

## New evidence cannot be filed for first time at General Court European Union - NJORD

May 11 2016

In *Danila Facchinello v Office for Harmonisation in the Internal Market* (Case T-81/15), the General Court was asked to annul a decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO – formerly OHIM), ruling on infringement of Article 51(1)(a) of EU Regulation 207/2009, insofar as the First Board of Appeal revoked a Community trademark (now EU trademark (EUTM)) on the ground that the evidence provided by its proprietor was not capable of establishing genuine use of the mark. The General Court entirely dismissed the action, confirming the judgment of the First Board of Appeal.

The intervener, Olimpia Splendid SpA, asked the Cancellation Division of EUIPO to revoke the rights of the proprietor of the figurative trademark SYNTHESIS due to non-use. SYNTHESIS was registered in 2004 for goods and services in Classes 7, 9 and 11 of the Nice Classification and was more than five years old.

On the basis of an overall evaluation of the evidence provided, the Cancellation Division confirmed an EUTM registration for “air conditioning apparatus” (in Class 11) but declared the mark revoked, with effect from September 16 2009, for goods and services in Classes 7 and 9.

Olimpia Splendid brought an action before the First Board of Appeal requesting revocation also for Class 11, on the grounds that evidence provided by the EUTM proprietor was insufficient to prove a serious and real use of the mark in the period under consideration.

Olimpia Splendid claimed that only one of the documents provided as evidence effectively showed use of the mark. The evidence consisted of copies of invoices showing an insignificant amount of air conditioning equipment sold in European and non-European countries during a period of four months. One invoice in particular – due to its substantial amount (€94,797.75) – was taken into consideration by the Cancellation Division in its judgment. However, the description of the invoice did not clearly show how much of the total referred to sales under the attacked trademark.

Facchinello requested that the First Board of Appeal confirm the decision of the Cancellation Division in relation to goods in Class 11 and to declare the registration valid for Class 7.

According to Rule 40(5) in conjunction with Rule 22(3) of the EU Trademark Implementing Regulation, the indications and evidence for submitting proof of use must consist of indications concerning the place, time, extent and nature of use of the contested trademark for the goods and services for which it is registered. In accordance with settled case law, this proof can include:

- the trademark’s market share;
- the intensity, geographical scope and duration of use of the trademark;
- the amount invested by the company in promoting the trademark;
- the proportion of the relevant public that identifies the product with a certain company through the trademark; and
- rulings of chambers of commerce and industry or other professional associations.

The First Board of Appeal found that the proof of use was insufficient to confirm the trademark registration for products in the relevant classes and, consequently, declared the mark revoked.

Facchinello appealed the decision to the General Court. As part of the appeal, she filed additional invoices proving the sale of air conditioning equipment with the SYNTHESIS mark in the relevant period. However, the court held that this new evidence was inadmissible as it had not been filed before the case came to court. According to Article 65(2) of the European Trademark Regulation, actions before the court against decisions of the boards of appeal may be brought on the grounds of lack of competence, infringement of an essential procedural requirement or infringement of the treaty, the regulation or any rule of law relating to their application or misuse of power. It follows that, under the terms of Article 65(2) of the regulation, the court can review the legitimacy of decisions of the EUIPO Boards of Appeal, verifying, where necessary, whether a correct juridical qualification of the facts of the controversy has been given or whether the evaluation of the elements of fact submitted has been spoiled by mistakes. However, the court cannot rule on the substance in light of documents and evidence submitted for the first time before it.

With reference to the invoices previously provided, the court considered them as indicative elements related to the geographical scope of the use. Nevertheless, those elements – even if considered as a whole – did

IP offices  
Examination/opposition  
Court system  
Registration  
Cancellation  
Administration/management  
Supranational

not demonstrate a 'real' use of the mark under the meaning given by case law.

The appellant's claim focused, in particular, on an invoice for €94,797.75 dated March 8 2010 concerning exports to the United Kingdom, which was not considered by the First Board of Appeal in its decision. According to the court, the invoice did not distinguish with precision the three types of products referred to, insofar as the description mentioned three different models of air-conditioning equipment (Synthesis S13HPCPE, Millennium M13HPCPE and BABY B95HPCPE). Furthermore, it was not possible to identify which part of the whole amount referred to the sale of the Synthesis air-conditioning apparatus because the individual amounts of the products listed were hidden in the copy of that invoice as filed. Facchinello also did not prove that the Millennium M13HPCPE and BABY B95HPCPE were sold under the same mark SYNTHESIS; nor did she lodge a clearer copy of the invoice.

The court held that the other evidence introduced before the EUIPO, besides the invoices considered by the court, was insufficient to show the precise volume of the transactions related to the products countersigned by the controversial mark or to prove a constant use of the mark in the relevant period.

The court therefore dismissed Facchinello's appeal and upheld the First Board of Appeal's decision to revoke the mark SYNTHESIS concerning goods in Class 11.

The court's ruling is interesting for several reasons. First, it states that the notion of 'real use' of the mark, under the meaning of Rule 22(3) of the EU Trademark Implementing Regulation, must not be interpreted as directed to appraising the commercial success or contributing to the economic strategy of an enterprise, and not even to reserving the trademark's protection to commercial transactions for a quantitatively significant amount. As a trademark serves to guarantee the identity of origin of the goods and services for which it has been registered, its use must create and maintain a sales market for those goods. Consequently, the real use of a mark cannot be shown from probabilities, but must be founded on concrete and objective elements proving a real and sufficient use of that mark in the relevant market. Second, this case shows clearly that it is incumbent on an EUTM owner to have hard evidence of use readily available in case of attack for non-use. Finally, if evidence is not filed with the Board of Appeal, a registration may be cancelled, regardless of the actual use of the mark in Europe.

*Peter Gustav Olson, NJORD Law Firm, Copenhagen*

---

**World Trademark Review ([www.worldtrademarkreview.com](http://www.worldtrademarkreview.com)) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.**