



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

Opposition Division

OPPOSITION No B 2 116 229

Deus BVBA, Kattenberg 93, 2140 Antwerp, Belgium (opponent), represented by **Didier Deneuter**, Edmond Tollenaerestraat 56-76 bus 23, 1020 Brussel (Laken), Belgium (professional representative)

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Deus Ex Machina Motor Cycles Pty Ltd, 98-104 Parramatta Road, Camperdown NSW 2050, Australia (holder), represented by **Merkenbureau Heemskerk B.V.**, Keizersgracht 531, 1017 DP Amsterdam, The Netherlands (professional representative).

On 18/03/2015, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 116 229 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against some of the goods and services of international registration designating the European Union No 1 109 651 for the



figurative mark, namely against all the goods and services in Classes 9, 14, 16, 18, 25, 28 and 35. The opposition is based on Benelux trade mark registration No 614 956 for the word mark 'dEUS' and on non-registered trade name 'dEUS' used in the course of trade in all Member States of the European Union. The opponent invoked Article 8(1)(a) and (b), 8(4) and 8(5) CTMR.

SUBSTANTIATION of earlier Benelux trade mark registration No 614 956

According to Article 76(1) CTMR, in proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the opponent does not submit appropriate evidence.

According to Rule 19(1) CTMIR, the Office shall give the opposing party the opportunity to present the facts, evidence and arguments in support of its opposition or to complete any facts, evidence or arguments that have already been submitted together with the notice of opposition, within a time limit specified by the Office.

According to Rule 19(2) CTMIR, within the period referred to above, the opposing party shall also file proof of the existence, validity and scope of protection of his earlier mark or earlier right, as well as evidence proving his entitlement to file the opposition.

In particular, if the opposition is based on a registered trade mark which is not a Community trade mark, the opposing party must provide a copy of the relevant registration certificate and, as the case may be, of the latest renewal certificate, showing that the term of protection of the trade mark extends beyond the time limit referred to in paragraph 1 and any extension thereof, or equivalent documents emanating from the administration by which the trade mark was registered - Rule 19(2)(a)(ii) CTMIR.

According to Rule 19(3) CTMIR, the information and evidence referred to in paragraphs 1 and 2 *shall be in the language of the proceedings or accompanied by a translation* (emphasis added). The translation shall be submitted within the time limit specified for submitting the original document. In the present case, the time limit for the opponent to file facts, evidence and arguments substantiating its opposition expired on 17/11/2014.

The evidence filed by the opponent, concerning the substantiation of earlier Benelux trade mark registration No 614 956 is not in the language of the proceedings, namely English.

The evidence filed by the opponent consists of a registration certificate from the online database of the Benelux Trademark Office (BOIP), in Dutch. This document contains the handwritten translation of two of the information headings in English, namely 'filing date' and 'valid until'.

The opponent has also filed a document in the language of the proceedings containing information on the trade mark on which the opposition is based, namely the goods and services covered by this mark. However, this document and the two translated entries of the original registration certificate mentioned above do not meet the requirements set in Rule 98(1) CTMIR.

The Opposition Division notes that the document submitted by the opponent does not reproduce the structure and contents of the evidence to be translated, namely the registration certificate from the aforementioned online database.

In particular, as regards the translation of registration certificates and extracts from the official registries, the Opposition Division notes the following:

- the Office accepts that no translation of the information headers in the extracts/certificates (such as 'filing date', 'colour claim', etc.) is needed, provided that they are also identified using standard INID codes or national codes;
- irrelevant administrative indications with no bearing on the case may be omitted from the translation.

In the case at hand the extract in question also contains entries (such as '*Status Merk ingeschreven*', '*Publicatiedatum van de vernieuwing*', '*Publicatiedatum van de inschrijving*') that are not preceded by any codes and are not translated but might have a bearing on the case.

According to Rule 98(1) CTMIR, when a translation of a document is to be filed, the translation shall identify the document to which it refers and reproduce the structure and contents of the original document. Therefore, the principle is that the entire relevant documents must be translated into the language of the proceedings and that these translations must follow the structure of the original documents. The opponent failed to comply with this requirement.

According to Rule 19(4) CTMIR, the Office shall not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by the Office.

It follows that the evidence filed by the opponent cannot be taken into account.

According to Rule 20(1) CTMIR, if until expiry of the period referred to in Rule 19(1) CTMIR the opposing party has not proven the existence, validity and scope of protection of his earlier mark or earlier right, as well as his entitlement to file the opposition, the opposition shall be rejected as unfounded.

The opposition must therefore be rejected as unfounded, as far as it is based on this earlier mark and on Article 8(1)(a) and (b) and 8(5) CTMR.

Consequently, the examination continues in relation to the other ground invoked by the opponent, namely Article 8(4) CTMR.

NON-REGISTERED MARK OR ANOTHER SIGN USED IN THE COURSE OF TRADE – ARTICLE 8(4) CTMR

The opponent has invoked as a basis of the opposition the non-registered trade name 'dEUS' used in the course of trade in all Member States of the European Union, and in particular in Belgium, in relation to *entertainment in the broad sense (record industry, publishing industry, live entertainment, audio productions and audiovisual productions); merchandising and branding; clothing; endorsement and online retail.*

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.

Therefore, the grounds of refusal of Article 8(4) CTMR are 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 opponent acquired rights to the sign on which the opposition 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.

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

a) The right under the applicable law

According to Article 76(1) CTMR, in proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

According to Rule 19(2)(d) CTMR, if the opposition is based on an earlier right within the meaning of Article 8(4) CTMR, the opposing party shall provide evidence showing evidence of its acquisition, continued existence and scope of protection of that right.

According to case-law, it is up to the opponent '... to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application ... but also particulars establishing the content of that law' (judgment of 05/07/2011, C-263/09 P, 'Elio Fiorucci', paragraph 50). The evidence to be submitted must allow the Opposition Division to safely determine that a particular right is provided for under the law in question as well as the conditions for acquisition of that right. The evidence must further clarify whether the holder of the right is entitled to prohibit the use of a subsequent trade mark as well as the conditions under which the right may prevail and be enforced vis-à-vis a subsequent trade mark.

In the present case, the opponent invokes Article 8 of the Paris Convention: 'A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark'. The opponent has also quoted the Guidelines for Examination in the Office, Part C, Opposition, Section 4 (page 8), where it is stated that 'Trade names are protected as exclusive rights in all Member States'. Finally, the opponent has claimed that 'for example, in Belgium, trade names are protected in case of a concrete risk of confusion with regard to the sign invoked, based on Art. VI. 104 "Wetboek van Economisch Recht"'.

As regards Article 8 of the Paris Convention, it must be noted that, from the wording of this provision, no entitlement for the owner of a trade name to prohibit the use of a subsequent, conflicting sign can be derived. Furthermore, the broad wording of this provision enables the various national legislatures to set up a variety of protection systems laying down, inter alia, conditions relating to minimum use or minimum awareness of the trade name. Consequently, there is no uniform protection of trade names on the EU level.

Indeed, Article 8 of the Paris Convention does not define either the extent of or the conditions for the protection conferred on a trade name, but merely sets out the requirement to implement such protection. The lack of precision in the text itself

prevents the creation of rights which the opponent could rely on before EU judicature. Therefore, the opponent cannot rely solely on Article 8 of the Paris Convention in order to claim protection of his trade name (see judgments of 30/11/2006, T-43/05, 'Brothers by Camper', paragraph 84 and of 03/05/2012, T-270/10, 'Karra', paragraph 70).

A fortiori, the quotation of a sentence from the Guidelines for Examination in the Office is also manifestly insufficient to comply with the abovementioned requirements. Although trade names do enjoy protection in all Member States, the onus is on the opponent to submit all the information necessary for the decision, including identifying the applicable law and providing all the necessary information for its sound application.

In the present case, the opponent has claimed that trade names are protected in case of a concrete risk of confusion with regard to the sign invoked, according to the Belgian legislation (allegedly, Art. VI. 104 "Wetboek van Economisch Recht" has this content).

However, there is no reference to the actual content of the legal provision in question and its respective translation. Furthermore, there is no indication of any other legal provisions concerning the protection of trade names under Belgian law. There is no indication as to the conditions of acquisition of this right under Belgian law either. Moreover, the opponent did not indicate any other national law of any of the Member States of the EU. Therefore, the Opposition Division considers that the mention provided by the opponent in its observations is clearly insufficient to comply with the abovementioned requirements and substantiate a claim under Article 8(4) CTMR.

Consequently, the opponent did not submit sufficient information on the legal protection granted to the type of trade sign invoked under Article 8(4) CTMR, namely a non-registered trade name used in the course of trade in all Member States. The opponent did not submit any information on the possible content of the rights invoked or the conditions to be fulfilled for the opponent to be able to prohibit the use of the contested trade mark under the laws in Belgium or in any of the other Member States mentioned by the opponent. It is not sufficient to make a general reference to the national legislation in question or to its publication somewhere in the legal literature.

Therefore, the opposition is not well founded under Article 8(4) CTMR.

Summary

The opposition failed under all invoked grounds, namely Article 8(1)(a) and (b), 8(4) and 8(5) CTMR. Therefore, the opposition is rejected in its entirety.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the holder in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) CTMR, the costs to be paid to the holder are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Deirdre QUINN

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According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. 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 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to 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(30) CTMFR) has been paid.