

DECISION
of the Fifth Board of Appeal
of 21 January 2020

In case R 962/2019-5

Chiquita Brands L.L.C.

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Suite C-436
Fort Lauderdale FL 33004-2275
United States of America

Cancellation applicant / Appellant

represented by BIRD & BIRD LLP, Zuid-Hollandplein 22, 2596 AW, The Hague,
Netherlands

v

Fyffes International Unlimited Company

29, North Anne Street
Dublin 7
Ireland

EUTM proprietor / Defendant

represented by FRKELLY, 27 Clyde Road Ballsbridge, Dublin 4, Ireland

APPEAL relating to Cancellation Proceedings No 15 563 C (European Union trade
mark registration No 10 612 166)

THE FIFTH BOARD OF APPEAL

composed of A. Pohlmann (Acting Chairperson), V. Melgar (Rapporteur) and C.
Govers (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 2 February 2012, Fyffes International, subsequently Fyffes International Unlimited Company ('the EUTM proprietor') sought to register the figurative mark



for the following list of goods:

Class 31 - Pineapples; bananas; fresh fruit and vegetables.

The EUTM proprietor claimed the colours:

Yellow (Pantone 123) Blue (Pantone 280) , Black (Process).

- 2 The application was published on 22 March 2012 and the mark was registered on 29 June 2012.
- 3 On 22 August 2017, Chiquita Brands L.L.C. ('the cancellation applicant') filed a request for revocation of the registered mark for all the above goods.
- 4 The grounds of the request for revocation were those laid down in Article 58(1)(a) EUTMR.
- 5 By decision of 26 April 2019 ('the contested decision'), the Cancellation Division partially revoked the contested EUTM for namely:

Class 31: Fresh fruit except pineapples and bananas; fresh vegetables.


The EUTM remained registered for the following goods:

Class 31: Pineapples and bananas.


It gave, in particular, the following grounds for its decision:

- In the present case, the EUTM was registered on 29/06/2012. The revocation request was filed on 22/08/2017. Therefore, the EUTM has 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 22/08/2012 to 21/08/2017 inclusive, for the contested goods.
- On 2/02/2018 the EUTM proprietor submitted evidence as proof of use. The evidence consists of a statutory declaration issued by Ms. Ann Duffy, Director of Corporate Affairs within the Fyffes Group of Companies, dated 31/01/2018. It explains the company profile and includes annual turnover and sales figures of its products in respect of Ireland and the United Kingdom. Said declaration attaches the following documents:
 - Exhibit AD 1: a copy of the Certificate of Incorporation on Change of Name of Fyffes International to Fyffes International Unlimited Company dated 26/10/2016;
 - Exhibit AD 2: a document dated 23/01/2018 showing the schedule of the HOYA trade mark registrations in different countries within and outside the European Union since 1986;
 - Exhibit AD 3: non-dated pictures showing bananas and boxes containing




bananas. The sign  is displayed on the bananas and on the boxes containing the bananas;



- Exhibit AD 4: a non-dated document showing labels as follows  ;
- Exhibit AD 5: Thirty-nine invoices issued by Fyffes and addressed to Total Produce Ltd. in Ireland dated between 2009 and 2017. The product description shows Costa Rica Hoya; however the amounts in euros are blacked out. Some of the invoices dated within the relevant period show the goods 'bananas' next to the mark COSTA RICA HOYA;


- Exhibit AD 6: a letter issued from the European Marketing Director of Total Produce PLC dated 01/12/2016 confirming that, for the relevant goods, it is a customer of the proprietor selling HOYA bananas in the Republic of Ireland to a number of retailers;
- Exhibit AD 7: More than sixty invoices issued by BFS Bananas UK (one of the companies under the Fyffes Group of Companies) and addressed to different customers in the United Kingdom (Bristol, London, Cardiff, Cornwall) dated between 2009 and 2017. The product description shows Banana Colombia/Costa Rica Hoya; however the amount fields are empty or blacked out;
- Exhibit AD 8: a letter issued from the Director of Bristol Fruit Sales (Bananas) Limited dated 15/01/2018 confirming that it has been selling bananas and pineapples to retailers under the HOYA trademark;
- Exhibit AD 9: More than seventy invoices of which some of them are issued by Fyffes BV (one of the companies under the Fyffes Group of Companies) and addressed to different customers in Germany, the Benelux, the Czech Republic, the UK, France, Latvia, Lithuania, Poland and the Netherlands between 2012 and 2017. The product description shows Pineapples Costa Rica Hoya and Banane/Plantains Hoya Colombia; however some of the amounts in euros are blacked out. It also includes a breakdown of sales per country of HOYA bananas and plantains between 2011 and 2015;
- Exhibit AD 10: a statement issued by Wim Karsten on 26/11/2016, owner of the Karsten firm (one of the proprietor's customers). He states that he is one of the customers of bananas branded under the HOYA mark and that the Karsten firm sells those products to small supermarkets, shops and groceries within Amsterdam. It also includes three annexes: pictures of the products, sales history of Karsten BV (2016) and pictures showing boxes containing plantains ready to be




delivered to retailers and which bear the sign ;


- Exhibit AD 11: photographs showing how the products bearing the



sign  appear at points of sale of the retailer **LIDL**. The extracts are not dated and the points of sale seem to be located in the United Kingdom considering that the price of the products are shown in 'p' which refers to 'penny', the smallest unit of money in the UK;

- Exhibit AD 12: several quality control reports of pineapples dated 2017. It encloses pictures showing boxes containing pineapples, bearing the

sign  from Costa Rica dated in 2013 and 2014, and also from


Panama and Cape Town. A sample of the labels  and



are also enclosed.

– On 19 June 2018, the proprietor furnished additional evidence which consists of the following:

- Exhibit AD 13: A letter from Mr. Dirk Allerding and Mr. Jens Allerding from Fruchtimport Van Wylick GmbH in Germany dated 11/06/2018

attesting to their purchase of pineapples bearing the sign  on a regular basis since 2012 and their subsequent sale of said goods to the supermarket chain **Aldi**;

- Exhibit AD 14: a copy of a case file page (dated 21/03/2017) before The Hague District Court between the same parties as in the current cancellation proceedings containing photographs of bananas bearing the



- Exhibit AD 15: Twelve invoices issued between 2012 and 2017 which were already submitted in the first batch on 2/02/2018 showing the sale of pineapples to one client in Germany;
- Exhibit AD 16: Twenty one invoices issued by Fyffes BV (one of the companies under the Fyffes Group of Companies) and addressed to a customer in Germany between 2012 and 2017. The product description

shows Pineapples Costa Rica Hoya and the amounts in euros are blacked out.

- The proprietor states that the trade mark owner is the holding company owner within The Fyffes Group of Companies. This Group includes the Irish company Fyffes Limited, an Irish company Fyffes Tropical (Ireland) Limited, a U.K. company called Bristol Fruit Sales (Bananas) Limited and a Dutch company Fyffes BV (hereinafter individually and collectively called the EUTM proprietor's companies).
- The fact that the EUTM proprietor submitted evidence of use of its marks by a third party shows that it consented to this use (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225).
- To this extent, and in accordance with Article 18(2) EUTMR, the Cancellation Division considers that the use by those other companies within the same group was with the EUTM proprietor's consent and, therefore, is equivalent to use by the EUTM proprietor itself.
- On 19 June 2018, after the expiry of the original time limit, the proprietor submitted additional evidence. The issue of whether or not the Office may exercise the discretion conferred on it by Article 95(2) EUTMR to take it into account can remain open, as the evidence previously submitted within the time limit is sufficient to prove the required genuine use of the EUTM for some of the goods for which it is registered, and the additional evidence does not contain any reference to the remaining goods.
- As regards the attachments to the statutory declaration, they are independent pieces of evidence which back up the statements made in said declaration, and therefore, the Cancellation Division considered that they are valid evidence which must be duly considered.
- Although some documents are not dated (exhibits AD3, AD4 and AD11) or are dated outside of the relevant period (some invoices), it must be noted that the majority of the invoices (exhibits AD5, AD7 and AD9) and the quality controls of the pineapples (exhibit AD12), provide sufficient indications as to the use of the contested mark during the relevant time period, namely, from 22/08/2012 to 21/08/2017. The evidence filed by the EUTM proprietor contains sufficient indications concerning the time of use.
- The relevant invoices clearly indicate that the products were addressed to customers in Ireland, Germany, the Benelux, the Czech Republic, the UK, France, Latvia, Lithuania, Poland and the Netherlands (exhibits AD5, AD7 and AD9).
- From the evidence provided it can be seen that, not only did the proprietor import goods into the EU, but it also sold the goods to customers within a number of countries within the European Union (relevant invoices-exhibits AD5, AD7 and AD9, and declarations from customers).

- Therefore, the evidence relates to the relevant territory and is sufficient to show place of use of the contested trade mark.

- In the present case, the majority of the documents show that the signs



and 'HOYA COSTA RICA/COLOMBIA' are used in connection with certain goods to indicate the commercial origin and therefore they are used as trade marks. Consequently, the consumers can distinguish the goods from those of different manufacturers.

- In the present case, the mark is registered as the figurative sign



- The majority of the evidence, namely, the invoices (relevant invoice exhibits AD5, AD7 and AD9) and the pictures, as well as the screenshots show the following signs:



- 1) , 2) and 3) 'HOYA COSTA RICA/COLOMBIA'.

- The contested mark is a figurative mark which consists of an oval form with a black background and outlined with a yellow border. Inside it, there is a rhombus form depicted in yellow, inside of which the word 'HOYA' is represented in standard capital black letters. The word 'HOYA' does not have any particular meaning in relation to the relevant goods for which the EUTM is registered and is therefore, distinctive. The oval figurative element of the sign as registered appears to be a commonly shaped label that might be attached to the goods themselves and therefore, this element plays a secondary role within the overall impression of the sign. The rhombus shape is somewhat decorative and serves to frame the word element 'HOYA'; however, it is still somewhat original and also has a degree of distinctive character.

- In relation to the figurative signs 1) and 2) above, it cannot be denied that the relevant documents show that the signs contain a rhombus form in red, inside of which the term ‘HOYA’ is represented and in 1) also the additional word element ‘COSTA RICA’ at the bottom of the sign. The term ‘COSTA RICA’ is descriptive as to the origin of the goods in question. However, both signs contain the distinctive element ‘HOYA’ and the rhombus shape, albeit in a different colour. In relation to sign 3) above, it also contains the distinctive element ‘HOYA’ and the descriptive elements ‘COSTA RICA/COLOMBIA’ since they refer to the places where the goods are produced.
- As all of the signs as used contain the distinctive element ‘HOYA’, and indeed the two figurative signs even coincide in the rhombus shape, the Cancellation Division considers that the signs used constitute use of the contested sign as registered. In all of the signs the distinctive element ‘HOYA’ is clearly discerned and in signs 1) and 2) placed inside a rhombus and the differing elements between the figurative signs as used are confined to the colour of the background and the oval black form of the contested sign which are merely decorative elements.
- As far as the addition of the element ‘COSTA RICA’ is concerned, it plays a non-dominant role in its size and position and it is non-distinctive since it refers to the place where the goods come from. All those elements do not alter the distinctive character of the contested mark.
- In the present case, the pictures and the packaging of the products only show that the company sells certain goods. This set of evidence does not give any indication as regards the sales figures or commercial volume.
- The Cancellation Division notes that the proprietor has filed more than a hundred invoices to prove use of its mark. In fact, the criteria of the extent of use will not necessarily depend on the number of invoices but on the commercial volume of the overall use, as well as the length of the period during which the mark was used and the frequency of use.
- In the case at hand, the invoices enclosed describe the products (bananas, pineapples). Even though the amounts in euros or GBP were blacked out, some of the relevant invoices nevertheless contained the quantity of the products to customers throughout the relevant territory during the relevant period (2012 to 2017). The invoices do contain the contested mark next to the products in the description line (as a word mark).
- Although it cannot be denied that certain invoices are dated outside of the relevant period, the date of such invoices is in one or two months falling directly after the relevant period; therefore, they cannot be immediately disregarded since they provide indirect proof that the mark must have been put to genuine use during the relevant period and that this use carried on afterwards.
- Moreover, the applicant states that those figures are insufficient to establish proof of use since the European banana and pineapple market is rather

significant and submits evidence in support of its claim. On the other hand, the proprietor has admitted that there has been a commercial decision for sales under this particular trade mark to be modest in the context of both the trade mark owner's own market segment for bananas and the banana market as a whole. The proprietor points out that it should not be penalised for this commercial decision and a consequential low market share under its HOYA trade mark. Regard should be taken of the evidence as filed and not the positioning of the HOYA trade mark as a percentage of the banana, plantain and pineapple market as a whole.

- Although the amounts included in the invoices are not disclosed since they are blacked out, taking into account the type of goods, 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). Although the exact amount of sales volumes is not disclosed, it can be seen from the invoices that the use was long-term, frequent and regular; therefore, the applicant's argument is dismissed as unfounded.
- The Cancellation Division notes that the pictures from the supermarket **LIDL** in the United Kingdom (Exhibit AD11) showing the products at the point of sale of the end consumers and the declaration from one of the proprietor's customers (Exhibit AD10) stating that it sells the products to small supermarkets, shops and groceries within Amsterdam are sufficient evidence of sales to retailers. The applicant's argument is dismissed as unfounded.
- Bearing in mind the type of goods and that the relevant invoices are regular, frequent and long-term and supported by the remaining documents, the Cancellation Division considers that the evidence, taken as a whole, is therefore sufficient to prove the extent of use of the registered mark, and exceeds mere token use, at least in respect of some of the goods.
- Consequently, the Cancellation Division finds that the documents filed provide sufficient information concerning the commercial volume, the duration and the frequency of use at least for some of the contested goods.
- The evidence filed by the EUTM proprietor does not show genuine use of the trade mark for all the goods against which the application for revocation was directed.
- According to Article 58(2) EUTMR, where there are grounds for revocation in respect of 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.

- The evidence (invoices, pictures) shows use in relation to ‘pineapples; bananas’.
- The contested mark is registered for, inter alia, ‘fresh fruit’. In the present case, the evidence proves use only for bananas and pineapples, belonging to the following category in the specification: ‘fresh fruit’. Although the proprietor is not required to prove use of all the conceivable variations of the category of goods for which the mark is registered, use for only two types of products from the very broad category of ‘fresh fruits’ does not justify maintaining the registration for the mark for the entire broad category. Since the goods for which use has been proven do not constitute a coherent and objective subcategory of fresh fruit, the Cancellation Division finds that the use was only in relation to two individual types of products ‘bananas and pineapples’.
- However, the Cancellation Division considers that the evidence does not prove use for the remaining goods included in the category of ‘fresh fruits’.
- As regards the remaining contested goods ‘fresh vegetables’, the evidence provided does not show use of the mark for those goods.
- In conclusion, in the present case, the evidence provided shows genuine use of the trade mark only for the following goods:

Class 31: Pineapples and bananas.

- 6 On 2 May 2019, the revocation applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 26 August 2019.
- 7 In its response received on 8 November 2019, the EUTM proprietor requested that the appeal be dismissed.

Submissions and arguments of the parties

- 8 The arguments raised in the statement of grounds by the cancellation applicant may be summarised as follows:

Violation of the right to be heard

- Fyffes submitted additional evidence and arguments after the expiry of the original time limit. The Cancellation Division correctly questioned whether this evidence should be taken into account. Ultimately, the Cancellation Division left this questioned undecided, because it was - incorrectly – of the opinion that the original evidence was sufficient to prove genuine use.
- With its first submission of 2 February 2018, Fyffes did not submit any argumentation in support of the genuine use of the contested trade mark. The respondent merely submitted a statutory declaration by its Director of

Corporate Affairs, which together with several annexes was intended to constitute evidence of use. Only with its additional submission of 19 June 2018 did Fyffes submit any argumentation, this despite the fact that Fyffes had ample opportunity to not only put forth its own arguments, but even to anticipate Chiquita's arguments, due to the ongoing opposition proceedings during which the issue of proof of use had already been raised, and the ongoing Dutch proceedings between the parties wherein proof of use was also extensively discussed. Nonetheless, Fyffes kept all its arguments silent until its additional submission on 19 June 2018 (hereinafter: the 'Additional Submission'). Several of the arguments belatedly put forward by Fyffes were used by the Cancellation Division as vital grounds on which the contested decision was based, but crucially, Chiquita was not granted any opportunity to respond to these arguments. In doing so, the Cancellation Division violated Article 94(1) EUTMR, which sets out that decisions of the Office shall only be based on reasons or evidence on which the parties concerned have had an opportunity to present their comments. The Cancellation Division has furthermore violated Article 64(1) EUTMR, according to which the Office shall invite the parties, as often as necessary, to file observations on communications from the other parties or the Office itself.

- An example of the submissions on which Chiquita was not allowed to comment is Fyffes' argument - which was raised for the first time in its Additional Submission - that the minimal sales under the contested trade mark would allegedly be the result of a conscious commercial decision to seek only a modest market share. The Cancellation Division accepted this argument on page 12 of the contested decision as a vital reason for concluding that the extent of use of the contested trade mark exceeds mere token use.
- The revocation applicant claims that had it been given the opportunity to comment on this point, then it would certainly have influenced the Cancellation Division's decision.
- Another crucial point that Fyffes first discussed in its Additional Submission is the question of use of the contested trade mark in a different form to how the mark has been registered. With its initial submission of 2 February 2018, Fyffes submitted evidence that related almost in its entirety to a completely different device mark, i.e. the EU device mark with registration number 3 972 775; (hereinafter: the 'Red Fyffes Logo', see Exhibit 2 Chiquita):



- The Statutory Declaration submitted by Fyffes did not acknowledge in any way that the accompanying annexes showed a different logo than the contested trade mark and in fact, the entire declaration completely ignored the fact that almost all the evidence had already been submitted in the opposition proceedings as proof of use for the Red Fyffes Logo and the Benelux word

mark 'HOYA' with registration number 41 812 (hereinafter: the 'HOYA Word Mark', Exhibit 19). Certainly, no argument was made that use of the Red Fyffes Logo should be considered use of the contested trade mark.

- Fyffes' Additional Submission however, extensively discusses why it would be entitled to rely on use of the Red Fyffes Logo as a form of the contested trade mark, differing in elements which do not alter the distinctive character of the mark as compared to the form in which it was registered. This argument was accepted by the Cancellation Division on pages 10 and 11 of the contested decision, despite not having allowed the revocation applicant to comment on Fyffes' arguments. The Cancellation Division was furthermore incorrect to accept use of the Red Fyffes Logo and the 'HOYA Word Mark' as use of the contested trade mark in a different form.
- In basing its decision, amongst others, on the abovementioned reasons, the Cancellation Division thus violated Article 94(1) and Article 64(1) EUTMR. This presents a separate ground for the Board of Appeal to annul the contested decision.

No use of the trade mark as registered

- On page 11 of the contested decision, the Cancellation Division incorrectly held that use of the following signs could be seen as use of the contested trade mark in a form that does not alter the distinctive character of the mark as registered in the sense of Article 18 EUTMR:



- These signs (hereinafter respectively: 'Sign 1', 'Sign 2' and 'Sign 3' and collectively the 'Signs') essentially consist of two of Fyffes' other registered trademarks, namely the Red Fyffes Logo and the 'HOYA Word Mark'. Use of these marks cannot validly constitute use of the contested trade mark in a different form as under Article 18 EUTMR.

Purpose of Article 18 EUTMR

- Article 18 EUTMR permits the trademark proprietor to update its logo to changing market conditions, while still allowing the use of the updated logo to contribute to the genuine use of the registered older device mark, provided that the updated logo does not alter the distinctive character of the mark as registered. This thus prevents the trademark proprietor from having to file

every negligible change it makes to its registered logo as a separate trademark registration in order to maintain trademark protection.

- However, this is not the situation in the present case. In fact, this case is concerned with the opposite situation. Fyffes is not attempting to prove genuine use of its older registered device mark by showing examples of its newer logo as used in practice.
- Rather, Fyffes has submitted examples of use of the old Red Fyffes Logo in an attempt to prove genuine use of the newer contested trade mark. Yet that is not the situation that Article 18 EUTMR was intended to cover.
- As the CJEU explained in ‘Rintisch’, the framework of Article 18 EUTMR ‘makes it possible, where necessary, to anticipate changes that may occur in the trade mark’s image and thus to adapt it to the realities of a changing market’.
- This indicates that Article 18 EUTMR is only intended to cover situations where the use in practice of a newer (registered) trademark is employed to show genuine use of an older registered trademark. The provision is not intended to simply allow trademark proprietors to register a wide variety of trademarks and maintain protection for all of these on the basis of the genuine use of only one trademark.
- As the CJEU set out in ‘Bainbridge’, ‘it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former’. Similarly, in ‘Menelous’, the General Court held that Article 18 EUTMR ‘does not allow the proprietor of a registered trade mark to avoid his obligation to use that mark by relying to his advantage on the use of a similar mark covered by a separate registration’.
- It is for this reason that Fyffes cannot benefit from examples of use of the Red Fyffes Logo and the ‘HOYA’ word mark in order to prove genuine use of the contested trade mark. Both the Red Fyffes Logo and the ‘HOYA’ word mark are many years older than the contested trade mark. Perhaps Fyffes did intend to switch to the contested trade mark when it was registered, but in practice this switch never took place. In those circumstances, Fyffes cannot be allowed to refer to any supposed use of the Red Fyffes Logo and the ‘HOYA’ word mark in an attempt to prove use of a younger registered device mark that was never put to genuine use.

Assessment of Article 18 EUTMR

- Even if the Board of Appeal would conclude that Article 18 EUTMR also applies to situations where use of an older registered trademark is employed to prove genuine use of a younger registered trademark, then it must be concluded that the conditions of Article 18 EUTMR have not been fulfilled in

the present case. The signs mentioned above - and the Red Fyffes logo and 'HOYA Word Mark' - do not qualify as a form differing in elements which do not alter the distinctive character of the contested trade mark as compared to the form in which it was registered.

- The assessment of Article 18 EUTMR requires a two-step approach, whereby firstly the distinctive character and the visually dominant elements of the registered trademark are assessed. Secondly, the differences between the trademark as registered and the form as used must be established, as well as the effect thereof on the distinctive character of the mark.

Step 1

- In the present case, the Cancellation Division's assessment already runs into error at the first step. In its assessment on page 11 of the contested decision, the Cancellation Division completely ignores that according to standard case-law, distinctive character must be established firstly by reference to the goods and services for which a sign has been registered, and secondly by reference to the perception of the public.
- It must be noted that the public generally perceives a trademark as a whole and does not proceed to analyse its various details. The contested trade mark was registered for 'Pineapples; bananas; fresh fruit and vegetables' and was maintained by the Cancellation Division for 'Pineapples; bananas'.
- These goods are all everyday consumer products that are most commonly purchased in supermarkets or establishments where goods are arranged on shelves and the consumer picks up the goods himself/ herself. According to the CJEU, the consumer will in such a case be guided more by the visual impact of the mark he or she is looking for. The figurative elements of the mark at issue, including the trademark's colour, which is a particularly quick indicator for shoppers in a rush, will thus be of greater importance.
- Standard case-law furthermore holds that the distinctive and dominant character of elements within a trademark must be assessed on the basis of the intrinsic qualities of each of those elements, as well as the relative position of the various elements within the arrangement of the mark.
- The Cancellation Division's conclusion that the small lettering spelling out the word 'HOYA' would be the distinctive element of the contested trademark is in direct contradiction of the abovementioned standard case law. Looking at its overall impression, the visual impression of the contested trade mark is dominated by the large black oval shape with yellow border, which makes up about 80% of the entire trademark as registered. The colours of the contested trade mark have furthermore been explicitly claimed in the registration as 'Yellow (Pantone 123), Blue (Pantone 280), Black (Process)' (Exhibit 1 Chiquita). Within the large black oval, a smaller yellow rhombus is placed. The rhombus indeed contains the word 'HOYA', but compared to the

remainder of the contested trade mark, this cannot be said to be visually dominant.

- Given that the contested trademark is registered for everyday products that the consumer picks up himself/ herself in the supermarket, it also cannot be maintained in the present case that a word element would in general be more distinctive, as Fyffes alleged in its Additional Submission.
- The Cancellation Division dismisses the dominant, black, oval shape by stating that this ‘appears to be a commonly shaped label that might be attached to the goods themselves and therefore, this element plays a secondary role within the overall impression of the sign’.
- It is unclear why one possible application of a trademark should affect the distinctive character per se of a trademark as registered. All the more so since it must be presumed that the Cancellation Division is referring to labelling on ‘bananas’, but Fyffes has not submitted a single picture of a banana to which the contested trade mark was attached.
- Therefore, the Cancellation Division cannot know how the contested trade mark would be attached to a banana and has no reason to take this into account. Even if it did take into account the use of a label on a banana, then the Cancellation Division should at least take into account that when affixing the contested trade mark to a banana by way of a small label, then the text ‘HOYA’ inside the yellow rhombus – inside the large black oval shape - would be so small that it would barely be legible for the average consumer, especially for a supermarket shopper who will pick up everyday products without paying them much attention.
- In dismissing the relevance of the black oval shape, the Cancellation Division furthermore entirely failed to consider pineapples, to which no label can be attached due to the scaly exterior of the fruit and there is no reason for a label on a string around the neck of a pineapple to be any particular shape.
- Contrary to the black oval shape, the Cancellation Division does attribute a degree of distinctive character to the rhombus shape, but does not give any reasons why this should be intrinsically different from the black oval. In fact, the two shapes interact in the contested trade mark to create a distinctive overall impression. The Cancellation Division has failed to take into account this interplay between the yellow rhombus and the black oval shape surrounding it, as well as the connection between the yellow rhombus and the yellow border of the black oval. Moreover, the Cancellation Division does not discuss the impact of the colours of the contested trade mark on its distinctive character at all.
- In brief, the contested trade mark as registered is domineered by the large black oval shape with yellow border that makes up the largest part of the sign. The yellow rhombus within and the small lettering ‘HOYA’ therein also play a role in the overall impression and distinctive character of the sign, but the contested trade mark cannot be reduced to only these elements. It certainly

cannot be said that ‘HOYA’ is the only distinctive element of the contested trademark as registered. As already set out above, it is the visual impression of a mark as a whole that should be given the greatest importance where it concerns an everyday product that the consumers will pick off supermarket shelves themselves.

Step 2

- The Cancellation Division's assessment is also flawed in relation to step two: the assessment of the differences and their effect on the distinctive character of the registered trade mark.
- As provided by the General Court and confirmed by the CJEU in ‘Bainbridge’, Article 18 EUTMR applies ‘where the sign used in trade differs from the form in which it was registered only in negligible elements’. Any alteration which is more than negligible must thus be held to alter the distinctive character of the trade mark as registered. When the contested trade mark is compared with the examples of use that Fyffes provided, it is clear that the differences are far from negligible. The dominant black oval and yellow border are entirely missing. Also the striking yellow rhombus cannot be found in any of the Signs. Rather, in Signs 1 and 2, an eye-catching red colour jumps out at the consumer. Sign 3 has no figurative elements at all, but does contain additional text, which creates a very distinct visual impression.
- The Cancellation Division nonetheless concluded that Signs 1, 2 and 3 all constitute use of the contested trade mark as registered, because they contain the distinctive element ‘HOYA’. This conclusion is incorrect for multiple reasons.
- Firstly, as set out above, it cannot be maintained that ‘HOYA’ is the only distinctive element in the contested trade mark. Already for that reason, the mere fact that ‘HOYA’ is included in the Signs is insufficient for Article 18 EUTMR to apply.
- Secondly, even if ‘HOYA’ was the only distinctive and dominant element in the contested trade mark, it cannot be maintained that the prominent figurative elements and the striking colours of the contested trade mark are negligible. As set out above, according to case-law, an alteration must be negligible in order not to alter the distinctive character of a mark as registered. As the General Court ruled in cases such as ‘Arthur’ and ‘Vila Vita’, even if the figurative elements of a mark are considered secondary in comparison to the distinctive word element, the alteration of these figurative elements can only be said not to alter the distinctive character of the mark as registered if the figurative elements are entirely negligible. When looking at the contested trade mark, this is clearly not the case.
- Thirdly, the Cancellation Division gave an incorrect account of the differences between the contested trade mark and the Signs. With regard to the figurative signs (Signs 2 and 3 above), the Cancellation Division considered that ‘the

differing elements between the figurative signs as used are confined to the colour of the background and the oval black form of the contested sign which are merely decorative elements.’ This is incorrect.

- Not only are the signs placed on a differently coloured background and is the large black and yellow encircled oval entirely missing from Signs 1 and 2, also the striking yellow colour of the rhombus and thereby the black and- yellow colour composition of the contested trade mark are absent from Signs 1 and 2. As mentioned above, both black and yellow have been explicitly claimed in the registration of the contested trade mark. Also the registration of the Red Fyffes Logo, which is represented by Signs 1 and 2, explicitly claims ‘Colour Red, blue, white’ (Chiquita's Exhibit 2).
- Furthermore it can not be maintained that the colours used in Signs 1 and 2 are broadly equivalent to that of the contested trade mark. In fact, the colours and contrasts used in the contested trade mark and Signs 1 and 2 are the complete opposite. In the contested trade mark, the letters ‘HOYA’ are depicted in black against a light and striking yellow rhombus, surrounded by a prominent black oval with a yellow border.
- On the other hand, in Signs 1 and 2 - and the Red Fyffes logo - the exact opposite contrast is used: the letters ‘HOYA’ are included in white against a darker, red background, which is not surrounded by a large black oval, but simply placed on a light background. Neither the colours nor the contrast of the registration have thus been adhered to.
- When buying the goods for which the contested trade mark is registered, the average consumer will be looking for a label with a certain colour in order to quickly identify the goods. For supermarket goods it is the overall visual impression that primarily guides the perception of the average consumer and not so much the word elements of a combined mark. It is therefore clear that the overall impression of the contested trade mark will not be recognized by the average consumer in the labels included as Signs 1, 2 and 3.
- Finally, with regard to Sign 3 - incorporating the ‘HOYA’ word mark - the Cancellation Division merely stated that it includes the distinctive element ‘HOYA’, but gave no further reasoning why the absence of all figurative elements would not alter the distinctive character of the contested trade mark. This assessment therefore contravenes Article 94 EUTMR due to a lack of motivation. Similarly, on page 12 of the contested decision, it is noted that the ‘invoices do contain the contested mark next to the products in the description line (as a wordmark)’. This cannot be accepted.
- The Cancellation Division's assessment contradicts the case-law of the General Court, which dictates that the mere use of a word alone cannot constitute use of a combined word/device mark. After all, the contested trade mark was not registered as a simple word mark, but as a device mark with specific figurative elements and an explicit colour claim. It must be noted that for instance in the cases of ‘Arthur’ and ‘Art's Cafè’, the device marks in

question consisted of little more than a stylisation of the word itself with no additional figurative elements.

- Even so, the General Court held that the mere use of those words in a different font was insufficient to constitute genuine use of the mark as registered. A fortiori, use of Sign 3 - or the 'HOYA' word mark - cannot constitute use of the contested trade mark in a form that is acceptable under Article 18 EUTMR.
- The contested decision is moreover also internally contradictory. In its assessment of the distinctive character of the contested trade mark, the Cancellation Division itself admitted that the rhombus shape in the contested trade mark has a degree of distinctive character. Nonetheless, in the next paragraph the Cancellation Division concluded that the distinctive character of the contested trade mark would not be altered when the sign 'HOYA COSTA RICA/COLOMBIA' is used, despite the fact that this sign omits all figurative elements including the clear yellow rhombus, which by the Cancellation Division's own admission is distinctive. This reasoning cannot hold up.

Conclusion: Lack of use of the trade mark as registered

- Considering the above, all evidence containing Signs 1, 2, and 3 above - or the Red Fyffes Logo or 'HOYA' word mark - must be disregarded, because it does not represent use of the contested trade mark as registered or in a form that is acceptable under Article 18 EUTMR.
- Only Fyffes' exhibits AD 12 and AD 13 actually show the contested trade mark. Exhibit AD 13 must be disregarded, because it was submitted outside the time-limit set for Fyffes to submit its proof of use, in violation of Chiquita's right to be heard. AD 12 cannot be taken into account either, because it dates from the last three months before the request for revocation was submitted. Furthermore, it is uncertain and indeed even unlikely that the pineapples photographed in the Quality Reports in AD 12 were actually brought onto the market in the EU.
- For the sake of completeness, it is noted that no evidence at all has been submitted of the contested trade mark being actually applied to or used in relation to a banana. In fact, in its Additional Submission, Fyffes admitted that it did not use the contested trade mark as registered in relation to bananas.

Evidence showing genuine use

- Undated evidence and evidence falling outside the relevant period, evidence showing entirely different trade marks, pictures of a banana bearing the Red Fyffes Logo taken on one single day in one supermarket in the United Kingdom, and a few invoices which provide no clear information whether, a trademark was used on the actual products and if so which trademark and where these products were put onto the market, is entirely insufficient to

solidly and fulfil the cumulative conditions for proof of use, i.e. place, time, extent and nature of use.

This also shows that the Cancellation Division was incorrect to take into account the statement by Ms Ann Duffy as it is not supported by independent pieces of evidence that solidly back up the statements made in the declaration, aside from the incorrectness of the statement, as already pointed out.

No use within the relevant period

- As highlighted above, the only photograph of a product that actually bears the contested trade mark - and not one of the other signs which do not qualify as genuine use under Article 18 EUTMR - is contained in AD12. No other photographs of the contested trade mark have been submitted.
- These photos date solely from the last three months before the submission of the request for revocation and should therefore be disregarded on the basis of Article 58(1)(a) EUTMR. If the evidence submitted by Fyffes is capable of showing any use in the EU at all, then this does not qualify as more than token use.
- AD12 therefore cannot be taken into account in these proceedings. In any case, as set out above, it is unlikely that the ‘pineapples’ shown in this exhibit have ever been brought onto the market in the EU and even if so, such use in only one single shipment a few weeks before the request for revocation would be insufficient to constitute genuine use.

No use within the European Union

- The photographs in AD3, certain invoices in AD9 and the Quality Reports in AD12 do not actually prove that any products bearing the contested trade mark were brought onto the market in the EU. This is because the photographs in AD3 have allegedly been taken in the ports of Portsmouth, Cork, Antwerp, Rotterdam and Hamburg and the photographs in AD12 were taken in the port of Rotterdam, but this does not prove that these goods were also brought onto the market in the EU and were more than mere transit goods. Similarly, certain invoices in AD9 indicate a ‘T’ for ‘transit’. On this basis, it is argued that these photographs and invoices must be disregarded.
- The Cancellation Division did not provide any further consideration of the circumstances of the present case to justify taking mere import to be sufficient. It may possibly be accepted that the use of a business name upon the importation of goods from another state could constitute use of that business name in the country of importation. Nonetheless, that does not mean that mention of a word mark - which is not the contested trade mark itself - on an invoice would constitute genuine use if it has not been proven that those goods have actually been brought onto the market in the EU under the contested trade mark. After all, genuine use requires use of the trade mark for

goods in an attempt to create a market share for those goods in the European Union.

- The simple importation into the EU does not constitute use of a trademark with a view to creating an outlet for those goods in the EU if the products would then be exported again (see General Court 9 December 2015, T-354/14 ZUMEX vs JUMEX, para 62). Fyffes has not proven that the goods shown in the pictures of AD3 and AD12 or on the invoices marked 'T' for 'transit' in AD9 have actually been put on the EU market instead of continuing their way to destinations elsewhere and has even admitted in its additional observations that this may not be the case. Therefore, these exhibits should be disregarded.

Extent of use does not amount to genuine use

- In its discussion of the extent of use, the Cancellation Division dismissed each of the appellant's arguments one by one, but failed to look at the bigger picture and the evidence as a whole. Doing so clearly points to Fyffes' token use in an attempt to artificially maintain the protection for the contested trade mark. According to standard case-law such symbolic or token use does not constitute genuine use.
- While it is true that the CJEU previously ruled that a *de minimis* rule cannot be established for genuine use, this does not mean that any minimal use of a trademark will by definition suffice, as the Cancellation Division seems to have concluded. Minimal use can only be sufficient where it is justified by all other circumstances of the case at hand.
- Europe is the largest consumer of bananas worldwide. Every year between 5 and 6 billion kilos of bananas are consumed within the European Union. Fyffes is the market leader on the European banana market and sells truly gigantic amounts of bananas. For instance in 2013, Fyffes sold between 33 and 50 million kilos of bananas in the Netherlands, between 39 and 45 million kilos in Ireland and no less than 266 to 355 million kilos of bananas in the United Kingdom. The minimal use of the contested trade mark is thus entirely out of touch with the massive size of the European banana market. The above also shows that neither Fyffes' volume of business nor its production or marketing capacity offer any justification for the extremely low use of the contested trade mark. Fyffes simply does not use this capacity to find an outlet for the contested trade mark.
- In any case, it may be questioned whether such minimal use of a trademark - even if one would incorrectly accept the vague evidence submitted by Fyffes as being conclusive - constitutes genuine use in the sense of the EUTMR. As the CJEU held in *Ansul vs Ajax*, genuine use requires a real commercial exploitation that is aimed at maintaining or obtaining a market share for the goods in the European Union. Merely pushing an occasional batch of products under the relevant trademark together with other orders, without actively seeking to obtain a market share under this trademark, is not aimed at real commercial exploitation and therefore cannot constitute genuine use.

- Moreover, even in its best year of 2015 according to Fyffes' own alleged sales, the 'HOYA' brand barely made up for 0.1% of the European banana market. It may also be questioned whether this even qualifies as a 'market share' in the sense of the CJEU's *Ansul vs Ajax* judgment. It is clear that if Fyffes, as a market leader, had any intention of achieving anything more than token sales under the 'HOYA' brand, it would have long ago obtained a normal market share.
- The Cancellation Division thus accepted genuine use on the basis of an argument that is not supported by any facts and does not match the circumstances of the case at hand. On this basis, the Cancellation Division pieced together a supposed picture of genuine use.
- However, direct proof and a proper chain of evidence are missing. The Cancellation Division thereby violated the standard case-law that genuine use cannot be accepted on the basis of probabilities or suppositions.
- Certainly in that light, the Cancellation Division could not have accepted that the invoices noting the mere word mark 'HOYA' would be proof of the relevant goods having been brought onto the market under the contested trade mark in the EU. Nor could the Cancellation Division have taken into account invoices outside the relevant period. Invoices outside the relevant period provide no indication of whether any genuine use took place within that period, certainly given the limited number of invoices submitted for the various territories and products that fall within the relevant period and the fact that Fyffes was already aware of the fact that Chiquita could file a request for revocation well before the expiration of the relevant period.
- The Cancellation Division was furthermore incorrect to deduce from these invoices that the use of the contested mark would have been long-term, frequent and regular, despite the fact that by its own admission the amount of sales volumes had not been disclosed or in any case corroborated by any independent evidence. This is furthermore factually incorrect, since it can be deduced even from the invoices that any use of the contested trade mark - even if it would be accepted on the basis of mere invoices - was only occasional. In relation to Belgium, the Czech Republic, Latvia, Lithuania, Poland, the UK and France, Fyffes has for instance submitted only one or at most three invoices. Further, in relation to the invoices in AD 9 to Fruchtimport van Wylick GmbH, it may be remarked that the nine invoices falling within the relevant period all relate to the same period at the start of the year; a clear indication that this concerns nothing more than token use intended to artificially maintain trade mark protection.
- Finally, the Cancellation Division was also incorrect to accept proof of use in relation to retailers; no real proof thereof has been provided. The contested decision refers to only two items of evidence in this respect. Firstly, pictures from the supermarket Lidl, which are undated yet all taken on one single day, and in which regard no further evidence has been provided that could link the

offer of these bananas at Lidl to any sales within the relevant period. This can hardly be sufficient to constitute genuine - and not just token use.

- Secondly, the Cancellation Division referred to the declaration by Mr Karsten in support of use of the contested trade mark by retailers. By his own admission, Mr Karsten only sells ‘plantains’ under the mark ‘HOYA’. ‘Plantains’ are entirely different goods to ‘bananas’, and any alleged use of the contested trade mark for ‘plantains’ cannot contribute to proof of use for ‘bananas’.
- Moreover, in support of his declaration Mr Karsten provided a few undated pictures of markets and shops in which he allegedly sells ‘plantains’ under the trade mark HOYA. In the framework of the Dutch proceedings on the merits, Chiquita checked up on each of the locations shown in the photographs: the small shops Kumasi Market and Ummah Supermarkt in Amsterdam and the Ganzenhoef market in Amsterdam.
- Photographs of all bananas and plantains found at these locations are submitted as Exhibits 20-22, as previously submitted in the Dutch proceedings on the merits. As may be seen, Kumasi Market is permanently closed and neither Ummah Supermarkt nor the Ganzenhoef market in Amsterdam sells any bananas or plantains under the mark ‘HOYA’. While the revocation applicant admits this evidence does not relate to the relevant period, it does show how minimal Fyffes' proof of use really is. At most, plantains with the Red Fyffes Logo have been offered for sale at three locations in one city in the EU on one single occasion. Fyffes has not proven more than that, despite the fact that it bears the burden of proof. This cannot suffice to prove genuine use.
- It must be remarked that in any case, even if the abovementioned two items of evidence were accepted, this relates only to one unnamed location in the United Kingdom and three locations in one single city in the Netherlands. This cannot be sufficient to support genuine use in the European Union in relation to ‘plantains’, let alone ‘bananas’ or ‘pineapples’.

No use in relation to the registered goods

- ‘Bananas and pineapples’ are distinct types of products; Fyffes has not shown genuine use of the contested trade mark in relation to ‘fresh fruit’ in general. Nonetheless, it must be pointed out that in the remainder of the decision the Cancellation Division did not sufficiently keep the distinction between these products in mind.
- Firstly, it must be pointed out that not a single piece of evidence has been submitted that shows the contested trade mark (as registered) actually used on or in connection to a banana. Fyffes has only submitted pictures showing the Red Fyffes Logo applied to a box or bunch of bananas and has admitted that the invoices relating to ‘bananas and plantains’ do not concern the contested trade mark as registered.

- Secondly, a large part of the evidence that the Cancellation Division took into account for ‘bananas’ actually relates to ‘plantains’. This is an entirely different product from ‘bananas’; ‘plantains’ are not easily digestible when raw and require cooking.
- It is important to emphasize that ‘plantains’ have an entirely different public. ‘Bananas’ are a mass consumption product, while ‘plantains’ are only sold to consumers who know how to prepare this special fruit. In terms of trademark law, ‘plantains’ and ‘bananas’ are thus different goods and any alleged use of the contested trade mark for ‘plantains’ cannot be taken into account for ‘bananas’.
- The Cancellation Division ignored that part of the invoices in AD 9 and the photographs in AD 11 all relate to ‘plantains’ and not ‘bananas’. The majority of the invoices in AD 5 does not even specify which products it concerns; the invoices merely state ‘COSTA RICA HOYA’ or ‘Hoya Standard’, but not whether this relates to ‘bananas, plantains, pineapples’ or any other unspecified product from Costa Rica.
- Furthermore, the declaration by Mr Karsten in AD 10, and the corresponding evidence in that exhibit, as well as in AD 9 and AD 11, entirely relates to ‘plantains’, as explicitly noted in his declaration. Importantly it is this evidence which - apart from undated pictures from Lidl that were all taken on the same day - is the exclusive basis for the Cancellation Division to conclude that sales to retailers have taken place. However, this evidence can neither relate to ‘bananas’ nor to ‘pineapples’.
- Finally, on page 14 of the contested decision, the Cancellation Division accepts use for pineapples. However, most of its preceding considerations do not apply to pineapples at all.
- For instance, the invoices in AD 9 only contain nine invoices within the relevant period that relate to ‘pineapples’. The Cancellation Division's consideration on page 12 of the contested decision that Fyffes had submitted over a hundred invoices therefore does not apply to ‘pineapples’. It can furthermore not be accepted that nine invoices - every time relating to the same period at the start of the year - would prove any long-term, frequent and regular use of the contested trade mark for ‘pineapples’, as the Cancellation Division concludes on that same page of the contested decision.
- The ‘pineapples’ were moreover sold to only one single customer in Germany. Also the Cancellation Division's general remark that the products were sold in various countries around Europe is therefore incorrect in relation to ‘pineapples’. Furthermore, the vital argument that the modest sales under the contested trade mark would have been a conscious decision has not even been put forward by Fyffes in relation to pineapples’.
- Finally, on page 13 of the contested decision, use in relation to retailers was accepted, but not a single piece of evidence thereof has been provided with regard to ‘pineapples’.

- The Cancellation Division therefore could not have accepted genuine use of the contested trade mark for ‘pineapples’. This is essential, given that the only photographs that Fyffes submitted of the actual contested trade mark as registered relate to only ‘pineapples’.

Conclusion

- Considering the above, the contested decision violated Chiquita's right to be heard and furthermore incorrectly accepted genuine use of the contested trade mark. The appellant therefore requests the EUIPO Board of Appeal to annul the contested decision in so far as the contested trade mark remained registered for ‘pineapples and bananas’, to grant the application for revocation in full and to order the respondent to pay the costs of these proceedings.
- 9 The arguments raised in reply to the appeal by the EUTM proprietor may be summarised as follows:

- On the violation of the right to be heard the EUTM proprietor submits that its submissions were a response to the criticism by the revocation applicant in relation to the evidence submitted. It is not new evidence. The trade mark owner in its submissions (which were not belated submissions) is fully entitled to explain to the Cancellation Division, the correct criteria to be used in the context of evidence already filed. These have been categorised by the revocation applicant as being ‘additional submissions’ but they were certainly not out of time submissions and were in direct response to the revocation applicant’s own submissions. The only evidence which was not supplied within the original time frame was not significant and was introduced to simply supplement and corroborate the evidence which had already been submitted. Such supplemental evidence was deemed appropriate to counteract the revocation applicant’s criticisms and to illustrate that although the trade mark owner had already produced significant evidence, more evidence was indeed available to supplement and corroborate the existing evidence.

On the non-use of the trade mark as registered and Article 18 EUTMR

- The EUTM proprietor submits that the trade mark owner did in fact produce evidence of use of the trade mark registration in the context of ‘pineapples’. The further use (relates to ‘bananas including plantains’) was against ‘essentially the same’ trade mark being the word ‘HOYA’ within a red rhombus with a blue surround (hereinafter referred to as the red/blue ‘HOYA’ label).
- The revocation applicant has chosen to describe this trade mark as the Red Fyffes Logo. This is a somewhat crude and deliberate attempt to distract from the fact that its trade mark is substantially the word ‘HOYA’ and has absolutely nothing to do with the Trade Mark FYFFES. The revocation applicant did, of course, have an impossible task establishing a way of describing this trade mark without reference to the word ‘HOYA’ (hence it chose a different trade mark FYFFES) because the word ‘HOYA’ is the

dominant feature. The EUTM proprietor refers to it as the ‘red/blue HOYA label’.

- The trade mark as depicted in EUTM No 10 612 166 (yellow/black HOYA Label) was not a replacement for the red/blue HOYA label trade mark. It is to be treated as a sister trade mark. The two trade marks sit side by side. The red/blue ‘HOYA’ label is primarily for ‘bananas including plantains’ and the yellow/black ‘HOYA’ label initially for ‘pineapples’ is planned for use in relation to other fruits including bananas. This is a commercial decision ‘adapting to the realities of a changing market’ (RINTISCH – para 22).
- It is, of course, long established case-law that persons pay more attention to words than they do to colours. Colours and colour combinations usually (but not always) are notoriously difficult to register because they are viewed as being non-distinctive. Nearly all labels have background and/or surrounding colours (they could very well constitute 80% or indeed more of the actual surface area of the trade mark) but this is irrelevant because the visual and aural element which attracts the relevant purchaser to request their purchase would be the word ‘HOYA’ (see Judgement of 6 September 2013 in *Leiner v OHIM – Recaro (REVARO) T-349/12* para 23 and case-law cited).
- The revocation applicant has ignored the fact that the word ‘HOYA’ appears prominently – slap bang in the middle of the trade mark. There is no justification for the revocation applicant’s statements that the colours are dominant. The trade mark does not only appear on small labels/stickers on the fruit but the evidence provided shows that sales take place to purchasers in large boxes and sometimes even boxes bearing the trade mark are present in the aisles of supermarkets themselves. Thus, the example given (by the revocation applicant) of the labels being so small or on the scaly exterior of fruit so that the word ‘HOYA’ appears to ‘barely be legible’ should be treated with a pinch of salt.

No chain of evidence showing genuine use

It is unclear to the trade mark owner’s legal representative as to how to treat this as a separate ground of appeal. It is nothing more than a mishmash of criticism of the trade mark owner’s evidence and how such was treated by the Cancellation Division which have been voiced and treated elsewhere in the appellant’s submissions.

Non-use during the relevant period

- The main criticism from the revocation applicant appears to be the lack of any dated photographs. It is, of course, the position that we have been able to show use during the relevant period by additional evidence (T-324/09 – *FRIBOI* Judgement of 17/2/2011). It is often difficult for trade mark owners to file dated photographs because when use occurs; it is not the norm to take physical photographs of the use in anticipation that at some time in the future, such might be utilised in litigation in defence of non-use revocation

proceedings. This would be with the benefit of hindsight. In this case, there is litigation between the parties and thus, the trade mark owner was able to utilise evidence used in litigation and in conjunction with further evidence which predated the date of filing of the application for revocation. For the revocation applicant to ask the Board of Appeal to discount such evidence has no legal justification.

No use within the European Union

- It is clear that the Cancellation Division did not base its decision on imports alone. In addition, the evidence shows that the genuine use arises by virtue of sales to customers who are wholesalers within the European Union. It is, of course, a possibility that once a customer has taken delivery (in an EU port) that they may be transported elsewhere including outside of the European Union. Transportation outside of the European Union is unlikely given the perishable nature of the goods but even if it arises, this is also irrelevant. The ultimate location of the sale of the goods in supermarkets and retailers is irrelevant. What a wholesaler does with the goods which it has purchased is not at issue. The trade mark owner has made the sale to a wholesaler within the European Union and this amounts to genuine use (commercial sales) within the European Union.

Extent of use does not amount to genuine use

- There is no reason for the Board of Appeal to deviate from the contested decision's conclusion. The revocation applicant accepts that there is no *de minimis* rule for genuine use (SUNRIDER v OHIM C-416/04 para 72). Despite this, the revocation applicant makes the comparison between the trade mark owner's use and the banana market as a whole. Why? It is suspected that it is because it is the only straw which it can clutch onto. It is true that the trade mark owner is a large player in the banana market. However, this does not mean that the trade mark owner must use each and every trade mark in the context of high volume banana or fruit sales. It is a commercial choice of the trade mark owner to use its trade marks for a low volume segment of the market. The trade mark owner should be allowed to make such a commercial decision. Small can be beautiful. Small can create a niche. Small can be a deliberate attempt to distinguish the product line and be seen not to compete with a more established branding. It is, of course, necessary that the sales be more than mere token but volume is only part of the multi factorial assessment of whether the use is commercial and not token.
- The trade mark owner explained the rationale for their low volume use. The use is continuous, frequent, historical, directed to a number of different customers and although volumes are small in the context of the overall banana/fruit market, they are not insignificant and the trade mark yellow/black 'HOYA' label and red/blue 'HOYA' label consequently play an important commercial role. The revocation applicant sets the threshold of genuine use out at a much higher level than justified and seems to impose on the trade mark owner levels which are more akin to trying to prove that the trade mark

enjoys a reputation or acquired distinctiveness through use. The trade mark owner makes no such claim for its trade mark(s). It is not a trade mark which one will always find in use at specific locations (para 91) or indeed in specific countries (para 88).

- It is indeed true the trade mark owner sells its ‘bananas’ as being premium (para 82). This does not mean that ‘HOYA’ bananas cannot be niche or tertiary. ‘HOYA’ branded bananas are put on the market to supply a commercial need for a branding which differs from the primary branding (FYFFES). It is secondary but it is still commercial; it is certainly not token. The use is genuine in fulfilling this commercial role.

No use in relation to the registered goods

- The Cancellation Division concluded that within the goods of registration, use was proven in relation to two specific products, namely ‘pineapples and bananas’ both of these (a) pineapples and (b) bananas fall within the goods of the trade mark registration. The trade mark owner accepts that some of this evidence of use pertains to use on ‘plantains’.
- ‘Plantains’ are members of the banana family but are starchier and lower in sugar. They are a sub category of a ‘banana’ but are rarely eaten raw. The revocation applicant quotes from the trade mark owner’s own website (para 9) and the heading identifies a ‘plantain’ as being a ‘vegetable bananas’. They are often referred to as ‘cooking bananas’ and are classified as a ‘fruit’. This means that if the Cancellation Division is to be criticised since use on ‘plantains’ was proven, they should have included ‘plantains’ as goods that could be retained within the specification. The failure to do so was simply because they considered that such were a type of ‘banana’.
- The trade mark owner should not be penalised either because the evidence of use on ‘plantains’ should be equated to use on bananas or in the alternative, ‘plantains’ should be retained within the specification as being an example of a fresh fruit or vegetable for which use was proven. The *Encyclopaedia Britannica* <https://www.britannica.com/plant/plantain> states the following: ‘the botanical classification of plantains and bananas is so complicated that plantain is variously viewed as a subspecies of the banana, and the banana as a subspecies of plantain.’ Reference - *The Editors of Encyclopaedia Britannica 2019, Plantain, Encyclopaedia Britannica*, viewed 07 Nov 2019.

Conclusion

- The revocation applicant has adopted a kitchen sink approach in relation to these revocation proceedings and this appeal. They have criticised each and every piece of use and aspect of the Cancellation Division’s decision. By doing so, it is really hard to form a view as to whether or not they actually believe merit exists in any of their contentions. It is a scatter gun approach and as such is demonstrative that there is no actual legal substance in any of the specific grounds of appeal.

- It is also unfair towards the Cancellation Division who having considered all of the evidence in a well-reasoned decision, found that genuine use was proven for ‘bananas (including plantains) and pineapples’ and within established principles of what constitutes genuine use.
- There is absolutely no reason for the Board of Appeal to deviate from this conclusion. It is the collective (an accumulation of the individual) which proves the overall, namely that the trade mark owner has made commercial (more than mere token) use falling within the representation of the trade mark as registered or a substantially similar trade mark on certain goods falling within the specification in the European Union and during the relevant period.
- To decide otherwise means that the trade mark owner will lose the benefit of a trade mark registration which is clearly based on grounds which although voluminous, when drilled down lack any actual substance.

Reasons

- 10 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 11 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

- 12 The revocation applicant’s appeal is directed against the cancellation decision to refuse revocation for ‘pineapples and bananas’ in Class 31.
- 13 The EUTM proprietor could have appealed the revocation for ‘Fresh fruit, except pineapples and bananas; fresh vegetables’ but it did not do so; the contested decision is therefore final in relation to these goods.

On the violation of the right to be heard

- 14 Under Article 96 EUTMR the Office’s decisions are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. The right to be heard covers all the factual and legal evidence which forms the basis for the decision-making act but not the final position which the administration intends to adopt (3/12/2003,T-16/02, TDI, EU:T:2003:327, § 75).
- 15 The revocation applicant argues that the EUTM proprietor kept all its arguments silent until its additional submission on 19 June 2018 named ‘Additional Submission’. It takes the view that several of the arguments belatedly put forward by Fyffes were used by the Cancellation Division as vital grounds on which the contested decision was based, but crucially, it was not granted any opportunity to respond to these arguments. In doing so, the Cancellation Division violated Article 94(1) EUTMR, which sets out that decisions of the Office shall only be based on

reasons or evidence on which the parties concerned have had an opportunity to present their comments. The Cancellation Division has furthermore violated Article 64(1) EUTMR, according to which the Office shall invite the parties, as often as necessary, to file observations on communications from the other parties or the Office itself.

- 16 The EUTM proprietor replies that its additional submissions were filed to answer to the criticisms put forward by the revocation applicant regarding the lack of genuine use.
- 17 On 19 June 2018, after the expiry of the original time limit, the proprietor submitted additional evidence.
- 18 It should be borne in mind that according to Rule 40(5) Regulation (EC) No 2868/95, applicable to the cancellation phase, the EUTM proprietor has to submit proof of use within a time limit set by the Cancellation Division; this cannot be interpreted as preventing additional evidence from being taken into account where new factors emerge (12/12/2007, T-86/05, *Corpo livre*, EU:T:2007:379, § 50). The Office has to exercise the discretion conferred on it by Article 76(2) EUTMR (18/07/2013, C-621/11 P, *Fishbone*, EU:C:2013:484, § 30).
- 19 The factors to be evaluated when exercising this discretion are, first, whether the material that has been produced late is, on the face of it, likely to be relevant to the outcome of the proceedings and, second, whether the stage of the proceedings at which that late submission takes place, and the circumstances surrounding it, do not argue against these matters being taken into account (18/07/2013, C-621/11P, *Fishbone*, EU:C:2013:484, § 33). The acceptance of additional belated evidence is unlikely where the EUTM proprietor or IR holder has abused the time limits set by knowingly employing delaying tactics or by demonstrating manifest negligence (18/07/2013, C-621/11 P, *Fishbone*, EU:C:2013:484, § 36).
- 20 The Cancellation Division took the decision to leave open the issue of whether or not the Office may exercise the discretion conferred on it by Article 95(2) EUTMR to take into account the additional evidence filed on 19 June 2018, as the evidence previously submitted within the time limit was considered sufficient to prove the required genuine use of the EUTM for some of the goods for which it is registered, and the additional evidence did not contain any reference to the remaining goods.
- 21 The Board takes the view that the EUTM proprietor is right when it says that it had the right to complement and file more evidence as the revocation applicant was criticising the nature and extent of use of the evidence already filed. The evidence filed in the second stage of cancellation proceedings was not new but complemented the evidence already filed and had the purpose of convincing the revocation applicant who expressed heavy criticism of the evidence filed within the time limit. Therefore this argument is hereby rejected.

On the genuine use

- 22 Pursuant to Article 58(1)(a) EUTMR the rights of the proprietor of the EUTM shall be declared 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 European Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.
- 23 There is ‘genuine use’ of a trade mark 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 does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43).
- 24 It is also important to bear in mind that it is not the purpose of the assessment of proof of use to measure commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade mark protection to only large-scale commercial use of the marks (08/07/2004, T-334/01, *Hipoviton*, EU:T:2004:223, § 32; 08/07/2004, T-203/02, *Vitafruit*, EU:T:2004:225, § 38).
- 25 According to Article 19(1) EUTMDR in conjunction with Article 10(3) EUTMDR the indications and evidence for the furnishing of proof of use shall concern the place, time, extent and nature of use of the trade mark for the goods and services in respect of 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).
- 26 The EUTMDR gives examples of acceptable evidence, such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and statements in writing. However, this does not mean that each item of evidence must necessarily give information about all four elements to which proof of genuine use must relate, namely the place, time, nature and extent of use (16/11/2011, T-308/06, *Buffalo Milke*, EU:T:2011:675, § 61; 24/05/2012, T-152/11, *Mad*, EU:T:2012:263, § 33).
- 27 An accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (17/04/2008, C-108/07 P, *Ferro*, EU:C:2008:234, § 36; 24/05/2012, T-152/11, *Mad*, EU:T:2012:263, § 34). Indeed, the sufficiency of the indications 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.

- 28 The Board will therefore evaluate the evidence submitted in an overall assessment, taking into account all the circumstances of the case and assessing all the materials submitted in conjunction with each other.

Evidence of use



- 29 The contested EUTM was registered on 29/6/2012.
- 30 The application for revocation for non-use was filed on 22/8/2017; therefore the EUTM has been registered for more than five years at that date. The relevant period extends from 22/8/2012 to 21/8/2017.

Time of use

- 31 It is not a matter of examining whether the trade mark has been put to continuous use over the course of the relevant period. It is sufficient that a trade mark has been put to genuine use during a part of that period (15/07/2015, T-398/13, TVR ITALIA (fig.) / TVR et al., EU:T:2015:503, § 52-53).
- 32 Although some documents are not dated (exhibits AD 3, AD 4 and AD 11) or are dated outside of the relevant period (some invoices), it must be noted as in the contested decision, that the majority of the invoices (exhibits AD 5, AD 7 and AD 9) and the quality controls of the pineapples (exhibit AD12), provide sufficient indications as to the use of the contested mark during the relevant time period, namely, from 22 August 2012 to 21 August 2017. Therefore, the evidence filed by the EUTM proprietor contains sufficient indications concerning the time of use.

Place of use

- 33 The territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. Since the earlier mark is an EUTM, use of the mark had to be shown in the territory of the EU. This must be interpreted as meaning that the territorial borders of the Member States should be disregarded when assessing whether an EUTM has been put to 'genuine use' in the European Union (19/12/2012, C-149/11, Leno, EU:C:2012:816, § 44).
- 34 It is not necessary that the mark should be used in an extensive geographic area for use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (19/12/2012, C-149/11, Leno, EU:C:2012:816, § 54-55).
- 35 The relevant invoices clearly indicate that the products were addressed to customers in Ireland, Germany, the Benelux, the Czech Republic, the UK, France, Latvia, Lithuania, Poland and the Netherlands (exhibits AD 5, AD 7 and AD 9).

- 36 The revocation applicant argues that the single fact that the bananas find their way into the harbours in Europe from third countries, does not mean that the products will be brought onto the market in the European Union or its Member States and therefore does not constitute use of the trade mark in the course of trade. Such products may well be transit goods with a destination outside of the European Union.
- 37 In relation to transit, the Board notes that evidence that only relates to the import of the goods in the relevant area may, depending on the circumstances of the case, suffice as proof of use in this area (see by analogy 09/07/2010, T-430/08, Grain Millers, EU:T:2010:304, § 33, 40 et seq. regarding the proof of use in the course of trade of a sign on the basis of imports from Romania to Germany).
- 38 In any case as noted by the contested decision the evidence filed shows that not only did the proprietor import goods into the EU, but it also sold the goods to customers within a number of countries within the European Union (relevant invoices exhibits AD 5, AD 7 and AD 9, and declarations from customers).
- 39 Therefore, the evidence relates to the relevant territory and is sufficient to show the place of use of the contested trade mark.

Extent of use

- 40 Concerning the extent of use to which the earlier mark has been put, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred as well as the frequency of those acts on the other (08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 35). Nevertheless, use need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39).
- 41 The Board emphasises that the requirement for the extent of use does not mean that the EUTM proprietor has to reveal the entire volume of sales or turnover figures. It is sufficient to submit evidence which proves that the minimum threshold for a finding of genuine use has been passed (11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310, § 72), whereby 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. There is no *de minimis* rule (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 25).
- 42 In its affidavit Ms Ann Duffy, Director of Corporate affairs of the EUTM proprietor declares that it has been using the trade mark 'HOYA' for 'bananas including plantains' since 1986. The use of the trademark for 'pineapples' is more recent. She declares that the 'HOYA' trademark is a secondary trade mark used beside the house mark 'FYFFES'. She explains that in relation to Ireland the relevant goods 'bananas, plantains and pineapples' are warehoused by Total produce plc. who is a wholesaler.

- 43 As a preliminary remark the Board will address the probative value of Ms Duffy's declaration.
- 44 Her statement is supported and accompanied by a number of witness statements. As to the probative value of witness statements, it must be recalled that statements which have evidential value under national legislation constitute, in principle, evidence which is admissible in proceedings before the Office (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 40-41). The probative value of a statement depends first and foremost on the credibility of the account it contains. It is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 42).
- 45 It is clear from case-law that witness statements by a party with close links to the party concerned are of lesser probative value than those of third parties and cannot on their own constitute sufficient evidence (16/06/2015, T-585/13, *Gauff JBG Ingenieure*, EU:T:2015:386, § 28 and the case-law cited; 15/02/2017, T-30/16, *Natural Instinct*, EU:T:2017:77, § 41).
- 46 In this connection, the Board observes that part of the documentation emanates from wholesalers that used to be part of the group of the EUTM proprietor (for example *Total Produce plc* in 2006) but also from wholesalers independent from the *Fyffes* group. Moreover the witness statements are supported by financial documentation such as invoices. An example is the declaration contained in Exhibit AD 6 where '*Total produce plc*,' an Irish company independent from the EUTM proprietor declares that it is a customer of '*HOYA*' products which it sells to retailers in Ireland.
- 47 As regards *Bristol Fruit Sales (Bananas)* a UK company, although it is owned by the EUTM proprietor group, it sells to other wholesalers and retailers across the United Kingdom, see Exhibit AD8).
- 48 For the Dutch market: exhibit AD10 contains a declaration from the firm *KARSTEN* explaining the sales of '*plantains*' in the Dutch market.
- 49 In relation to '*pineapples*' '*Fruchtimport*' a German firm who buys the fruit from the EUTM proprietor declares that it sells to clients such as *ALDI*, a very important retailer in the German market (see exhibit AD9).
- 50 Thus, the content of the witness statements appears reliable and plausible.
- 51 As to certain financial documents, in particular the invoices, it is recalled as in the contested decision, that according to Article 18(2) EUTMR, use of the mark with the consent of the proprietor is deemed to constitute use by the proprietor. This means that the owner must have given its consent prior to the use of the mark by the third party. In this regard, pursuant to settled case-law, it is unlikely that the proprietor of a trade mark would be in a position to submit evidence if the mark had been used against its wishes (08/07/2004, T-203/02, *Vitafruit*, EU:T:2004:225, § 25).

- 52 For these reasons, also these documents must be taken into consideration.
- 53 Ms Duffy gives in an attachment to her declaration (exhibit AD 5) the figures of the annual turnover under the 'HOYA' trademark for the years 2009 to 2017. In relation to the relevant period 2012-2017 the figures are:

EUR	185.557	in	2012,	and
2013		€218,142		
2014		€90,215		
2015		€94,022		
2016		€197,226		
2017		€372,656		

A total of EUR 1 047 818 is the amount of sales for the Irish market.

- 54 In relation to the United Kingdom market Ms Duffy declares that most of the sales take place between Bristol Fruit Sales (Bananas) limited and retailers and wholesalers; the following figures represent the turnover for the relevant period:

2012	€3,795,812
2013	€3,317,498
2014	€3,266,842
2015	€5,250,739
2016	€2,821,668
2017	€2,788,668

A total of EUR 21 241 327 is the amount of sales for the UK market.

- 55 To this declaration the EUTM proprietor annexed more figures, for example in exhibit AD 9 the number of boxes of bananas and plantains for other territories are detailed. Besides the United Kingdom and Ireland there are some boxes sold for these products in the Czech Republic for 2014 and 2015, in France, Latvia Lithuania Poland and Sweden.
- 56 In the same AD 9 exhibit some invoices reflecting sales of 'pineapples' to Fruchimport van Wylick GmbH are annexed which concern the relevant period. The quantities are important. Another invoice reflects sales of 'HOYA' 'bananas' to a company in Brussels; the amount of sales is not negligible, the same type of quantities appear in the same exhibit in relation to firms in the Czech republic, in Riga, in Vilnius and in Poland.
- 57 In relation to the Netherlands, invoices for 'plantains' to the firm Karsten showing the mark 'HOYA' were filed. Other invoices relate to other Dutch firms and show the mark 'HOYA' in relation to 'bananas'.
- 58 As regards 'pineapples' a number of invoices corresponding to sales to a German wholesaler Fruchimport van Wylick GmbH were filed showing a non-negligible

quantity of pineapples sold in the relevant period. The figures corresponding to the number of boxes sold are the following:

YEAR	BOXES
2012	310,305
2013	269,200
2014	227,600
2015	91,280
2016	184,240
2017	151,920
TOTAL	1,234,545

- 59 The Board agrees with the contested decision in that the EUTM proprietor has filed more than a hundred invoices to prove use of its mark. These invoices although not revealing the prices, show the quantities of ‘bananas, plantains and pineapples’ sold in the relevant period in different areas of the EU. The range of dates of the invoices, the different firms involved in the trade and the different territories show a significant commercial volume overall during a significant period.
- 60 The invoices enclosed list the products (bananas, plantains and pineapples). The invoices do contain the contested mark next to the products as a word mark. In relation to the volumes, the revocation applicant claims that compared to the total banana market in the EU the numbers are insignificant. As stated above, the proof of genuine use is not a measure of commercial success; therefore as such, the revocation applicant’s argument in this regard is unfounded.

Nature of use

- 61 The required ‘nature of use’ of the sign refers to: (a) use as a trade mark in the course of trade; (b) use of the mark as registered or of a variation thereof; and (c) use for goods and services for which it is registered.

Use as a trade mark in the course of trade

- 62 Genuine use of a trade mark requires that such mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the registered goods or services in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 43). As such, the mark must be used to distinguish the goods and services offered by a specific undertaking.
- 63 As to this aspect of the nature of use, the revocation applicant suggests that the Cancellation Division erred in taking into consideration the evidence of use in relation to some invoices as they are not outward use, since, in its opinion, the use shown therein is intra-group use only.

- 64 'Wholesaling' is defined as 'the business of selling to retailers, especially in large quantities' (<http://www.dictionary.com/browse/wholesaling>; last accessed on 10 January 2020). It is the process whereby a person or firm buys large quantities of goods from various producers or vendors, warehouses them, and resells them (in the main) to retailers.
- 65 'Retailing' is defined as 'the action or business of selling goods or commodities in relatively small quantities for use or consumption rather than for resale. Retail services allow consumers to satisfy different shopping needs in one place and are usually directed at the general consumer. They can take place in a fixed location, such as a department store, supermarket, boutique or kiosk, or in the form of non-shop retailing, such as through the internet, by catalogue or mail order'.
- 66 From the documents filed by the EUTM proprietor and as explained by the declaration of Ms Duffy, the Fyffes group sells to wholesalers directly who then in turn sell to retailers.
- 67 For example exhibit AD 5 shows sample invoices to 'Total produce plc' a company that is not related to the EUTM proprietor who is a wholesaler in Ireland.
- 68 These acts amount to external use in order to distinguish commercial origin of the EUTM proprietor's products. The Board will deal in detail with the type of products shown by the above-mentioned documents below when assessing the use in relation to the registered goods.
- 69 Therefore, the documents filed establish that the contested EUTM was used as a trade mark in the course of trade.

Use as registered

- 70 Article 18(1)(a) EUTMR states that use of the mark in a form different from that registered still constitutes use of the trade mark as long as the differing elements do not alter the distinctive character of the trade mark.
- 71 The purpose of Article 18(1)(a) EUTMR is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered and to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In such situations, where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade (23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50). Several signs may be used simultaneously without altering the distinctive character of the registered sign (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 34).

72 A finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the added elements based on the intrinsic qualities of each of those elements and the relative position of the different elements within the arrangement of the trade mark (12/03/2014, T-381/12, Palma Mulata, EU:T:2014:119, § 30; 10/06/2010, T-482/08, Atlas Transport, EU:T:2010:229, § 31 and the case-law cited).

73 It must be examined in light of the rules set out above, firstly, whether, in the present case, the differences between the sign in its registered form and the sign in its forms used by the EUTM proprietor are such so as to alter the distinctive character of the contested mark from the form in which it was registered.

74 The contested EUTM was registered as a figurative sign with colour claims. It is a



figurative mark bearing the verbal element 'HOYA'

75 Most of the evidence in relation to pictures and labels relate to the EUTM no



3 972 775 also registered by the EUTM proprietor:



76 Other documents show the following sign:

77 Some evidence related to 'pineapples' (exhibit AD12) show the sign as registered.

78 As regards the invoices filed they all mention the word mark 'HOYA'.

79 As the Cancellation Division, the Board agrees that the EUTM derives its distinctiveness mainly from this word element 'HOYA'. This word has no meaning in relation to the goods so it is distinctive. As regards the colours and the shapes,

they are not sufficiently original to divert the consumers' attention from the word element 'HOYA'.

- 80 The distinctive element that will be perceived by the public as having the function of distinguishing the goods at issue from those of other undertakings is therefore the word 'HOYA'. This element is present in the signs represented in the evidence submitted by the EUTM proprietor.
- 81 Furthermore, it must be recalled that when a mark is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter, since the average consumer of the relevant public will more easily refer to the goods in question by citing the word elements rather than describing the figurative elements of the mark (12/03/2014, T-381/12, *Palma Mulata*, EU:T:2014:119, § 38 and the case-law cited). In the present case, consumers will refer orally to the contested mark as 'HOYA', which coincides identically with the signs shown in the proof of use.
- 82 Since the main elements are present in the signs as represented in the documents filed, the difference in their get-up represents an acceptable variation that does not alter the distinctiveness of the EUTM as registered. They can therefore be regarded as broadly equivalent in accordance with the above cited case-law. The different geometric shapes and colours used in the background are secondary elements and therefore, their omission does not alter the contested mark's distinctive character (24/11/2005, T-135/04, *Online Bus*, EU:T:2005:419, § 37). The distinctive word element is present in all the signs used in a clearly visible manner.
- 83 In relation to the other elements sometimes shown in the evidence files such as 'Costa Rica' or 'Colombia' it is clear that they will be perceived as the country of origin of the goods, so no particular attention will be given to them by consumers.
- 84 To conclude on this point, the Board agrees with the Cancellation Division that the mark has been used in a form quite similar to the registered figurative sign and in a way that does not alter the distinctive character of the mark which stems from the word element 'HOYA'.

Use in relation to the registered goods

- 85 Pursuant to Article 58(2) EUTMR where the grounds for revocation of rights exist in respect of only some of the goods or services for which the trade mark is registered, the rights of the proprietor shall be declared revoked in respect of those goods or services only.
- 86 In accordance with Article 18 EUTMR, the mark must be used for the goods or services for which it is registered in order to be enforceable.
- 87 The evidence shows the images of 'bananas, plantains and pineapples', products marked with the 'HOYA' mark. This relates not only to the pictures filed but also to the dozens and dozens of invoices referring specifically to these three categories of products.

- 88 The revocation applicant draws attention to the fact that ‘plantains’ are a different type of ‘banana’ and the Board agrees with its arguments. The cancellation decision should have made a difference as did the EUTM proprietor in its documentation.
- 89 ‘Plantains’ are defined by the Oxford Online Dictionary as ‘a fruit like a large banana, but less sweet, that is cooked and eaten as a vegetable’ (<https://www.oxfordlearnersdictionaries.com/definition/english/plantain?q=plantain> consulted on 10/1/2020).
- 90 Although they look like bananas, they are green and cooked in a different way; they are considered to be vegetables. The Board clarifying the scope of the revocation takes the view that the EUTM ‘HOYA’ should also remain registered for ‘plantains’ as is clear from the evidence of use filed by the EUTM proprietor (see in particular exhibits AD 10 and AD 11).
- 91 The contested decision simply included ‘plantains’ under the banana category without explicitly referring to them; however the Board considers that this must be corrected and clarified.
- 92 Regarding the ‘bananas’ and ‘pineapples’ the Board agrees with the contested decision that the EUTM proprietor has been able to show a long-standing use of the mark registered (at least since 2009) for ‘bananas, plantains and pineapples’ in a significant part of the EU territory in particular, in the United Kingdom, Ireland, the Netherlands and Germany.
- 93 Contrary to the criticisms put forward by the revocation applicant, the Board adheres to the arguments expressed by the Cancellation Division and takes the view that the mark has been used for ‘bananas, plantains and pineapples’. The appeal must therefore be rejected.

Global assessment of the evidence

- 94 The Board has assessed all the evidence submitted together and considers that, although some items of proof may be outside the relevant period or undated, they contribute to substantiating the use together with other documents and information.
- 95 From a global assessment of all the relevant factors, the Board therefore concludes that the use shown by the EUTM proprietor in relation to ‘bananas, plantains and pineapples’ is sufficient to maintain or create a market share on the specific market. As already mentioned, it is not relevant whether this use results in actual commercial success (see Advocate General’s opinion delivered on 19/12/2012, C-149/11, Leno, EU:C:2012:816, § 50).
- 96 It is thus concluded that the contested decision is upheld to the extent that it maintained the registration of the mark with the clarification that the decision included ‘plantains’.

Costs

- 97 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the revocation applicant, as the losing party, must bear the EUTM proprietor's costs of the appeal proceedings. These consist of the EUTM proprietor's costs of professional representation of EUR 550.
- 98 As to the revocation proceedings, the Cancellation Division ordered each party to bear its own costs. This decision remains unaffected.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. EUTM no 10 612 166 remains registered for ‘pineapples, bananas and plantains’ in Class 31;**
- 3. Orders the revocation applicant to pay EUR 550 for the EUTM proprietor’s costs in the appeal proceedings.**

Signed

A. Pohlmann

Signed

V. Melgar

Signed

C. Govers

Registrar:

Signed

H.Dijkema

