

DECISION
of the First Board of Appeal
of 2 September 2024

In case R 307/2024-1

Drifa ehf.

Suðurhrauni 12c
210 Garöabaer
Iceland

Cancellation Applicant / Appellant

represented by Jordi Güell Serra, Av. Diagonal 622, 3º, 08021 Barcelona, Spain

v

GILMAR S.P.A.

Via Malpasso, 723/725
47842 S. Giovanni in Marignano
(Province of Rimini)
Italy

EUTM Proprietor / Defendant

represented by PERANI & PARTNERS SPA, Piazza Armando Diaz, 7, 20123 Milano, Italy

APPEAL relating to Cancellation Proceedings No 55 915 C (European Union trade mark registration No 10 941 615)

THE FIRST BOARD OF APPEAL

composed of M. Bra (Acting Chairperson), C. Bartos (Rapporteur) and
A. González Fernández (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 6 June 2012, GILMAR S.P.A. ('the EUTM proprietor') sought to register the sign

ICE

for goods and services in Classes 9, 11, 16, 18, 20, 21, 24, 25, 27 and 35. The following goods are relevant to the current proceedings:

Class 18: Bags; backpacks; wallets; vanity cases; all the aforementioned goods made of imitations of leather.

Class 25: Clothing, footwear, headgear.

- 2 As type of mark, the EUTM proprietor indicated 'figurative mark' (Article 3(3)(b) EUTMIR).
- 3 The EUTM was registered on 13 June 2017.
- 4 On 17 August 2022, Drifa ehf. ('the cancellation applicant') filed an application for revocation of the EUTM based on Article 58(1)(a) EUTMR – non use.
- 5 In order to establish genuine use of its EUTM, the EUTM proprietor submitted the following evidence, in total more than 2 000 pages:

Annex	Short description
A	Decisions of the Opposition Division and the Boards of Appeal
B	Affidavit signed by the CFO of the proprietor ('first affidavit')
C	Invoices dated in the period 2017 to 2022
D	Screenshots from several Italian online shops including the EUTM proprietor's website, undated
E	Affidavit signed by the CFO of the EUTM proprietor ('second affidavit')
F	Invoices issued by third parties to the EUTM proprietor for promotional services and maintenance of the EUTM proprietor's website, dated between 2017 and 2022
G	Screenshots from social media
H	Look books and catalogues, collections for 2017, 2018, 2019 and 2020
I	Undated photographs of goods
J	Photographs of labels, allegedly used on goods since 1987 until the present day

- 6 By decision of 8 December 2023 ('the contested decision'), the Cancellation Division partially rejected the application for revocation, namely for those goods in Classes 18 and 25 explicitly mentioned in paragraph 1 above, upheld the application for the remaining goods and services and ordered each party to bear its own costs.

- 7 First of all, it argued that the probative value of an affidavit, drawn up by the interested parties themselves or their employees, are generally given less weight than independent evidence. However, this does not mean that such statements do not have any probative value at all. The final outcome depends on the overall assessment of the evidence in the particular case. The probative value of such statements depends on whether or not they are supported by other types of evidence (labels, packaging etc.) or evidence originating from independent sources.
- 8 With respect to the time of use, the contested decision held that most of the evidence is dated within the relevant period, in particular, the invoices, the invoices for promotional activities, most of the look books or references to campaigns, screenshots from the social media.
- 9 With respect to the place of use, the evidence relates mainly to Italy, as is clear from the sales invoices, the language of the documents and the presence of goods on Italian online shopping platforms. Nevertheless, the invoices demonstrate significant sales also to other EU countries, namely Belgium, France, Germany, the Netherlands and Poland.
- 10 Next, the Cancellation Division analysed the nature of use and concluded that the following examples did not show the sign with respect to the main function of a trade mark, i.e. to indicate the badge of origin

			
‘example 1’	‘example 2’	‘example 3’	‘example 4’

and could not be taken into consideration to establish genuine use.




- 11 On the other hand, the following signs showed use as a badge of origin

			
‘example 5’	‘example 6’	‘example 7’	‘example 8’

			
'example 9'	'example 10'	'example 11'	'example 12'
			
'example 13'	'example 14'	'example 15'	'example 16'
			
'example 17'		'example 18'	

Moreover, the catalogues introduce the presented articles as 'ICE', 'ICE ICEBERG' or 'ICE PLAY' and on the invoices the goods are identified as belonging to the 'ICE', 'ICEBERG' or 'ICE PLAY' lines. Overall, there are sufficient indications that the sign was used in accordance with its essential function, that is, to identify the commercial origin of the goods.

- 12 With respect to the nature of use, the Cancellation Division stated that the evidence of use must refer to the sign as registered, or of a variation thereof which, pursuant to Article 18(1)(a) EUTMR, does not alter the distinctive character of the EUTM. The following examples show use of a variation which is in line with Article 18 EUTMR

		
'example 19'	'example 20'	'example 21'

Moreover, the sign is sometimes used together with another word, 'ICEBERG'. On these occasions, both words are used clearly separated in a way that it is clear that both the word 'ICE' and 'ICEBERG' are independent trade marks (see examples 5, 7 and 8).

They do not form a unit and there is no visual or apparent conceptual interaction between them. This is also acceptable use of the contested sign. Trade marks are often used together with other marks, for example, to indicate a house mark and a sub-brand. This constitutes use of a trade mark in the same form as registered, in parallel with, but independently from, other trade marks (simultaneous use of independent trade marks). This is to be differentiated from cases where only the sign 'ICEBERG' is used to label the goods. The addition of 'berg' to the word 'ice' creates not only visually a different word but there is also a conceptual interaction in a way that the addition changes the meaning of the word. Therefore, the addition of 'berg' to the contested trade mark clearly alters the distinctiveness of the trade mark as registered and use of the sign 'ICEBERG' alone cannot be considered as valid evidence of use of the contested trade mark. The same holds true for the following use, where 'ICE' and 'PLAY' is joined



'example 22'



'example 23'

- 13 Finally, the Cancellation Division held that the sign was used in relation to the goods mentioned in paragraph 1 above, but not with respect to any other goods or services.

Submissions and arguments of the parties

- 14 The cancellation applicant filed a notice of appeal against the contested decision, duly followed by a statement of grounds, requesting that the decision be set aside insofar as the Cancellation Division considered that genuine use was established.
- 15 The cancellation applicant argued, first, that the use of 'ICE PLAY' and 'ICE ICEBERG' (see e.g. examples 11, 14, 15, 19, 20 and 21) cannot serve to prove valid use of the trade mark as registered; the term 'ice' is of weak distinctiveness, so the fact that the longest and most distinctive parts are 'ICEBERG' and 'PLAY' prevents it from being seen as a simultaneous use of two trade marks.
- 16 Furthermore, the EUTM proprietor owns also the following trade marks

ICE PLAY

EUTM No 15 402 266'

ICE
ICEBERG

IR No 942 787

- 17 Second, the cancellation applicant claims that the affidavits were not supported by any annexes that would serve to confirm their content; consequently, and since the EUTM proprietor has not established that making false statements before the Italian Trade Mark Office would be considered as a crime, the affidavit must simply be regarded as a very general and unclear declaration made by the interested party.

- 18 Regarding the invoices, many of them refer to the trade marks 'ICEBERG' or 'ICE PLAY' rather than 'ICE'. In any case, the volume of sale is very low.
- 19 As for what the EUTM proprietor calls 'catalogues', it is a sort of collage prepared by the interested party that must be given little value. Most of these documents show the trade marks mentioned above in paragraph 15 or use in a decorative way (see examples 1, 2, 3 and 4).
- 20 A similar conclusion can be reached regarding printouts of the EUTM proprietor's website. From the examination of Annex J, one can conclude that 'ICE' was used as a trade mark more than 15 years ago, but it was progressively abandoned and replaced by the trade marks mentioned above in paragraph 15, which are the trade marks used in the last five years.
- 21 The EUTM proprietor, in its response, requested to dismiss the appeal.
- 22 It mostly referred to the contested decision and argued that the Cancellation Division assessed the evidence correctly.
- 23 The EUTM proprietor argued that the cancellation applicant had not substantiate its argument that consumers would perceive the contested sign only as a decorative element and that, consequently, such a consumer would not be able to infer the commercial origin of the goods. These arguments must therefore be rejected as unfounded.
- 24 The same holds true with respect to the allegation that the term 'ice' would enjoy only a low distinctive character with respect to the goods in question. To the contrary, due to the fact that the sign is distinctive per se and its long-standing and intensive use, it has acquired even an enhanced degree of distinctive character.
- 25 It further pointed out that in the fashion field, the majority of brands are used as a 'decorative element' playing a relevant and eye-catching position on the garments. This kind of use does strengthen the trade mark role of indicator of commercial origin. In fact, it enables the relevant consumers to establish a clear link between the relevant goods and the producer. This is confirmed by judgment of 30 January 2020, in case T-598/18, BROWNIE / BROWNIE, Brownie, EU:T:2020:22, § 69, where the General Court stated that
'[t]he fact that, in view of its particular stylisation, a figurative mark, while having a certain distinctive character, may also be used to decorate the product bearing it does not affect the ability of such a figurative mark to fulfil the essential function of a [trade] mark. That is especially true of the clothing sector, in the broad sense, in which it is not unusual for the products concerned to bear a stylised form of a [sign]. Consequently, even if, in the present case, the affixing of the [sign], as stylised, may also be used to decorate the goods concerned, in the light of its distinctive character, it nevertheless at the same time fulfils the essential function of a trade mark.'
- 26 Contrary to the cancellation applicant's submission, it must be held that the EUTM proprietor submitted more than 2 000 pages of evidence in support of its affidavits. The probative value of the affidavits submitted is real, since they are duly supported by other types of evidence.

- 27 Furthermore, the EUTM proprietor clarified that the term ‘accessories’ refers to any product which does not fall within the core business of the EUTM proprietor, but which fall unquestionably in Class 18. This is also conferred by the invoices submitted as Annexes C1 – C11.

Reasons

- 28 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible and also well founded.




I. Article 58(1)(a) EUTMR – non use

- 29 Pursuant to Article 58(1)(a) EUTMR, the rights of the proprietor of an EUTM shall be declared revoked on application to the Office if, within a continuous five-year period preceding the filing date of the application for a declaration of revocation, the trade mark has not been put to genuine use in the European Union in connection with the goods or services in respect of which it is registered.
- 30 In accordance with to Article 10(3) and (4) EUTMDR, the indications and evidence for furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the contested EUTM for the goods and services in respect of which it is registered. The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspapers, advertisements, and statements in writing as referred to in Article 97(1)(f) EUTMR.
- 31 There is ‘genuine use’ of a trade mark where the trade mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services, thereby excluding token use for the sole purpose of preserving the rights conferred by the trade mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43). Genuine use of the trade mark requires that the trade mark is used publicly and outwardly (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 37).
- 32 When assessing whether use of the trade mark is genuine, 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 trade mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the trade mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43).
- 33 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 (18/01/2011, T-382/08, *Vogue*, EU:T:2011:9, § 22).
- 34 In order to examine, in a given case, whether use of the earlier trade mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case (08/07/2004, T-334/01, *Hipoviton / HIPPOVIT*, EU:T:2004:223, § 36).

- 35 Genuine use of the trade mark entails use of the trade mark on the market for the goods or services protected by that trade mark and not just internal use by the undertaking concerned. The protection the trade mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the trade mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the trade mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the trade mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 37).
- 36 In accordance with Article 10(3) EUTMDR, which applies mutatis mutandis pursuant to Article 19(2) EUTMDR in proceedings concerning the application for revocation of an EUTM, the indications and evidence of use shall establish the place, time, extent and nature of use of the contested EUTM in respect of the goods and services under attack.
- 37 The contested EUTM was registered on 9 June 2017. Since the application for revocation was filed on 17 August 2022, the EUTM proprietor had to prove genuine use of its trade mark for the registered goods during the five-year period preceding that date, i.e. from 17 August 2017 until 16 August 2022 inclusive. In revocation proceedings contesting genuine use of a trade mark in respect of a number of registered goods or services, it is the obligation of the proprietor of the trade mark to furnish proof of such genuine use with regard to each of the goods or services at issue.
- 38 The goods which are the subject of the current appeal are the following:
- Class 18: *Bags; backpacks; wallets; vanity cases; all the aforementioned goods made of imitations of leather;*
- Class 25: *Clothing, footwear, headgear.*
- 39 The cancellation applicant argues first of all that some of the evidence cannot establish genuine use of the contested trade mark and cannot be taken into consideration since the use is not with respect to the main function of a trade mark, but in a purely decorative way; second, some evidence refers to different trade marks and the use of those trade marks cannot be considered as use which does not alter the distinctive character pursuant to Article 18 EUTMR; third, the affidavits were not supported by any attachments that would serve to confirm their content; and fourth, the volume of the sale is very low.
- 40 In accordance with Article 10(3) EUTMDR reflecting general principles for establishing proof, the EUTM proprietor has first to allege the relevant facts, secondly to give sufficient evidence for its allegations, and thirdly to clearly link each allegation with the relevant particular piece of evidence. All relevant facts must be indicated in the pleadings. All evidence offered in support of specific facts must be expressly and accurately indicated in such a way as to show clearly the facts to be proven. The Cancellation Division and the further instances deciding on the file must be placed in a position to link specific documents on file with the different facts alleged. If the EUTM proprietor does not establish such link between the relevant facts and the evidence

provided, it is not for the Board to search for such a link (11/01/2016, R 1177/2014-4, Golden Eagle Deluxe (fig.) / DEVICE OF RED CUP (fig.) et al., § 56).

- 41 Considering the invoices as well as the pictures (Annexes C1 – C4) and the affidavit (Annex B), it is clear that the EUTM proprietor sold clothing and accessories in Italy to third parties (retailers) between 2017 and 2022, i.e. within the relevant period which ran from 17 August 2017 until 16 August 2022 (see above paragraph 37); however, it remains unclear to which goods the invoices refer to.
- 42 In the present case, the EUTM proprietor filed a plethora of invoices (Annex C). The invoices follow the same structure and contain product codes, consisting of a combination of several codes, namely ‘MOD’, most probably standing for model, ‘ART’ for article and ‘COL’ for colour. Some invoices are accompanied by photographs, depicting specific goods such as a T-Shirt, a sweater or socks, accompanied by a product code. From the outset, it must be mentioned that apparently none of the product codes on the invoices coincide. However, it appears that on the invoices, ‘MOD’ is abbreviated, since it consistently lacks the first three digits and the digit ‘0’ before the letter ‘M’ and ‘F’.
- 43 It must be stressed that the EUTM proprietor did not highlight the product codes on the invoices to which the depiction of the products referred. However, for the sake of completeness, the Board analysed to the best of its ability the invoices submitted, which fall all within the relevant period, but cannot guarantee that it has not overlooked some matches. With this respect, since it was the burden of the EUTM proprietor to link the evidence, the Board cannot be blamed for any mistake and cannot be called upon to correct deficient pleadings of the EUTM proprietor (11/01/2016, R 1177/2014-4, Golden Eagle Deluxe (fig.) / DEVICE OF RED CUP (fig.) et al., § 59).
- 44 The Board was able to identify the following matching product codes on invoices and photographs depicting goods:

Invoice	Page of the file	Product code	Product	Sign	Page of the file	Quantity
FT/2393	246	U1MF053 P410 9000	T-shirt		248	16
FT/4101	252	U2MF087 P430 1101	T-Shirt		257	6
FT/40606	274	U1M131 P403 9000	sweatshirt		277	6

Invoice	Page of the file	Product code	Product	Sign	Page of the file	Quantity
FT/3912	302	U2MF032 P435 1101	T-shirt		305	5
FT/3912	302	U2MF061 P430 9000	T-shirt		306	4
FT/3064	375	U1M6301 9615 9000	Socks		377	7
F1/118	559	U2MF025 P430 1101	T-Shirt		560	5
F1/118	559	U2MF025 P435 1101	T-Shirt		561	5
F1/1232	584	U1MF053 P410 9000	T-Shirt		583	5
F1/3830	599	U1MF053 P410 9000	T-Shirt		606	3
F1/3830	602	U2MF087 P430 9000	T-Shirt		613	2
F1/7275	1689	U1M131 P403 9000	sweatshirt		1694	5

Invoice	Page of the file	Product code	Product	Sign	Page of the file	Quantity
F1/9039	1701	U1MA020 9005 9000	Knitted round neck		1703	6
F1/379	1718	U1MF019 P410 9000	T-shirt		1720	9
F1/653	1731	U2MF094 P435 1101	T-shirt		1735	5
F1/128	1793	U1MF01D P410 6692	T-shirt		1796	6
F1/128	1793	U1MF01G P410 1101	T-shirt		1977	4
F1/128	1793	U1MF018 P400 9000	T-shirt		1798	4
F1/1307	1801	U1MF053 P410 9000	T-Shirt		1804	6
F1/1307	1801	U1MF075 P410 1101	T-Shirt		1805	5
F1/418	1818	U1MF019 P410 9000	T-Shirt		1820	6

- 45 Annex H is a plethora of depictions of various products, partly with the EUTM under attack, partly not.
- 46 Annex H1 is undated and lacks any product codes. For that reason, it cannot help the EUTM proprietor to establish genuine use of its EUTM.

- 47 Pages 668 – 685 of the file concern a catalogue for the spring and summer collection 2018 for boys. Pages 695 – 738 of the file concern the spring and summer collection 2018 for accessories, such as bags. Pages 866 – 911 of the file concern the spring and summer collection 2020 for kids. While these catalogues contain product codes, the Board cannot recall that any of these product codes appear on the invoices; it must be recalled that it would have been the obligation of the EUTM proprietor to link this evidence with the invoices. Consequently, it cannot help the EUTM proprietor to establish genuine use of its EUTM, neither for goods in Class 18 nor for those in Class 25.
- 48 Pages 739 – 839 of the file concern the fall and winter catalogue 2018 for women, the fall and winter catalogue 2018 for men, the spring and summer catalogue 2018 for women, the spring and summer catalogue 2018 for bags and the spring and summer catalogue 2018 for men. None of these catalogues contain any product codes. Consequently, it cannot help the EUTM proprietor to establish genuine use of its EUTM, neither for goods in Class 18 nor for those in Class 25.
- 49 Furthermore, part of that evidence (pages 686 – 694 of the file) appears to be for internal use only and therefore cannot be considered as evidence supporting an outward use. Consequently, it cannot help the EUTM proprietor to establish genuine use of its EUTM, neither for goods in Class 18 nor for those in Class 25.
- 50 Annex I3 (pages 954 – 1064 of the file) concerns the depictions of different bags with product codes. The Board cannot recall that any of these products codes appear on the invoices; it must be recalled that it would have been the obligation of the EUTM proprietor to link this evidence with the invoices.
- 51 Pages 1086 – 1554 of the file concern the depiction of various apparel without any product codes. Consequently, it cannot help the EUTM proprietor to establish genuine use of its EUTM, neither for goods in Class 18 nor for those in Class 25.
- 52 Annex J (pages 1556 – 1589 of the file) concerns labels; however, it is not clear for which products they were used. Consequently, it cannot help the EUTM proprietor to establish genuine use of its EUTM, neither for goods in Class 18 nor for those in Class 25.
- 53 Annexes D2, D3, D4 (pages 1899 – 1994 of the file) are screenshots from the EUTM proprietor's official online shop and concern various accessories and apparel with product codes. The Board cannot recall that any of these products codes appear on the invoices; it must be recalled that it would have been the obligation of the EUTM proprietor to link this evidence with the invoices.
- 54 Annex G concerns the social media presence of the EUTM proprietor. While such evidence shows publicity, it does not guarantee that the products reached the market. In any case, it is not clear how many users saw these social media accounts and whether the products shown were indeed offered for sale.
- 55 As can be seen, many invoices refer to sales of goods containing different trade marks, which the EUTM proprietor apparently all bundles under its 'ICE' trade mark. For that reason, and since there is no differentiation with respect to specific goods, not even

between goods in Class 18 and Class 25, the sales figures stated in the affidavit are neither reliable nor supported by the evidence.

- 56 Before reaching a final conclusion concerning genuine use of the earlier trade mark, the Board needs to address another crucial question, namely whether the sign identified below in paragraph 69 concerns use of the EUTM as registered.
- 57 In accordance with Article 18(1)(a) EUTMR, genuine use of a trade mark also includes use of the sign in a form differing in elements which do not alter the distinctive character of that trade mark in the form in which it was registered, regardless of whether or not the sign in the form as used is also registered in the name of the proprietor.
- 58 The purpose of this provision, which avoids imposing strict conformity between the form of the sign as used and the form in which the trade mark was registered, is to allow its proprietor, in the commercial exploitation of the sign, to make variations which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In such situations, where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the registered trade mark may be fulfilled by furnishing proof of use of a sign which constitutes the form in which it is used in trade (29/04/2020, T-78/19, green cycles (fig.), EU:T:2020:166, § 66 and the case-law cited).
- 59 Therefore, a finding that the distinctive character of the sign as registered has been altered requires a case-by-case assessment of the distinctive and dominant character of the added, omitted or altered elements, carried out on the basis of the intrinsic qualities of each of those elements, as well as of the relative position of the various elements within the arrangement of the sign (29/04/2020, T-78/19, green cycles (fig.), EU:T:2020:166, § 67 and the case-law cited).
- 60 For the purposes of that finding, account must be taken, in particular, of the greater or lesser degree of distinctive character of the earlier trade mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the sign will lose its ability to be perceived as an indication of the origin of the product it designates. The reverse is also true (10/10/2018, T-24/17, D TACK / TACK et al., EU:T:2018:668, § 47 and the case-law cited).
- 61 It is settled case-law that a number of signs may be used jointly and autonomously without changing the distinctive character of the registered sign (18/10/2017, T-110/16, SAVANT, EU:T:2017:521, § 32 and the case-law cited). Where several signs are used simultaneously, steps must be taken to ensure that, for the purposes of the application of Article 18(1)(a) EUTMR, such use does not alter the distinctive character of the registered sign, having regard inter alia to business practices in the relevant sector (10/10/2018, T-24/17, D TACK / TACK et al., EU:T:2018:668, § 44).
- 62 The condition of genuine use of a trade mark, within the meaning of Article 18(1)(a) EUTMR, may be satisfied where a registered trade mark, which has become distinctive as a result of the use of another composite trade mark of which it constitutes one of the elements, is used only through that other composite trade mark, or where it is used only in conjunction with another trade mark, and the combination of those two trade marks is,

furthermore, itself registered as a trade mark (18/04/2013, C-12/12, Colloseum Holding, EU:C:2013:253, § 36).

- 63 However, a registered trade mark that is used only as part of a composite trade mark or in conjunction with another trade mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 18(1) EUTMR (18/04/2013, C-12/12, Colloseum Holding, EU:C:2013:253, § 35).
- 64 Additions consisting solely of indications or characteristics of the goods and services, such as the kind, quality, quantity, intended use, value, geographical origin or the time of production of the goods or of rendering of the services, are not generally capable of altering distinctive character of the mark as registered (see, for instance, 23/09/2015, T-426/13, AINHOA, EU:T:2015:669, § 31-32).
- 65 It must be recalled that when a sign is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter, since the average consumer of the relevant public will more easily refer to the goods in question by citing the word elements rather than describing the figurative elements of the sign (10/12/2015, T-690/14, Vieta, EU:T:2015:950, § 49 and the case-law cited; 12/03/2014, T-381/12, Palma Mulata, EU:T:2014:119, § 38 and the case-law cited).
- 66 The term ‘ICE’ has no specific meaning with respect to the goods at stake. The term is distinctive, despite having a clear meaning. The term does not describe any characteristics within the meaning of Article 7(1)(c) EUTMR and has therefore an average inherent distinctive character with respect to the goods in Classes 18 and 25.
- 67 The sign for which the contested EUTM is protected is figurative, ‘ICE’. However, the figurative elements rest in a specific typeface, which resembles ‘Times New Roman’ in bold. Therefore, the font does not add up at all to the distinctive character of the sign and any alteration of it has no impact on the distinctive character of that sign.
- 68 The Board could identify the use of the following signs and link these signs with invoices:



- 69 As regards use 1, use 2, use 3 and use 4, the term ‘ICE’ is visually dominant and keeps an independent role and must therefore be considered as use of the contested EUTM.
- 70 Use 5 consists of the term ‘ICE’ and some other elements below. However, in this case, ‘ICE’ is visually dominant and also keeps its independent role and can be considered as use of the contested EUTM.
- 71 Use 6, use 7 and use 8 concern different factual circumstances. In these examples, ‘ICE’, despite depicted in bold, is combined with another word to form a neologism. It does not keep any independent role and, therefore, these examples cannot be considered as use of the contested sign which does not alter the distinctive character pursuant to Article 18 EUTMR.
- 72 Use 9 and use 10 concern signs in which the term ‘ICE’ is not clearly visible. Lacking a depiction of the back of the T-shirts, it cannot be excluded that the combination ‘IC’ is not part of a combined term such as ‘ICEBERG’, ‘ICEPLAY’ or ‘ICEWILD’. All these terms can be found, i.e. on product depictions submitted as evidence. These examples cannot be considered as clear evidence of use of the contested sign in a way which does not alter the distinctive character pursuant to Article 18 EUTMR.
- 73 Use 11, use 12, use 13 and use 14 show the term ‘ICE’ together with various other word and figurative elements. Despite it is clearly discernible, it does not keep any dominant nor independent role in these signs and cannot be considered as use of the contested sign which does not alter the distinctive character pursuant to Article 18 EUTMR.
- 74 In use 15, the term ‘ICE’ is used to form a slogan, namely ‘ice in the sky’. The term ‘ice’, although placed at the beginning and written in a different font, does not keep any independent role in this sign and cannot be considered as use of the contested sign which does not alter the distinctive character pursuant to Article 18 EUTMR (12/05/2015, R 1641/2014-2, FRUIT, § 26; 25/04/2017, R 2119/2016-4, FRUIT, § 14; confirmed by 22/11/2018, T-424/17, FRUIT, EU:T:2018:824).
- 75 It follows from the above, that only use 1, use 2, use 3 and use 4 can be taken into consideration for the purposes of assessing the extent of use of the contested EUTM.
- 76 The EUTM proprietor has therefore establish the sale of
- a) 7 pairs of socks,
 - b) 6 knitted round neck shirts, and
 - c) 20 T-shirts.
- 77 Such a low sales figure, on a market with a turnover of billions of EUR per year in the entire European Union, cannot be considered as genuine use of the contested EUTM.
- 78 For the sake of completeness, even if the other examples of use were to be taken into consideration, the EUTM proprietor would have established the sale of a total of 7 pairs of socks, 17 sweatshirts and knitted round neck shirts, and 96 T-shirts. Again, this would not have been enough to qualify as genuine use of the contested EUTM.
- 79 None of the sales proven concern use with respect to goods in Class 18. Therefore, the EUTM proprietor was not able to establish genuine use for any of these goods.

- 80 Last, Annex C1 does not contain any photographs at all and Annex C2 refers first of all (pages 158 – 194 of the file) to spectacle frames under the sign ‘ICEBERG’ and, therefore, does not refer either to the sign or to the goods which are the subject of the proceedings. As of page 195 of the file, the invoices contain reference to various articles of clothing or various types of bags; however, no trade marks are mentioned on the invoices and no examples with product codes have been submitted.
- 81 As already stated above in paragraph 33, 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 (18/01/2011, T-382/08, Vogue, EU:T:2011:9, § 22).
- 82 The Board has carefully assessed the evidence all together, and not only the invoices and the photographs or catalogues. None of the other evidence establishes genuine use of the earlier trade mark. It remains unclear how many users within the European Union, and furthermore in which member states, accessed the social media account. It remains unclear whether the catalogues were published or how many consumers within the European Union had access to them.
- 83 The lack of clear and objective sale and the fact, that the invoices and the goods could hardly be linked and considering that the invoices were submitted in an electronic format, namely as a ‘pdf’ document, which disabled the automatic search function, the Board has severe doubts concerning the extend of use and, for that reason, the evidence submitted does not allow the conclusions of effective and sufficient use of the trade mark on the market.
- 84 To sum it up, the EUTM proprietor tried to impress the Office by submitting more than 2 000 pages of evidence, but failed to link this evidence. The Board has carefully and, far beyond its obligation, analysed and assessed the evidence submitted. It could not establish genuine use for any of the goods in Classes 18 and 25 which are the subject of the current appeal proceedings.

Result

- 85 Consequently, the appeal is allowed, the contested decision annulled insofar as it rejected the application for revocation for the goods which are the subject of the appeal and, the EUTM revoked also for

Class 18: Bags; backpacks; wallets; vanity cases; all the aforementioned goods made of imitations of leather.

Class 25: Clothing, footwear, headgear.

Costs

- 86 Since the EUTM proprietor is the losing party within the meaning of Article 109(1) EUTMR, it must bear the costs incurred by the cancellation applicant in the cancellation and appeal proceedings.

- 87 In accordance with Article 109(7) EUTMR, Article 18(1)(c)(iii) EUTMIR, the Board fixes the amount of representation costs to be paid by the EUTM proprietor to the cancellation applicant in the appeal proceedings at EUR 550 and in the cancellation proceedings at EUR 450. Additionally, it has to bear the fees, namely the appeal fee (EUR 720) and the fee for an application for revocation (EUR 630).
- 88 In total, the costs are fixed at the level of EUR 2 350.

Order

On those grounds,

THE BOARD

hereby:

- 1. Upholds the appeal and annuls the contested decision insofar as it rejected the application for revocation;**
- 2. Revokes EUTM No 10 941 615 as of 17 August 2022 also for the following goods:**

Class 18: Bags; backpacks; wallets; vanity cases; all the aforementioned goods made of imitations of leather.

Class 25: Clothing, footwear, headgear.

- 3. Orders the EUTM proprietor to bear the costs of the cancellation and appeal proceedings, which are fixed at the level of EUR 2 350.**

Signed

M. Bra

Signed

C. Bartos

Signed

A. González Fernández

Registrar:

Signed

H. Dijkema

