

## CANCELLATION No 9896 C (INVALIDITY)

**Eumedics Medizintechnik Handels-und Marketingges.m.b.H.**, Linzer Str. 45, Purkersdorf, Austria (applicant), represented by **Frieders Tassul & Partner**, Stadiongasse 6 – 8, Wien, Austria (professional representative)

a g a i n s t

**Eumedica s.r.l.**, Via Risorgimento, 14, Noventa Padovana (PD), Italy (EUTM proprietor), represented by **Società Italiana Brevetti S.P.A**, Piazza di Pietra, 39, Rome, Italy (professional representative).

On 26/01/2018, the Cancellation Division takes the following

### DECISION

1. The application for a declaration of invalidity is rejected in its entirety.
2. The applicant bears the costs, fixed at EUR 450.

### *Preliminary remark*

*As from 01/10/2017, Regulation (EC) No 207/2009 and Regulation (EC) No 2868/95 have been repealed and replaced by Regulation (EU) 2017/1001 (codification), Delegated Regulation (EU) 2017/1430 and Implementing Regulation (EU) 2017/1431, subject to certain transitional provisions. All the references in this decision to the EUTMR, EUTMDR and EUTMIR shall be understood as references to the Regulations currently in force, except where expressly indicated otherwise.*

### REASONS

The applicant filed an application for a declaration of invalidity against some of the goods of European Union trade mark No 12 026 084 , namely against all the goods in Class 10. The application is based on the following national trade marks, all for the word EUMEDICS:

- Austrian trade mark registration No 186 459.
- Austrian trade mark registration No 278 158.
- German trade mark registration No 30 2013 054 201.

The applicant invoked Article 60(1)(a) EUTMR in connection with Article 8(1)(b) EUTMR.

## SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argues that there is a likelihood of confusion between the marks. In support of its observations, it filed the extracts from TMView for the trade marks invoked, as well as a licence agreement from the owner of the Austrian trade mark registration No 186 459.

The EUTM proprietor requested proof of use of all the national marks invoked as basis of the invalidity request.

## PROOF OF USE

### On the admissibility of the proof of use request

On 2411/2015, the EUTM proprietor requested proof of use of all the earlier marks invoked as basis for the invalidity request. For the purpose of the present decision a description of the basic information as regards the earlier rights is nevertheless necessary.

The Austrian trade mark 186 459 was registered on 02/02/2000, that is for more than 5 years prior to the publication date of the contested EUTM on 16/09/2013. Therefore, for this mark, the request for proof of use is clearly admissible.

As regards the Austrian trade mark registration No 278 158 and the German trade mark registration No 30 2013 054 201, the indicated dates of registration in the notice of invalidity are 19/05/2014 and 18/02/2014 respectively, therefore after the publication date of the contested mark mentioned in the previous paragraph. However, the proprietor informed the Cancellation Division that these two registrations originate from the conversion of the EUTM 2 003 325, filed on 18/12/2000 and registered on 31/08/2004. This conversion took place after the mark was partly invalidated following a decision in cancellation case C 5855. Despite the fact that the registration dates of two of the earlier marks were after the publication date of the contested EUTM, also for these two earlier national marks the Cancellation Division found the request for proof of use as admissible. The reason for this decision is explained in the following text.

Conversion is the process of turning an EUTM application or **registration** into one or more national applications. If an EUTM ceases to exist it can, depending on the precise reason for that, be converted into trade marks that are valid in certain Member States.

The applicant indicated that the two national marks originating from the conversion of its EUTM have a date of registration at national level in 2014. Nevertheless, these two marks cannot be regarded as independent and autonomous registrations from the converted EUTM. Article 112(3) of the Regulation (EC) No 207/2009 (now Article 139 EUTMR) states clearly that the filing or the priority date of the converted EUTM is preserved and becomes the filing or priority date of the national applications. Furthermore, in its decision of 15/07/2008 in case R1313/2006-G 'cardiva', the Grand Board of EUIPO stated that an opposition based on an earlier EUTM application can be maintained on the basis of material trade mark registrations resulting from the conversion of the EUTM application. However, the conversion of an EUTM into national registrations should not imply that the applicant benefits from a new 5 years grace

period starting the registration date or the date of entering in the register under the national laws. In the present case, the converted EUTM was registered in 2004 and from that date the applicant enjoyed a 5 years grace period in which it should have started using its mark in the EU, that meaning, the Austrian and German territories inclusive. A fresh 5 years grace period of use for the national trade mark registration resulting from a conversion of an EUTM would mean that a legal loophole would be created for the applicants wishing to invoke EUTMs that had not been used.

This is also in line with the treatment offered to the international trade marks designating the EU which have been transformed into EUTMs. According to Article 145 Regulation (EC) No 207/2009 (now Article 182 EUTMR), unless there are specific provisions to the contrary, the provisions of the EUTMR and the acts adopted pursuant to it apply *mutatis mutandis* to IRs designating the EU. This includes, *inter alia*, Article 15(1) Regulation (EC) No 207/2009 (now Article 18(1) EUTMR), which imposes on EUTM proprietors the obligation to use the mark within a period of five years following registration. According to Article 160 Regulation (EC) No 207/2009 (now Article 203 EUTMR), the date of the second republication of an IR designating the EU is the date taken for calculating its grace period. Furthermore, from the equity point of view, a trade mark owner that enjoys the full rights of trade mark protection without interruption is also under the corresponding obligations as set out by the law, including *inter alia* the obligation to use the trade mark concerned. Consequently, the transformation of an IR designating the EU after the second republication has no impact on the calculation of the grace period, which commences as provided for in Article 203 EUTMR with the second republication, namely on the date of the second republication of the original EU designation in part M.3 of the EUTM Bulletin. Since the situation of an IR designating the EU that has been transformed into an EUTM registration after its second republication is no different from that of an EUTM registration filed directly with the EUIPO, there is no reason for any different treatment either.

Consequently the request for proof of use for all the earlier trade marks is admissible.

#### On the proof of use

According to Article 57(2) and (3) Regulation (EC) No 207/2009 (now Article 64(2) and (3) EUTMR), if the EUTM proprietor so requests, the applicant shall furnish proof that, during the five-year period preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the applicant cites as justification for its application, or that there are proper reasons for non-use. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years. If, on the date of publication of the contested EUTM, the earlier mark had been registered for not less than five years, the applicant must submit proof that, in addition, the conditions set out in Article 42(2) Regulation (EC) No 207/2009 (now Article 47(2) EUTMR) were satisfied on that date.

The same provision states that, in the absence of such proof, the application for a declaration of invalidity shall be rejected.

Following the EUTM proprietor' request, on 13/01/2016 the applicant was given three months to submit proof of use. The period was subsequently extended upon request of the applicant and expired on 18/06/2016.

The applicant has not submitted any evidence concerning use of the earlier trade marks on which the application for invalidity is based. Nor has it argued that there are proper reasons for non-use.

According to Rule 40(6) Regulation (EC) No 2868/95 (now Article 19(2) EUTMDR), if the applicant does not submit such proof before the time limit expires, the Office shall reject the application.

Therefore, the application must be rejected pursuant to Article 57(2) and (3) Regulation (EC) No 207/2009 (now Article 64(2) and (3) EUTMR).

### **COSTS**

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the costs incurred by the EUTM proprietor in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(ii) EUTMIR, the costs to be paid to the EUTM proprietor are the representation costs, which are to be fixed on the basis of the maximum rate set therein.



### **The Cancellation Division**

José-Antonio  
GARRIDO OTAOLA

Ioana  
MOISESCU

Oana-Alina  
STURZA

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.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. According to Article 109(8) EUTMR, such a request must be filed within one month of the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Annex I A(33) EUTMR) has been paid.