



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

**DECISION  
of the Second Board of Appeal  
of 29 August 2012**

In Case R 1839/2011-2

**Copernicus-Trademarks Limited**

Devonshire House  
Manor Way  
Borehamwood  
Herts WD6 1QQ  
United Kingdom

CTM Proprietor / Appellant

represented by Erich Auer, Anton Baumgartner Str. 43/1, AT-1230 Vienna, Austria

v

**FMC AUTOMOBILES (Société par Actions Simplifiée)**

34, rue de la Croix de Fer  
FR-78100 St Germain en Laye  
France

Cancellation Applicant / Respondent

represented by Hogan Lovells, Avenida Maisonnave 22, ES-03003 Alicante, Spain

APPEAL relating to Cancellation Proceedings No 3998 C (Community trade mark registration No **5 150 032**)

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairperson and Rapporteur), H. Salmi (Member) and G. Bertoli (Member)

Registrar: P. López Fernández de Corres

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 20 June 2006, VERUS EOOD ('the CTM proprietor') sought to register the word mark

### FEELING

for 'vehicles, and parts and fittings therefor, included in Class 12; wheels for vehicles' in Class 12.

- 2 The application was published in the **Community Trade Marks Bulletin No 49/2006 of 4 December 2006** and the mark was registered on 13 April 2007.
- 3 On 4 November 2009, FMC AUTOMOBILES (Société par Actions Simplifiée) ('the Cancellation applicant') filed a request for a declaration of invalidity.
- 4 The grounds for the request for a declaration of invalidity were those laid down in **Article 53(1)(a) CTMR**.
- 5 The application for a declaration of invalidity was based on the French trade mark registration No **96 633 095** of the word mark 'FEELING', filed on 5 July 1996 and registered on 30 December 1996 for the following goods in Class 12: 'vehicles, apparatus for locomotion by land, by air or by water; bodies for vehicles; engines for land vehicles; trees and transmissions for land vehicles; shock absorbers and vehicle suspension springs; rims and wheel hub caps; pneumatic tyres; spikes for tyres; gearboxes for land vehicles; hydraulic circuits for automobiles; seats and headrests for vehicles seats; seat covers for vehicles; sound alarms against theft; breaks for vehicles, brake linings for vehicles; brake shoes for vehicles, break segments for vehicles; clutches for land vehicles; chassis for automobile vehicles; bumpers for automobiles; cork for tanks for motor fuel vehicles; safety belts for the seats of vehicles; bags inflatable for protection of driver and occupying vehicle in case of shocks accidental; devices cooling engines land vehicles; repair outfits for inner tubes; direction signals for vehicles; windscreen wipers; interior trimmings for cars; hubs for vehicle wheels; windscreens and window glass for cars; anti dazzle devices for vehicles; steering wheels for vehicles; anti theft devices for vehicles; devices locking door curtain vehicles.'
- 6 The application for a declaration of invalidity was based on all of the goods covered by the earlier mark and directed against all of the goods covered by the CTM.
- 7 On 12 July 2011, the Cancellation Division adopted its decision ('the contested decision') declaring the CTM invalid in its entirety and ordering the CTM proprietor to bear the costs incurred by the Cancellation applicant. The decision may be summarized as follows:

- On 2 December 2009 the CTM proprietor was notified of the request of invalidity and filed observations on 2 March 2010 and requested that the Cancellation applicant file proof of use of its earlier mark pursuant to **Article 57(2) and (3) CTMR**.
- The Cancellation applicant replied on 6 September 2010 submitting observations and evidence of use and a time-limit was given for reply. The CTM proprietor replied on 24 January 2011.
- The Cancellation applicant argued that the request for invalidity should be upheld because the trade marks and part of the goods in question are identical and because, the marks being identical, there is a likelihood of confusion since the goods are either identical or similar.
- The CTM proprietor requested proof of use of the earlier trade mark and complained that the Cancellation applicant had behaved in an ‘unusual/unfriendly’ way, because the Cancellation applicant never contacted the CTM proprietor.
- The Cancellation applicant submitted evidence of use and explained why the conditions of **Article 8(1)(a) and (b) CTMR** are fulfilled in the present case.
- The CTM proprietor contested the sufficiency of the documents filed in order to prove use of the earlier trade mark.

*Preliminary remark*

- The Cancellation Division notes that there is no legal obligation on the part of the Cancellation applicant for invalidity to contact the CTM proprietor prior to the filing of the cancellation request.
- This argument of the CTM proprietor must be rejected as unfounded.

*Proof of use*

- The Cancellation applicant’s registered trade mark had been registered for more than five years before the date of the request for invalidity and for more than five years before the date of publication of the application for the contested CTM.
- Evidence has to be filed showing that the earlier French trade mark had been used during the period of five years preceding the date of publication of the contested CTM application and during the period of five years preceding the date of the application for a declaration of invalidity, i.e. between 4 December 2001 and 3 December 2006 and between 4 November 2004 and 3 November 2009, for the registered goods in Class 12.

- On 6 September 2010, the applicant submitted the following documents as evidence of use:
  - Exhibit 1, samples of advertisements in the French press for Volvo V50 FEELING and Volvo S 40 FEELING, dated between 2005 and 2008;
  - Exhibit 2 invoices and credit notes for the purchase of media space for the V50 Feeling campaign, dated in 2005 and 2006;
  - Exhibit 3, catalogues for Volvo C30 Série Spéciale FEELING (April 2008), Volvo S40 and V50 Série Spéciale FEELING (June 2005), Volvo S40 GAMME 2010 (April 2009), Volvo C30 GAMME 2010 (April 2009);
  - Exhibit 4, invoices for vehicles, issued by the Cancellation applicant to different entities – car dealers – within the territory of France, and dated in 2005, 2006, 2007 and 2008;
  - Exhibit 5, declaration of Mr Pierre Chetcuti, manager of the product marketing department of Volvo Automobiles France, a division of the Cancellation applicant, stating the total figures for Volvo models C30, S40 and V50 in France for the years 2004, 2005, 2006 and 2007 (in total 3 865 retail deliveries in 2004, 4 378 in 2005, 4 274 in 2006 and 4 155 in 2007); and indicating that the sales of vehicles under the FEELING trade mark amount to 80% of total sales of S40/V50 models between June 2005 and April 2010 and 90% of total sales of the C30 model between September 2007 and May 2009;
  - Exhibit 6-10. various articles in online automobile magazines dated 2005 and 2007 concerning the Volvo S40 and V50 ‘Feeling’ models.
- When contesting the evidence filed by the Cancellation applicant, the CTM proprietor argued as follows:
  - As regards Exhibit 1, no relevant dates (before 4 December 2006) were shown on the first two pages, therefore they must be dismissed; there is no independent proof that the dates are correct, and that the advertisements had really been published in the media; all the information is highly mistrusted; the documents should be dismissed, because they are biased, not independent and no statutory declarations have been made for them;
  - Concerning Exhibit 2, only two invoices show a date before 4 December 2006; moreover they have the same number and the same amount, so the CTM proprietor assumes that the invoice has been submitted twice; the invoices are issued to VOLVO Automobiles and not to the Cancellation applicant;
  - As far as Exhibit 3 is concerned, all documents are irrelevant because they bear no date or are later than 4 December 2006; only on page 7, the date

22 June 2005 is shown, but the CTM proprietor doubts whether it is 'real'; furthermore, the CTM proprietor suggests that the documents provided might not even be real catalogues but Adobe Photoshop documents that were created by the Cancellation applicant in 2010;

- As regards Exhibit 4 from the Cancellation applicant, the CTM proprietor submitted only eight invoices dated before 4 December 2006, moreover they were not issued by the Cancellation applicant but by VOLVO Automobiles France and they are in French, the language of the proceedings being English; again, the CTM proprietor implies that the invoices might not be 'real', that they might have been created just for these proceedings;
- As regards the declaration contained in Exhibit 5, the CTM proprietor argues that it concerns the period from June 2005 to April 2010 and from September 2007 to May 2009 and that it provides no relevant data for the period before 4 December 2006, because there is no breakdown for the period in question; furthermore the CTM proprietor claims that the declaration was drawn up by an interested party and not by an independent entity;
- Furthermore, the CTM proprietor criticizes the fact that the only 'online magazine' dated before 4 December 2006 is an excerpt from a privately owned amateur webpage, which is not an independent automobile magazine, and that all the other materials are irrelevant because they are dated after 4 December 2006, except for the excerpt from emarketing.fr, which is dated 13 September 2005, however, this should be dismissed because no English translation is provided and it cannot be read.
- The CTM proprietor concludes that the French trade mark invoked by the Cancellation applicant was used very sporadically, if at all, before 4 December 2006 and there was no genuine use before that date.
- The Cancellation Division infers from such use, combined with the Cancellation applicant's ability to present proof of it, that use has been made with the Cancellation applicant's prior consent.
- The CTM proprietor contests the use of the earlier trade mark in particular in the first relevant period (i.e. between 4 December 2001 and 3 December 2006). The following items of evidence relate however to the first relevant period:
  - Exhibit 1: Two advertisements from the French press, both promoting Volvo V50 FEELING. They concern a special offer valid in the first case from 1 September to 31 October 2005 and in the second case until 30 June 2006. It is clear that these two advertisements therefore pertain to the relevant period.
  - Three samples of advertisements put together in a table – all of them are for Volvo V50 FEELING and are dated in 2006 and 2005; the media

indicated is 'press' and the first appearance indicated is in '*Le Figaro*', '*La Voix du Nord*' and '*La Provence*'.

- Exhibit 2: Two credit notes (Nos 2007/05/0312 and 2007/04/0489) and one invoice (submitted twice) (No 2006/01/0721), for the purchase of media space for the 'V50 Feeling Campaign'. The invoice, for the total amount of EUR 159 955, is dated 28 January 2006, therefore clearly within the relevant period. The credit notes are dated in 2007 but they concern advertising in January 2006, and are therefore considered relevant for the purposes of proving use in the period in question. All the invoices and credit notes are in French and are issued by the company MINDSHARE, based in Paris.
  - Exhibit 3: Two pages from a catalogue for the VOLVO S40 and V50 Série Spéciale FEELING, dated June 2005. The catalogue is in French.
  - Exhibit 4: Eight invoices, Nos 5-507926, 5-508680, 5-509831, 5-510814, 6-501304, 6-501714, 6-504025 and 6-505987, all of them dated within the relevant period. These invoices are for vehicles 'Série Spéciale Feeling', they are issued by VOLVO Automobile France and are addressed to different entities within the territory of France.
  - Exhibit 5: Declaration of Mr Pierre Chetcuti, manager of the product marketing department of Volvo Automobiles France, a division of the Cancellation applicant, stating the total figures for the Volvo models C30, S40 and V50 in France for the years 2004, 2005, 2006 and 2007 (in total 3 865 retail deliveries in 2004, 4 378 in 2005, 4 274 in 2006 and 4 155 in 2007); and indicating that the sales of vehicles under the FEELING trade mark amount to 80% of total sales of S40/V50 models between June 2005 and April 2010 and 90 % of total sales of the C30 model between September 2007 and May 2009.
  - Exhibits 6-10: Various articles from the Internet about the Volvo S40 and V50 'Feeling' vehicles, dated 2005.
  - Exhibit 5 cannot be disregarded as a whole, but can serve as supportive or additional evidence. If sales under the FEELING trade mark amounted to 80% between June 2005 and April 2010, it seems unlikely to the Cancellation Division that the sales between June 2005 and December 2006 under the same mark would be negligible. However, the document provided by the Cancellation applicant, being a declaration of the same, does not have particularly strong probative value.
- Viewed as a whole, the evidence provided by the Cancellation applicant reaches the minimum threshold for use to be considered genuine in the first relevant period, ending on 4 December 2006.
  - In the present case, the Cancellation applicant's declaration in Exhibit 5 is in English, i.e. in the language of the proceedings. The invoices and credit notes

submitted in Exhibits 2 and 4 are self-explanatory, contain the invoked trade mark, and need no translation into English. Finally, the advertisements, catalogues and articles submitted in Exhibits 1, 3 and 6-10 contain pictures of cars and the invoked trade mark is clearly visible therein and there is no need for their translation either.

- When examining the evidence as a whole, the Cancellation Division can infer that at least from 2005, the FEELING mark was used in France to designate a special edition of Volvo S40 and V50 cars.
- All the documents relate to the territory of France and/or are in French; therefore the indication of place of use is considered to be fulfilled.
- As seen above, the evidence also relates to the relevant period between 4 December 2001 and 3 December 2006.
- As regards the fact that the evidence is from 2005 and 2006 only, it must be mentioned that 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 stipulate continuous use.
- The figures contained in the declaration filed by the Cancellation applicant and in the invoices submitted are sufficient for the extent of use to be considered sufficient.
- The eight invoices submitted for the first relevant period (invoices from 2005 and 2006 – each of them for one car – Série Spéciale Feeling) are obviously only examples, as can be seen from their numbering. It can be quite safely presumed that there are more invoices in between that were not submitted by the Cancellation applicant. The submitted invoices are evenly distributed in time, being dated 13/09/2005, 26/09/2005, 27/10/2005, 01/12/2005, 24/02/2006, 06/03/2006, 04/05/2006, 27/06/2006, and not concentrated in a very short period of time. Moreover, these eight invoices are addressed to six different entities – car dealers – within the territory of France (Annecy, Chennevieres, Le Pontet, Cesson Sevigne, Paris, Les Ulis). All these facts support the Cancellation Division's conclusion that the extent of use of the earlier trade mark is sufficient.
- Finally, the mark FEELING can be seen in the evidence as designating a special edition of cars, and is used in the trade mark sense.
- There is no proven use of the mark in relation to all the goods invoked, in particular, there is no evidence for 'apparatus for locomotion by air or by water; bodies for vehicles; engines for land vehicles; trees and transmissions for land vehicles; shock absorbers and vehicle suspension springs; rims and wheel hub caps; pneumatic tyres; spikes for tyres; gearboxes for land vehicles; hydraulic circuits for automobiles; seats and headrests for vehicles seats; seat covers for vehicles; sound alarms against theft; breaks for vehicles, brake linings for vehicles; brake shoes for vehicles, break segments for vehicles;

clutches for land vehicles; chassis for automobile vehicles; bumpers for automobiles; corks for tanks for motor fuel vehicles; safety belts for the seats of vehicles; bags inflatable for protection of driver and occupying vehicle in case of shocks accidental; devices cooling engines land vehicles; repair outfits for inner tubes; direction signals for vehicles; windscreen wipers; interior trimmings for cars; hubs for vehicle wheels; windscreens and window glass for cars; anti-dazzle devices for vehicles; steering wheels for vehicles; anti-theft devices for vehicles; devices locking door curtain vehicles’.

- The evidence relates exclusively to ‘cars’.
- Accordingly, the earlier trade mark shall be deemed registered, pursuant to the last sentence of **Article 57(2) CTMR**, in respect of *cars* only, *cars* being a discernible subcategory of *apparatus for locomotion by land* (covered by the earlier trade mark), capable of being viewed independently (see to this effect **judgment of 14 July 2005, T-126/03, ‘ALADIN’**).
- As far as the second relevant period (4 November 2004 to 3 November 2009) is concerned, the evidence filed by the Cancellation applicant is, given the conclusions above concerning the first relevant period, *a fortiori* sufficient. The Cancellation applicant submitted evidence for the years 2005 and 2006, i.e. overlapping years pertaining to both relevant periods, and, in addition to that, evidence pertaining only to the second period. It is, therefore, clear that since sufficient use was proven for the first period, this must also be the case for the second one.

#### *Likelihood of confusion*

#### *Comparison of the goods*

- The request for a declaration of invalidity is deemed to be based on ‘cars’ in Class 12.
- The contested *vehicles* cover, as a broader category, the Cancellation applicant’s ‘cars’. Since the Cancellation Division cannot dissect *ex officio* the broad category of the contested ‘vehicles’, these are considered to be identical to the opposing ‘cars’, although it is clear that they also cover goods which are not identical.
- The contested ‘parts and fittings therefor (vehicles)’ are considered to be similar to ‘cars’ covered by the earlier trade mark.
- The contested ‘wheels for vehicles’ are hence also considered similar to ‘cars’ covered by the Cancellation applicant’s mark.



*Comparison of the signs*

- The signs that have to be compared are:

<b>FEELING</b>	<b>FEELING</b>
<i>Contested CTM</i>	<i>Earlier trade mark</i>

- The marks are identical.

*Global assessment of likelihood of confusion*

- The signs and a part of the contested goods (*vehicles*) were found to be identical.
  - Therefore the request for a declaration of invalidity must be upheld under Article 53(1)(a) CTMR in conjunction with Article 8(1)(a) CTMR in so far as it is directed against *vehicles* in Class 12.
  - The rest of the contested goods were found to be similar to those covered by the earlier trade mark and in view of the fact that the signs are strictly identical, the relevant public might think that the similar goods in question, bearing the respective identical marks, come from the same or economically-linked undertakings.
  - There is a likelihood of confusion between the CTM and the earlier mark on the part of the public and the request for a declaration of invalidity is upheld under Article 52(1)(a) CTMR in conjunction with Article 8(1)(b) CTMR in so far as it is directed against ‘parts and fittings therefor (vehicles), wheels for vehicles’ in Class 12.
  - The present request for a declaration of invalidity must be upheld in its entirety and the contested CTM declared invalid.
- 8 On 7 September 2011, the CTM proprietor filed a notice of appeal against the contested decision. The statement of grounds was filed on 14 November 2011.
  - 9 On 27 January 2012, the Cancellation applicant submitted observations in reply.
  - 10 On 27 August 2012 the Office registered a transfer of ownership of the CTM Proprietor’s mark to Copernicus-Trademarks Limited (hereinafter the ‘CTM Proprietor’).

### **Submissions and arguments of the parties**

- 11 The CTM proprietor requests the Board to annul the contested decision. Its arguments can be summarized as follows:

- The evidence to prove use of the earlier trade mark is insufficient.

#### *Language of the proof submitted*

- Most of the evidence was furnished in the French language, not translated into the language of the proceedings, English.
- The provisions regarding cancellation proceedings in the CTMIR do not contain any derogation of **Rule 96 CTMIR**, contrary to what occurs in the provisions regarding oppositions. Before the entry into force of Regulation 1041/2005, **Rule 40 CTMIR** (old version) included a reference to the language regime regarding proof of use in opposition proceedings.
- This reference was deleted by the legislator and consequently, **Article 119 CTMR** and **Rule 96 CTMIR** are applicable in invalidity proceedings.
- Proof not filed in English should be disregarded.

#### *Time and nature of use*

- The time period as regards proving genuine use was calculated incorrectly by the Cancellation applicant.
- Genuine use must be proven during both periods applicable to the case, i.e., between 4 November 2001 and 3 December 2006, as well as between 4 November 2004 and 3 November 2009.
- Insufficient genuine use has been shown for the first relevant period.
- Reference to the **judgment in case T-382/08 of 18 January 2011, ‘Vogue’ para. 50**, is made as regards the need to verify the credibility and veracity that the goods are sold bearing the mark.
- As regards Exhibit 1:
  - a. Only one of the ads is within the relevant period.
  - b. The words volvocars.fr are insufficient to prove that it was published in France, as French is also the official language in other countries.
  - c. The remaining documents are private print-outs and unreadable pictures and the name FEELING in a publicity campaign cannot demonstrate how the word FEELING was brought to the public.
  - d. No information on volume and period of distribution of the advertising material has been given.

- As regards Exhibit 2:
    - a. The publicity itself is not submitted.
    - b. Only invoices relating to it and lists of when and where the publicity was shown.
    - c. It cannot be seen whether the word ‘feeling’ was used in connection with cars.
  - As regards Exhibit 3:
    - a. It refers to a series which is called ‘speciale feeling’.
    - b. That sign is different to the registered sign ‘feeling’.
    - c. Only one page of the contained catalogues concerns the relevant period but does not show the mark ‘FEELING’ but ‘Série spéciale feeling’.
  - As regards Exhibit 4:
    - a. Only eight invoices are dated within the relevant period between 4 December 2001 and 3 December 2006.
    - b. In those invoices no use of the trade mark alone is made but it is referred to as ‘série spéciale feeling’.
    - c. All those invoices were issued to the same distributor.
    - d. In two years this special series was invoiced eight times to the same car dealer.
    - e. The invoices do not show if the cars ever reached the end consumer.
  - As regard Exhibit 5:
    - a. The statement should be given a low weight, not being an external document.
    - b. It lacks additional evidence on the number of cars sold.
  - As regards Exhibit 6:
    - a. It refers to print-outs of an internal database.
    - b. It is not relevant to the dates in question.
  - As regards Exhibits 7-10: They are not relevant for the time period between 4 December 2001 and 3 December 2006.
- 12 The Cancellation applicant requests the Board to uphold the contested decision. Its arguments can be summarized as follows:

- The evidence filed was submitted in accordance with Article 57(2) CTMR.
- It is left to the discretion of the Office to request a translation of documents, as confirmed for invalidity proceedings in judgement of 16 December 2010 in joined cases T-354/08 and T -357/08 ‘Botolist / Botocyl’ and the decision of Second Board of Appeal of 16 February 2009 in Case R 553/2008-2 and of 15 January 2009 in Case R 74/2008-2.
- The pieces not translated are self-explanatory, namely Exhibits 1 to 4, and 6 to 10.
- The submitted evidence pertains to the relevant periods.
- The Cancellation Division applied the correct deadlines and all submitted evidence relates to either the relevant period or both periods.
- Evidence for the first period has been submitted, namely, three advertisements in Exhibit 11, one invoice and the extract from TNS monitoring service showing the type of media space used in Exhibit 2, one sales brochure in Exhibit 3 and eight sales invoices in Exhibit 4 as well as Exhibits 6 and 7 and the declaration submitted as Exhibit 5 which covers the period from June 2005 to December 2006 and the sales figures shown in the documentation submitted as annex to the declaration of Exhibit 5 refer to 2005 and 2006 as well.
- Those documents also pertain to the second relevant period.
- The following documents were filed additionally, i.e., three advertisements in Exhibit 1, two invoices in Exhibit 2, three sales brochures in Exhibit 3, eight sales invoices in Exhibit 4 as well as Exhibits 8 and 9, and the declaration submitted as Exhibit 5 also covers the period from September 2007 to May 2009 for the car model C30 FEELING.
- The exhibits clearly show the mark FEELING in relation to vehicles and the press advertisements were used for several months, among others, in the daily newspaper ‘*Le Figaro*’, reaching a large number of consumers in the relevant periods.
- The invoices submitted as Exhibit 2 show that the total cost of purchased media space relating to publicizing the earlier mark on vehicles amounts to EUR 1 768 323 in 2005 and EUR 746 884 in 2006.
- All invoices show the trade mark FEELING at the top, left-hand side of the documents in the letterhead.
- The figures given in the table TNS monitoring software shows that advertisements were placed in the daily newspaper ‘*Le Monde*’ and ‘*L’Equipe*’.

- The Cancellation applicant bought 5 532 advertisements for the car model Volvo 50 FEELING in September 2005 as is shown in Exhibit 1 under ‘JC Decaux’ (outdoor billboard).
- The following additional evidence is submitted before the Board:
  - a. Enclosure 1: Wikipedia articles as regards the publications ‘*Le Figaro*’, ‘*Telerama*’ and ‘*L’Express*’ and their respective circulation figures.
  - b. Enclosure 2: Overview of the circulation of selected newspapers from 1999 to 2007.
  - c. Excerpts from JC Decaux on the presence of its billboards and transport ads in France.
- Exhibit 4 contains eight invoices which pertain to the first time period and eight invoices which pertain to the second time period and covers the years 2005, 2006 and 2007.
- The actual sum of the invoices is EUR 400 000; the average price of a car being EUR 20 000.
- The fact that about the same amount of cars were sold in the period from November 2004 to December 2006 as after this period suggests that this was the case before December 2004 as well.
- The declaration submitted as Exhibit 5 and the table showing the sales for Volvo models in France for 2004 to 2007 shows that vehicles sold under the FEELING trade mark were 80% of the total sales of S40/V50 models from June 2005 to April 2010.
- The declaration is supported by clear evidence attached to it as it is supplemented by an overview of the retail deliveries and retail orders over the years 2004 to 2007.

#### *Nature of use*

- It is evident that the term FEELING on the pictures submitted as Exhibit 1 refers to the cars depicted in the pictures.
- The connection between the earlier mark and the products is obvious.
- The submitted evidence consists of clearly legible pictures and corresponding tables setting out the product details and the time period when each advertisement was used in public campaigns.
- The trade mark does not have to appear on the car itself (see VORSPRUNG DURCH TECHNIK).

- Invoices and credit notes refer to these car models and thus to vehicles, thus media space was bought to advertise the car models.
- The term ‘série speciale’ is just added to the name of the car FEELING’, as ‘FEELING’ is not used with those words in all documents.
- There is no need to reach end consumers as long as there is a proper connection between the marks and the goods in question.

#### *Place of use*

- The advertising campaign was obviously held in France.
- All advertisements are shown in French publications.

#### *Conclusion*

- Genuine use has been proved sufficiently.

### **Reasons**

- 13 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 CTMIR. It is, therefore, admissible.

#### *Scope of the appeal*

- 14 For the sake of clarity, it should be noted that, according to CTM proprietor’s statement of grounds, the appeal is exclusively aimed at the annulment of the contested decision insofar as the Cancellation Division erred when it considered that, in the case at hand, the evidence filed to prove the genuine use of the earlier mark contained sufficient indications concerning time, place, nature and extent of use.

#### *Proof of use*

- 15 Article 57 CMTR provides, in relevant part, the following:
  - ‘2. If the proprietor of the Community trade mark so requests, the proprietor of an earlier Community trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, 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 application, 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. If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been

registered for not less than five years, the proprietor of the earlier Community trade mark shall furnish proof that, in addition, the conditions contained in Article 42 (2) were satisfied at that date. In the absence of proof to this effect the application for a declaration of invalidity 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 purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services.

3. 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.'
- 16 It follows from the above that the proprietor of an earlier trade mark has to prove genuine use of its mark. 'Genuine use' must be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such 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 him/her, without any possibility of confusion, to distinguish the product or service from others which have another origin (see judgment of 11 March 2003, C-40/01, 'Minimax', para. 36).
  - 17 The Court has stressed that any evaluation of evidence of use does not mean assessing commercial success or reviewing the economic strategy of an undertaking, nor is it intended to restrict trade mark protection where large-scale commercial use has been made of the marks (see judgment of 8 July 2004, T-203/02, 'Vitafruit I', para. 38).
  - 18 On the other hand, to be genuine in nature, use must be more than token and must be made to create or preserve an outlet for the goods or services covered by the registration (see judgment of 11 March 2003, C-40/01, 'Minimax', para. 43). Clearly, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly 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, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see, for example, judgments of 11 March 2003, C-40/01, 'Minimax', para. 43, and of 8 July 2004, T-203/02, 'Vitafruit I', para. 40).
  - 19 The Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it 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 (see judgment of 11 March 2003, C-40/01, 'Minimax', paras 38 and 39, the order of 27 January 2004, C-259/02, 'Laboratoire de la mer', para. 21; judgments of 8 July 2004, T-203/02, 'Vitafruit I', para. 42, and of 8 July 2004, T-334/01, 'Hipoviton', para. 36).

- 20 However, the more limited the volume of sales of items bearing the mark, the more necessary will it be to produce additional evidence to dispel possible doubts as to the genuineness of the use of the mark in question (see, by analogy, judgment of 30 April 2008, T-131/06, ‘Sonia Sonia Rykiel’, para. 42 and the case-law cited therein).
- 21 It is relevant that genuine use implies real use of the mark on the market concerned for the purpose of identifying goods or services. Genuine use is therefore to be regarded as excluding minimal or insufficient use for the purpose of determining that a mark is being put to real, effective use on a given market. In that regard, even if it is the owner’s intention to make real use of his/her trade mark, if the trade mark is not objectively present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign, so that it cannot be perceived by consumers as an indication of the origin of the goods or services in question, there is no genuine use of the trade mark (see judgment of 23 February 2006, T-194/03, ‘Bainbridge’, para. 32 and case-law mentioned therein).
- 22 Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see judgment of 12 December 2002, T-39/01, ‘Hiwatt’, para. 47). In other words, it is not sufficient for genuine use of the mark to appear probable or credible; actual proof of that use must be given (see judgment of 18 January 2011, T-382/08, ‘Vogue’, para. 40).
- 23 As to the criteria for assessing genuine use, pursuant to Rule 40(6) in conjunction with Rule 22(2) and (3) CTMIR the indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the earlier trade mark for the goods and services in respect of which it is registered and on which the request for a declaration of invalidity is based.
- 24 The Cancellation applicant had to prove use of the earlier French mark No 96 633 095, ‘FEELING’, both in the five-year period preceding the date of publication of the contested CTM, i.e. from between 4 December 2001 and 3 December 2006 (hereinafter ‘the first relevant period’) and the five-year period preceding the date of filing the invalidity request, i.e. between 4 November 2004 and 3 November 2009 (hereinafter ‘the second relevant period’). In this respect, it should be noted that both periods were rightly taken into account in the contested decision when assessing the evidence filed, being the CTM proprietor’s argument irrelevant that they were eventually miscalculated by the Cancellation applicant. Further, the Cancellation applicant had to prove that the earlier trade mark had been put to genuine use in France for the registered goods in Class 12.

*Translation of the evidence into the language of the proceedings*

- 25 The CTM proprietor argues that part of the evidence was filed in French and was not translated into the language of the proceedings, i.e., English and that, for this reason, it should not be taken into account as regards the use made of the earlier



mark. The CTM proprietor further argues that [Article 119 CTMR](#) and Rule 96 are particularly applicable to invalidity proceedings.

- 26 Where the language of such documents is not the language of the proceedings, the Office may require that a translation be supplied, within a period specified by it, in that language or, at the choice of the party to the proceeding, in any language of the Office (see [Rule 96\(2\) CTMIR](#)). As rightly pointed out by the Cancellation Division, it is left to the discretion of the Office whether the Cancellation applicant has to submit a translation of the evidence into the language of the proceedings or not, requiring it to balance the interests of both parties; on one hand, the unnecessary burdensome task for one party of having to translate each and every element of evidence, and, on the other, the right of the other party to be heard and to defend its interests.
- 27 It is true that, save the declaration of the Cancellation applicant, the documents filed are written mostly in French, English being the language of the proceeding. However, some of the documents written in French, concern invoices or credit notes, which being self-explanatory, do not, in the present case, require a translation for the CTM proprietor to understand their evidential content. As regards the remaining pieces of evidence, i.e., advertisements, catalogues and articles, they do contain pictures concerning the goods themselves and representations of the earlier mark, these being the elements which incorporate the most relevant evidential value.
- 28 Consequently, in the present case, it cannot be held that the lack of a translation of part of the evidence produced in French adversely affected the rights of defence of the CTM proprietor, since it admits having ‘carefully evaluated each of the submitted materials as to whether it really reflects the use’ [sic], since they were actually able to challenge the evidential value of those documental pieces both before the Cancellation Division as well as before the Board (being to some extent irrelevant if they were written in a particular language) and since it seems that the CTM proprietor actually understood the contents of those documents, where, by the way, many of the words contained did not need any translation as they coincide with equivalent words in English (see [judgement of 10 May 2012, C-100/11 P, ‘Botocyl’, para. 103](#)).
- 29 The CTM proprietor’s argument in this respect must, therefore, be rejected as unfounded.

#### *Time of use*

- 30 As regards the time of use, the CTM proprietor argues that insufficient genuine use has been shown for the first relevant period, that only one of the advertisements submitted is within the relevant period and that only one page of the catalogue concerns that period.
- 31 It should thus be noted that, contrary to CTM proprietor’s arguments, two of the advertisements promoting Volvo V50 FEELING concern a special offer valid, respectively, from 1 September to 31 October 2005 and in the second case until 30 June 2006, i.e., pertaining both to the first and second relevant periods, as

rightly pointed out in the contested decision, which is easily confirmed by further information on the media release and invoices issued by the firm MINDSHARE.

- 32 Furthermore, while it is true that only one of the catalogues bears a date within the first relevant period, again, this should be viewed in relation with other pieces of evidence, such as for example, the eight invoices submitted and which were issued by VOLVO Automobile France between 2005 and 2006, included under Exhibit 5.
- 33 Moreover, the Board considers that the evidence contained under Exhibit 7 regarding a press article from the website emarketing.fr, even if printed out recently, concerns a release which took place in September 2005 and does therefore relate to the first relevant period, contrary to CTM proprietor's arguments.

The Board concludes that the evidence filed does sufficiently concern both of the relevant periods at issue, regardless of whether part of the evidence overlaps one period or the other.

#### *Place of use*

- 34 Concerning the place of use, most of the documents filed seem to originate and refer to the French territory and/or are written in French. The CTM proprietor argues that the words volvocars.fr. are insufficient to consider that the advertisements and catalogues were published in France.
- 35 In the opinion of the Board, when this evidence is viewed in relation with the invoices, it can be easily concluded that the advertising campaign included French newspapers and magazines (*Le Figaro*, *L'équipe*, etc.).
- 36 On the other hand, the catalogues contained under Exhibit 3 include in their footnotes on the last pages, respectively, a reference to the tariff applicable in France (*metropolitaine*) which demonstrates sufficiently that the evidence relates to use made of the mark in the territory of France. The submission of the CTM proprietor must be refused on this point.

#### *Nature of use*

- 37 As regards the CTM proprietor's argument that the use made concerns a different mark than that registered, the Board confirms the conclusion reached by the Cancellation Division in the sense that the mark 'FEELING' is used in a manner which does not alter its distinctive character.
- 38 Certainly, the fact that in some pieces of evidence the mark is preceded by the expression in the French language, 'Série spéciale', does not in any case substantially affect its distinctiveness for the simple reason that such an expression, meaning 'special series' merely describes a characteristic of the goods, i.e., being conceived as an exceptional, extraordinary, product.

*Extent of use*

- 39 Concerning extent of use, it should be noted that at least six different companies were issued with invoices regarding cars manufactured or equipped under the mark.
- 40 On the other hand, the evidence shows that the goods were aimed at end consumers. It follows that the commercialization of a car with the sign 'FEELING', being a car manufactured or equipped outside ordinary production lines (a special series), is usually ordered by the customer beforehand.
- 41 Finally, the statement filed by the Cancellation applicant together with the invoices submitted demonstrates that the mark has been used for cars to a sufficient extent overall.
- 42 Consequently, the Board reaches the same conclusion as the Cancellation Division in that the evidence filed contains sufficient indications as regards the place, time, extent and nature of use of the earlier trade mark FEELING for the part of the goods in respect of which it is registered and that, consequently, genuine use of the earlier mark has been demonstrated with regard to the goods 'cars' in Class 12 in the territory of France and during the relevant periods.
- 43 As the evidence filed before the Cancellation Division was found sufficient to show genuine use made of the earlier mark, the Board considers it unnecessary to enter into the examination and assessment of the evidence filed before the Board by the Cancellation applicant.
- 44 Consequently, the earlier mark invoked as a basis for the request for invalidity was duly substantiated by the Cancellation applicant.
- 45 In order to avoid unnecessary repetition, the Board refers to the contested decision, as well as to the reasons given therein by the Cancellation Division, in particular, with respect to the finding that the conflicting signs are identical and that the goods in question are partially identical and similar.
- 46 Consequently, the request for a declaration of invalidity must be upheld under Article 53(1)(a) CTMR in relation with Article 8(1)(a) CTMR as regards the contested goods 'vehicles' in Class 12, as well as in relation with Article 8(1)(b) CTMR in so far as it was directed against 'parts and fittings therefor (vehicles), wheels for vehicles in Class 12' also.
- 47 The appeal is, consequently, dismissed and the contested decision declaring the invalidity of the Community trade mark confirmed in its entirety.

**Costs**

- 48 Pursuant to Article 85(1) CTMR, the CTM proprietor, as the losing party, must bear the costs of the appeal proceedings. Pursuant to Article 85(6) first sentence CTMR and Rule 94(3) last sentence CTMR, the CTM proprietor is, therefore,

ordered to reimburse the Cancellation applicant with the costs of professional representation for the appeal proceedings at the level laid down in Rule 94(7)(d) CTMIR (EUR 550). As to the cancellation proceedings, the apportionment of the costs made in the contested decision is confirmed.

**Order**

On those grounds,

THE BOARD

hereby:

**1. Dismisses the appeal;**

**2. Orders the CTM proprietor to bear the representation costs of the Cancellation applicant in the appeal proceedings fixed at EUR 550.**

Signed

T. de las Heras

Signed

H. Salmi

Signed

G. Bertoli

According to Article 6 of  
Commission Regulation  
(EC) No 216/96

Registrar:

Signed

P. López Fernández de  
Corres

