

## CANCELLATION No C 30 743 (REVOCACTION)

**Ares Performance AG**, Sihlbruggstrasse 105, 6340 Baar, Switzerland (applicant), represented by **Gleiss Große Schrell und Partner mbB**, Leitzstr. 45, 70469 Stuttgart, Germany (professional representative)

a g a i n s t

**Ferrari S.p.A.**, Via Emilia Est, 1163, 41100 Modena, Italy (EUTM proprietor), represented by **Dr. Modiano & Associati S.p.A.**, Via Meravigli, 16, 20123 Milano, Italy (professional representative).

On 29/05/2020, the Cancellation Division takes the following

### DECISION

1. The application for revocation is partially upheld.
2. The EUTM proprietor's rights in respect of European Union trade mark No 6 543 301 are revoked as from 12/12/2018 for some of the contested goods, namely:

Class 12: *Vehicles; apparatus for locomotion by land, air or water; air bags [safety devices for automobiles]; pumps (air -) [vehicle accessories]; anti-glare devices for vehicles; anti-skid chains; anti-theft alarms for vehicles; anti-theft devices for vehicles; automobile bodies; automobile chains; automobile chassis; automobile hoods; tyres for motor vehicles; sun-blinds adapted for automobiles; axle journals; axles for vehicles; pushchairs; stroller covers; balance weights for vehicle wheels; bands for wheel hubs; torsion bars for vehicles; baskets adapted for bicycles; bells for bicycles, cycles; sleeping berths for vehicles; bicycle bells; brakes for bicycles, cycles; frames for bicycles, cycles; cycle saddles; bicycle spokes; bicycle stands; bicycle tires [tyres]; boat hooks; bodies for vehicles; bogies for railway cars; brake facings for vehicles; brake segments for vehicles; brakes for vehicles; buffers for railway rolling stock; vehicle bumpers; bumpers for automobiles; caps for vehicle petrol [gas] tanks; luggage carriers for vehicles; casings for pneumatic tires [tyres]; casters for trolleys [vehicles] [carts (am)]; chains for bicycles, cycles; vehicle chassis; cleaning trolleys; cleats [nautical]; spoke clips for wheels; clutches for land vehicles; connecting rods for land vehicles, other than parts of motors and engines; torque converters for land vehicles; railway couplings; couplings for land vehicles; seat covers for vehicles; covers for vehicle steering wheels; crankcases for land vehicle components, other than for engines; cranks for cycles; cycle bells; brakes for bicycles, cycles; frames for bicycles, cycles; handle bars for bicycles, cycles; hubs for bicycle wheels; cycle mudguards; pumps for bicycles, cycles; rims for wheels of bicycles, cycles; spokes for bicycles, cycles; cycle stands; direction signals for vehicles; disengaging gear for boats; doors for vehicles; driving chains for land vehicles; driving motors for land vehicles; ejector seats for aircraft; traction engines; motors for land vehicles; fenders for ships; flanges for railway wheel tires [tyres]; freewheels for land vehicles; funnels for locomotives; funnels for ships; gear boxes for land vehicles; gearing for land vehicles; gears for cycles; trolleys; security harness for*

*vehicle seats; head-rests for vehicle seats; hoods for vehicle engines; hoods for vehicles; horns for vehicles; hub caps; hubs for vehicle wheels; ship hulls; hydraulic circuits for vehicles; inclined ways for boats; tire patches; repair outfits for inner tubes; inner tubes for pneumatic tires; jet engines for land vehicles; tailboard lifts [parts of land vehicles]; luggage nets for vehicles; mine cart wheels; rearview mirrors; motors for cycles; motors, electric, for land vehicles; mudguards; tires (non-skid devices for vehicle -); oars; paddles for canoes; panniers adapted for cycles; pedals for cycles; pneumatic tyres; portholes; propulsion mechanisms for land vehicles; stroller covers; pushchair hoods; reduction gears for land vehicles; reversing alarms for vehicles; pushchair hoods; reduction gears for land vehicles; reversing alarms for vehicles; rims for vehicle wheels; oarlocks; rudders; vehicle running boards; saddle covers for bicycles or motorcycles; safety belts for vehicle seats; safety seats for children, for vehicles; screw-propellers; screw-propellers for boats; ship propellers; stern oars; vehicle seats; ships (timbers [frames] for -); suspension shock absorbers for vehicles; shock absorbers for automobiles; shock absorbing springs for vehicles; shopping trolleys [carts (am)]; ski carriers for cars; spars for ships; spikes for tires [tyres]; vehicle wheel spokes; vehicle suspension springs; tipping apparatus, parts of trucks and waggons; tipping bodies for lorries [trucks]; steering gears for ships; steering wheels for vehicles; vehicle suspension springs; tipping apparatus, parts of trucks and waggons; tipping bodies for lorries [trucks]; tires for vehicle wheels; trailer hitches for vehicles; transmission chains for land vehicles; transmission shafts for land vehicles; transmission mechanisms, for land vehicles; treads for retreading tires [tyres]; treads for vehicles [roller belts]; turbines for land vehicles; sack trucks; undercarriages for vehicles; upholstery for vehicles; valves for vehicle tires [tyres]; vehicle wheels; wheels for bicycles, cycles; windows for vehicles; windscreens; windscreen wipers; masts for boats; stroller covers; wheelbarrows; handbarrows; linings for vehicles; chains for bicycles, cycles; brakes for bicycles, cycles; tubeless tyres for cycles, bicycles; prams (baby carriages); pushchairs; dress guards for bicycles, cycles.*

- Class 25: *Clothing, footwear, headgear; napkins (babies' -) of textile; boots (heelpieces for- ); heelpieces for footwear; heelpieces for shoes; heelpieces for stockings; fittings of metal for footwear; non-slip devices for boots; non-slipping devices for footwear; shoes (non-slipping devices for- ); dress shields; tips for footwear; footwear uppers; frames (hat -) [skeletons]; heels; insoles; linings (ready-made -) [parts of clothing]; pockets for clothing; shirt fronts; shirt yokes; footwear soles; football boots [shoes] (studs for —); visors; boots (welts for -); shoes (welts for- ); fittings of metal for footwear.*
- Class 28: *Games and playthings, except toy vehicles, scale-model vehicles; gymnastic and sporting articles not included in other classes; decorations for christmas trees; bags especially designed for skis and surfboards; artificial fishing bait; billiard cue tips; billiard markers; billiard table cushions; bite sensors [fishing tackle]; bladders of balls for games; billiard cue chalk; christmas tree stands; christmas trees of synthetic material; confetti; sole coverings for skis; cricket bags; divot repair tools [golf accessories]; edges of skis; rollers for stationary exercise bicycles; fairground ride apparatus; fish hooks; floats for fishing; golf bags, with or without wheels; gut for fishing; gut for rackets; kite reels; lines for fishing; masts for sailboards; party favors; paddings (protective -) [parts of sports suits]; paintballs [ammunition for paintball guns] [sports apparatus]; pistols (caps for -) [toys]; gut for rackets; strings for rackets; reels for fishing; rosin used by athletes; scrapers for skis; seal skins [coverings for*

*skis]; ski bindings; wax for skis; surfboard leashes; bite indicators [fishing tackle].*

3. The European Union trade mark remains registered for all the remaining goods, namely:  
Class 28: *Toy vehicles, scale-model vehicles.*
4. Each party bears its own costs.

## REASONS

The applicant filed a request for revocation of European Union trade mark No 6 543 301



(shape mark) (the EUTM). The request is directed against all the goods covered by the EUTM, namely

Class 12: *Vehicles; apparatus for locomotion by land, air or water; air bags [safety devices for automobiles]; pumps (air -) [vehicle accessories]; anti-glare devices for vehicles; anti-skid chains; anti-theft alarms for vehicles; anti-theft devices for vehicles; automobile bodies; automobile chains; automobile chassis; automobile hoods; tyres for motor vehicles; sun-blinds adapted for automobiles; axle journals; axles for vehicles; pushchairs; stroller covers; balance weights for vehicle wheels; bands for wheel hubs; torsion bars for vehicles; baskets adapted for bicycles; bells for bicycles, cycles; sleeping berths for vehicles; bicycle bells; brakes for bicycles, cycles; frames for bicycles, cycles; cycle saddles; bicycle spokes; bicycle stands; bicycle tires [tyres]; boat hooks; bodies for vehicles; bogies for railway cars; brake facings for vehicles; brake segments for vehicles; brakes for vehicles; buffers for railway rolling stock; vehicle bumpers; bumpers for automobiles; caps for vehicle petrol [gas] tanks; luggage carriers for vehicles; casings for pneumatic tires [tyres]; casters for trolleys [vehicles] [carts (am)]; chains for bicycles, cycles; vehicle chassis; cleaning trolleys; cleats [nautical]; spoke clips for wheels; clutches for land vehicles; connecting rods for land vehicles, other than parts of motors and engines; torque converters for land vehicles; railway couplings; couplings for land vehicles; seat covers for vehicles; covers for vehicle steering wheels; crankcases for land vehicle components, other than for engines; cranks for cycles; cycle bells; brakes for bicycles, cycles; frames for bicycles, cycles; handle bars for bicycles, cycles; hubs for bicycle wheels; cycle mudguards; pumps for bicycles, cycles; rims for wheels of bicycles, cycles; spokes for bicycles, cycles; cycle stands; direction signals for vehicles; disengaging gear for boats; doors for vehicles; driving chains for land vehicles; driving motors for land vehicles; ejector seats for aircraft; traction engines; motors for land vehicles; fenders for ships; flanges for railway wheel tires [tyres]; freewheels for land vehicles; funnels for locomotives; funnels for ships; gear boxes for land vehicles; gearing for land vehicles; gears for cycles; trolleys; security harness for vehicle seats; head-rests for vehicle seats; hoods for vehicle engines; hoods for vehicles; horns for vehicles; hub caps; hubs for vehicle wheels; ship hulls; hydraulic circuits for vehicles; inclined ways for boats; tire patches; repair outfits for inner tubes; inner tubes for pneumatic tires; jet engines for land vehicles; tailboard lifts [parts of land vehicles]; luggage nets for vehicles; mine cart*

wheels; rearview mirrors; motors for cycles; motors, electric, for land vehicles; mudguards; tires (non-skid devices for vehicle -); oars; paddles for canoes; panniers adapted for cycles; pedals for cycles; pneumatic tyres; portholes; propulsion mechanisms for land vehicles; stroller covers; pushchair hoods; reduction gears for land vehicles; reversing alarms for vehicles; pushchair hoods; reduction gears for land vehicles; reversing alarms for vehicles; rims for vehicle wheels; oarlocks; rudders; vehicle running boards; saddle covers for bicycles or motorcycles; safety belts for vehicle seats; safety seats for children, for vehicles; screw-propellers; screw-propellers for boats; ship propellers; stern oars; vehicle seats; ships (timbers [frames] for -); suspension shock absorbers for vehicles; shock absorbers for automobiles; shock absorbing springs for vehicles; shopping trolleys [carts (am)]; ski carriers for cars; spars for ships; spikes for tires [tyres]; vehicle wheel spokes; vehicle suspension springs; tipping apparatus, parts of trucks and waggons; tipping bodies for lorries [trucks]; steering gears for ships; steering wheels for vehicles; vehicle suspension springs; tipping apparatus, parts of trucks and waggons; tipping bodies for lorries [trucks]; tires for vehicle wheels; trailer hitches for vehicles; transmission chains for land vehicles; transmission shafts for land vehicles; transmission mechanisms, for land vehicles; treads for retreading tires [tyres]; treads for vehicles [roller belts]; turbines for land vehicles; sack trucks; undercarriages for vehicles; upholstery for vehicles; valves for vehicle tires [tyres]; vehicle wheels; wheels for bicycles, cycles; windows for vehicles; windscreens; windscreen wipers; masts for boats; stroller covers; wheelbarrows; handbarrows; linings for vehicles; chains for bicycles, cycles; brakes for bicycles, cycles; tubeless tyres for cycles, bicycles; prams (baby carriages); pushchairs; dress guards for bicycles, cycles.

Class 25: *Clothing, footwear, headgear; napkins (babies' -) of textile; boots (heelpieces for-); heelpieces for footwear; heelpieces for shoes; heelpieces for stockings; fittings of metal for footwear; non-slip devices for boots; non-slipping devices for footwear; shoes (non-slipping devices for- ); dress shields; tips for footwear; footwear uppers; frames (hat -) [skeletons]; heels; insoles; linings (ready-made -) [parts of clothing]; pockets for clothing; shirt fronts; shirt yokes; footwear soles; football boots [shoes] (studs for —); visors; boots (welts for -); shoes (welts for- ); fittings of metal for footwear.*

Class 28: *Games and playthings; gymnastic and sporting articles not included in other classes; decorations for christmas trees; bags especially designed for skis and surfboards; artificial fishing bait; billiard cue tips; billiard markers; billiard table cushions; bite sensors [fishing tackle]; bladders of balls for games; billiard cue chalk; christmas tree stands; christmas trees of synthetic material; confetti; sole coverings for skis; cricket bags; divot repair tools [golf accessories]; edges of skis; rollers for stationary exercise bicycles; fairground ride apparatus; fish hooks; floats for fishing; golf bags, with or without wheels; gut for fishing; gut for rackets; kite reels; lines for fishing; masts for sailboards; party favors; paddings (protective -) [parts of sports suits]; paintballs [ammunition for paintball guns] [sports apparatus]; pistols (caps for -) [toys]; gut for rackets; strings for rackets; reels for fishing; rosin used by athletes; scrapers for skis; seal skins [coverings for skis]; ski bindings; wax for skis; surfboard leashes; bite indicators [fishing tackle].*

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

## SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argues that the contested EUTM has not been put to genuine use for a continuous period of five years.

In particular with regard to the goods listed in Class 12, the EUTM was in use in a similar form only for a few years, namely in the 1960s. It is similar to Ferrari's 250 GTO model, which was created in 1962, with a relatively small production run of 36 cars.

Therefore, the applicant requests that the EUTM is revoked.

The EUTM proprietor submits proof of use.

It argues that the 250 GTO model is a sports car produced from 1962 until 1964 only in 39 units, all still existing, and that it is recognised as one of the most glorious and iconic Ferrari cars ever created. Although no longer in production, the 250 GTO is still in great demand. The car and corresponding EUTM have become a symbol of Italian style in the world, making it a way of living and a status symbol.

The EUTM, corresponding to the external aspect of the 250 GTO, is a trade mark inextricably tied to the legend of Ferrari S.P.A. and is synonymous of luxury, prestige and high quality both in the past and today. Its use largely coincides with the presence on the market of the car itself, as far as Class 12 is concerned. With regard to Class 28, it is used for model cars, and with regard to Class 25, it is used on clothing items bearing a device which reproduces the three-dimensional shape of the car.

Further, the EUTM proprietor argues that Ferrari's 250 GTO is destined to a very restricted market of collectors, celebrities and super-rich who can afford to spend millions of Euros to buy such an extra-expensive luxury car. This means that, at least as Class 12 is concerned, it will be sufficient to show very few sales of the products, of their spare parts, or of the related activities of maintenance, repair and restoration, to fulfill the use requirement.

In the view of the EUTM proprietor, the EUTM has been genuinely used on the relevant market in the relevant period. Moreover, substantial goodwill and reputation have been established in the EUTM in connection with cars and related accessories.

Therefore, the EUTM proprietor requests that the application be rejected.

The applicant reiterates that the contested EUTM has not been put to use since 1964. It follows that the proprietor, at the time of filing the EUTM in 2007, had no intention to use it. The fact that Ferrari designed the 250 GTO purely for racing success shows that even between 1962 and 1964 there never was real economical will to produce and use the trademark filed 43 years later. Consequently, the EUTM was filed in bad faith, namely, as a defensive mark in order to block third parties to produce and sell similarly built sports cars.

Moreover, the applicant argues that, from a legal point of view, the fact that the goods in Class 12 are high-priced luxury items is irrelevant. The use of the sign by third parties and consumers cannot be deemed use by the trade mark proprietor, who only fuels memories, but cannot be considered trying to maintain a market share.

What is more, as the contested EUTM only shows typical but no extraordinary sports car features, there exists no genuine use in the EU.

As regards use of the EUTM in relation to spare parts, the applicant points out that the evidence filed does not contain any information on the numbers, place, nature and kind of the goods sold. Moreover, there is no reference to the EUTM.

Documents in relation to the 250 GTO 55th anniversary and articles and celebrations celebrating the 250 GTO are not appropriate to prove use of any trademark at all. As pointed out before, private activities of third parties have no meaning legally in relation to the present proceedings.

Furthermore, most of the documents have not been submitted in the language of the proceedings.

With regard to goods in Classes 25 and 28, no real and genuine use of the mark has been shown either, except for, at most, t-shirts for children. This is, *inter alia*, because *toys*, as which the proprietor's car models are distributed, are not listed in the specifications of the contested EUTM, because the 250 GTO car model worth EUR 6 775 cannot be considered a plaything, and because the extent of sales is insufficient.

The applicant further criticises the affidavit submitted by the EUTM proprietor, which does not originate from an objective source and, moreover, does not contain any relevant information with regard to the genuine use of the EUTM, but only in relation to its repute and distinctiveness.

The EUTM proprietor contests the applicant's observations as being unfounded. The 39 cars produced were then sold to consumers and used on the road in the past as well as in recent years. They have, furthermore, been resold in private transactions and public auctions, which constitutes a more public and outward use. The documents filed in this regard demonstrate that the cars incorporating the EUTM still have a market share, although a niche market, reserved to rich collectors. Since there is still a market for this kind of product, the proprietor has all the interest in keeping the EUTM alive.

What is more, as stated by the Court, the use of a trade mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available. If the parts are integral to the goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods. The same may be true where the trade mark proprietor makes actual use of the mark under the same conditions for goods and services which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services such as sale of accessories or related parts or the supply of maintenance and repair services (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 40 et seq.).

In this regard, the EUTM proprietor also points to the opinion of the European Commission in the context of a preliminary ruling in relation to the interpretation of Article 12 of Directive 2008/95/EC (joined cases C-720/18 and C-721/18, *Testarossa*). Therein it is stated that the marketing by the proprietor of a trade mark of second-hand goods which he has already put on the market under the conditions laid down in Article 7(1) of Directive 2008/95/EC shall constitute use of the mark within the meaning of Article 12(1) of that Directive if the proprietor of the trade mark inspects, reconditions and certifies the goods before they are resold, thereby contributing to their survival and their value.

The EUTM proprietor points out that it has been constantly active in providing services of maintenance, inspection, restoration, painting and, consequently, the provision of spare parts to the owners of 250 GTO models.

As regards the applicant's assertions with regard to bad faith and the inherent distinctiveness of the contested EUTM, the proprietor puts forward that these have no bearing on the present case. In order to show use of a registered 3D mark, it is not required that said mark has extraordinary features.

The EUTM proprietor submits additional evidence.

## **GROUNDINGS 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 earlier 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 registered on 29/09/2008. The revocation request was filed on 12/12/2018. 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 12/12/2013 until 11/12/2018 inclusive, for the contested goods listed in the section 'Reasons' above.

On 12/04/2019 the EUTM proprietor submitted evidence as proof of use.

As the EUTM proprietor requested to keep certain commercial data contained in the evidence confidential vis-à-vis third parties, the Cancellation Division will describe the evidence only in the most general terms without divulging any such data.

The evidence to be taken into account is the following:

- **ANNEX 1:** two CDs containing the proof of use of the European Union trademark No. 006543301 **250GTO** in classes 12, 25 and 28 in the concerned period.

The documents are organized as follows:

**Exhibit A: documents from 1 to 136**, all consisting of articles in online or paper magazines or newspaper or on specialized website, attesting to the sales of the Ferrari 250 GTO car, either at auction or through private sales or by dealers.

The articles are dated between 2010 and 2019, and report on auctions by Sotheby's, Bonhams', private sales as well as sales through specialist dealers, selling Ferrari 250 GTOs built in the years from 1962 to 1964. Most of the sales were carried out in the United States, some private and specialist dealer sales took place in Europe.

**Exhibit B: documents from 1 to 125**, all consisting of articles in online or paper magazines or newspaper or on specialized website, attesting to the fact that the 250 GTO is widely present on mass media.

**Exhibit C: documents from 1 to 8**, consisting of photographs and other documents related to the celebration of the 55<sup>th</sup> anniversary of the 250 GTO.

**Exhibit D: documents from 1 to 8**, consisting of invoices issued by Ferrari for the services of maintenance, repair and restoration of the cars (doc. 1, 2, 3 and 4) and extracts from Ferrari's website concerning the Ferrari Classiche Department (doc. 5, 6, 7 and 8).

The services charged for in the four invoices are indicated as 'PAINTING OF CAR 250 GTO CHASSIS NO. [...]', 'Complete restoration of 250 GTO car, chassis no. [...]', 'Metallographic examination of the chassis 250 GTO' and, summarised under the mention 'Car 250 GTO Chassis [...]', some control, analysis, maintenance and inspection works, as well as 'FINE LAVORI RESTAURO VETTURA 250 GTO - TELAIO [...]' with the mention 'The invoice refers to spare parts for cars and/or promotional material'. The amounts charged are substantial. The



invoices show the signs **Ferrari** and . With regard to the extracts from the website ferrari.com, it is noted that they contain pictures of cars, including the 250 GTO. However, the only signs shown are the aforementioned, as well as the horse device on its own.

**Exhibit E: doc. 1 and doc. 2**, consisting of two technical Certifications of the cars

The cars concerned are Ferrari GTOs. The certificates contain data and pictures, as well as the mention 'Complete restoration performed by Ferrari Classiche / Ferrari S.p.A. in 2012-2014' and '['...]' in 2015-2016', respectively.

**Exhibit F: divided into two folders, A and B.** Folder A contains documents from 1 to 4 (extracts from Ebay and the online Ferrari store) attesting to the sale of products in class 25, while Folder B contains documents from 1 to 9 (invoices, catalogues, excel file) attesting to the sale of model cars in class 28.

The three products offered for sale as shown in folder A are a children's t-shirt, a tie pin and cuff links, all referring to 'FERRARI 250 GTO' and depicted as follows:



The relevant products offered for sale as demonstrated in folder B are six toy car models of the Ferrari 250 GTO, namely, scale 1/8 for EUR 6 775 as shown on extracts from the website [ferrari.com](http://ferrari.com) of 16/06/2015 and 22/12/2015, as well as scales 1/18, 1/24, 1/32 and 1/43 and a 'pocket garage car & launcher', no prices indicated, as shown in product catalogues by the company Bburago from 2017 and 2018. The items are depicted as follows:



Two invoices of 2018, issued by Bburago to customers in Italy, include 12 units of 1/24 Ferrari 250 GTO without any price indication and 36 units of 1/18 Ferrari 250 GTO with a unit price of EUR 29.59.

Two invoices issued by B.B.R. Exclusive Car Models S.r.l. to customers in Italy and the Netherlands, include 1 unit of 'Ferrari 250 GTO Press day 1962 - limited 250 pcs' and 1 unit of 'Ferrari 250 GTO LE MANS 1962'.

The excel sheet lists Ferrari 250 GTO 1:18 scale model cars as well as the 'Edition 32' by country, units (between 1 and 4), gross and net sales prices and royalties. However, the sheet lacks any mention of source or date.

- **ANNEX 2: doc. No. 1: Original of a declaration of Mr. Keith Bluemel (and a copy of the passport)**, mentioned on page 16 of these observations.

Mr Keith Bluemel, for the purposes of this declaration of 30/01/2019, identifies as automotive journalist and historian, an expert in the sector, and member of IAC/PFA. Mr Bluemel states that with the contested EUTM he associates a distinctive line of vehicles made by the well-known company Ferrari S.p.A. and on the market for at least 50 years. He comments that the '250 GTO' trade mark rapidly conquered the market from its initial launch in 1962, establishing itself as an instantly recognisable sign that exclusively identifies and distinguishes the vehicle model in question, along with toys and collectible models of that vehicle model, as a typical and characteristic product originating from Ferrari S.p.A..

Mr Bluemel further attests that the Ferrari 250 GTO achieved legendary status amongst motor sports aficionados, having won no fewer than three consecutive Manufacturers' titles in the GT category of the Worlds Sports Car Championship between 1962 and 1964, and that, thanks to this international racing pedigree, the 250 GTO is one of the icons of Ferrari's production history, with a revered position in collector's circles.

Moreover, he certifies that, compared to automobile sector standards and practices, the characteristics of the external appearance of the vehicle in question stand out from the typical features of ordinary vehicles. In this regard, he points out the design characteristics peculiar to the vehicle model, which induce the user to perceive the unique shape of the 250 GTO as an indicator of exclusive origin and provenance from Ferrari S.p.A..

On 13/01/2020, after expiry of the time limit, the EUTM proprietor submitted the following additional evidence:

- **ANNEX 1: doc. 1 to 6:** example of sports cars of 2007;
- **ANNEX 2: doc. 1:** extract from the Merriam Webster dictionary;

The extract shows the definition of 'plaything'.

- **ANNEX 3: doc. 1 and 2:** page of the 9<sup>th</sup> edition of the Nice Classification and EUIPO's grey list;
- **ANNEX 4: doc. 1 and 2:** definition of collection in the Italian Treccani dictionary and related translation;
- **ANNEX 5: doc. 1 to doc. 8:** invoices issued by Bburago International, excel file with the sales turnover relating to 250 GTO model cars, screenshot of two clients of Bburago, three images of the 2018 Bburago catalogue showing 250 GTO model cars;

The two invoices of 18/10/2018 and 20/12/2018, issued by Bburago to customers in Poland and Spain, include 8 units of 1/18 FERRARI ORIGINAL - 250 GTO with a unit price of USD 31.15, and 120 units of 1/24 FERRARI - 250 GTO with a unit price of EUR 5.77, respectively.

The excel sheet 'Ferrari 250 GTO 2015-2018 (Sales to Europe)', which appears to be an internal document, comprises a list by country, customer name, royalties, sales amount, invoice, item number and item description.

The remaining evidence contained in Annex 5 consists of information about the companies midex and Tobar Group Trading Ltd., and three extracts from product catalogues by Bburago, undated, showing toy car models, including of the 250 GTO (1/18 and 1/24), as depicted above.

- **ANNEX 6: doc. 1 and doc. 2: opinion of the European Commission in the German and English versions.**

The document constitutes a brief pursuant to Article 23(2) of the Protocol on the Statute of the Court of Justice in joined Cases C-720/18 and C-721/18, lodged by the European Commission, concerning a preliminary ruling pursuant to Article 267 TFEU, requested by the Oberlandesgericht Düsseldorf (Germany), on the interpretation of Directive 2008/95/EC.

In the main proceedings, a third party seeks cancellation of a trade mark covered by that Directive for lack of use. Between 1984 and 1991, the owner had used the 'Testarossa' trade mark concerned for a sports car model, but no longer for new vehicles which he had since marketed. The questions referred essentially concern Article 12(1) and, in part, Article 13 of Directive 2008/95/EC. Inter alia, the Commission proposed the following replies to those questions referred by the national court which may have a bearing on the present proceedings:

*2. Does the marketing by the trade mark proprietor of used goods which have already been put on the market in the European Economic Area by the trade mark proprietor constitute use of the trade mark within the meaning of Article 12(1) of Directive 2008/95/EC?*

*The marketing by the proprietor of a trade mark of second-hand goods which he has already put on the market under the conditions laid down in Article 7(1) of Directive 2008/95/EC shall constitute use of the trade mark within the meaning of Article 12(1) of that Directive if the proprietor of the trade mark inspects, reconditions and certifies the goods before they are resold, thereby contributing to their survival and their value.*

*4. In assessing whether there has been genuine use, must account also be taken of whether the trade mark proprietor, while not using the trade mark, offers certain services for the goods already marketed?*

*The assessment as to whether a trade mark has been put to genuine use for certain goods within the meaning of Article 12(1) of Directive 2008/95/EC is not affected by the fact that the trade mark proprietor provides services in relation to those goods but does not use the trade mark concerned for those services.*

With regard to the additional evidence submitted, the Cancellation Division notes that, even though, according to Article 19(1) EUTMDR, the EUTM proprietor has to submit proof of use within a time limit set by the Office, Article 10(7) EUTMDR (applicable to cancellation proceeding by virtue of Article 19(1) EUTMDR) expressly invites the Office to exercise its discretionary power if relevant evidence was submitted in time and, after the expiry of the time limit, supplementary evidence was filed.

According to Article 10(7) EUTMDR, where, after the expiry of the time limit set by the Office, indications or evidence is filed that supplement prior relevant indications or evidence submitted within the time limit, the Office may take into account the evidence submitted out of time as a result of exercise of the discretion conferred on it by Article 95(2) EUTMR. When

exercising its discretionary power, the Office must take into account, in particular, the stage of proceedings and whether the facts or evidence are, *prima facie*, likely to be relevant for the outcome of the case and whether there are valid reasons for the late submission of the facts or evidence.

In this regard, the Cancellation Division considers that the EUTM proprietor did submit relevant evidence within the time limit initially set by the Office and, therefore, the later evidence can be considered to be additional.

The fact that the applicant disputed the initial evidence submitted by the EUTM proprietor justifies the submission of additional evidence in reply to the objection (29/09/2011, T-8209;415/09, Fishbone, EU:T:2011:550, § 30 and 33, upheld by judgment of 18/07/2013, C-8209;621/11 P, Fishbone, EU:C:2013:484, § 36).

What is more, the evidence submitted as Annex 6 has been received by the Court only on 21/05/2019, that is, after the deadline given to the EUTM proprietor to submit evidence, which expired on 17/04/2019.

For the above reasons, and in the exercise of its discretion pursuant to Article 95(2) EUTMR, the Cancellation Division therefore decides to take into account the additional evidence submitted on 13/01/2020.

The applicant criticises that the EUTM proprietor did not submit translations of some of the evidence of use. However, the EUTM proprietor is not under any obligation to translate the proof of use, unless it is specifically requested to do so by the Office (Article 10(6) EUTMDR, applicable *mutatis mutandis*).

First, the Cancellation Division notes that some of the documents that are not in the language of the proceedings have, in fact, been translated. Moreover, it has to be noted that such translations serve the purpose to allow the applicant to understand the content of the documents submitted and thus construct an effective defence. Nevertheless, the lack of a translation did not prevent the applicant from understanding the content of each of these documents and arguing about their probative value. At no time did it state that it was unable to take a position on those items of evidence on the ground that they had not been translated into the language of proceedings. The Cancellation Division therefore believes that the interest protected, that is, the comprehension of the evidence against the case of the applicant, has not been called into question.

What is more, taking into account the nature of the contested EUTM, namely a 3D mark, and of the documents which have not been translated and are considered relevant for the present proceedings, namely press articles on the sales of Ferrari 250 GTOs, the Cancellation Division considers that there is no need to request a translation. Irrespective of the language of said articles, the objects of the sales (Ferrari 250 GTO) and pictures thereof, the places of sale and the prices realised can be deduced from those documents.

Furthermore, from the overall assessment of the press articles in their entirety, including those in the language of the proceedings, it becomes clear that they all refer to the sales of vintage Ferrari 250 GTOs by way of auctions, private transactions and through specialist dealers. The articles confirm that only a very limited number of these cars exist (according to the EUTM proprietor and some of the press articles, 39), and that they have been built between 1962 and 1964. These facts are undisputed by the parties.

As far as the affidavit is concerned, Article 10(4) EUTMDR (applicable to cancellation proceedings by virtue of Article 19(1) EUTMDR) expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of proof of use. Article 97(1)(f)

EUTMR lists, as means of giving evidence, sworn or affirmed written statements or other statements that have a similar effect under the law of the State in which they were drawn up. As far as the probative value of this kind of evidence is concerned, statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perceptions of a party involved in a dispute may be more or less affected by its personal interests in the matter.

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.

In view of the foregoing, the remaining evidence must be assessed in order to see whether or not the contents of the declaration are supported by the other items of evidence.

The applicant argues that not all the items of evidence indicate genuine use in terms of time, place, extent, nature and use for the goods for which the EUTM is registered.

The applicant's argument is based on an individual assessment of each item of evidence regarding all the relevant factors. However, when assessing genuine use, the Cancellation Division must consider the evidence in its entirety. Even if some relevant factors are lacking in some items of evidence, the combination of all the relevant factors in all the items of evidence may still indicate genuine use.

## **PRELIMINARY REMARKS**

With regard to the applicant's assertions that the contested EUTM was filed in bad faith and lacks inherent distinctiveness, the Cancellation Division notes that these claims are not subject to, and have no bearing on, the present proceedings, the sole aim of which is to establish whether the contested EUTM has been genuinely used.

## **ASSESSMENT OF GENUINE USE – FACTORS**

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

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 EUTM proprietor is obliged not only to indicate but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the entirety of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 31).

### **Class 28**

In relation to Class 28, the EUTM proprietor has submitted extracts from the website [ferrari.com](http://ferrari.com) of 16/06/2015 and 22/12/2015, two product catalogues 'Collezione Ferrari' by the company Bburago from 2017 and 2018, as well as three further extracts from product

catalogues by that same company, undated, showing model cars, including the Ferrari 250 GTO.

In addition, the EUTM proprietor has provided six invoices. Five of them are dated within the relevant period of time, two of which are issued by B.B.R. Exclusive Car Models S.r.l. to customers in Italy and the Netherlands. They include 1 unit of 'Ferrari 250 GTO Press day 1962 - limited 250 pcs' and 1 unit of 'Ferrari 250 GTO LE MANS 1962'. These models appear to be collectibles, which can be inferred from the item description and their price, which is considerably higher than that of the models listed in the other invoices.

The other three invoices which are dated within the relevant period are issued by Bburago to customers in Italy and Poland. They appear to list model cars as shown in the Bburago product catalogues, including 12 units of the 1/24 scale toy model of the Ferrari 250 GTO without any price indication, 36 units of the 1/18 scale model with a unit price of EUR 29.59, and another 8 units of the 1/18 scale model with a unit price of USD 31.15. The invoice of 20/12/2018, listing 120 units of the 1/24 scale model for a unit price of EUR 5.77, although dated shortly after the relevant period of time, appears to refer to the model car shown in the 2018 product catalogue.

#### Time of use

The product catalogues and most of the invoices fall within the relevant period of time. Therefore, the evidence of use filed by the EUTM proprietor contains sufficient indications concerning the time of use.

Evidence referring to use outside the relevant period is disregarded unless it contains conclusive indirect proof that the mark must have been genuinely used during the relevant period as well. Events subsequent to the relevant period may make it possible to confirm or assess more accurately the extent to which the earlier mark was used during the relevant period and the EUTM proprietor's real intentions at the time (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50).

In the present case, the evidence referring to use outside the relevant period confirms use of the EUTM proprietor's mark within the relevant period, since it refers to goods shown in a product catalogue which was valid throughout the year 2018.

Regarding duration of use, it is important to remember that only trade marks whose genuine use was interrupted for a continuous period of five years are subject to the sanctions provided for in Article 18(1) EUTMR. Therefore, it is sufficient for avoiding these sanctions that a trade mark was genuinely used for only part of this period (16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 52; 09/07/2009, R 623/2008-4, Walzer Traum (fig.) / Walzertraum, § 28).

#### Place of use

The invoices show that the place of use is at least Italy, the Netherlands, Poland and Spain. This can be inferred from, the currency mentioned (Euro) and some addresses in those Member States. Therefore, the evidence relates to the relevant territory.

In this regard, it should be noted that use of the mark by a client importing goods for which the mark is registered can be sufficient to demonstrate genuine use if it appears that importing is commercially justified for the proprietor of the mark (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 24).

### Nature of use

Nature of use requires, *inter alia*, that the contested European Union trade mark is used as a trade mark, that is, for identifying origin, thus making it possible for the relevant public to distinguish between goods and services of different providers.

It has not been disputed by the applicant, and the evidence does not suggest otherwise, that the EUTM has been used as a trade mark and, moreover, essentially as registered, that is, in accordance with Article 18 EUTMR.

### Extent of use

Concerning extent of use, it is settled case-law that account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (e.g. 08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 35).

The Court has held that '[u]se of the mark need not ... always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market' (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39).

It is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule cannot therefore be laid down. When it serves a real commercial purpose, even minimal use of the mark can be sufficient to establish genuine use (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 25, 27).

The assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. Likewise, the territorial scope of the use is only one of several factors to be taken into account, so that a limited territorial scope of use can be counteracted by a more significant volume or duration of use.

Use of the mark by a single client importing the goods for which the mark is registered can be sufficient to demonstrate genuine use, if it appears that importing is commercially justified for the mark's proprietor (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 24).

Moreover, the Court has found that, under certain circumstances, even circumstantial evidence such as catalogues featuring the trade mark, while not providing direct information on turnover, can also be sufficient for proving extent of use in an overall assessment (08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 42 et seq.).

Although the excel sheets showing sales of Ferrari 250 GTO toy car models are undated and appear to be internal documents, and the invoices submitted do not indicate a particularly extensive commercial volume and cover a rather short period of time, these documents, to a certain extent, corroborate the statements made by the EUTM proprietor and show use of the EUTM in several Member States, namely, at least in Italy, the Netherlands, Poland and Spain.

More importantly though, the invoices confirm actual sales of goods under the EUTM as shown in two product catalogues by the supplier. These product catalogues are dated 2017 and 2018 and, therefore, demonstrate that the goods shown therein were available for purchase throughout these two years. The contested EUTM is depicted in these catalogues in the form

of toy car models in different sizes, all accompanied by article numbers and the reference '250GTO', as mentioned in the invoices.

Taken as a whole, the evidence provides sufficient indications to conclude that the EUTM was genuinely used in relation to certain goods during the relevant period in the relevant territory.

#### Use in relation to the registered goods

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

The contested EUTM is registered for the goods listed above in the section 'Reasons'. However, the evidence filed by the EUTM proprietor does not show genuine use of the trade mark for all the goods for which it is registered.

According to Article 58(2) EUTMR, where there are grounds for revocation for only some of the goods or services for which the contested mark is registered, the proprietor's rights will be revoked for those goods and services only.

According to case-law, when applying the abovementioned provision the following should be considered:

... if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

(14/07/2005, T-126/03, Aladin, EU:T:2005:288)

Since consumers are searching primarily for a product or service to meet their specific needs, the purpose of the product or service in question is vital for determining their choice. Consequently, it is of fundamental importance when defining a subcategory of goods or services (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 29).

The contested EUTM is registered for, inter alia, *playthings* in Class 28. It is clear that this category of goods is sufficiently broad for several subcategories to be identified within it. The evidence shows that the contested EUTM has been used for *toy cars*, *scale-model cars*. On the basis of the purpose of the goods used, the Cancellation Division finds that the use for these goods, which fall under the broad category of *playthings*, constitutes use for the subcategories of *toy vehicles*, *scale-model vehicles*.

The applicant's arguments that *toys*, as which the EUTM proprietor's car models are distributed, are not listed in the specification of Class 28 and that, moreover, these car models do not constitute *playthings*, because not even the cited 'superrich' would use a EUR 6 775 car model as a plaything, has to be dismissed. The goods shown in the Bburago product catalogues clearly fall into the category of *playthings*, which is also supported by the unit prices shown in the invoices.

## Class 25

With regard to the goods in Class 25, the EUTM proprietor has provided two extracts from the website [store.ferrari.com](http://store.ferrari.com) of 16/06/2015, which show a children's t-shirt 'Polo Ferrari 250 GTO Bambino da 3 a 7 anni', and two extracts from the website [ebay.it](http://ebay.it) of 22/12/2015, which show a tie pin 'FERRARI GTO 250' and a pair of cufflinks 'FERRARI GTO 250', each in the shape of a car.

The evidence submitted does not allow any conclusions with regard to the extent to which the goods shown therein have been marketed. The documents do not provide the Cancellation Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use.

What is more, the Cancellation Division notes that the goods offered do not show the EUTM as registered and, moreover, part of those goods, namely, the tie pin and cufflinks, are not registered under the mark.

Therefore, the Cancellation Division considers that the EUTM proprietor has not provided sufficient indications concerning the extent of use of the contested EUTM in relation to the goods for which it is registered in Class 25.

## Class 12

In the *Minimax* judgment, the Court held that, in certain circumstances, use of the mark may be considered genuine also for 'registered' goods that had been sold at one time and were no longer available (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 40 et seq.).

This may apply where the proprietor of the trade mark under which such goods had been put on the market sells parts that are integral to the make-up or structure of the goods previously sold. The same may apply where the trade mark proprietor makes actual use of the mark for after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

In the present case, the EUTM proprietor did not prove use of the mark in the course of trade for any of the goods in Class 12. The evidence demonstrates that a vehicle model in the shape of the mark used to be built between 1962 and 1964, but there is no evidence of use for these goods, or any of the other goods covered in Class 12, by the proprietor in the relevant period of time.

In this regard, it should be noted that reputation or goodwill of the contested EUTM on the part of the public, as attested by affidavit and confirmed by the press articles, are irrelevant in the case at hand.

As claimed by the EUTM proprietor, the evidence shows that a few vintage (second-hand) models of 'Ferrari 250 GTOs', the shape of which corresponds to the contested EUTM, have changed owners at auctions, private transactions, and some through specialist dealers. Furthermore, considering the nature of the goods concerned, which are very rare and highly expensive sports cars, as well as the structure of the relevant market, it is true that the number of vehicles sold under the mark does not, in principle, have to be extensive. However, such sales do not constitute genuine use attributable to the EUTM proprietor, because the latter does not have any influence on these resales.

With regard to the *Minimax* judgment, the Cancellation Division notes that the evidence submitted does not demonstrate that after-sales services have been carried out under the contested EUTM. In fact, the mark does not appear anywhere on these documents. Instead,

the services appear to have been carried out under the umbrella brand **Ferrari** and



the marks  and 'Ferrari Classiche'.

The same applies with regard to the reconditioning and certification of vintage cars before resale. Although the European Commission in joined cases C-720/18 and C-721/18 takes the view that such services do not necessarily have to be carried out under the same contested mark, because in any case they contribute to the survival and the value of the designated goods, this opinion has been issued before the background that, in that particular case, the second-hand cars had been resold by the trade mark owner itself. This is not the case here.

Therefore, the Cancellation Division concludes that the EUTM proprietor failed to show genuine use of the contested EUTM in relation to the goods it is registered for in Class 12.

### Overall assessment

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, EU:T:2004:223, § 36).

In the present case, the Cancellation Division considers that genuine use of the contested EUTM has been sufficiently demonstrated for the relevant factors in relation to *toy vehicles, scale-model vehicles*, whereas no use of the mark or proper reasons for non-use have been demonstrated in relation to any of the other goods for which it is registered.

### Conclusion

It follows from the above that the EUTM proprietor has not proven genuine use of the EUTM for the following goods, for which it must, therefore, be revoked:

Class 12: *Vehicles; apparatus for locomotion by land, air or water; air bags [safety devices for automobiles]; pumps (air -) [vehicle accessories]; anti-glare devices for vehicles; anti-skid chains; anti-theft alarms for vehicles; anti-theft devices for vehicles; automobile bodies; automobile chains; automobile chassis; automobile hoods; tyres for motor vehicles; sun-blinds adapted for automobiles; axle journals; axles for vehicles; pushchairs; stroller covers; balance weights for vehicle wheels; bands for wheel hubs; torsion bars for vehicles; baskets adapted for bicycles; bells for bicycles, cycles; sleeping berths for vehicles; bicycle bells; brakes for bicycles, cycles; frames for bicycles, cycles; cycle saddles; bicycle spokes; bicycle stands; bicycle tires [tyres]; boat hooks; bodies for vehicles; bogies for railway cars; brake facings for vehicles; brake segments for vehicles; brakes for vehicles; buffers for railway rolling stock; vehicle bumpers; bumpers for automobiles; caps for vehicle petrol [gas] tanks; luggage carriers for vehicles; casings for pneumatic tires [tyres]; casters for trolleys [vehicles] [carts (am)]; chains for bicycles, cycles; vehicle chassis; cleaning trolleys; cleats [nautical]; spoke clips for wheels; clutches for land vehicles; connecting rods for land vehicles, other than parts of motors and engines; torque converters for land vehicles; railway couplings; couplings for land vehicles; seat covers for vehicles; covers for vehicle steering wheels; crankcases*

*for land vehicle components, other than for engines; cranks for cycles; cycle bells; brakes for bicycles, cycles; frames for bicycles, cycles; handle bars for bicycles, cycles; hubs for bicycle wheels; cycle mudguards; pumps for bicycles, cycles; rims for wheels of bicycles, cycles; spokes for bicycles, cycles; cycle stands; direction signals for vehicles; disengaging gear for boats; doors for vehicles; driving chains for land vehicles; driving motors for land vehicles; ejector seats for aircraft; traction engines; motors for land vehicles; fenders for ships; flanges for railway wheel tires [tyres]; freewheels for land vehicles; funnels for locomotives; funnels for ships; gear boxes for land vehicles; gearing for land vehicles; gears for cycles; trolleys; security harness for vehicle seats; head-rests for vehicle seats; hoods for vehicle engines; hoods for vehicles; horns for vehicles; hub caps; hubs for vehicle wheels; ship hulls; hydraulic circuits for vehicles; inclined ways for boats; tire patches; repair outfits for inner tubes; inner tubes for pneumatic tires; jet engines for land vehicles; tailboard lifts [parts of land vehicles]; luggage nets for vehicles; mine cart wheels; rearview mirrors; motors for cycles; motors, electric, for land vehicles; mudguards; tires (non-skid devices for vehicle -); oars; paddles for canoes; panniers adapted for cycles; pedals for cycles; pneumatic tyres; portholes; propulsion mechanisms for land vehicles; stroller covers; pushchair hoods; reduction gears for land vehicles; reversing alarms for vehicles; pushchair hoods; reduction gears for land vehicles; reversing alarms for vehicles; rims for vehicle wheels; oarlocks; rudders; vehicle running boards; saddle covers for bicycles or motorcycles; safety belts for vehicle seats; safety seats for children, for vehicles; screw-propellers; screw-propellers for boats; ship propellers; stern oars; vehicle seats; ships (timbers [frames] for -); suspension shock absorbers for vehicles; shock absorbers for automobiles; shock absorbing springs for vehicles; shopping trolleys [carts (am)]; ski carriers for cars; spars for ships; spikes for tires [tyres]; vehicle wheel spokes; vehicle suspension springs; tipping apparatus, parts of trucks and waggons; tipping bodies for lorries [trucks]; steering gears for ships; steering wheels for vehicles; vehicle suspension springs; tipping apparatus, parts of trucks and waggons; tipping bodies for lorries [trucks]; tires for vehicle wheels; trailer hitches for vehicles; transmission chains for land vehicles; transmission shafts for land vehicles; transmission mechanisms, for land vehicles; treads for retreading tires [tyres]; treads for vehicles [roller belts]; turbines for land vehicles; sack trucks; undercarriages for vehicles; upholstery for vehicles; valves for vehicle tires [tyres]; vehicle wheels; wheels for bicycles, cycles; windows for vehicles; windscreens; windscreen wipers; masts for boats; stroller covers; wheelbarrows; handbarrows; linings for vehicles; chains for bicycles, cycles; brakes for bicycles, cycles; tubeless tyres for cycles, bicycles; prams (baby carriages); pushchairs; dress guards for bicycles, cycles.*

- Class 25: *Clothing, footwear, headgear; napkins (babies' -) of textile; boots (heelpieces for-); heelpieces for footwear; heelpieces for shoes; heelpieces for stockings; fittings of metal for footwear; non-slip devices for boots; non-slipping devices for footwear; shoes (non-slipping devices for- ); dress shields; tips for footwear; footwear uppers; frames (hat -) [skeletons]; heels; insoles; linings (ready-made -) [parts of clothing]; pockets for clothing; shirt fronts; shirt yokes; footwear soles; football boots [shoes] (studs for —); visors; boots (welts for -); shoes (welts for- ); fittings of metal for footwear.*
- Class 28: *Games and playthings, except toy vehicles, scale-model vehicles; gymnastic and sporting articles not included in other classes; decorations for christmas trees; bags especially designed for skis and surfboards; artificial fishing bait; billiard cue tips; billiard markers; billiard table cushions; bite sensors [fishing tackle]; bladders of balls for games; billiard cue chalk; christmas tree stands; christmas trees of synthetic material; confetti; sole coverings for skis; cricket bags; divot repair tools*

*[golf accessories]; edges of skis; rollers for stationary exercise bicycles; fairground ride apparatus; fish hooks; floats for fishing; golf bags, with or without wheels; gut for fishing; gut for rackets; kite reels; lines for fishing; masts for sailboards; party favors; paddings (protective -) [parts of sports suits]; paintballs [ammunition for paintball guns] [sports apparatus]; pistols (caps for -) [toys]; gut for rackets; strings for rackets; reels for fishing; rosin used by athletes; scrapers for skis; seal skins [coverings for skis]; ski bindings; wax for skis; surfboard leashes; bite indicators [fishing tackle].*

The EUTM proprietor has proven genuine use for the remaining contested goods; therefore, the application is not successful in this respect.

According to Article 62(1) EUTMR, the revocation will take effect from the date of the application for revocation, that is, as of 12/12/2018.

## **COSTS**

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party. According to Article 109(2) EUTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Cancellation Division will decide a different apportionment of costs.

Since the cancellation is successful only for part of the contested goods, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



### **The Cancellation Division**

Richard BIANCHI

Natascha GALPERIN

Elena NICOLÁS GÓMEZ

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.