



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

Cancellation Division

C491B

Alicante, 07/09/2011

**INVALIDITY PROCEEDINGS: NOTIFICATION OF A DECISION TO THE
CTM PROPRIETOR**

Address of proprietor / representative: NOTARBARTOLO & GERVASI
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Fax number: 00 39-0236216366

Community trade mark concerned: 003503869
ECM

OHIM reference: **000002807 C**
Language of the proceedings: English

Please see attached the decision terminating the invalidity proceedings referred to above. It was delivered on 07/09/2011.

Miriam SANCHEZ FUNES

Attached: 8 pages including cover page



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

Cancellation Division

**DECISION
of the Cancellation Division
of 07/09/2011:**

IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY

OHIM reference number: 2807 C

Community trade mark: 3 503 869



Language of the proceedings: English

APPLICANT

**ECM Espresso Coffee Machines
Manufacture GmbH**
Dilsberger Str. 68
69151 Neckargemünd
Germany

REPRESENTATIVE

Ullrich & Naumann
Schneidmühlstrasse 21
69115 Heidelberg
Germany

**COMMUNITY TRADE MARK
PROPRIETOR**

DBL S.r.l.
Via Carducci, 15
20123 Milan
Italy

REPRESENTATIVE

Notarbartolo & Gervasi S.P.A.
Corso de Porta Vittoria, 9
20122 Milan
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THE CANCELLATION DIVISION

composed of: Stephan Hanne, José Antonio Garrido Otaola and André Pohlmann has taken the following decision on 07/09/2011:

1. **The request for a declaration of invalidity is rejected.**
2. **The applicant shall bear the costs of the Community trade mark proprietor.**
3. **The costs are fixed as follows:**

The amount of costs to be paid by the applicant to the Community trade mark proprietor shall be EUR 450, corresponding to representation costs.

FACTS AND ARGUMENTS

- (1) The Community trade mark No 3 503 869, as depicted on the cover page of this decision ("the CTM"), was filed on 31/10/2003 and registered on 19/04/2005 for goods in classes 9, 11 and 30.
- (2) On 03/04/2008, the applicant filed a request for a declaration of invalidity against the CTM, on the basis of relative grounds, namely that the CTM was registered contrary to Article 8(4) CTMR, in conjunction with Article 53(1)(c) CTMR.
- (3) The applicant invoked the following earlier right:
 - Company name "ECM Espresso Coffee Maschinen Vertriebs GmbH", used in the course of trade in Germany for *trade and service of espresso-coffee machines and other electrical devices of all kinds; coffee.*
- (4) The applicant filed its request for a declaration of invalidity in respect of all the goods covered by the CTM.
- (5) The CTM proprietor was duly notified of the invalidity application and the parties were given ample opportunity to comment upon the observations made by the counterparty in accordance with the relevant provisions of the CTMR and the CTMIR.
- (6) The applicant argues that the company name on which the application is based has been used in the course of trade in Germany since 1996 and that such use has been of more than local significance. It further argues that, pursuant to paragraphs 5 and 15 of the German Trade Mark Law ("Markengesetz"), the owner of a business sign, such as the name of a firm, has the right to prohibit the use of an identical or similar sign for identical or similar goods and services in the whole territory of Germany if it is likely to create confusion with the earlier business sign. Finally, it claims that the contested CTM is very similar to the earlier sign invoked by the applicant and covers identical goods, so that there is a risk of confusion between the signs

in question. Consequently, and in accordance with Article 8(4) CTMR, it requests the invalidity of the contested CTM.

- (7) In support of its arguments, the applicant files the following documents:
- Extract from the Commerce Register of Mannheim, dated 05/03/2008, which shows, *inter alia*, that the applicant was incorporated on 27/11/1996 and that it changed its name from “E C M Espresso Coffee Maschinen Vertriebs GmbH” to “E C M Espresso Coffee Machines Manufacture GmbH” on 18/01/2006 (change of name registered on 17/05/2006).
 - Copies of seven advertisements of coffee machines published in different German magazines within the period from the summer of 1999 until March 2002. It should be noted that the company name invoked by the applicant does not appear as such in any of the advertisements (instead there are references to “ECM Espresso Company Milano” and/or “ECM GmbH”).
 - Brochure about the “Ferrari Racing Days 2004”, which were scheduled to take place in September 2004 in Germany. The brochure shows that “ECM Espresso Company Milano” was one of the sponsors.
 - Brochure from a German magazine which mentions “ECM” and “ECM Deutschland” in connection with a collection of historical espresso machines.
 - Advertising brochure of the applicant, dated 2001, regarding different types of coffee machines with use of the signs “ECM Espresso Company Milano” and “ECM GmbH”.
 - Advertising brochure of the applicant, dated 2000, regarding different types of coffee machines, in which the company name “ECM Espresso Coffee Maschinen Vertriebs GmbH” is used.
 - Copies of the distribution and sales figures of the applicant for the years 2000-2003, broken down by product.
 - Copy of a letter in German, not translated (despite the Cancellation Division’s request in this regard), which was sent on 01/04/1999 by a company called “ECM srl”.
 - Copy of a page from an instruction manual for a coffee machine in Dutch which contains the sign “ECM Espresso Company Milano”, as well as the name and address of an importer to the Netherlands.
 - Letter from a representative of the applicant to its representative, dated 21/01/2011, stating the yearly sales figures of the applicant from 1997 to 2003.
- (8) The CTM proprietor did not submit any observations in reply.
- (9) On 13/04/2011, the parties were informed that the adversarial part of the proceedings was closed and that a decision would be taken in due course.

GROUNDS FOR THE DECISION

On the admissibility

- (10) The request complies with the formalities prescribed in particular in Article 56(1) CTMR and Rule 37 CTMIR and is, therefore, admissible.

On the substance

Non-registered marks or other signs used in the course of trade – Article 8(4) in conjunction with Article 53(1)(c) CTMR

- (11) Pursuant to Article 53(1)(c) CTMR a Community trade mark shall on request to the Office be declared invalid where there is an earlier right as referred to in Article 8(4) CTMR and the conditions set out in the latter provision are fulfilled.

- (12) According to Article 8(4) CTMR upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

(a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

- (13) The grounds of refusal of Article 8(4) CTMR are therefore subject to the following requirements:

- The earlier sign must have been used in the course of trade of more than local significance prior to the filing of the contested trade mark;
- Pursuant to the law governing it, prior to the filing of the contested trade mark, the applicant acquired rights to the sign on which the application for invalidity is based, including the right to prohibit the use of a subsequent trade mark.
- The conditions under which the use of a subsequent trade mark may be prohibited are fulfilled in respect of the contested trade mark.

- (14) These conditions are cumulative. Thus, where a sign does not satisfy one of those conditions, an application for invalidity based on the existence of a non-registered trade mark or of other signs used in the course of trade within the meaning of Article 8(4) CTMR cannot succeed.

Prior use in the course of trade of more than mere local significance

- (15) The condition requiring use in the course of trade is a fundamental requirement, without which the sign in question cannot enjoy any protection

against a Community trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights.

- (16) Furthermore, such use must indicate that the sign in question is of more than mere local significance. The rationale of that provision is to restrict the number of conflicts between signs, by preventing an earlier sign, which is not sufficiently important or significant, from making it possible to challenge either the registration or the validity of a Community trade mark. In order to ascertain whether that is the case, account must be taken of the duration and intensity of the use of that sign as a distinctive element vis-à-vis its addressees, namely purchasers and consumers as well as suppliers and competitors. In that regard, the use made of the sign in advertising and commercial correspondence is of particular relevance (see in this regard judgment of 29/03/2011, C-96/09P, 'BUD', paragraphs 157 and 160).
- (17) Pursuant to Article 8(4) CTMR, the applicant is required to prove that the signs on which the application for invalidity is based were used in the course of trade of more than local significance in the territory where the signs are protected (Germany) before the filing date of the contested trade mark (see 'BUD' judgment, paragraphs 162 and 166).
- (18) In addition, it should be taken into account that in cancellation proceedings the applicant also has to prove that the signs were used in the course of trade of more than local significance at another point in time, namely at the time of filing of the invalidity request. Such condition stems from the wording of Article 53(1)(c) CTMR which states that a Community trade mark shall be declared invalid 'where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled' (see also in this regard decision of the Cancellation Division of 05/10/2004, No. 606 C, 'ANKER').
- (19) Consequently, in the present case the invalidity applicant has to prove use in the course of trade of the earlier sign in Germany both before the filing date of the contested CTM (31/10/2003) and at the date of the invalidity request (03/04/2008).
- (20) However, the evidence furnished by the applicant and listed in paragraph (7) above is clearly insufficient to prove use in the course of trade at the date of the invalidity request, since it is too far apart in time from said date. In this regard, the Cancellation Division notes that the great majority of the evidence predates the filing date of the CTM (31/10/2003), the only exceptions being an advertising leaflet for a event scheduled to take place in September 2004 and the sales figures for 2003, inasmuch as they can be deemed to include at least some sales for the months of November and December of that year. There is no evidence of use regarding the years 2005-2008.
- (21) In addition, the extract from the Commerce Register submitted by the applicant actually contains an indication that the earlier right on which the application is based (the company name "E C M Espresso Coffee Maschinen Vertriebs GmbH") was no longer being used in the course of trade at the time of the invalidity request, since it states that the company name was changed on 18/01/2006 to "E C M Espresso Coffee Machines Manufacture GmbH". This circumstance would normally lead a company to stop using the old company name which, in fact, had ceased to exist as such, and start using

the new company name instead. In any event, as has already been mentioned, the applicant has not submitted any evidence of use of either the old or the new company name after 2004.

Conclusion

- (22) In the light of the above, it is concluded that the applicant has not proved that the company name “E C M Espresso Coffee Maschinen Vertriebs GmbH” was being used in the course of trade at the date of the invalidity request. Given that one of the necessary requirements of Article 8(4) CTMR in conjunction with Article 53(1)(c) CTMR has not been met, it is not necessary to examine the remaining requirements, and the application for invalidity must be rejected as unfounded.

COSTS

- (23) Pursuant to Article 85(1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The applicant, as the party losing the cancellation proceedings shall bear the costs of the CTM proprietor.
- (24) The amount of the costs to be paid by the applicant to the CTM proprietor pursuant to Article 85(6) CTMR in conjunction with Rule 94(3) CTMIR shall be: EUR 450, corresponding to representation costs.



THE CANCELLATION DIVISION

<hr/> Stephan Hanne	<hr/> José A. Garrido Otaola	<hr/> André Pohlmann
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Notice on the availability of an appeal:

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

Notice on the review of the fixation of costs:

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94(4) CTMIR such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2 point 30 of the Fees Regulation) has been paid.