

Alicante, 12/03/2020

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**Notification of a decision to the applicant**

<i>Your reference:</i>	<b>285216(revocation)</b>
<i>Revocation number:</i>	<b>000028762 C</b>
<i>Contested trade mark:</i>	<b>011385333</b>
	<b>SUPERIOR</b>

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on **12/03/2020**.

**Please note that the decisions of the Cancellation Division are not signed by the officials responsible but only indicate their full name and bear a printed seal of the Office in accordance with Article 94(2) EUTMR.**



**Frédérique SULPICE**

Enclosures (excluding the cover letter): 14 pages.

## CANCELLATION No 28 762 C (REVOCATION)

**Worldwide Machinery Ltd.**, 16031 I-10 East Freeway, Channelview, Texas 77530, United States of America (applicant), represented by **AKD N.V.**, Wilhelminakade 1, 3072 AP Rotterdam, Netherlands (professional representative)

a g a i n s t

**Scaip, S.P.A.**, Via Roma, 18 - Frazione San Pancrazio, 43126 Parma, Italy (EUTM proprietor), represented by **Ing. Dallaglio S.R.L.**, Via Mazzini, 2, 43121 Parma, Italy (professional representative).

On 12/03/2020, the Cancellation Division takes the following

### DECISION

1. The application for revocation is partially upheld.
2. The EUTM proprietor's rights in respect of European Union trade mark No 11 385 333 are revoked as from 19/10/2018 for some of the contested goods, namely:

Class 12: *Vehicles (except self-propelled equipment for placing pipes); apparatus for locomotion by land (except self-propelled equipment for placing pipes), screening equipment, self-propelled vehicles with screening equipment and sifting bucket, crawler vehicles with a loading platform, crawler land vehicles with vacuum lifters, couplers, crimping machines.*

3. The European Union trade mark remains registered for all the remaining goods, namely:

Class 12: *Self-propelled machines for creating oil pipelines, gas and water conduits; land vehicles, namely self-propelled equipment for placing pipes; kits for converting crawler land vehicles to land vehicles comprising self-propelled equipment for placing pipes; sifting buckets; suction cups for lifter; hydraulic chucks; self-propelled pipe bending machines.*

4. Each party bears its own costs.

## REASONS

The applicant filed a request for revocation of European Union trade mark registration



No 11 385 333 (figurative mark) (the EUTM). The request is directed against all the goods covered by the EUTM, namely

Class 12: *Vehicles; apparatus for locomotion by land, self-propelled machines for creating oil pipelines, gas and water conduits, land vehicles comprising self-propelled equipment for placing pipes, kits for converting crawler land vehicles to land vehicles comprising self-propelled equipment for placing pipes, screening equipment, sifting buckets, self-propelled vehicles with screening equipment and sifting bucket, crawler vehicles with a loading platform, crawler land vehicles with vacuum lifters, suction cups for lifters, couplers, crimping machines, hydraulic chucks, self-propelled pipe bending machines.*

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

## SUMMARY OF THE PARTIES' ARGUMENTS

The applicant claimed that the EUTM had not been put to genuine use in the European Union for a continuous period of 5 years for all the goods for which it was registered.

The EUTM proprietor submitted evidence of use (listed and assessed below). It also argued, as preliminary remarks, that there had been commercial relationships between the parties from 1996 to 2016 (exclusive distribution agreement). The applicant was the exclusive distributor of the EUTM proprietor for pipeline equipment worldwide, excluding Italy and the reserved customers. The EUTM proprietor considered that the applicant was acting in bad faith when filing the application for revocation since it knew that the EUTM proprietor used its trade mark and sold products in the European Union, given the commercial relationships between the parties. To demonstrate the bad faith of the applicant, the EUTM proprietor also referred to two EUTMs filed by the applicant in 2013



(EUTM No 12 329 711), identical to the contested EUTM, and EUTM

No 2 329 645  **SUPERIOR**  
MANUFACTURING).

In reply, the applicant argued that the distribution agreements submitted by the EUTM proprietor did not mention the trade marks under which the products were sold and the EUTM proprietor was only authorised to sell its products in Italy. It also considered that the bad faith invoked by the EUTM proprietor in its observations was irrelevant to the present proceedings, adding that in any case the EUTM proprietor itself filed the contested EUTM in bad faith. Regarding the evidence of use submitted by the EUTM

proprietor, the applicant argued that use in Italy was not sufficient to admit use in the European Union and referred to T-386/16, dated 06/10/2017 (06/10/2017, T-386/16, *silente PORTE & PORTE*, EU:T:2017:706). It then appraised each piece of evidence individually and concluded that the proprietor had not submitted sufficient evidence to prove use of the contested EUTM, in particular regarding the place of use and the goods for which the contested EUTM was registered. The applicant argued that *vehicles* was a broad category and the specific pipeline equipment used by the EUTM proprietor was distinct and independent from that category.

To support its allegations, the applicant submitted the distribution agreement dated 2013 with its annexes, showing that the EUTM proprietor was only entitled to sell the listed products in Italy; a decision dated 10/04/2019 of the Registrar of Trade Marks in Australia, ruling in an opposition filed by Scaip S.R.L. against two applications filed by Worldwide machinery Ltd.; and a decision dated 29/06/2015 from the UK High Court of Justice, referring to the territoriality of an EUTM.

In its final observations, the EUTM proprietor argued that the products listed in the distribution agreements correspond to those for which the contested EUTM is registered and they bear the contested mark, as shown in the evidence, even though no trade mark was mentioned in the distribution agreements. It reiterated that Italy was excluded from the exclusive distribution agreement and the EUTM proprietor could therefore sell its products in Italy and to specific Italian customers ('reserved customers'). It pointed out that the documents referring to Australia are irrelevant and that the documents submitted previously, as a whole, show genuine and continuous use of the contested EUTM, even before the relevant period. It argued that as the goods concerned are expensive, specialised machines addressed to specific customers in the pipeline sector, the quantities sold cannot be very high. Furthermore, it argued that, given the territorial restriction for the sale of the products in the distribution agreements until 2016 and the specific nature of the products limited to the pipeline sector, use only in Italy to different customers should be considered as sufficient. Moreover, the EUTM proprietor argued that the invoices submitted, which depict the contested EUTM, show use of the mark and the codes mentioned in the invoices correspond to pipeline equipment products. It also submitted additional evidence, namely the invoices previously submitted together with the relevant technical sheets of the products (including the depiction of the products bearing the contested EUTM). Finally, the EUTM proprietor considered that use should be considered for vehicles in general and for all the listed goods in Class 12.

## **GROUND FOR THE DECISION**

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

Genuine use of a trade mark exists where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. Genuine use requires actual use on the market of the registered goods and services and does not include token use for the sole purpose of preserving the rights conferred by the mark, nor use which is solely internal (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, in particular § 35-37, 43).

When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether commercial exploitation of the

mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a market share for the goods or services protected by the mark (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 38). However, the purpose of the provision requiring that the earlier mark must have been genuinely used 'is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks' (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 38).

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

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

In the present case, the EUTM was registered on 01/05/2013. The revocation request was filed on 19/10/2018. Therefore, the EUTM had been registered for more than five years at the date of the filing of the request. The EUTM proprietor had to prove genuine use of the contested EUTM during the five-year period preceding the date of the revocation request, that is, from 19/10/2013 to 18/10/2018 inclusive, for the contested goods listed in the section 'Reasons' above.

On 11/02/2019, within the time limit, the EUTM proprietor submitted the following evidence as proof of use:

- Document No 1: distribution agreements between the parties dated 1996, 2007 and 2013 (renewed in 2015) between the supplier 'SCAIP S.R.L.' and the exclusive distributor 'Worldwide Machinery Ltd'. The geographical scope is worldwide, with the exclusion of Italy and the listed reserved customers. In the distribution agreement dated 2013, the products concerned are kit conversion packages, pipe layers, flat bed tractors, welding cabins, bending machines, hydraulic wedge mandrels, line-up clamps, facing machines, padding buckets, padding machines, vacuum lifts and suction pads.
- Document No 2: copy of a fax dated 2002 about the sketches of the contested EUTM.
- Document No 3: invoices dated 2009-2013 (before the relevant period), issued by the EUTM proprietor and sent to clients in Italy. They depict the contested EUTM and concern the sales of pipe layers and pipe benders. There are also certificates of conformity and of machine-marking plates for those goods.

- Document No 3.1: undated catalogue showing a padding machine. It shows the



- Document No 4: extracts from the IPLOCA yearbook 2014-2015 (international sector association) with the depiction of 'SUPERIOR' machines.

- Document No 5: vacuum lift brochure with related invoice dated 2016 from 'digigraph' (printer) to SCAIP SRL. The brochure depicts a pipe vacuum lift bearing the contested EUTM.
- Document No 6: user manual dated 2012 with related invoice dated 31/07/2014 from 'digigraph' (printer) to SCAIP SRL. The user manual concerns pipe bending machines and the contested EUTM is depicted on these machines.
- Document No 6.1: technical sheet/instruction manual for padding machine and related invoice dated 31/05/2016 from digigraph' (printer) to SCAIP SRL. The

manual shows the sign  **SUPERIOR**  
MANUFACTURING

- Document No 7: calendars dated 2013, 2014 and 2017. The contested EUTM is depicted in some machines such as vacuums lifts and pipe benders.
- Document No 8: institutional brochure for pipeline equipment, showing the signs



and



, and related invoices from the printer dated 26/10/2016 and 30/11/2016. There are also invoices from 'Publi Service serigrafia' to SCAIP SRL dated 2014, 2015 and 2017 for the printing of labels bearing the trade mark 'SUPERIOR MANUFACTURING'.

- Document No 9: sales invoices dated 2014-2017 issued by the EUTM proprietor



to different clients in Italy. They depict the trade marks



on the top of the invoices. The amounts and prices have been redacted for confidentiality reasons. They refer to the sales of pipeline equipment, namely kit conversion packages, supports for rops/fops, hydraulic/pneumatic mandrels, lined bending sets, pipe bending machines, vacuum lifts, suction pads, screening buckets and padding machines.

- Document No 10: photographs with pipe layers bearing the contested EUTM, dated 18/12/2018.
- Documents No 11-13: three sales invoices dated 2016 and 2017 issued by the EUTM proprietor to clients in Australia. They depict the trade marks



and



on the top of the invoices and refer to the

sales of conversion kits, wedge sockets, rollers, electrical connectors, threaded rod section, rubber chains.

- Document No 14: undated catalogue showing a padding machine (same as document No 3.1).
- Document No 15: old user manual (undated).
- Document No 16: cancellation decision from the Australian Government, IP Australia, dated 18/08/2017.
- Documents No 17, 18: extracts from TMview relating to EUTM No 12 329 645 and EUTM No 12 329 711, both registered in the name of the applicant.
- Document No 19: extracts from the EUTM proprietor's website (undated) showing its machines (pipe layers, padding machines, pipe bending machines, tracked flatbed, pipe carriers, vacuum lifts, conversion kits, mandrels, canopies rops/fops, welding cabins, line-up clamps, screening buckets, modular units, lifting equipment, wheel dozers, tracked tractors).
- Document No 20: declaration dated 07/02/2019 by the account manager of the advertising agency 'Armani & Associati', mentioning that many advertising projects had been carried out for SCAIP. Enclosed are the printed company profile, extracts of catalogues and a photograph taken inside the SCAIP plant in Parma showing a pipe bending machine bearing the contested EUTM.

On 14/08/2019, after expiry of the time limit, the EUTM proprietor submitted the same invoices as submitted on 11/02/2019 (Document No 9) with the additional corresponding technical sheets for padding buckets, pipe bending machines and vacuum lifts (both bearing the contested EUTM), suction pads, padding machines (bearing the contested EUTM).

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

According to Article 10(7) EUTMDR, where, after the expiry of the time limit set by the Office, indications or evidence is filed that supplement prior relevant indications or evidence submitted within the time limit, the Office may take into account the evidence submitted out of time as a result of exercise of the discretion conferred on it by Article 95(2) EUTMR. When exercising its discretionary power, the Office must take into account, in particular, the stage of proceedings and whether the facts or evidence are, *prima facie*, likely to be relevant for the outcome of the case and whether there are valid reasons for the late submission of the facts or evidence.

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

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

The additional evidence merely strengthens and clarifies the evidence submitted initially, as it does not introduce new elements of evidence but merely enhances the conclusiveness of the evidence submitted within the time limit.

For the above reasons, and in the exercise of its discretion pursuant to Article 95(2) EUTMR, the Cancellation Division therefore decides to take into account the additional evidence submitted on 14/08/2019.

However, since these documents mainly consist of invoices already submitted and the additional evidence cannot change the outcome of the proceedings, the Cancellation Division did not consider it necessary to reopen the present proceedings for another round of observations to allow the applicant to comment on the belated evidence.

### **Preliminary remarks**

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

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

### **Assessment of genuine use — factors**

#### **Time of use**

The evidence must show genuine use of the European Union trade mark within the relevant period.

Although some documents are dated outside the relevant period, there is sufficient evidence of use of the contested mark within the relevant period. In particular, the invoices submitted in Documents No 9 and No 11-13 are all dated within the relevant period.

#### **Place of use**

The evidence must show that the contested European Union trade mark has been genuinely used in the European Union (see Article 18(1) EUTMR and Article 58(1)(a) EUTMR).

According to Article 18(1), second subparagraph, point (b) EUTMR, affixing the European Union trade mark to goods or the packaging thereof in the Union solely for export purposes also constitutes use within the meaning of paragraph 1.

The documents show that the place of use is Italy. This can be inferred from the language of the documents, the addresses mentioned in the invoices in different Italian cities (Parma, San Donato Milanese, Milan, Busseto, Siena) and also from the exclusive distribution agreements with the distributor 'Worldwide Machinery Ltd.' that excluded



Italy from the exclusive distribution and allowed the EUTM proprietor to sell its products in Italy.

Furthermore, the evidence also shows that some goods were manufactured in Italy and sold in Australia (Documents No 11-13). This shows that some goods were exported from the relevant territory.

Following the 'Leno Marken' judgment (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 44), Article 18(1) EUTMR 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.

In territorial terms and in view of the unitary character of the EUTM, the appropriate approach is not that of political boundaries but of market(s). Moreover, one of the aims pursued by the EUTM system is to be open to businesses of all kinds and sizes. Therefore, the size of an undertaking is not a relevant factor for establishing genuine use.

As the Court indicated in the 'Leno Marken' judgment, it is impossible to determine a priori and in the abstract what territorial scope should be applied in order to determine whether the use of the mark is genuine or not (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 55). All the relevant facts and circumstances must be taken into account, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and scale of the use as well as its frequency and regularity (19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 58).

According to the applicant, use in Italy is not sufficient to admit use in the European Union, and it referred to a judgment dated 06/10/2017 (06/10/2017, T-386/16, *silente PORTE & PORTE*, EU:T:2017:706).

In a recent judgment, the Court held that

for use of an EU trade mark to be deemed genuine, it is not required that that mark be used in a substantial part of the European Union. Furthermore, the possibility that the mark in question may have been used in the territory of a single Member State must not be ruled out, since the borders of the Member States must be disregarded and the characteristics of the goods or services concerned must be taken into account.

In accordance with the principles laid down by the judgment of 19 December 2012, *Leno Marken* (C-149/11, EU:C:2012:816), the General Court has held on numerous occasions that use of an EU trade mark in a single Member State (for example, in Germany, in Spain, or in the United Kingdom), or even in a single city in a Member State of the European Union, like the United Kingdom (for example, in London), is sufficient to satisfy the criterion of territorial scope ...

In other words, as Advocate General Sharpston stated in the Opinion she gave in *Leno Marken* (C-149/11, EU:C:2012:422), whether an EU trade mark has been used in one Member State or several is irrelevant. What matters is the impact of the use in the internal market: more specifically, whether it is sufficient to maintain or create market share in that market for the goods and services covered by the mark and whether it contributes to a commercially relevant presence of the goods and services in that market. Whether that use

results in actual commercial success is not relevant (Opinion of Advocate General Sharpston in *Leno Merken*, C-149/11, EU:C:2012:422, point 50).

(07/11/2019, T-380/18, INTAS / INDAS (fig.) et al., EU:T:2019:782, § 80, 81, 84).

Given that use took place in different Italian cities and considering the geographical restriction agreed by the parties limited to the Italian territory in relation to highly specialised goods, the Cancellation Division considers that use in Italy is considered geographically sufficient to constitute genuine use in the European Union.

### **Extent of use**

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

The assessment entails a degree of interdependence between the factors taken into account. Therefore, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa (08/07/2004, T-203/02, *Vitafruit*, EU:T:2004:225, § 42).

The condition relating to genuine use of the mark requires that the mark be used publicly and outwardly for the purpose of ensuring an outlet for the goods or services which it represents (12/03/2003, T-174/01, *Silk Cocoon*, EU:T:2003:68, § 39).

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

The evidence cannot be assessed in absolute terms but must be assessed in relation to other relevant factors. In this respect, the evidence should be viewed in relation to the nature of the goods and the structure of the relevant market (30/04/2008, T-131/06, *Sonia Sonia Rykiel*, EU:T:2008:135, § 53).

The invoices show that sales took place in Italy, to different clients, in several years (2014-2016). Although the number of products sold is quite low, given the regularity and length of use, as well as the nature of the goods, the specific niche market (highly specialised goods for the pipeline industry) and the considerably high price of some machines, the Cancellation Division considers that the mark was used in a serious attempt to create and maintain an outlet for the goods.

As mentioned before, genuine use does not require commercial success but just real exploitation on the market. Taking into account the evidence in its entirety, although the evidence submitted by the EUTM proprietor is not particularly exhaustive, it does reach the minimum level necessary to establish genuine use of the contested trade mark. The volume of sales, in relation to the period and frequency of use, is not so low that it might be concluded the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark (16/11/2011, T-308/06, *Buffalo Milke*, EU:T:2011:675, § 68).

In other words, the extent of use was sufficiently proven, for some of the contested goods, as will be analysed below.

#### **Nature of use: use as a trade mark**

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

The mark was clearly used to identify the commercial origin of the goods since it was affixed on the goods themselves. Therefore, it was used as a trade mark.

#### **Nature of use: use of the mark as registered**

'Nature of use' in the context of Article 10(3) EUTMDR further requires evidence of use of the mark as registered, or of a variation thereof which, pursuant to Article 18(1)(a) EUTMR, does not alter the distinctive character of the contested European Union trade mark.



The registered EUTM is the figurative mark . Although in some



documents the sign was also used as , the evidence shows use of the sign as registered in the invoices and on the goods themselves, which, therefore, constitutes use of the contested EUTM under Article 18 EUTMR.

Furthermore, 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).



The fact that contested mark was used together with the house mark did not alter its distinctive character within the meaning of Article 18(1)(a) EUTMR.

It is quite common in some market areas for goods and services to bear not only their individual mark, but also the mark of the business or product group ('house mark'). In these cases, the registered mark is not used in a different form, but the two independent marks are validly used at the same time.

Two or more trade marks may be used together in an autonomous way, or with the company name, without altering the distinctive character of the registered trade mark, as in the present case (06/11/2014, T-463/12, MB, EU:T:2014:935, § 43).

### Use in relation to the registered goods

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

The contested EUTM is registered for the following goods in Class 12: *vehicles; apparatus for locomotion by land, self-propelled machines for creating oil pipelines, gas and water conduits, land vehicles comprising self-propelled equipment for placing pipes, kits for converting crawler land vehicles to land vehicles comprising self-propelled equipment for placing pipes, screening equipment, sifting buckets, self-propelled vehicles with screening equipment and sifting bucket, crawler vehicles with a loading platform, crawler land vehicles with vacuum lifters, suction cups for lifters, couplers, crimping machines, hydraulic chucks, self-propelled pipe bending machines.*

However, the evidence filed by the EUTM proprietor does not show genuine use of the trade mark for all the goods for which it is registered.

According to Article 58(2) EUTMR, where there are grounds for revocation 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.

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

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

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories.

[...]

[Furthermore,] allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use has been established ... must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection which registration of the trade mark confers on him.

(14/07/2005, T-126/03, Aladin, EU:T:2005:288, applied by analogy).

The evidence (in particular the invoices assessed together with the brochures/manuals and technical sheets) shows that the contested EUTM was used in relation to pipeline equipment, namely kit conversion packages, supports for rops/fops, hydraulic/pneumatic mandrels, lined bending sets, pipe bending machines, vacuum lifts, suction pads, screening buckets and padding machines.

Some of these goods or their synonyms are expressly listed in the contested EUTM, namely *kits for converting crawler land vehicles to land vehicles comprising self-propelled equipment for placing pipes* (conversion kits), *sifting buckets* (screening buckets), *suction cups for lifters* (suction pads), *hydraulic chucks* (hydraulic mandrels) and *self-propelled pipe bending machines*.

The contested EUTM is registered for *self-propelled machines for creating oil pipelines, gas and water conduits*. Given that the evidence shows use of the contested EUTM for self-propelled machines used in the pipeline sector such as pipe bending machines and padding machines, the Cancellation Division considers that use has been shown for the whole category *self-propelled machines for creating oil pipelines, gas and water conduits*.

The contested EUTM is also registered for *land vehicles comprising self-propelled equipment for placing pipes*. The Cancellation Division interprets the term 'comprising' as meaning 'including', namely as indicating that the specific goods (*self-propelled equipment for placing pipes*) are only examples of items included in the broad category and that protection is not restricted to them. Use was shown only for self-propelled equipment for placing pipes. Furthermore, apart from equipment and machines for the pipeline sector, the evidence does not show use for vehicles and land vehicles. Therefore, on the basis of the purpose of the goods used and the fact that there are no examples of other goods belonging to the broader category of land vehicles, the Cancellation Division finds that use has been demonstrated only for the specific goods *land vehicles, namely self-propelled equipment for placing pipes*.

The evidence submitted does not show that the mark was used in relation to the remaining goods, since either the goods are not mentioned at all or the evidence is not relevant and the Cancellation Division cannot ascertain if the goods were marketed under the contested EUTM. For instance, although use was shown for sifting buckets and vacuum lifters, as parts of vehicles or machines, use was not shown for the vehicles themselves (*self-propelled vehicles with screening equipment and sifting bucket, crawler vehicles with a loading platform, crawler land vehicles with vacuum lifters*).

Finally, some goods mentioned in the invoices such as canopies, bending sets, wedge sockets, rollers, rubber chains do not fall within any of the categories of goods for which the contested mark is registered.

## Overall assessment

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

It was demonstrated that the EUTM had been used in relation to some of the contested goods during the relevant period in the relevant territory to an extent sufficient to indicate that the use was genuine. The EUTM was used as a trade mark, as registered. Considering all the above, the Cancellation Division concludes that the evidence, as a whole, is sufficient to demonstrate that the contested mark was genuinely used during the relevant period in the relevant territory for the following goods in Class 12: *self-propelled machines for creating oil pipelines, gas and water conduits; land vehicles, namely self-propelled equipment for placing pipes; kits for converting crawler land vehicles to land vehicles comprising self-propelled equipment for placing pipes; sifting buckets; suction cups for lifters; hydraulic chucks; self-propelled pipe bending machines.*

## Conclusion

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

Class 12: *Vehicles (except self-propelled equipment for placing pipes); apparatus for locomotion by land (except self-propelled equipment for placing pipes), screening equipment, self-propelled vehicles with screening equipment and sifting bucket, crawler vehicles with a loading platform, crawler land vehicles with vacuum lifters, couplers, crimping machines.*

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

According to Article 62(1) EUTMR, the revocation will take effect from the date of the application for revocation, that is, as of 19/10/2018.

## COSTS

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

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



### **The Cancellation Division**

Julie, Marie-Charlotte  
HAMEL

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