogues
and brochures

Packaging

Standard of proof

- Place of use**
- Time of use**
- Extent of use**
- Nature of use**
 - Use for the goods or services for which the mark is registered
 - Use of the mark in forms different from that registered
 - Use as a trade mark in accordance with its function

Overall assessment – evidence assessed in conjunction with each other

Factors

Place of use

EUTM must be used ‘in the Union’

National marks: use in the relevant Member State

- **Not required in a substantial part of the relevant territory**

5 different provinces of Spain were sufficient (Case: 04/04/2019, T-779/17, VIÑA ALARDE / ALARDE, EU:T:2019:220, § 37, 41)

- **Used in the territory of a single Member State**

Case: 07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782, § 80

Addresses, Currency, language

Use for export purposes also constitutes valid use

Factors

Time of use

Documents from just outside the relevant period — Consideration in combination with other evidence for extent of use.

Extent of use

- Territorial scope or geographical dimension of use
- Commercial volume
- Market characteristics
- Duration and frequency of use

Interdependence - overall assessment

- Use not merely token - the owner has seriously tried to acquire a commercial position in the relevant market

Factors

☐ Nature of use

▪ Use as trademark

Case: 31/01/2019, C-194/17 P, Cystus, EU:C:2019:80, § 83

▪ Use in connection with relevant goods & services

❖ Catalogues and magazine submitted, the sign does not appear on the clothing, but in the page margins

Case: 17/09/2019, T-633/18, TON JONES / Jones (fig.) et al., EU:T:2019:608, § 70, 86-87

B 3 135 297 VINITES/VINATIS the evidence shows use for retail services of wines while the earlier mark covers alcoholic beverages and import-export services

Factors- Nature of use

Nature of use

Scenarios

- Used for all the registered goods & services
- Use for some of the registered goods & services
- Use for some of the registered goods & services which fall within a registered broad category

Subcategories

BoA decision	Registered goods or services	Goods or services used	Use accepted for the subcategory
R 269/2016-1 of 09/01/2017	Preparations made from cereals	Chocolate cereals and chocolate cereal bars	Chocolate cereals and chocolate cereal bars
R 295/2016-2 of 07/04/2017	Class 5: Pharmaceutical & Sanitary preparations	Eye drops	Ophthalmic pharmaceutical preparations

Factors – Nature of use

- ❑ **Art. 18 EUTMR → Use in a different form**
 - **Additions**
 - **Omissions**
 - **Alterations**

 - **Use which does not alter the distinctive character of the sign registered**

Factors- Nature of use

Use which does not alter the distinctive character of the sign registered

❖ Additions

Case: R 0918/2016-4

RATTI



Case: R 2297/2016-4

Fruitfuls



Case: T-426/13

AINHOA



AINHOA
AINHOA BIO

Factors- Nature of use

Use which alters the distinctive character of the sign registered

❖ Additions

Case: T- 514/10

FRUIT

FRUIT OF THE LOOM

Case: R 2435/2017-4

TECA

TECAMID

TECATHERM

TECAFLON

TECADUR

Case: T-204/12

VILA VITA PARC

Vila vita hotel & feriendorf panno[n]ia

Factors- Nature of use

- Use which alters the distinctive character of the sign registered

Omissions

Case: 1264/2016-5



Case: B 1034208

TONY HAWK



HAWK

Factors- Nature of use

- ❑ Use which alters the distinctive character of the sign registered

Other alterations

Case: T-82/14



Case: R 1753/2016 & R 1802/2016-4



Case: R 2066/2010-4



Factors- Nature of use

Use which alters the distinctive character of the sign registered

R 2041/2013-2



Mark used together with other signs

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





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THANK YOU



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