**CANCELLATION No C 55 440 (REVOCATION)**

**Funline International**, 10 Rockefeller PLZ, suite 1001, 10020 New York, United States of America(applicant), represented by **Marks & Us Lawyers, Marcas y Patentes S.L.P**, Ibáñez de Bilbao 26, 8º dcha, 48009 Bilbao (Vizcaya), Spain (professional representative)

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**MS Trade S.R.O.**, Borská 37, 198 00 Praha 9, Czech Republic (EUTM proprietor), represented by **Daněk & Partners**, Vinohradská 17, 120 00 Prague 2, Czech Republic (professional representative).

On 02/06/2023, the Cancellation Division takes the following

**DECISION**

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| **1.** | The application for revocation is upheld. |
| **2.** | The EUTM proprietor’s rights in respect of European Union trade mark No 10 071 512 are revoked in their entirety as from 25/07/2022. |
| **3.** | The EUTM proprietor bears the costs, fixed at EUR 1 080. |

**REASONS**

On 25/07/2022, the applicant filed a request for revocation of European Union trade mark No 10 071 512  (figurative mark) (the EUTM). The request is directed against all the goods covered by the EUTM, namely:

Class 1: *Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; Unprocessed artificial resins, unprocessed plastics; Manures; Fire extinguishing compositions; Tempering and soldering preparations; Chemical substances for preserving foodstuffs; Tanning substances; Adhesives used in industry.*

The applicant invoked Article 58(1)(a) EUTMR.

**SUMMARY OF THE PARTIES’ ARGUMENTS**

The applicant argued that the contested mark had not been put to genuine use during the period of five years after its registration and before the filing of the request for revocation.

The EUTM proprietorsubmitted evidence of use, which will be analysed in detail below, and argued that this evidence was sufficient to show genuine use of the contested mark for at least some of the relevant goods.

In reply, the applicant argued that the evidence submitted by the proprietor did not show genuine use for the registered goods but for other goods. Furthermore, argued that the EUTM proprietor had acted in bad faith when filing the contested mark because the contested mark was identical to the applicant’s prior mark ‘RUSH’ and the EUTM proprietor had been aware of the applicant’s use of this mark.

In the final reply, the EUTM proprietor reiterates its previous arguments stating that the evidence submitted as sufficient to show genuine use of the contested mark at least for some of the relevant goods.

**PRELIMINARY REMARK**

The applicant filed a request for revocation of the contested mark, invoking Article 58(1)(a) EUTMR. In its submissions filed during the adversarial stage of the proceedings, the applicant argued that the proprietor was aware of its use of the mark ‘RUSH’, which according to the applicant, was indicative of the proprietor’s bad faith.

The Cancellation Division finds as follows:

1. The applicant may limit the grounds on which the application was initially based but cannot enlarge the scope of the application by claiming any additional grounds during the course of the proceedings.

2. Bad faith is an absolute ground for invalidity under Article 59(1)(b) EUTMR. Therefore, even if the applicant’s argument regarding bad faith were to be interpreted as an additional ground, it is inadmissible, as revocation and invalidity grounds cannot be combined in a single application but must be subject to separate applications and entail the payment of separate fees.

**GROUNDS FOR THE DECISION**

According to Article 58(1)(a) EUTMR, the rights of the proprietor of the European Union trade mark will be revoked on application to the Office, if, within a continuous period of five years, the trade mark has not been put to genuine use in the Union for the goods or services for which it is registered, and there are no proper reasons for non-use.

Genuine use of a trade mark exists where the 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. Genuine use requires actual use on the market of the registered goods and services and does not include token use for the sole purpose of preserving the rights conferred by the mark, nor use which is solely internal (11/03/2003, C‑40/01, Minimax, EU:C:2003:145, in particular § 35-37 and 43).

When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether 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 market share for the goods or services protected by the mark (11/03/2003, C‑40/01, Minimax, EU:C:2003:145, § 38). However, the purpose of the provision requiring that the mark must have been genuinely used ‘is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks’ (08/07/2004, T‑203/02, Vitafruit, EU:T:2004:225, § 38).

According to Article 19(1) EUTMDR in conjunction with Article 10(3) EUTMDR, the indications and evidence of use must establish the place, time, extent and nature of use of the contested trade mark for the goods and/or services for which it is registered.

In revocation proceedings based on the grounds of non-use, the burden of proof lies with the EUTM proprietor as the applicant cannot be expected to prove a negative fact, namely that the mark has not been used during a continuous period of five years. Therefore, it is the EUTM proprietor who must prove genuine use within the European Union, or submit proper reasons for non-use.

In the present case, the EUTM was registeredon 18/10/2011. The revocation request was filed on 25/07/2022. Therefore, the EUTM had been registered for more than five years at the date of the filing of the request. The EUTM proprietor had to prove genuine use of the contested EUTM during the five-year period preceding the date of the revocation request, that is, from 25/07/2017 until 24/07/2022 inclusive, for the contested goods listed in the section ‘Reasons’ above.

On 12/09/2022 the EUTM proprietor submitted evidence as proof of use.

The evidence to be taken into account is the following:

 **Annex 1**: four printouts from web.archive.org referring to the web site rushoriginal.eu and indicating the dates 05/11/2016, 04/01/2018, 10/01/2019 showing as follow:



This annex also contains WHOIS screenshot concerning the registration of the domain name rushoriginal.eu.

 **Annexes 2 and 3**: a number of invoices dated between 2017 and 2021 issued by the proprietor to clients in the EU concerning the sale of goods bearing the mark RUSH (e.g. RUSH ORIGINAL EU 10ml/24 units and RUSH ULTRA 10ml EU/18 units) under the indication ‘leather cleaner’, and one sample of an English translation thereof.

 **Annexes 4 and 5**: a copy of Act No. 441/2003 Coll. on Trade marks and the Amendments to Act No. 6/2002 Coll. of the Czech Republic in Czech together with the English translation thereof.

**ASSESSMENT OF GENUINE USE**

In order to examine, in a given case, whether use of the mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by high intensity of use or a certain constancy regarding the time of use of that trade mark or vice versa (08/07/2004, T-334/01, Hipoviton / HIPPOVIT, EU:T:2004:223, § 36).

According to Article 10(3) EUTMDR, the indications and evidence required in order to provide proof of use must concern the place, time, extent and nature of use of the trade mark for the relevant goods and services. These requirements for proof of use are cumulative (05/10/2010, T-92/09, STRATEGI / Stratégies, EU:T:2010:424, § 43). This means that the owner of the mark is obliged not only to indicate but also to prove each of these requirements.

Article 58(1)(a) EUTMR and Article 10(3) EUTMDR require that the EUTM proprietor proves genuine use for the contested goods and services for which the European Union trade mark is registered.

In view of the number of marks registered and potential conflicts between them, it is essential that the rights conferred by a mark for a given class of goods or services are maintained only where that mark has been used on the market for goods or services belonging to that class (15/01/2009, C-495/07, Wellness, EU:C:2009:10, § 19).

In the present case, the invoices refer to leather cleaners. The screenshots from the internet bear the indications ‘supreme power-extra kick hyper strong’ and ‘look for new itramyl rush’ without clearly indicating the relevant goods.

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).

Leather cleaners, which are indicated in the invoices are not covered by the contested mark and fall into Class 3 of the Nice Classification.

The proprietor argues that the trade mark is used for leather cleaners and that these goods fall into the category of chemical and organic compositions and substances for treat leather and textiles, and in particular of fabric protectant for commercial dry cleaning use. However, fabric protectants are for treat leather for repelling water, stains, and dirt from fabric surfaces, and help to increase surface tension. Although these goods can be used for commercial drycleaning, their nature and intended purpose is different.

Although the Nice Classification was adopted for exclusively administrative purposes, its class numbers and explanatory notes may be relevant in order to determine the nature and purpose of the goods or services for which a trade mark is registered and for which genuine use must be proven.

The impact of classification is even more apparent when similar categories of goods or services have been classified in different classes because their specific purpose differs. Although Class 1 can include chemical substances, chemical materials and chemical preparations for cleaning such as chimney cleaners, fuel injection cleaners, solvent cleaners for removing grease during manufacturing operations, industrial cleaners [preparations] for use in manufacturing processes, water-based solvent cleaners for use in manufacturing processes, and solvent based cleaning preparations for removing grease during manufacturing operations, none of them has the purpose of cleaning leather, and leather cleaners are not classified in Class 1 but in Class 3. Leather cleaners are final products designed to be applied to leather articles/components, to maintain, enhance, clean, protect, or modify the appearance, durability, fit, or flexibility of leather articles or components.

According to the ‘Explanatory Note’ of the Nice Classification ‘Class 1 includes mainly chemical products for use in industry, science and agriculture, including those which go to the making of products belonging to other classes’. The goods in Class 1 for which the earlier mark is registered are essentially chemicals used in industry and ingredients sold to manufacturers, and not final goods that target end consumers.

For sake of completeness, in line with the applicant’s reasoning, the Cancellation Division also notice the following concerning the screenshots submitted by the proprietor.

The indication ‘itramyl’ which appears in the screenshot refers to amyl nitrite, commonly referred to as poppers. These are stimulating inhalants, which are final products for personal use by the general consumer. This is reinforced by the indications ‘supreme power-extra kick hyper strong’ and ‘look for new itramyl rush’ which are expressions that are not normally used in relation to leather cleaners.

Additionally as mentioned above, the goods in Class 1 for which the earlier mark is registered are essentially chemicals used in industry science and agriculture, ingredients sold to manufacturers, and not final goods that target the end consumers. The goods appearing in the evidence must be subsumed strictly under the terms for which the mark is registered. The registered goods must then be interpreted accordingly, not because they fall into Class 1, but because they are defined as chemical preparations.

It is generally accepted that a clear difference must be made between finished products and raw materials. It clearly matters whether a product is to be applied directly by or to a human being, or whether it is sold as a substance needed for the manufacturing of a finished product, simply because the target public of raw vs finished goods is different, manufacturing companies in the former case, end consumers in the latter.

Raw materials are essentially different from the finished products that incorporate, or are covered by, those raw materials, in terms of nature, aim and intended purpose (03/05/2012, T-270/10, Karra, EU:T:2012:212, § 53), and if their nature is not the same then they cannot be identical, as required for the use requirement. Genuine use for a raw material does not in itself extend to use of goods made of that material and vice-versa (16/06/2015, T-660/11, Polytetraflon, EU:T:2015:387, § 68, 69).

The goods that appear in the evidence are not chemical preparations or substances within the natural meaning of those terms but products for direct consumption by or application to human beings, which do not fall under the definition of the goods as registered.

The evidence does not define or mention a given chemical compound or substance of which the goods at issue must consist. If the goods were to be characterised as a ‘chemical preparation’, their chemical composition should be disclosed. Nowhere in the evidence are the goods characterised as chemical compositions, preparations, or substances.

Therefore, from the submitted screenshots the goods in use certainly do not clean leather, or at least are not bought for that purpose. This indicates that the sale of the goods in issue is taking place in a disguised form, presenting the product in a different manner (e.g. as a leather cleaning agent) than the one for which it is actually intended, with a view to circumvent specific legislation. This can also be inferred from the indication concerning the number of units, and the capacities of the bottles (in milliliters) which are very small and are not used for cleaning products.

Therefore, the Cancellation Division concludes that the evidence filed by the proprietor does not show genuine use of the contested trade mark in connection with the goods covered by the mark in Class 1 (24/03/2020, R 2076/2019-4, ENERGY RUSH / RUSH).

**Conclusion**

It follows from the above that the EUTM proprietorhas not proven genuine use of the contested mark for any of the goods for which it is registered. As a result, the application for revocation is wholly successful and the contested European Union trade mark must be revoked in its entirety.

According to Article 62(1) EUTMR, the revocation will take effect from the date of the application for revocation, that is, as of 25/07/2022.

**COSTS**

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the EUTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(ii) EUTMIR, the costs to be paid to the applicant are the cancellation fee and the representation costs, which are to be fixed on the basis of the maximum rate set therein.



**The Cancellation Division**

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| Richard BIANCHI | Francesca CANGERI | Manuela RUSEVA |

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.