

INTA

EUROPE & CENTRAL ASIA LEGISLATION AND REGULATORY SUB- COMMITTEE

PART CANCELLATION REPORTS

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INTRODUCTION

During its 2006-2007 term, INTA's Europe & Central Asia Subcommittee of the Legislation and Regulation Committee (LRC ECAS) began a project on part cancellation reports for the countries within the subcommittee's jurisdiction. The purpose of the project was to compare the various approaches of the competent trademark offices or courts with respect to the requirement to provide evidence for genuine use in trademark proceedings.

Where one party is required to submit evidence of genuine use, problems sometimes arise when the trademark is registered for a broad term but evidence of use is only provided for specific goods falling under that broad term. While some authorities consider such evidence sufficient as evidence of genuine use for the broader term, other authorities take a so-called "re-writing approach" and consider only those specific goods where evidence of genuine use has been provided. In other words, the list of goods and services will be "re-written" and thus restricted to narrower terms.

Both approaches have advantages and disadvantages. For example, maintaining the trademark for the broader term will ensure protection for the trademark owner who should be entitled to use his trademark in an economically reasonable way, allowing him to vary the range of offered goods according to market needs. Also, this option offers the maximum possible scope of protection against younger trademarks. On the other hand, this approach may allow a trademark owner to block a trademark for goods that he does not offer and that for which he has no apparent interest. One could argue that the scope of protection of a trademark against other trademarks should not be considered in cancellation proceedings, but in the future proceedings against other trademarks where other important factors, like similarity of goods, similarity of signs, and distinctiveness of the earlier trademark will be considered.

The project has now been updated by the 2008-2009 LRC ECAS subcommittee. While the discussion regarding advantages and disadvantages of the various approaches continues within the subcommittee, the following report aims to provide an overview of the various country legislation and case law.

BULGARIA

I. Statutory Provisions

Under Bulgarian law, cancellation or partial cancellation of a trademark registration for non-use is governed by the *Law on Marks and Geographical Indications* ("LMGI").

Article 19, par. 1 of the LMGI outlines the following grounds for full and partial revocation of a trademark:

- (a) if within a period of five years as of the date of registration the proprietor has not put the trademark to genuine use on the territory of the Republic of Bulgaria in relation to the goods or services for which it is registered, and there are no proper reasons for non-use; or
- (b) if the use has been suspended for uninterrupted period of five years, and there are no proper reasons for non-use.

Article 25, par. 1, item 1 of the LMGI provides that the registration of a trademark shall be revoked per the request of any person if the trademark has not been used pursuant to Article 19 of the LMGI.

However, the aforesaid provision of Article 25, par. 1, item 1 of the LMGI shall not apply if the proprietor has commenced or resumed the genuine use within the period between the expiry of the five-year grace period and the date of filing of the revocation application. The commencement or resumption of use within three months term preceding the filing date of the revocation application shall be disregarded where the preparations for use or resumption were made only after the proprietor became aware that an application for revocation might be filed.

Further, Article 25, par. 3 of the LMGI reads as follows: Where the application for revocation concerns only some of the goods or services, the registration shall be declared to be revoked in respect of those goods or services only.

The LMGI also contains specific regulation with regard to the revocation undertaken as a counteraction to provisional refusals of registration of trademarks or invalidation of trademark registrations.

In particular, Article 37a, par. 1 of the LMGI provides that the procedure in respect of a pending application for registration of a trademark shall be suspended as per request of the applicant, if an application for revocation of the registration of the opposed earlier trademark has been filed.

According to Article 46a, par. 2 of the LMGI the invalidation procedure shall be suspended if a counter application for revocation of the registration of the earlier trademark has been filed.

Consequently, in practice the procedure for full or partial revocation of registration of a trademark

may be initiated either by any person (Art. 25, par. 1, item 1 of the LMGI), or a person having legitimate interest, i.e. an applicant of pending application for registration (Article 37a, par. 1 of the LMGI) or a proprietor of trademark subject to invalidation (Article 46a, par. 2 of the LMGI).

II. Procedural Issues

Under Bulgarian law the revocation procedure develops as an administrative procedure and it is initiated through submission of a written application for revocation to the Dispute Department of the Bulgarian Patent Office (“BPO”). The application for revocation is examined by a panel of five state experts, two of whom should be lawyers.

Following the remedy of the deficiencies to the application, if any or if such are not established, a copy of the application is sent to the proprietor of the trademark that is subject to the revocation attack, and the latter is given a three-month period to object thereto and submit evidence of the use of the trademark in the territory of the Republic of Bulgaria. In other words, the burden of proof in trademark revocation proceedings on the grounds of non-use is reversed.

If the proprietor of the trademark submits an objection and evidences of use, the latter are sent to the petitioner, who may respond within one-month term. In addition, the Dispute Department may request presentation of further evidence and materials from the parties *ex officio*, if necessary.

A decision on the application should be taken within three months after the collection of evidences and materials has been completed. The decision for revocation is issued by the Chairperson of the BPO based on the report prepared by the panel.

The decision for declaration of the revocation of a trademark is subject to an appeal before the Administrative Court of Sofia within three months term as of the notification of the decision. The same applies to the decision dismissing the revocation request.

The decisions of the Administrative Court of Sofia are further subject to a final cassation appeal before the Supreme Administrative Court.

III. Case Law

Since December 15, 1999 when the LMGI came into effect there have been only few court cases involving full or partial revocation of trademarks, and namely cases concerning revocation or upholding of decisions of the Chairperson of the BPO for revocation of trademark registration.

Below is a summary of the relevant cases.

1. Administrative Case No 2350/ 2007, Supreme Administrative Court

By decision No 86/ 27.05.2004 the Chairperson of the BPO has declared the revocation of CALGIN trademark, reg. No 22881 for the goods “*pharmaceutical preparations for human use*” of class 05, where the trademark has been registered for “*pharmaceutical preparations*” of class 05. The administrative body brought forth as an argument for the revocation the fact that the trademark has been used only in relation to the goods “*veterinary preparations*” of class 05, the latter included in the general term “*pharmaceutical preparations*”.

The proprietor of the trademark appealed decision No 86/ 27.05.2004 of the Chairperson of the BPO before the first instance court, i.e. Sofia City Court at the time.

Under administrative case No 3331/ 2004 the first instance court has considered whether the sale only of “*veterinary preparations*” as a part of the goods of class 05, for which the trademark is registered, may qualify as use of the trademark within the meaning of Article 19 of the LMGI. The court stated that the general term “*pharmaceutical preparations*” includes both “*pharmaceutical preparations for human use*” and “*pharmaceutical preparations for veterinary use*”. Although the sale covers only “*veterinary preparations*” it might be concluded that the trademark has been put to genuine use in respect of the registered goods of class 05.

Thus, the first instance court repealed decision No 86/ 27.05.2004 of the Chairperson of the BPO for the partial revocation of the trademark for the goods “*pharmaceutical preparations for human use*” of class 05.

As a result of the subsequent appeal of the first instance court decision, the Supreme Administrative Court upheld the decision thereof.

2. Administrative Case No 11419/ 2007, Supreme Administrative Court

By decision No 16/ 29.01.2003 the Chairman of the BPO has declared the revocation of ФАРМАЗИН trademark, reg. No 18304 for the goods “*pharmaceutical preparations for human use*” of class 05, where the trademark has been registered for “*pharmaceutical preparations*” of class 05. The proprietor has used the trademark upon production and export of “*veterinary preparations*”.

The petitioner, who filed the application for revocation of the trademark, appealed decision No 16/ 29.01.2003 of the Chairman of the BPO for partial revocation of the trademark before the Sofia City Court.

Under administrative case No 2398/ 2003 the first instance court has considered whether the sale of “*veterinary preparations*” as a part of the goods of class 05 may qualify as use of the trademark within the meaning of Article 19 of the LMGI. The court stated that the general term “*pharmaceutical preparations*” includes both “*pharmaceutical preparations for human use*” and

“pharmaceutical preparations for veterinary use” and irrespective of the fact the production and the export have been conducted only in respect of *“pharmaceutical preparations for veterinary use”*, it might be concluded that there is genuine use of the trademark in relation to these goods.

The first instance court dismissed the appeal of the petitioner. The petitioner has filed a cassation appeal against the decision of the first instance court.

The Supreme Administrative Court stated that the pharmaceutical preparations depending on their intended use are divided into *“pharmaceutical preparations for human use”* and *“pharmaceutical preparations for veterinary use”*. It has been proven that that the proprietor of the trademark has used it in respect of *“pharmaceutical preparations for veterinary use”* and therefore concerning these particular goods the prerequisites for revocation of a trademark as provided for by Article 19, par. 1 of the LMGI are not at hand. However, it has been also established that in respect of *“pharmaceutical preparations for human use”* the trademark has not been used within the meaning of Article 19, par. 1 of the LMGI.

The Supreme Administrative Court upheld the decision of the Sofia City Court on administrative case No 3331/ 2004.

IV. Conclusions and Comments

In the light of the above cases, it appears that the BPO has adopted restrictive approach upon taking decisions on partial revocation of a trademark, i.e. the list of goods or services shall be limited not only to particular general category such as “pharmaceutical preparations”, but the list of goods or services may be actually re-written in a limited form (i.e. limit “pharmaceutical preparations” to *“pharmaceutical preparations for veterinary use”* and delete *“pharmaceutical preparations for human use”*).

On the other hand, it is evident that there is no established court practice in Bulgaria on the interpretation of the statutory provisions concerning the partial revocation of trademark and respectively the decisions of the Chairperson of the BPO on identical cases.

CYPRUS

I. Statutory Provisions

Article 28 of the Cyprus Trade Marks Law Cap. 268 (as amended), provides as follows:

28. (1) A registered trademark may be taken off the register in respect of any of the goods or services in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of s. 49, to the Registrar, if:

(a) for a continuous period of five years it has not been put to genuine use by the proprietor in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use;

(b) following the date of its registration, the trademark has, in consequence of acts or inactivity of the proprietor, become a common name in the trade for a product or service for which it is registered;

(c) in consequence of use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services”.

(2) The registration of a trademark shall not be revoked on the ground mentioned in paragraph (a) of subsection (1), if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

Pursuant to s. 33 of the Law, the Registrar has a general power to rectify entries in the Register. Pursuant to s. 34, the Registrar has the power to expunge or vary registration for breach of a condition. Pursuant to s. 35(d), the proprietor or some person entitled by law to act in his name, may request from the Registrar to strike out any goods or classes of goods from those in respect of which a trademark is registered.

II. Procedural Issues

An application to the Registrar under any of the abovementioned sections is made on form T.M. No 26 and is accompanied by a Statement of Case setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. Upon filing such

Application, a copy thereof is transmitted to the proprietor of the trademark who then has two months within which he must file a counter-statement, setting out the grounds on which he relies in support of the registration.

Upon receipt of the proprietors' counter-statement, the applicant has two months within which to file such evidence by way of affidavit as he may desire to adduce in support of the application and must deliver to the proprietor of the mark copies thereof. If he fails to do so he will, unless the Registrar otherwise directs, be deemed to have abandoned his application. If he does file evidence, then within two months from its receipt the proprietor must file with the Registrar his evidence in support of the registration, delivering to the applicant copies thereof.

Within one month from the receipt by the applicant of the proprietor's affidavits, the applicant may file affidavit evidence in reply.

Upon completion of the exchange of evidence procedure, the Registrar issues directions regarding the filing of Written Addresses and, subsequently, the case is fixed for clarifications. The Registrar then proceeds with issuing his decision.

The decision of the Registrar in such proceedings being an administrative act is subject to an Administrative Recourse before the Supreme Court.

III. Case Law

We are not aware of any reported case in which a partial cancellation was filed by an aggrieved third party.

IV. Conclusion and Comments

In our opinion, problems might arise regarding the applicability of the relevant sections in cases where the specification of goods or services of a trademark is widely drafted, rendering it difficult for the Registrar or the Court to decide the precise extent to which such wide specification should be cut down.

EUROPEAN UNION

I. Statutory Provisions

Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark

Article 43 Examination of opposition

2. If the applicant so requests, the proprietor of an earlier Community Trade Mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community Trade Mark application, the earlier Community Trade Mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community Trade Mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community Trade Mark has been used in relation to only part of the goods or services for which it is registered, it shall for the purposes of the examination of the opposition be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trademarks referred to in Article 8 (2) (a), by substituting use in the Member State in which the earlier national trademark is protected for use in the Community.

Article 50 Grounds for revocation

1. The rights of the proprietor of the Community Trade Mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) if, within a continuous period of five years, the trademark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; ...

2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community Trade Mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

II. Case Law

1. European Court of Justice, judgment dated 15 January 2009, legal case C-495/07 - SILBERQUELLE

It follows that the referring court essentially asks whether Articles 10(1) and 12(1) of the Directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, that proprietor makes genuine use of that mark in respect of the class covering those items.

According to Maselli and the Czech Government, that question must be answered in the affirmative. Silberquelle, the Portuguese Government and the Commission of the European Communities take the opposite view.

It is settled case-law that 'genuine use' within the meaning of the Directive must be understood to denote actual use, consistent with the essential function of a trademark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (Case C-40/01 Ansul [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 Verein Radetzky-Orden [2008] ECR I-0000, paragraph 13).

It follows from that concept of 'genuine use' that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (Ansul, paragraph 37, and Verein Radetzky-Orden, paragraph 14).

As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class of goods or services only where that mark has been used on the market for goods or services belonging to that class.

For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

In such a situation, those items are not at all distributed with the aim of penetrating the market for goods in the same class. Under those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1)

and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items.

2. Court of First Instance, judgment dated 17 October 2006, legal case T-483/04, sections 26, 27 - GALZIN/CALSYN

It is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trademark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established (Case T-126/03 Reckitt Benckiser (España) v OHIM – Aladin (ALADIN) [2005] ECR II-2861, paragraph 44).

It follows from the provisions cited above that, if a trademark 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 sub-categories 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 sub-category or sub-categories to which the goods or services for which the trademark has actually been used belong. However, if a trademark 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 (ALADIN, paragraph 45).

3. Court of First Instance, judgment dated 14 July 2005, legal case T-126/03, sections 45, 46 - ALADIN/ALLADIN

It follows from the provisions cited above that, if a trademark 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 sub-categories 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 sub-category or sub-categories to which the goods or services for which the trademark has actually been used belong. However, if a trademark 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 trademarks 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 trademark 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 trademark 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 sub-categories.

4. Office for Harmonization in the Internal Market (Trade Marks and Designs), decision dated 25 October 2007, case 1897 C - SEBA MED

From Article 43 (1) 3 CTMR it follows that "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 sub-categories 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 sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong" (conf. decision dated 14 Juli 2005, T-126/03, Reckit Benckiser/HABM – Aladin, section 45). These observations made in opposition proceedings apply *mutatis mutandis* also for the proceedings before the Cancellation Divisions.

III. Conclusion and Comments

It follows from the above that according to the practise under Council Regulation (EC) No 40/94, if a trademark 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 sub-categories, proof that the mark has been put to genuine use in relation to a part of those goods or services, will afford protection only for the sub-category or sub-categories to which the goods or services for which the trademark has actually been used belong. However, if a trademark 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.

FRANCE

I. Statutory Provisions

By virtue of Article L 714-5 of the Intellectual Property Code, the owner of a trademark who without legitimate reasons has not made serious use thereof for the products and services in the registration for an uninterrupted period of five years is exposed to cancellation of his rights.

The same article states that if the request for cancellation relates to only a part of the products or services designated by the registration, cancellation shall only apply to those goods or services.

The following offers a brief examination on the implementation of the above provision in France in the context of non-use cancellation actions, oppositions, and enforcement.

Non-Use Cancellation

1. It is established case law that where evidence of use falls within one category only of goods or services claimed in the registration, cancellation will be pronounced for the other categories of goods.

Examples:

1. Registration covering clothing, footwear and headwear, and used only for items of clothing.

Such use will not save the registration from cancellation in respect of clothing and headgear (C.Paris 26.01.01).

2. Registration covering inter alia “products based on milk, or containing milk, yoghurts, cheese, iced creams”.

Evidence of use for products (other than cheese or iced cream) based on milk and for yoghurts, will not save the registration from cancellation in respect of cheese and iced cream.

(Cass com 21.01.04)

3. Registration covering perfumes and eaux de toilette, and used only for perfumes. Such use does not save the registration from cancellation in respect of “eaux de toilette”.

(TGI Paris 12.12.00)

4. Registration covering plant based nutritional supplements, cosmetics and perfumes, and used only for nutritional supplements. Such use does not protect the registration from cancellation in respect of perfumes and cosmetics.

(Cass Com 17.10.06)

In all the above decisions, and there are many others, the goods for which cancellation was pronounced, and the goods for which evidence of use was produced, were designated separately and distinctly in the registration.

A French Court will not, however, partially cancel beyond such distinct claims, and “rewrite” the specification.

Thus, a registration covering optical apparatus and instruments in class 9, and used for magnifying classes, was found to be used for optical apparatus and instruments, and cancellation was rejected for the latter (C. Paris 01.03.02).

2. Thus, if in the decision first cited, the evidence of use for clothing was limited to use for men’s trousers, such use amounts to use for clothing, and saves the registration from cancellation for “clothing”.

Had, on the other hand, the registration listed, distinctly, trousers, suits, skirts, socks, evidence of use for trousers only would have led to cancellation for suits, skirts, socks.

3. The rule is thus that partial cancellation can lead to cancellation for all goods and services in the registration, leaving only the narrowest category of goods or services listed, to which use corresponds.

But a court will not, in the light of current case law, narrow the scope of goods or services, beyond that category, and “rewrite” the specification, beyond the narrowest subcategory in the list.

(1) Opposition

The applicant for a trademark that is being opposed on the basis of an earlier trademark that has been registered for over 5 years can call for evidence of use. If no evidence is produced within the prescribed deadline, the opposition is terminated.

If evidence is produced, it is notified to the applicant. The applicant may, in the light of such evidence, commence court non-use cancellation proceedings against the opposing rights. Such proceedings suspend the opposition.

If the Court subsequently part cancels the opposing registration, the opposition will be based only on the subsisting goods or services.

If no cancellation action is introduced, the opposition procedure continues, and the earlier right is deemed to cover all the goods and services in the registration.

There is thus no equivalent, in French legislation, to Article 43 (2) CTMR.

(2) Judicial enforcement

1. The defendant in an infringement action can counterclaim for non-use cancellation or part cancellation of the earlier right.

2. The Court will first decide on the cancellation counter-claim, applying the principles referred to in paragraph 1 above.

3. There is no equivalent under French law to Article 96 (5) CTMR (to be read in conjunction with Article 56 (2) and 43 (2) CTMR).

In other words, either an earlier right is cancelled or part cancelled following a counterclaim, applying the principles of paragraph 1 above, or it is not and the earlier right is deemed to cover all subsisting goods in the registration.

There is no provision that entitles a Court, faced with a counterclaim for partial revocation for non-use, to deem, as between the parties, the earlier right to be registered for a narrower category or goods or services than the narrowest relevant category expressly listed in the registration.

III. Conclusion

It is obvious from the above that there is considerable advantage, in France, in using relatively broad categories of goods or services, as use for one product or service falling clearly within such a category will protect the registration from non-use, and preserve its enforceability, for the whole category.

There are also dangers in being too broad, in cases where the product for which use is shown does not come clearly within a category contained in the registration. Thus, for example, use for

batteries may not be regarded as covered by electrical products. Use for engine pistons would not be regarded as falling within “motor vehicles”. Thus, where the applicant wishes to cover goods or services that do not clearly fall within one of the several categories of goods in the general classification, then it should describe its product clearly.

GERMANY

I. Statutory Provisions

German Trademark Act

Section 26 Use of Trademarks

(2) Insofar as the assertion of claims resulting from a registered trademark or the maintenance of the registration depends on the fact that the trademark has been used, it must have been used genuinely by the proprietor in the Federal Republic of Germany in connection with the goods or services in respect of which it is registered, unless there are proper reasons for non-use.

Section 49 Liability to Revocation

(3) The registration of a trademark shall, upon application, be cancelled because of liability to revocation, if, after the date of registration, the trademark has not been used in accordance with Section 26 within a continuous period of five years. However, no person may claim that the proprietor's right in a trademark should be revoked where during the interval between expiry of the five year period and filing of the application for cancellation, use of the trademark in accordance with Section 26 has been started or resumed. The commencement or resumption of use subsequent to a continuous period of five years within three months preceding the filing of the application for cancellation, shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor of the trademark becomes aware that the application for cancellation may be filed. If the application for cancellation is filed with the Patent Office pursuant to Section 53, Subsection 1, the application filed the Patent Office shall remain decisive for the calculation of the period of three months according to sentence 3, provided that the legal action for cancellation pursuant to Section 55, Subsection 1, is instituted within three months after service of the notification pursuant to Section 53, Subsection 4.

(5) Where grounds for liability for revocation exist in respect of only some of the goods or services for which the trademark is registered, cancellation of the registration shall cover those goods or services only.

II. Procedural Issues

From the above statutory provisions, it is clear that use of a trademark must be evidenced in two proceedings. On the one hand, evidence of use must be provided in opposition procedures. If no evidence is provided, the opposition will be lost for that reason alone. On the other hand, evidence

of use must be provided if a request for cancellation is filed after a grace period of five years after registration. This request may be filed with the German Patent- and Trademark Office. If the proprietor does not object to this request, the trademark will be cancelled. If the proprietor objects, the request must be brought before a competent civil court.

III. Case law

1. Federal Supreme Court, decision dated April 10, 2008, legal case I ZR 167/05 – LOTTOCARD

In cancellation proceedings based on non-use, where a trademark is genuinely used for a part of goods or services falling under a broader term, the trademark shall not be restricted to only those specific goods or services where evidence for use has been provided. Instead, the trademark shall be maintained also for those goods and services that are considered by the public as belonging to the same area of goods.

2. Federal Supreme Court, decision dated October 18, 2007, case no. I ZR 162/04 - AKZENTA

The Court of Appeal has correctly assumed that use of a trademark may only be considered genuine and suitable for maintaining the 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 by allowing the public to differentiate the goods or services originating from a different undertaking. For that purpose, it is necessary and sufficient that the trademark be used in a way that is common and economically reasonable for those goods for which the trademark is registered. Furthermore, the Court of Appeal has correctly assumed that there is no genuine use where the sign is used exclusively as company name and not at least also as trademark for the relevant product that is actually being sold. With trademarks registered for services, the question of genuine use must be considered bearing in mind, in particular, that contrary to the situation with a trademark registered for goods, a physical connection between the trademark and the services is not possible. Therefore, as acts of genuine use, the only use that may be considered is use of the sign at the place of business as well as on other objects that are being used on the occasion of the supplying of the services like, in particular, professional clothing, business letters and business papers, prospects, price lists, invoices, announcements and advertising material. Therefore, it is necessary that the public will understand the sign at least also as indication of origin. The public must be able to see that with the use of a sign not only the business is designated but also the service provided by it. Furthermore, use must refer to a specific service. This requires that the public can see to which service use of the sign actually refers.

Based on the observations made so far, it cannot be ultimately decided whether a partial cancellation of the trademark in question with respect to the very broad term “insurance” should in

fact be considered. According to the explanations above under Section II 2, the trademark in question has, however, been used as indication of origin for the service “arranging of insurance” that is expressly covered by the broad term. Whether the trademark has also been used for other services in the area of insurance services cannot be determined based on the observations made so far.

3. Federal Supreme Court, decision dated June 29, 2006, case no. II ZR 110/03 - Ichthyol II

If the prior trademark is only used for part of the goods that it is registered for, then the trademark will be considered as being registered only for these goods for the purpose of evaluating similarity of goods in case of a dispute. If there is no specific term that may be collectively used for different areas of application for pharmaceutical products designated with the trademark, only the respective product in its respective area of application may be considered for the evaluation similarity of goods. It is irrelevant in how far non-use would have to result in part-cancellation of the mark.

4. Federal Supreme Court, decision dated May 17, 2001, case no. I ZR 187/98 - ISCO

The restriction of a broad term registered in the list of goods of a trademark may be carried out also under the new German Trademark Law if the trademark is only being used for a part of the goods that fall under the broad term (Section 49 Subsection 3 German Trademark Law).

From a legal point of view, the assumption of the Court of Appeal is correct that a limitation of the registered broader term may have to be carried out if the trademark is only being used for part of the goods that fall under that broader term. If a trademark is only being genuinely used for part of the goods, the trademark will nevertheless not necessarily have to be strictly limited to the goods that have actually been used. The required economic view and the legitimate interest of the proprietor of the sign not to be overly restricted in his business activities justify that, besides the actually used goods, also those goods are left in the list of goods that are generally considered by the public as belonging to the same area of goods. On the other hand, it is not justified to maintain a broad term in the list of goods only because the actually used product falls into the category of this broad term. In this case, it may be considered to maintain the broad term while limiting it to only those goods that have actually been used (see previous decisions rendered under the previous trademark law: FSC decision dated June 7, case no. I ZR 125/76, GRUR 1978, 647, 648 = WRP 1978, 813 – TIGRESS; FSC, decision dated July 13, 1989, case no. I ZR 157/87, GRUR 1990, 39, 40 - Taurus; FSC, decision dated April 21, 1994, case no. I ZR 291/91, GRUR 1994, 512, 515 = WRP 1994, 621 - Simmenthal).

The introduction of the requirement of genuine use was intended to improve the possibility to

register trademarks in the interest of all new applicants of signs and therefore the whole economy while at the same time reducing the work load of the German Patent and Trade Mark Office. In order to prevent that an incentive is given to apply for registration of signs not only for those goods for which the sign shall be used but also for all goods similar in kind, use of the sign for certain goods shall not be considered use of that sign for goods similar in kind (see FSC decision dated June 7, case no. I ZR 125/76, GRUR 1978, 647, 648 - TIGRESS; 1990, 39 - Taurus).

(Thus, genuine use for optical checking apparatus and instruments, optical measuring apparatus and instruments by use of closed-circuit television was denied.)

5. Federal Supreme Court, GRUR 1990, 39, 40 f. - TAURUS

Goods and services may be considered similar in kind where they correspond in their characteristics and their purpose of use.

IV. Conclusion and Comments

With respect to cancellation of a trademark for non-use, Section 49 Subsection 3 German Trade Mark Law establishes the principle that where a trademark is only used for some of the goods or services for which the trademark is registered, the trademark shall not be cancelled completely but only with respect to those goods or services that have not been used. The registration may, however, also be maintained for goods and services that are generally considered by the public as “belonging to the same area of goods”. However, genuine use will not be assumed for goods that are merely “similar in kind” to those goods that have actually been used. This approach is called “extended minimal solution”.

GREECE

I. Statutory Provisions

1. The Greek Law No 2239/1994 on Trademarks, under which the Directive 89/104/EEC was implemented into the Greek legal regime, explicitly provides for a partial cancellation of a trademark registration (Art. 18§1), provided that a person showing a legitimate interest filed that cancellation action (Art. 18§5).

2. The grounds on which a Greek trademark registration is liable to cancellation are the following (Art. 18§1, headings a-e) :

(i) if for a continuous period of five years (starting from its registration date or anytime afterwards) the trademark at issue has not been put to genuine use in Greece in connection with the goods or services in respect of which it is registered.

(ii) the proprietor of the trademark has ceased doing business in respect of the goods/services covered by that trademark.

(iii) the trademark became the common name or of common use in respect of the goods/services for which it has been registered due to its proprietor's acts or omissions.

(iv) in consequence of the use made of it by the proprietor of the trademark or with his consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(v) on the basis of either absolute or relative grounds of registrability provided by Arts. 3 and 4 of the Greek Law on Trademarks within five years from the trademark's registration, unless that trademark constitutes a bad faith filing, in which case the abovementioned deadline does not apply (Art. 17§6).

3. It is notable that Greece has not exercised its discretion to implement Art. 11§3 of the Directive 89/104/EEC, under which a trademark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trademark could be revoked pursuant to Art. 12(1) of said Directive, already provided under Art. 17§1 of the Greek Law No 2239/1994 on Trademarks.

4. Furthermore, under Art. 18§1 the registered trademark confers on its proprietor exclusive right therein, which, among others, means that its proprietor is entitled to prevent any third party to use in the course of trade signs, which constitute an imitation or infringement *stricto sensu* of the trademark pursuant to Art. 4§1 of the same Law on Trademarks.

In this respect, it has to be noted that Art. 4§1 of the Greek Law on Trademarks is equivalent to Art. 4(1) and 4(2)(d) of the Directive 89/104/EEC as far as the wording is concerned, where the terms “imitation” and “infringement” *stricto sensu* are mentioned, but the term “likelihood of confusion” is mentioned instead. However, it is well established under Greek case law that the former terms fall unexceptionally, as a matter of interpretation, within the scope of the trademark’s registrability as prescribed by the abovementioned provisions of the Directive 89/104/EEC. More specifically, it has been repeatedly held that infringement *stricto sensu* of a trademark constitutes the servile, in respect of the principal elements, copy of that trademark, whereas imitation constitutes a special proximity to the trademark, which, assessed from the overall visual and phonetic impression rendered by the trademark, irrespective of the partial similarities or differences of the marks under comparison, may cause a likelihood of confusion on the part of the consumers regarding the origin of the designated goods or services from a specific business undertaking (*inter alia* Council of the State 1753/1998, 2812/1998, 859/2000, 914/2001 345/2001).

5. Finally, pursuant to Art. 7 of the Greek Law on Trademarks, the Applicant has the right until the hearing of the case before the Administrative Court of Appeals to proceed with restricting the specification of goods or services, as filed with the Trademarks Registry.

6. This report will mainly deal with issues of concern relating to that specific remedy of partial cancellation and not with issues of concern, which may be attributed to a cancellation action against a Greek trademark registration in general, either a partial or a full one, unless such an issue reflects “tricky” points of Greek legal practice as far as the discussed topic is also concerned.

In this respect, the following factors are of considerable importance:

- (i) the specification of goods or services as filed with the Trademarks Registry.
- (ii) the legitimate interest of a third party to seek partial cancellation of the trademark concerned.
- (iii) the discretion of the Trademarks Administrative Commission or of the Administrative Courts to “rewrite” the specification by upholding the claimant’s request.

II. Procedural Issues

1. Administrative Procedure

Partial cancellation of a Greek trademark registration may only be sought before the Trademarks Administrative Commission (TAC) pursuant to Art. 17§1 of the Greek Law on Trademarks on the grounds prescribed therein. Against TAC's relevant Decision an appeal may be filed before the Administrative Court of First Instance (Art. 13). Against the judgment rendered at first instance, a further appeal may be filed before the Administrative Court of Appeals (Art. 92 of the Administrative Code of Civil Procedure). Finally, against the latter judgment, a revision petition may be filed before the Council of the State (StE) according to Art. 53 of the Presidential Decree No 18/1989.

2. Civil Procedure

Pursuant to Art. 32§1, the Civil Courts have no subject matter jurisdiction, where such a jurisdiction is confined under this law to the Trademarks Administrative Commission and the Administrative Courts. In addition, pursuant to Art. 32§2 all irrevocable Decisions and Judgments of the abovementioned State Authority and Administrative Courts are binding for the Civil Courts and any other Authority.

Therefore, a Civil Court has no jurisdiction to declare a trademark, either partially or fully, cancelled. However, if the trademark invoked in trademark infringement proceedings is vulnerable to a cancellation action, the defendant may raise the objection of an abuse of process (Art. 281 of the Greek Civil Code), which, if sustained, leads to the rejection of the civil action, but not to the cancellation of the trademark concerned. Such a cancellation action may concurrently be launched, in which case the Civil Court has the discretion to order stay of proceedings until a final judgment is rendered on the cancellation action (Art. 249 of the Greek Code of Civil Procedure).

III. Case Law

1. There are no reported cases in Greek IP law journals regarding legal proceedings of partial cancellation of a trademark, which deal with the factors mentioned under (1.6) of the present report. In practice, many cases end up with an out-of-court settlement, under which the Applicant undertakes to restrict the specification of goods/services of the trademark under cancellation. This presupposes that the specification filed was broad enough, as filed in the first place, so that the Applicant could freely proceed accordingly without putting its legal interests in jeopardy .

2. In some instances, however, TAC seems to accept that even if the Applicant has filed a broad specification of goods/services, such a specification may remain intact against a cancellation

action request, provided that the Applicant has succeeded in showing genuine use of solely some goods/ services, which fall within the (broad) specification of the trademark, as filed in the first place.

In particular, under Decision No 2910/2002 TAC rejected a cancellation action for non-use against a trademark registration designating goods of classes 3 and 5, i.e. “perfumery, cosmetics, namely fragrances and air-freshening preparations”, whereas the Claimant was seeking to have the trademark cancelled for “perfumery and cosmetics” and the Applicant showed genuine use of “perfumed tissues, perfumes, perfumery, perfumed soaps, perfumed paper and body lotions”.

Theoretically, TAC could have accepted the cancellation action in respect of goods in classes 3 and 5 for which genuine use had not been shown and restrict accordingly the trademark under cancellation action to those goods, for which genuine use was shown. In essence, TAC denied “rewriting” of the specification of goods and the (broad) specification of the goods at issue survived.

3. In other instances, TAC seems to uphold its discretion to “rewrite”. In particular, trademark “E....” was filed for goods of classes 07, 09 and 11, i.e. gas and dual fuel or both burners, heating boilers for gas, dual fuel or both burners and for solids, atmospheric gas burners and gas boilers operating by atmospheric burners, heating plants, heat distributors, regulating and control apparatus, hydraulic distributors, centrifuged pumps and parts thereof, hot water storage apparatus and hot water generating installations, pumps, valves for heating installations, solar collectors, solar heating installations. A part cancellation was filed against said trademark with a request that said trademark be cancelled for all designated goods “except burners”. TAC dismissed the above mentioned remedy under its Decision No 9431/2006 as “vague” on the grounds that the Claimant did not adequately specified which of the abovementioned goods constitute “burners” in order for the rest to be deleted.

Although dismissed on procedural grounds said Decision revealed that TAC was inclined to proceed with “rewriting” the specification at issue, which notably was a detailed and not a broad one, but technical complexity was an obstacle, which could not overcome given that relevant claim for cancellation was not helpful in this regard as well.

4. On the other hand, pursuant to Art. 17§5 of the Greek Law on Trademarks, the person seeking to have the trademark at issue cancelled must show a legitimate interest. In this regard, it was held that a person with an intention to use a trademark, which is identical with or similar to an earlier trademark under cancellation for goods identical with or similar to the ones covered by the latter, lacks legitimate interest, provided that this person has filed its subsequent trademark in bad faith (StE 4494/2001).

IV. Conclusion and Comments

1. In view of the above, it seems that in legal proceedings regarding partial cancellation of a trademark registration much depends on the specific facts of the case as well as on the corresponding general principles of Trademark Law applicable, which are rather flexible and open-ended. Additionally, any difficulties that may arise in this context refer not only to the Applicant's chosen specification of goods or services, when applying for the trademark at issue, but also to how broad may be considered to be the discretion of TAC to "rewrite" said specification and, finally, how broad is the legitimate interest of the party seeking the cancellation to challenge the trademark registration at issue.

2. Firstly, one may reasonably argue that if the trademark was filed for various goods or services which are similar to one another, it is not possible to be cancelled for those goods or services from said specification which are not in genuine use. The opposite would run contrary to the Applicant's lawful right to exclusively use the trademark at issue, which includes the Applicant's right to prevent any third party to use in the course of trade signs, which constitute an imitation or infringement *stricto sensu* of the trademark (Art. 18§3).

For instance, if the trademark was filed for milk, yoghurt and ice-cream and genuine use has been shown for milk and yoghurt, that trademark should not be cancelled for ice-cream as well, provided that the Applicant may successfully show that its adversary's subsequent mark designating ice-cream could cause a likelihood of confusion on the part of the public.

This is in line with a desirable balance of convenience, according to which a slightly "dormant" trademark in respect of some goods/services would be preferable than a co-existence of two trademarks designating similar, though not identical, goods, which may cause a likelihood of confusion on the part of the public or, at least, runs contrary to good trade morals. At the end of the day, the Applicant may reasonably expect to enjoy protection not only for the "hard core" of its specification but also for a reasonably defined "grey area" surrounding the core of its business activity to which may *a fortiori* expand in the future.

3. On the other side, the person seeking a partial cancellation may not exclusively rely on a straightforward and rather rigid analysis, which solely connects the specification of goods of the trademark under cancellation with evidence of genuine use provided by the Applicant without any further evaluation.

This is also in line with a desirable balance of convenience as mentioned under (4.2) of the present. Ideally, non-(genuine)use for specifically identified goods or services of an earlier trademark registration should not suffice in partial cancellation proceedings, if the Claimant is not in

position to show a legitimate interest. In this context, what is really has to be examined is not whether genuine use for specific goods or services has been shown but why the Claimant wishes to use the specific mark or have this mark registered despite the fact that an earlier mark of concern already exists.

To elaborate in the example given above under (4.2), the ultimate test would be whether, for instance, one trademark "MONICA" for milk and yoghurt and one trademark "MONICA" for ice-cream in the name of different proprietors could co-exist without a likelihood of confusion on the part of the public.

4. Do all the above mean that TAC has a discretion to re-write the specification of goods or services of the trademark under cancellation? One may reasonably answer that this would be the only effective way to draw the desirable balance of convenience. It does not necessarily mean though that such a discretion could invariably be a broad one. In fact, the broader the specification in question is, the broader such a discretion should be, provided that the Applicant fails to successfully address and show likelihood of confusion on the part of the public or bad faith on its adversary's part, in which case the cancellation action should be dismissed and TAC's discretion should not be exercised.

However, as a matter of strategy, it seems preferable for the Applicant to choose broad specification of goods or services, not only because proof of use for some of the goods may save the whole specification, but also because it gives the Applicant the opportunity to voluntarily restrict that specification in consideration of an out-of-court settlement. This virtually means that the Applicant enjoys a very broad trademark protection for as long as someone does not decide to challenge the particularly trademark and then again it is on the Applicant to flexibly negotiate before cancellation proceedings carry on.

5. As in almost all important trademark related issues, flexible and open-ended notions such as "legitimate interest", "likelihood of confusion", "bad faith", "course of trade" have an important role to play. In that way, one could reasonably expect that depending on the individual facts of each case, the competent authority before which a case is to be heard, may deliver a just and fair ruling by properly applying the relevant legal principles.

6. To that end, drawing a set of guidelines would help, since sophisticated goods or services, complexity of technical issues, advanced marketing analysis etc, may well raise difficulties even where the trademark law basics would *prima facie* suffice for a case to be decided.

7. As a matter of procedure, it would be good to be clarified that the burden of proof lies on the Applicant to show that even if genuine use has not been shown, the cancellation action should fail on the basis that the Claimant lacks a legitimate interest for a specific reason. In that case, the burden of proof actually reverses, since in principle, it is on the Claimant to prove its legitimate interest, which according to Greek law is requisite that the administrative or judicial body should ex-officio examine. However, in the case of a part cancellation and provided that the Applicant failed to show genuine use for specific goods or services, it would be just and fair that the Applicant successfully show the reason for which the part cancellation action should nevertheless fail.

IRELAND

I. Statutory Provisions

The relevant statutory provision is Section 51(5) of the Trade Marks Act, 1996, which is set out below:

“Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.”

There are no other additional relevant statutory provisions relating to partial cancellation.

The onus is on the trademark proprietors to prove that they have used the registered trademark in relation to the goods/services for which it is registered and, if the latter fails to do so in respect of any of the respective goods/services then the registration will be revoked to the extent that it covers such goods/services.

II. Procedural Issues

1. Administrative Procedure

An application for revocation to the Controller at the Irish Patents Office should contain a statement of the grounds for which the application is made and must be accompanied by the prescribed fee. Within three months of the issue by the Controller to the proprietors of a copy of the application, the proprietors may file a Notice of Opposition with the Controller and the Controller shall send a copy thereof to the Applicant. The proprietors shall file with the Notice of Opposition evidence of use by them of the mark and upon failure to do so, the Controller may dismiss the opposition and grant the application. The Controller may require the submission to him/her of any further evidence or statement within such time as he/she may decide. Upon the completion of the documentation, the Controller will then offer both parties an opportunity to be heard at an oral Hearing.

If proceedings concerning the trademark in question are pending in the Court, the application must be made to the Court. If in any other case the application is made to the Controller, the Controller may at any stage of the proceedings refer the application to the Court.

2. Civil Procedure

Alternatively, an Applicant may apply directly to the High Court with similar evidence being submitted by the parties. Upon completion of the evidence the matter will be argued in open Court.

III. Case Law

As far as we are aware, no case concerning part cancellation has been heard by the Irish High Court. The matter has only briefly been discussed in two decisions handed down by the Irish Patents Office. The first case relates to “In the matter for Application for Revocation of the Register of Trade Mark No. 155890” (The Professional Golfer’s Association vs Ladies Professional Golf Association) which held that even though partial revocation was not pleaded (i.e. the Applicant had sought total revocation), the Hearing Officer found that there was no requirement on an Applicant for revocation specifically to request revocation in respect of each and every one of the goods/services for which a mark stands registered or risk seeing the application fail if the proprietors prove that the mark was used in relation to only some of the goods/services.

The other case concerns “In the matter for Application for Revocation of the Register of Trade Mark No. 159959” (Travel Hurry Projects Limited vs Stefcom S.p.A.) where the Hearing Officer found that use of a trademark on shoes only was sufficient to prevent the registration covering “clothing, including boots, shoes and slippers” from being revoked.

In the light of the above cases and despite the ruling in the earlier case, it is important to identify the exact goods/services against which revocation is sought and failure to do so may mean the proprietors will simply furnish evidence of use in respect of certain goods/services and defeat the entire action since in the case of a wide specification, it is unlikely that the proprietor will be called upon to provide evidence of use in relation to the entire specification. The revocation should probably define the scope of the relief sought. However, in view of broad specifications, a Court may be prepared to limit the specification in such a way as to have proper regard to the use that the proprietors have in fact made.

IV. Conclusion and Comments

If the trademark has only been used in relation to some of the goods/services, the registration will be removed in relation to those goods/services in respect of which the trademark has not been used. However, if there is a general description such as “confectionery” and the trademark has only been used in relation to a chocolate bar, the proprietors will probably not be requested to restrict the registration to “chocolate bars” but may retain the general wording “confectionery”.

ITALY

I. Statutory Provisions

Cancellation on a non-use basis was introduced in Italy in 1942 and although partial cancellation has since then been considered admissible both by judges and in doctrine, it was expressly introduced only in 1992, when the Italian Trademark Law was substantially amended in order to reflect the EU Trademark Directive. Presently, the new IP CODE dated 2005 provides for the following general principles:

Art. 24. Use of the mark

1. Being otherwise subject to cancellation, a trademark must be actually used by the proprietor or with his consent for the goods or services for which it is registered within five years from registration and such use should not be suspended for an uninterrupted period of five years, unless non-use is justified by proper reasons.

Art. 27 Partial cancellation or invalidity

If the grounds for cancellation or invalidity of a trademark exist only for some of the goods or services for which the mark is registered, then cancellation or invalidity shall relate to those goods or services only.

In Italy there is no administrative procedure relating to invalidity or revocation of trademarks and cancellation under Art. 24 can only be made within a court proceeding. Most often cancellation will be raised by a defendant by way of a counterclaim in infringement actions brought by the trademark owner, and will be decided by the court competent for the infringement issue.

As a matter of fact, in practice the infringement issue and the partial cancellation issue are strictly linked and decided on the basis of the same criteria, namely the similarity between the relevant goods/services.

II. Case Law

As Italy is not a common law country, case-law is only readily available when it is reviewed. Unfortunately it was necessary to go back until the '70s to find a significant number of cases. Below are cases reviewed by the most important journal of industrial property case-law, namely "Giurisprudenza Annotata di Diritto Industriale" (also known as GADI).

1. Court of Appeal, Milan, 1972

For the purpose of determining the actual scope of protection granted to the trademark owner, an interpretation of the system according to which it may be restricted within limits conceptually smaller than those indicated in the registration certificate, with respect to the kind of goods for which the mark has been granted, and in particular to one single product among those indicated in the certificate, is arbitrary.

This case related to a mark registered for pharmaceuticals and used for a specific pharmaceutical. Actually non-use was not an issue in this case. Nevertheless the decision is worth mentioning, because the principles stated therein have been recalled in subsequent cases relating to possible partial cancellation.

2. Court of First Instance, Rome, 1983

A restriction of the scope of protection of a mark by means of partial cancellation due to non-use is admissible. Said cancellation, however, can only refer to products being completely different from those for which the mark has been used, certainly not to similar goods, let alone goods belonging to the same commercial category.

As mentioned above, the first statement would now be superfluous since partial cancellation is provided for by law. As regards the second statement, it should be noted that the specific question was whether a trademark which had been used for sports shoes could be partially cancelled for other kind of shoes.

3. Court of First Instance, Milan, 1992

A restriction of the scope of protection of the mark due to partial cancellation on the basis of non-use is possible only with respect to goods being completely different from those for which the mark has been used, not for similar goods or goods belonging to the same commercial category.

The specific question was whether a trademark which has been used for shirts could be partially cancelled for clothing other than shirts in class 25.

4. Court of Appeal, Milan, 1994

It is not possible to declare the partial cancellation due to non-use of a mark for "casual clothing", since casual clothing does not enjoy actual autonomy within the category of clothing.

5. Court of First Instance, Turin, 1996

(...) Partial cancellation (due to non-use) cannot be evaluated independently from actual similarity between the products. As a consequence, use of the mark for one of the goods for which the mark has been registered bars partial cancellation with respect to goods similar thereto.

The specific question was whether a trademark used for biscuits could be cancelled partially for “panettoni” (typical north-Italian Christmas cakes).

6. Court of Appeal, Milan, 1998

Partial cancellation of a trademark for goods in class 33 should be excluded, if said mark has been used for oil, since the potential development of a firm marketing oil includes the marketing of wine.

7. Court of First Instance, Milan, 2001

Partial cancellation of a trademark cannot be declared with respect to goods similar to those for which the mark has actually been used. In the specific case, the partial cancellation was rejected for procedural reasons, but the court nevertheless made a statement of principle.

8. Court of First Instance, Verona, 2001

Partial cancellation on the basis of non-use is possible only with respect to goods being completely different from those for which the mark has been used. Accordingly, use for food for some specific animal is sufficient to avoid cancellation of the mark registered for “animal food” in general.

In the specific case the mark was used for cats and dogs food, and the question was whether it could be cancelled for other animal food.

IV. Conclusion and Comments

None of the above decisions expressly discusses whether by partial cancellation it is only possible to delete some goods (e.g. delete footwear from the list “clothing, footwear”) or on the contrary the list may actually be re-written in a limited form (e.g. limit “road vehicles” to “bicycles”, cancelling all road vehicles other than bicycles).

It seems, however, that the implicit answer is that the list may be re-written. As a matter of fact, it is discussed whether clothing can be limited to “casual clothing”, whether clothing can be limited to shirts, whether shoes can be restricted to “sports shoes”, whether “animal food” can be limited to “cats and dogs animal food”. There is however no question of whether the limitation can be made

in principle, but only whether it is sensible in the specific case.

Another reason why re-writing of a list of goods is likely to be considered admissible is that partial cancellation is dealt with by courts. Judges have considerable powers and it is unlikely that a judge will consider himself not in a position to re-write a list of goods.

To summarize, in all the cases mentioned, it appears that in order to decide whether partial cancellation of some goods is admissible, reference should be made to similarity between goods. It seems that the question whether a mark registered for example for “road vehicles” and used for bicycles can be partially cancelled for the rest of road vehicles, in fact should be treated exactly in the same way as if the mark were registered for a more detailed list such as “automobiles, motorcycles, bicycles”. In both cases the entire issue should be reduced to the question “are bicycles similar to automobiles?”.

PORTUGAL

I. Statutory Provisions

According to the Portuguese Industrial Property Code, approved by the Decree-Law N° 36/2003, of March 5, a trademark registration is subject to cancellation if, without legitimate reasons, has not been seriously used, for the products and services covered by the registration, for an uninterrupted period of five years.

If the request for cancellation relates only to a part of the products or services designated by the registration, cancellation shall only apply to those goods or services.

Aside from non-use there are some other reasons to cancel trademarks registrations.

In general, one may safely say that in most cases, it is possible to cancel a trademark registration only regarding certain goods or services: Art. 269, n° 6 clearly provides that *where there are grounds for the lapse of the registration of a trademark, only in respect to some of the goods or services in respect of which the same has been made the lapse shall only encompass those products or services.*

The provisions regarding cancellation of trademarks registrations, including partial cancellation are included in the Portuguese Industrial Property Code:

Article 244, Partial refusal

Wherever there are grounds to refuse the registration of a trademark solely with regard to some of the goods or services for which the same has been applied for, the refusal of the registration shall concern only such goods or services.

Article 265, Nullity

1. In addition to what is provided under Article 33, the registration of a trademark is null where, on its grant, an infringement has occurred:

- a) on paragraphs a) to c) of no. 1 of Article 238;
- b) on paragraphs a) to e) and i) to l) of Article 239.

2. It is applicable to the actions for nullity, with the necessary adaptations, the provision of no. 3 of Article 238.

Article 266, Voidability

1. In addition to what is provided under Article 34, the registration of a trademark is voidable:
 - a) where, on its grant, there have been infringed the provision of Article 226, of paragraphs f) to h) and m) of Article 239 and of Articles 240 to 242;
 - b) where it is recognized that the holder of the registration intends to enter into unfair competition, or that the same is possible irrespectively of its/his indication.
2. The person interested in the cancellation of the registration of the trademarks on the ground of the provision of Articles 241 or 242 should apply for the registration of the trademark which originates the application for annulment, for the goods or services which impart the well-known character, or reputation, respectively.
3. The registration cannot be annulled if an earlier trademark, claimed in the opposition, does not satisfy the conditions of a serious use, under the terms of Article 268.
4. The actions for annulment should be brought within the term of 10 years running from the date of the decision of grant of the registration, without prejudice of the right to ask for the annulment of the registered trademark on bad faith, which shall be not prescribe.

Article 268, Use of the trademark

1. It is deemed a serious use of a trademark:
 - a) The use of the trademark such as same it is registered or which does not differ only in elements which does not alter its distinctive character in accordance with the provision of Article 261, carried out by the holder of the registration, or its licensee, under a duly endorsed licence;
 - b) The use of the trademark, such as defined in the preceding paragraph, for goods or services solely intended for export;
 - c) The use of a trademark by a third party, provided such use is carried out under the control of the holder and for the purpose of maintaining the registration.
2. It is deemed as use of a collective trademark the one which is carried out under the holder's consent.
3. It is deemed as use of a guaranty or certification trademark, the one, which is carried out by a skilled person.
4. The commencement or resumption of a serious use within three months immediately before the filing of an application for declaration of lapse, running from the end of the uninterrupted period of

five years of non-use, shall not, however, be taken into consideration if the preparatory steps for the commencement or resumption of the use shall only occur after the holder has become aware that such application for declaration of lapse may be effect.

Article 269, Lapse

1. In addition to what is provided under Article 37, lapse of a registration should be declared if the trademark has not been the object of a serious use during five consecutive years, except for a just reason and without prejudice of the provision of no. 4 and of Article 268;
2. It should furthermore be declared the lapse of the registration if, after the date when same has been effected:
 - a) the trademark has become the common name in the trade of the product or service for which has been registered, as a consequence of the activity, or inactivity of the holder;
 - b) the trademark becomes liable to mislead the public into error, namely as to the nature, the quality or the geographical origin of those goods or services, further to the use of the trademark by its/his holder, or by a third party with its/his consent in respect of the goods or services for which it has been registered.
3. The lapse of the registration of a collective trademark should be declared:
 - a) if the legal entity in whose name the same was registered ceases to exist;
 - b) if the legal entity consents that the trademark being used in a way contrary to its general purposes or to the provisions of its by-laws.
4. The registration does not lapse if, before the declaration of lapse having been applied for, the serious use of the trademark has already been commenced or resumed, without prejudice of what is provided under no. 4 of the preceding article.
5. The time limit as referred under no. 1, shall begin with the registration of the trademark which, for international trademarks, shall be taken as the date of registration of the same at the International Bureau.
6. Where there are grounds for the lapse of the registration of a trademark, only in respect to some of the goods or services in respect of which the same has been effected, the lapse shall only encompass those products or services.

Article 270, Applications for declaration of lapse

1. The application for declaration of lapse shall be filed before the National Institute of Industrial

Property.

2. Those applications can be based on any of the motives set under nos. 1 to 3 of the preceding article, or which indicts the non-use of the trademark and its non-opposability to third parties.
3. Without prejudice of what is provided under no. 5, the holder of the registration should always be notified of the application for declaration of lapse to reply, if he wishes so, within the term of two months.
4. Upon request from the interested party, filed in due time, the term to which the preceding number refers may be extended for one additional month.
5. There only may be granted new extensions, for equal periods, if a just reason would occur and no opposition should be raised by the opposite party.
6. It is incumbent upon the holder of the registration or his licensee, if there is one, to show the use of the trademark, without which this is presumed as not being used.
7. Once elapsed the term for a reply, the National Institute of Industrial Property shall decide, within two months term, on the declaration of lapse of the registration.
8. The proceedings of lapse shall expire if, before the decision, the waiving of the application shall occur.
9. The lapse shall only have effect after having been declared in a proceeding, which runs their terms before the National Institute of Industrial Property.
10. The lapse shall be recorded and notice thereof shall be published in the Industrial Property Bulletin.

II. Procedural Issues

If the request for cancellation of a trademark registration is based on non-use, this request should be addressed to the Trademark Office. In this case, an inversion of the general rules regarding the burden of the evidence occurs. In fact, the proof that the trademark has been used should be presented to the Trademark Office by the trademark owner.

The applicant for a trademark which is being opposed on the basis of an earlier trademark that has been registered for over 5 years cannot call for evidence of use.

In this case, the applicant would be required to file a separate non-use cancellation action before the Trademark Office and then ask for the stay of the opposition procedure until the cancellation action is terminated.

If the Trademark Office subsequently partially cancels the opposing registration, the opposition will

be based only on the subsisting goods or services.

If no cancellation action is introduced, the opposition procedure continues, and the earlier right is deemed to cover all the goods and services in the registration.

The cancellation of trademarks registrations may also occur due to other reasons: e.g. similarity with prior marks or other distinctive signs, descriptiveness, etc. In all these cases the request for the trademark registration cancellation should be brought before a civil Court.

III. Conclusion and Comments

We are not aware of any Court decision which expressly addresses the issue of whether or not a partial cancellation of a trademark registration is possible. However, the reason for this seems to be that the Law clearly provides for partial cancellation and/or refusal of trademarks and in fact this is has been the Trademark Office common practice.

However, the Portuguese Courts did not adopt the “rewriting” approach of the UK Courts.

In fact, the Civil and Commercial Courts have very limited *ex officio* powers and it is unlikely that a judge would ever consider himself in a position to re-write a list of goods.

ROMANIA

I. Statutory Provisions

In respect of the cancellation for non-use, referred to by the Law on Trademarks and Geographical Indications as "revocation," the doctrine provides a general accepted definition: the act of revoking the legal effects of a right forward, from the moment revocation was decided upon.

In Romania, the provisions dealing with cancellation of trademarks for non-use are set out in chapter VIII (Loss of Rights in a Mark) of the Trademark Law no.84/1998. Article 45 of the Law no.84/1998 provides that any concerned person may apply to the Bucharest City Court, at any time during the term of protection of the mark, for revocation of the owner of the rights conferred by the mark for the following reasons:

- a) If, within a continuous period of five years, the mark has not been put to genuine use in the territory of Romania in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use;

Article 46 of the same law outlines that the rights of the owner may not be revoked if, in the time between expiry of the period referred to in item (a) of Article 45 and the submission of the request for revocation, the mark has been subject to effective use. However, if the beginning or resumption of use of the mark takes place within the three months preceding submission to the courts of the request for revocation, use of the mark shall not be taken into consideration if preparation for the beginning or resumption of use has been made only after the owner obtained knowledge of the intention to submit a request for revocation.

In relation to cancellation for non-use, "use" is defined as: effective, real, serious and unequivocal use in the Romanian territory for an uninterrupted period of 5 years for the products and/or services for which the trademark was registered. The burden of proof of use of the mark is with the owner of the mark and proof may be furnished by any means.

Further, Article 50 of the Romanian Trademark Law no.84/1998 provide that where grounds for revocation or invalidity exist in respect of only some of the goods or services for which the trademark is registered, revocation shall have effect only with respect to those goods or services only. Revocation of the rights conferred by a mark shall take effect as from the date of the final court decision.

The applicant for a trademark that is being opposed on the basis of an earlier trademark that has been registered for over 5 years can call for evidence of use. In the absence of the evidence for the use of the opposed mark, within the prescribed deadline, the opposition document shall be rejected.

Consequently, in practice the procedure in respect of a pending application for registration of a trademark shall be suspended as per request of the applicant, if an application for revocation of the registration of the opposed earlier trademark has been filed. In a similar way following the provisional refusals issued as a consequence of a substantive examination done by the State Office, suspension of the procedure may be requested on the basis of a revocation of the registration introduced before the Court.

II. Procedural Issues

For the time being, requests for cancellation can only be raised in the course of a civil procedure, be it by means of a cancellation action or by means of a counter-claim in response to an infringement action brought by the trademark owner.

Regulation for Implementing the Romanian Trademark Law no.84/1998 contains specific regulation regarding the request of cancellation of a mark. In particular Rule 32 (1) provide that a request of cancellation of the holder's right conferred by the mark may be formulated by any person concerned, for the reasons of non-use within a continuous period of five years, at the Law Court of Bucharest - Civil Department.

Decisions of the Bucharest City Court given in the cases of trademarks cancellation may be appealed from to the Bucharest Appeals Court within 30 days as from their notification.

The person concerned shall communicate the final and irrevocable judgement, by which the holder is lapsed from the right conferred by the mark, to the Romanian State Office for Inventions and Trade Marks (O.S.I.M.) O.S.I.M shall publish the decision in Official Gazette and shall mention this in the National Register of the Marks.

III. Case Law

1. High Court of Cassation and Justice (I.C.C.J.), Civil and Intellectual Property Section, decision no, 4089 of May 18th 2007.

On 7 December 2005 the plaintiff S.C. E. S.R.L. summoned to trial the defendant S.C. M.C.I. S.R.L. and requested the court to rule the termination of the defendant's rights on the ELITE trademark for meat and meat products, class 29.

In its statement of grounds, the plaintiff proved that it had filed with O.S.I.M. an application for the registration of the combined individual trademark "Gustul desăvârșit ELITE", which was rejected by decision no. 213909/2005 on the grounds that the previously registered trademark MN 33188- E was identified for similar goods in class 29, owned by the defendant company.

However, the defendant claims that the ELITE trademark was never used in the Romanian territory by the defendant during the past 5 years for goods in class 29, especially for meat and meat products. The defendant company, owner of the trademark, handles wrapping manufacture – according to its website – and has not performed activities in the field of food production during the past 5 years.

The defendant filed the statement of defence and requested the rejection of the claim stating that on 15 July 1997 it was granted the right to the ELITE trademark by registration with O.S.I.M. under no. 033188 for the goods and services in classes 29, 35 and 39 and since the registration date until today the trademark was actually used in the Romanian territory for all categories of goods in class 29.

The defendant filed a counterclaim requesting that the decision to be ruled should forbid the plaintiff to sell goods bearing the mark Gustul Desăvârșit Elite.

By the civil decision no. 776 of 7 June 2006, the Bucharest Court – 3rd Civil Section rejected the request of termination of the trademark right.

By the civil decision no. 776 of 7 June 2006, the Bucharest Court of Appeal – 9th Civil and Intellectual Property Section accepted the appeal filed by the plaintiff, amended the decision in its entirety, accepted the action and ordered the termination of the defendant's rights on the trademark ELITE no. 33188 regarding the meat and meat products and, at the same time, it ordered the defendant to pay the amount of RON 20.15 as trial expenses.

2. I.C.C.J. Civil and Intellectual Property Section, civil decision no. 2245 of 9 May 2007

By the claim registered on 3 February 2004, the plaintiff SC O.R.I.E. SRL summoned to trial the defendant O.B–U. H. GMBH & CO. K.S. versus O.S.I.M., requesting the termination of the defendant's rights granted by the registration on the Romanian territory of the trademarks:

- "OBI", registered on 06.02.1995 under no. 635568/21 March 1995 with the World Intellectual Property Office within WIPO, word mark registered for classes of goods and services no. 1, 2, 5, 7, 8, 9, 11, 16, 17, 19, 20, 21, 24, 27 and 31 according to the Nice classification and that includes a figurative element registered under no. 03.05.05, 25.07.20, 26.04.02, 26.04.08, 27.05.01 according to the classification provided for by the Vienna Arrangement, trademark that is also protected in Romania;

- "OBI", registered on 28.07.1995 under no. 646003/20 September 1995 with the World Intellectual Property Office within WIPO, word mark registered for classes of goods and services no. 1, 2, 5, 6, 7, 8, 9, 11, 16, 17, 19, 20, 21, 24, 27 and 31, having Romania designated among the countries in which it is protected;

- "OBI", registered on 18.05.1998 under no. 700415/20.08.1998 with the World Intellectual Property Office within WIPO, word mark registered for classes of goods and services no. 1, 2, 5, 6, 7, 8, 9, 11, 16, 17, 19, 20, 21, 24, 27 and 31 and that includes a figurative element registered under no. 03.05.05, 27.05.01, 29.01.01, 29.01.08 and having as claimed colours black, white and orange, trademark that is also protected in Romania;

It also requested to order O.S.I.M. to delete the above-mentioned trademarks from the National Trade Mark Registry and to order the first defendant to pay the trial expenses caused by this case.

The plaintiff stated that the three trademarks owned by the German company have not been the object of an actual use by neither by the defendant, nor by any other person in the Romanian territory during a continuous period of over 5 years.

The plaintiff claimed to have a legitimate interest in filing the claim, as it is the owner of two trademarks registered in Romania under no. 43164 on 13 July 2000 for class 35 - import-export services and 45428, respectively, of 24 January 2001 for class 39 – transport (distribution), packaging and storage of goods, the two trademarks being "OBI ROM IMPORT EXPORT". The plaintiff also shows that both trademarks with a figurative element are protected in the Romanian territory for a 10-year period as of the date of their registration and that it is using its registered trademarks and intends to proceed to the diversification of both its production and its services and the defendant's trademarks are a genuine obstacle in achieving these objectives since they are reserve marks, which is against the legal provisions in force.

The defendant claimed that the plaintiff's action was filed too early regarding the OBI trademark with a figurative element internationally registered under no. 700415 and filed for registration with WIPO on 20 August 1998 because the date as of which the 5-year term for the lack of trademark usage for the enforcement of the termination penalty starts not as of the date of filing the registration application but as of the date on which the receiving national office, in this case, the Romanian State Office for Inventions and Trade Marks, registered the trademark accepted for registration in Romania with the National Trade Mark Registry.

The defendant also invoked the defendant's lack of interest in filing the claim on the grounds that it failed to prove the status of "interested party" in the meaning of Art. 45 of the Trade Mark Law and Rule 32 of the Regulation. As these are different trademarks registered for different classes of goods and services, the defendant's mere statement that it intends to diversify its own production and services rendered under the OBI ROM IMPORT EXPORT trademark is not likely to make it an interested party in claiming the defendant's termination of the rights derived from its OBI trademarks.

By the civil decision no. 110 of 14 February 2005, the Bucharest Court – 5th Civil Section rejected as lacking grounds the exception of the premature action invoked by the defendant regarding the "OBI" trademark registered in 1998, accepted the exception of the defendant's lack of interest in

filing the claim and rejected the action on the grounds of this exception.

By the civil decision no. 51 A of 20 April 2006, the Bucharest Court of Appeal – 9th Civil and Intellectual Property Section rejected the appeal lodged by the plaintiff due to the lack of grounds.

IV. Conclusions and Comments

The above-cited cases show that Romanian Courts do not allow maintaining of registrations that were not put in genuine use for a period of five years and by giving in this way the possibilities to interested parties to offer their goods and services on the market in the benefit of consumers. As such court cases, where trademarks revocation are requested, very often appear due to the maintaining for this moment of the substantive examination by the Romanian Trademark Office, it is quite difficult for the owners who justify entry on the market because they have to spend a large amount with those trials.

On the other side, the consumers' culture has changed and consumption needs are different. In this context, some companies must level their offer to the competition or even exceed this level, extend their range of products and take a different stand.

SPAIN

I. Statutory Provisions

1. Revocation for non-use in Spain

The Spanish TM law n. 17/2001 in force, under Article 55 of the Law 17/2001, provides for the following:

“A trademark shall be revoked and the registration shall be cancelled:

- (1) Where the tm. has not been renewed in accordance with the provisions of the Article 32 of the present Law.*
- (2) Where the tm. has been voluntary surrendered by its owner.*
- (3) Where the tm. has not been used in accordance with the Article 39 of the present Law.*
- (4) [...]*

According to Spanish law, revocation for non-use of a TM may be declared by Spanish court.

The general principle on the basis of an action of cancellation for non-use is that a registered mark may be revoked if it has not been put into genuine use for a determinate period of time for the goods/services for which it is registered .

In particular, the Spanish provision related to the use of a trademark (Article 39 L. 17/2001) states that:

“Where no effective and real use of a trademark has been made in Spain on the goods or services for which the trademark was registered within a period of five years from the date of publication of the notice of registration, or where such use has been suspended for an uninterrupted period of five years, the trademark shall be subject to the sanctions provided by this Law, unless there are proper reason for non-use”.

It is also important to note that under the Article 58 of the Law 17/2001:

“In a revocation proceeding for non-use of the trademark, the trademark owner shall demonstrate that the use of the mark has been made in accordance with Article 39 or that there are reasons able to justify the non-use.

The trademark shall not be revoked where during the time between the expiration of the five-years period [...] and the filing of revocation action, an effective use of the mark has been started or resumed.

However, commencement or resumption of the use within a three-months period preceding the

filing of the revocation action (which period may not commence before expiry of the continuous period of five-years of non-use) shall not taken into consideration if preparation for commencement or resumption of use start after the owner have become aware that revocation action may be filed”.

2. Partial Revocation

It is interesting to note that, even though the partial revocation was provided in the Spanish Trademark law since 1988, under Spanish law the application of the same has not always been easy.

2.1 The provisions before the actual law on partial revocation.

The Trademark Law in force before Law no. 17/2001, i.e. Law no. 32/1988, included two separate articles on “partial” invalidity and “partial” revocation (Article 39 for the partial invalidity and Article 54 for partial revocation).

On the one hand, those articles started from the premise that the grounds of invalidity or revocation relate to only a part of the products or services designated.

On the other hand, with reference to revocation for non-use the same law, under art. 4.4, provided that “the use of a mark for a single product or a single service is enough to save the use of all the products and services of the class of the Nice classification”.

Those provisions were clearly in conflict, and as we will see, Spanish courts had to claim the principle of the EC directive on the use of marks, to overcome the same.

2.2 The actual rules: art. 60 of law no. 17/2001

The new Spanish Trademark Act, entered into force on 2001 (Law 17/2001), brought Spanish trademark Law into line with Community and international trademark provisions and provides a regulation of the invalidity and partial revocation strictly similar to those of many European countries.

The actual Trademark Law, incorporated into a single article, the two provisions on partial invalidity and partial revocation maintaining the same substance of the previous Law.

According to Article 60 of the Law 17/2001 (“Invalidity or partial revocation”):

“If the ground of invalidity or revocation only exists with respect to some of the goods or services for which the trademark has been registered, the declaration will be referred only to the goods and services in concern”.

2.3 Revocation for non-use

In view of what provided by Article 39 of Spanish Trademark Law and this article, the effects of an

action of revocation should refer only to the goods the goods and services in concern.

On the basis of the absence of a reference to the classification of Nice in the actual law, as well as the case-law we will examine, we can affirm that it is possible to have partial revocation of a mark only with reference to some goods included in one class but not with reference to other.

Furthermore, it seems to us that the Spanish law in principle admits that a list of goods and service may be re-written, however to the best of our knowledge there is not case law.

II. Case Law

Audencia Provincial de Pamplona: July 5, 1996. This judgment refers to the previous law, and provided that “the provisions included in art. 4.4,[...] which extend the proof of use of a good to the whole class of the Nice classification in which the good is included, may be not considered as a principle of the law, since it would make not applicable Article 54 of the law, which provide the partial revocation”.

Tribunal Supremo, June 24, 2002: This judgment confirms the position of the judges of Pamplona affirming that “the content of Article 4.4 does not comply with what stated by the EC directive 89/104 CEE”.

III. Conclusion and Comments

The provision of the Article 60 represents a substantial continuation with the old provision but also an innovation on the Spanish trademark regulation.

On a substantial point of view, the new Trademark Law foresees (as far as the previous Law) the possibility that *revocation* relates to only a part of the products or services designated by the registration; in such a case, cancellation shall only apply to those goods or services. It is clear that the intent of this provision is to underline the close relationship that must exist between trademark and the related goods and services.

On the other hand, the new provision represents an innovation on a systematic point of view since, as mentioned, all of the previous rules are put in the same provision.

SWEDEN

I. Statutory Provisions

The provision of partial cancellation (invalidation) was implemented in the Swedish Trademarks Act on January 1, 1993, in order to comply with the EC Directives (First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trademarks) Articles 10 – 13, due to Sweden's entry into the European Community in 1995. Prior to the mentioned date, partial cancellation of a trademark was not possible in Sweden.

Article 25a and 25b of the Trademarks Act (Law No. 644 of December 2, 1960,) deals with cancellation and partial cancellation of trademarks due to non-use, which reads as follows:

Article 25a

If, within five years from the completion of the registration procedure, the owner of a registered trademark has not put the trademark to genuine use in this country in connection with the goods for which it has been registered or if such use has been suspended for an uninterrupted period of five years, the registration may be terminated, unless there are proper reasons for the non-use.

The following shall also constitute use within the meaning of the first paragraph

- 1) the use of the trademark in a form differing from the registered one, where the difference concerns only insignificant elements and do not alter the distinctive character of the mark, and
- 2) the affixing of the trademark to goods or to the packaging thereof in the country solely for export purposes

The use of the trademark by someone else with the consent of the owner shall be deemed to constitute use by the owner. The registration may, however, not be invalidated where the trademark has been put into genuine use during the interval between the expiry of the first five-year period and the application for invalidation of the registrations. Use which has commenced or has resumed after the expiry of the five years period but within the three months preceding the filing of the application shall, however, be disregarded where the preparations for the commencement of the resumption occur only after the owner becomes aware of the fact that an application for invalidation may be filed.

Article 25b

Where grounds for invalidation exist only in respect of part of the goods for which the trademark

has been registered, the registration shall be invalidated only as regards those goods.

II. Procedural Issues

Anyone to whom a registration is *detrimenta*, may bring an action in a Court of law (District Court) for the cancellation of the registration. Also in an infringement case, the defendant may bring a counterclaim to have the registration cancelled or partly cancelled due to non-use.

With regard to the competence of the Court, the District Court of Stockholm (Stockholms Tingsrätt) shall be competent where the owner of the registration does not have its domicile in Sweden. For companies or persons (defendant) domiciled in Sweden, the competent court is the District Court where the board of directors has its headquarters in accordance with the articles of incorporation, and for physical persons the District Court at the place of residence of the person in question.

In Sweden, it is presently not possible to have a mark cancelled by administrative proceedings. However, a new Trademark Law is about to be implemented in Sweden, most likely in mid 2009. According to the proposed bill, it will be possible to apply for cancellation and partial cancellation of a trademark registration to the Swedish Patent and Registration Office (PRV) due to non-use. However, if the holder of the right contests the cancellation claim the case will be transferred to the appropriate court.

III. Case Law

There are only a few court cases in Sweden dealing with the question of partial cancellation due to non-use, most of them from District Courts and only one from the Court of Appeal.

The first time partial cancellation was considered was in the **TRIUMF**¹ case. The mark was registered for "*marmalade, jam, dried and preserved fruit*" in Class 29 and for "*chocolate, cocoa, tea, biscuits, glucose, caramels (candy), liquorice, honey, pastry and confectionery*" in class 30. It was proven that the mark had been used for "*waffles*" (for ice cream or cream). However, "*waffles*" was not listed in the specification of goods and the use of the mark for "*waffles*" was not regarded as evidence of use in relation to the other goods why the court cancelled the entire registration. According to the court, it had not been showed that "*waffles*" could be regarded as a product covered by the more general descriptions "*biscuits*" or "*confectionery*".

The trademark **EQUISTRO**² was registered for inter alia "*ointments (for wounds), healing ointments;diagnostic preparations for veterinary purposes; veterinary preparations; pharmaceuticals; plaster; materials for dressings; bandages (hygienic or for wounds) dietetic substances; dietetic feedstuff; medical supplemental feedstuff, mineral feedstuff; and mineral substances for medical use; vitamins; electrolytes containing inorganic salts, trace elements and*

other minerals for veterinarian purposes” in class 5. The mark had been used for “*ointments (for wounds)*” for the treatment of horses (cl 5) and for “*feedstuff, supplemental feedstuff (not for medical purposes)*” for horses (cl 31) and was marketed as “*pharmaceuticals*”. Since none of the goods had been approved as a “*pharmaceutical*” in Sweden, the court cancelled the mark for all the goods except for “*ointments (for wounds)*” and “*healing ointments*”.

In the **TRIPP TRAPP**³ case the trademark was registered for “*furniture; chairs*” in class 20. The mark was used on an *adjustable chair for children*. The court stated that the use was enough to prove use in relation to “*chairs*” – not only chairs for children - and also in relation to broader description “*furniture*” and the registrations was not cancelled.

In **THE HOME DEPOT**⁴ case, not only partial cancellation, but also the right to plead before the court, was the issue. The mark THE HOME DEPOT was registered for inter alia the goods “*building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.*” The claimant requested cancellation of all goods except for “*sawn timber; non-metallic transportable buildings; vinyl windows; and roof truss*”, due to non-use. Even if use could be proven only for some specific goods the registration was maintained for all the goods apart from those admitted by the defendant, namely for “*asphalt, pitch and bitumen*” and “*monuments, not of metal.*”. The reason was that these used goods were *representative* for the broader description.

This case was appealed to the Svea Court of Appeal who reversed the decision by the District court due to claimant’s lack of right to plead before court. The Court of Appeal did not find that the registration of inter alia the defendant’s registration THE HOME DEPOT was *detrimental* to the claimant, since the claimant’s base registration for this case, a Benelux registration, had been revoked. This revocation had also effect on the validity of the international registration in Sweden.

This decision has been appealed to the Supreme Court and a *leave to appeal* has been granted.

The trademark **CLASSIC**⁵ (three registrations) was registered for, inter alia, the goods according to the class headings of 29, 30, 31, and 32. It was incontestable that the mark has been used for the goods “*coffee*” and to some extent also for “*chocolate*”. The Court cancelled all the goods in the aforementioned classes apart from “*coffee, artificial coffee, tea, cocoa, sugar and chocolate*” in class 30 and coffee (raw beans) in class 31. The court’s motivations for not revoking the mark for goods which the mark had not been used for, namely “*artificial “coffee, tea and cocoa” and “raw beans”*”, was that these goods were regarded as very similar to coffee and “*sugar*” since this product were used in close relation to the goods “*coffee*”, since sugar is often served together with coffee. The goods “*milk*”, which also is often used in connection with “*coffee*” were though cancelled.

IV. Conclusion and Comments

Since the cancellation cases are dealt with at the courts of law, the proceedings are relatively expensive and time consuming. For example, the losing party usually ends up paying the costs of the winning party.

The new proposed system, which allows the Patent Office to cancel all registrations not contested, will in most cases make it much easier and more cost efficient to have registrations cancelled or partly cancelled due to non-use in Sweden.

Even if it is very difficult to draw a conclusion based on the above referred cases, given the fact that there are only a few cases and almost all are from district courts, the following seems fairly safe to state: the Swedish Courts will probably allow fairly general descriptions, as long as the goods for which the mark is used, are “representative” for the broader description used in the list of goods. For example, the use of a mark in connection with “chairs” will not revoke the goods “furniture” or the use of a mark on a “spoon” will probably be enough to maintain a registration for “cutlery”. It is also likely that use on a specific product will save the registration for very similar goods (coffee = tea, cocoa). However, we are still waiting for rulings by the appellate courts and the Supreme Court in Sweden and of course by the ECJ.

¹ Ludwig Chokolade GmbH v Oy Karl Fazer AB (Stockholm District court, DT 551/94, 1994-09-02)

² Pharmedica GmbH v American Cyanid Company (Stockholm District court, T 11666-98, 2002-03-11)

³ Trip Trap Denmark A/S v Stokke Gruppen AS (Stockholm District Court, T4943-02, 2004-05-07)

⁴ Demp B.V v Homer TLC Inc. (Stockholm District Court, T 15983-02.2004-11-25, Svea Court of Appeal, T 9815-04)

⁵ Lidl Stiftung & Co.KG v Arvid Nordquist Handelsbolag (Svea Court of Appeal, T 2856-05, 2005-12-07)

SWITZERLAND

I. Statutory Provisions

The Swiss provisions dealing with the cancellation of trademark registration for non-use are set out in Art. 12 of the Swiss Federal Law on the Protection of Trademarks and Indications of Source (of August 28, 1992; as amended; "Swiss Trademark Act") which states:

(1) If the owner has failed to use the trademark in connection with the goods and services for which it has been claimed, for an uninterrupted period of five years following expiry without opposition of the time limit for opposition or following termination of opposition proceedings, the owner may no longer assert the rights in the trademark unless there exist important reasons for the failure to use.

(2) If use of the trademark occurs for the first time or is resumed after more than five years, the rights in the trademark shall be restored with effect from the original priority date, unless non-use of the trademark in accordance with paragraph (1) has been invoked prior to the time of first or resumed use.

(3) Any person who invokes non-use of a trademark shall be required to substantiate the claim; evidence of use shall then be required of the owner of the trademark.

The Swiss Trademark Act does not contain any provision regarding the situation where grounds for cancellation exist in respect of only a part of the goods or services for which the trademark is registered.

Still, it is uncontested under Swiss law that in such case cancellation shall relate to those goods or services only.

The issue is to determine the goods and/services for which a trademark has been used or may be cancelled for lack of use, respectively.

II. Procedural Issues

Swiss law does not provide for an administrative procedure admitting requests for trademark cancellations because of non-use. However, the Swiss legislature, which is currently revising the Swiss Trademark Act, is considering introducing such a procedure. In particular, the Swiss legislature is scrutinizing the possible models of Art. 50 of the Community Trade Mark Regulation (Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark; as amended) and of § 53 of the German Trademark Act of 25 October 1994 (as amended).

For the time being, requests for cancellation can only be raised in the course of a civil procedure,

be it by means of a cancellation action or be it by means of a counter-claim in response to an infringement action brought by the trademark owner. The court competent for the infringement issue will decide both claim and counter-claim.

III. Case Law

The often non unanimous Swiss legal doctrine and Swiss courts have developed principles to answer the following basic question related to cancellation issues based on partial non-use:

Shall the use of the trademark for a specific product (good or service) be regarded as use just for this specific product or also as use for other products contained in the registered list of goods and services, in particular for registered class headings (according to the Nice classification system)?

The Swiss legal doctrine distinguishes between (1) cancellation issues, on the one hand, and (2) infringement issues, on the other hand.

(1) In case of cancellation actions (or cancellation requests brought by means of counter-claims following infringement actions), the use of a specific product is regarded as use of the registered class heading and/or other registered specific products falling under this class heading, if the specific product commercialized is *typical* for this class heading.

Accordingly, in Swiss case law the use of a trademark for the following specific products was regarded as proper use for the subsequently mentioned *registered* class headings:

- (5) "remedies [vegetable substances]" for "pharmaceutical preparations" (class 5);
- (6) "drawer liners of paper" for "paper" (class 16);
- (7) "solitary game" [one specific game, not very popular in Switzerland] for "games" (class 28; the decision may be regarded as overly liberal);
- (8) "cheese" for "milk products" (class 29);
- (9) "yoghurt" for "milk products" (class 29);
- (10) "cigars" for "tobacco" (class 34).

The Swiss legal doctrine has added the following examples, often based on foreign precedents, concerning actually used specific products and *registered* class headings:

- (3) The use for "MP3 players" is proper use for "apparatus for recording, transmission or reproduction of sound or images" (class 9);
- (4) the use for "chairs" is proper use for "furniture" (class 20; a part of the Swiss legal doctrine is dissenting);

(5) the use for "suits" is proper use for "clothing" (class 25);

(6) the use for "softly stuffed plush toys" is not proper use for "playthings", but proper use for "plush toys" (class 28).

In case a class heading is quite broad or comprises entirely different products, the Swiss legal doctrine proposes splitting the class heading into "class sub-headings", i.e., the use of a specific product would be regarded as proper usage of a "class sub-heading" only.

For instance, the use of a trademark for "baby carriages" is not regarded as proper trademark use for "vehicles" (class 12).

Accordingly, a Swiss court did not regard the use of a trademark for "alarm clocks" as proper use for "watches" (class 14; the decision may be regarded as overly strict).

(2) In case of infringement actions, i.e., in case the court shall determine whether risk of confusion exists, the court shall just look at the products for which the trademark owner is actually using its trademark, provided that the five-year non-use grace period has expired, and shall conclude whether these products are identical, similar, or dissimilar to the products for which the potential infringer is using its trademark.

In other terms: A trademark registered for "tobacco" (class 34) is properly used as a trademark if it is just used for "cigars" (see above ad (1)). However, if the trademark owner brings an infringement action based on such trademark, the court shall consider that the trademark is only being used for "cigars" and determine whether "cigars", and not whether "tobacco", are identical, similar, or dissimilar to the potential infringer's products.

IV. Conclusion and Comments

While the Swiss Trademark Act does not contain provisions concerning partial cancellation of trademarks because of non-use, it is uncontested that such partial cancellation actions may be brought.

If a trademark cancellation for non-use is at issue, the use of a specific product shall be regarded as proper trademark usage for the registered class heading and/or other registered specific products falling under this class heading if the specific product commercialized is *typical* for this class heading.

In case of an infringement issue, once the five-year non-use grace period has expired, only the products for which the trademark owner is actually using its trademark shall be taken into account to determine whether the trademark owner's and the potential infringer's products are identical, similar, or dissimilar. According to Swiss legal doctrine, this look at the products actually used by the trademark owner makes sure that it does not matter whether the trademark owner has

originally registered its trademark for a class heading and/or for specific products falling there under.

V. Relevant Swiss Legal Doctrine

- (2) BÜRGI LOCATELLI KARIN, Der rechtserhaltende Markengebrauch in der Schweiz, Berne 2008
- (3) DAVID LUCAS, Markenschutzgesetz, Muster- und Modellgesetz, Treatise, in: Honsell Heinrich/Vogt Nedim Peter/David Lucas (ed.), 2nd ed., Basle et al. 1999
- (4) MARBACH EUGEN, Markenrecht, in: von Büren Roland/David Lucas (ed.), SIWR III, Basel/Frankfurt a.M. 1996
- (5) MEIER ERIC, L'obligation d'usage en droit des marques, Geneva et al. 2005
- (6) WILLI CHRISTOPH, MSchG. Markenschutzgesetz, Treatise, Zurich 2002

UKRAINE

I. Statutory Provisions

Relevant provisions concerning partial non-use cancellation are comprised in Article 18, paragraph 4 of the current trademark law (with revisions of 22 May 2003) which read:

“In case of non-use of a mark, for all or for part of goods and services listed in the certificate, in Ukraine within three years from the date of publication of the mention of grant of a certificate, or from another date after this publication, any person may make an application for full or partial cancellation of the certificate to a court.

In this case a certificate may be cancelled in full or in part unless a certificate owner informs on good reasons that prevented him from such use. Such good reasons particularly include:

- circumstances preventing the certificate owner from using his trademark independent of his will, in particular limitation of import or imposing other requirement to goods and services by the law;
- likelihood of misleading consumers as to the manufacturer or person rendering services arising in the course of use of the trademark by the person who applied to the court or by another person for goods and services in respect of which cancellation of the certificate is being sought.

For the purpose of this clause the use of a trademark is also constituted by its use by a third person, provided such use is under control of the certificate owner.

(p. 4 included in Art. 18 under the Law N 850-IV of May 22, 2003)

Under the Ukrainian trademark law, use of a trademark is constituted by its application on goods for which it was registered, their package, signboards related to these goods, labels, tabs, tags or any other subjects fixed to the goods, storing goods bearing the said mark for the purpose of offering for sale, offering these goods for sale, sales, importation and exportation of these goods; its use in relation to rendering or offering any service in respect of which it has been registered; its use in business papers or advertising, as well as on the Internet, including use in domain names.

The trademark is deemed to be used if it is used in the form of the sign as registered, as well as in the form that differs from the registered sign only in certain elements, provided that this does not deteriorate the overall distinctive character of this sign.

Vulnerability for cancellation based on non-use may be avoided if use is initiated or earlier interrupted use is resumed after the expiration of the 3 year non-use grace period. However, this is the case only provided that in the interim no third party has brought a cancellation action against

such a trademark before the court.

In Ukraine a burden of proof in a non-use cancellation action is borne by the plaintiff. It is the plaintiff who has not only to substantiate one's claim, but to also prove that the opponent had not used the contested trademark for an uninterrupted period of 3 years before the date on which the court action was brought. Under certain circumstances and for some categories of goods it may be quite difficult to secure evidences.

The Ukrainian law does not specifically define criteria as to what has to be considered a sufficient use, neither are there clear provisions regarding cancellation in respect of a part of goods and services within a certain class for which the trademark is registered. However, based on the general provisions of the trademark law, a registration has to be cancelled only with regard to those goods and services for which the mark has not been used.

II. Procedural Issues

There is no administrative procedure for non-use cancellation actions. A trademark registration may be cancelled only before the court.

A trademark registration may be cancelled on the grounds of non-use through a cancellation action or a counter-claim brought in response to an infringement action against the trademark holder. The procedure is governed by general rules of civil procedure, or, where one of the parties is a legal entity, by the rules of commercial procedure.

A cancellation action may be brought before the court by an interested party, which means that the plaintiff must also show that he has a legitimate interest which is impaired by the existence of such an inactive registration.

Furthermore, as mentioned above, according to procedure rules, particularly under Article 33 of the Commercial Procedure Code, each party has to prove circumstances on which their claim is based. Thus, a burden of proof is borne by the plaintiff who has to secure evidences of non-use of the contested mark.

III. Case Law

To date the Ukrainian courts have developed certain approaches as to which evidences of non-use may be treated as due. This particularly relates to goods and services which require certification or licensing. For example, if a partial cancellation action is brought with regard to the trademark registered, among others, in class 33 (alcohol) or class 34 (tobacco), due evidences may be secured through obtaining extracts from the State Department of Provisions of Ukraine, the State Committee on Technical Regulation and Consumers Policies, the Department on Administration of

Excise Tax and Control of Manufacture and Distribution of Excise Goods, etc. All these agencies are responsible for certification and issuance of excise labels which are pre-requisites for marketing this type of products.

If the defendant is a foreign entity, supporting evidence of non-use may be qualified an extract from the Companies Register showing that this entity does not have any affiliates or representative offices in Ukraine. Further supporting evidences may be provided by the State Customs Service of Ukraine (however, these evidences may be secured by the plaintiff only through the court by filing a respective motion).

The current legal doctrine has not developed approaches to qualification of use for a specific product within a broad category; particularly, there is no clear answer whether such use may be qualified as sufficient. However, for the most part a more general approach is used by courts where the use for shirts is treated as a sufficient use for the heading of class 25 “clothing”, etc.

In each case, the court considers for which goods and services the contested trademark was registered and which evidences supporting use of this mark are provided by the defendant, but in most cases the use of a trademark for a specific kind of goods should be sufficient to maintain the registration for the respective category expressed in a class heading.

Supreme Arbitration Court of Ukraine, decision in case no. 6/42 of 1 June 1999; Reemstma Cigarettenfabriken GmbH v.s. Hugo Boss AG

The Plaintiff brought a court action against IR 516345 for partial cancellation based on non-use for the goods of class 34. According to the Plaintiff, the owner of contested trademark “**BOSS**” had not performed any action listed in Article 16 of the trademark law which would have evidenced of its use in the period since the publication of the notice of grant (namely as of 7 April 1993).

The Plaintiff provided extracts from the Trade Register according to which the main business activities of the Defendant were textile processing, manufacturing of clothing and sales of textile, clothing and accessories. At the same time, as follows from this document, the goods of class 34 such as tobacco, smoking appliances and matches are not subject to the Defendant’s activities.

The Defendant substantiated its interests stating that the existence of this registration would create obstacles to the use of the “BOSS” sign for tobacco goods. The Defendant also alleged that such actions were performed with an intent and constitutes an act of unfair competition.

As further evidences of non-use, the Plaintiff submitted documents from the Ukrainian Research and Development Institute of Standardisation, Certification and Information under the State Committee on Technical Regulation and Consumers Policies, as well as from SOCIS Gallup International evidencing that as of 7 April 1993 there were no goods bearing the word mark “BOSS” introduced in the Register of Certified Products, as well as that in the period since 1997

until April 1999 there was no advertising for the tobacco goods under the trademark “BOSS” either in press, or as an outside advertising.

Having considered all submitted evidences and having found that no evidence of genuine use of the “**BOSS**” trademark or serious circumstances which prevented the Defendant from such use were submitted, the court upheld the decisions of the courts of first and appellate instances awarding the claim. The court resolved to cancel IR 516345 (**BOSS**) for all goods of class 34 in Ukraine.

Similarly Ukrainian parts of other six international registrations of Hugo Boss AG were partially cancelled for the goods of class 34.

IV. Conclusion and Comments

The overall Ukrainian legal doctrine has been flexible enough in allowing partial cancellation of trademark registrations, particularly on the grounds of non-use. At the same time, there is no established common court practice in limitation of the list of goods and services in registrations subject to partial cancellation. A court non-use cancellation action may be cost and time-consuming and is complicated in that the burden of proof is shifted towards the Plaintiff who also must prove his legitimate interest which is impaired by such an inactive registration.

UNITED KINGDOM

I. Statutory Provisions

In the UK, the provisions dealing with revocation of trademarks for non-use are set out in section 46 of the Trade Marks Act 1994 (the "TMA 1994"). Section 46(1) provides among other things that the registration of a trademark may be revoked on the grounds:

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use¹;

(b) that such use has been suspended for an uninterrupted period of five years and there are no proper reasons for non-use²;

Section 46(5) provides:

Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

In the UK, an application for revocation under section 46 can be made in one of two ways. An application can be made to the UK Trade Marks Registry seeking revocation or partial revocation. Alternatively, revocation can be (and often is) raised by a defendant by way of a counterclaim in infringement proceedings brought by the proprietor of a trademark registration, in which case the application for revocation will be heard by the court deciding the issue of infringement.

The issue of revocation can have a significant impact on that of infringement. The broader the specification of goods the proprietor is left with, the wider the range of goods and services which are likely to be considered identical or similar to those covered by the mark and, therefore, infringe.

It will often be clear whether or not the proprietor of the mark in question has put the mark to genuine use and, if so, for which goods or services. There will, in many cases, be little difficulty in identifying which of the goods or services included in the specification should be deleted from the registration on the ground that there has been no genuine use within the relevant period.

In some cases, however, issues can arise over the extent to which the specification of goods or services should be cut down. The problem is particularly acute in cases of specifications covering general or collective terms such as "pharmaceutical preparations", "computer software" or "financial services" where the proprietor is likely to have used the mark only on a limited range of the goods or services covered.

¹ section 46(1)(a) TMA 1994

² section 46(1)(b) TMA 1994

II. Case Law

In the first cases decided by the UK courts applying section 46(5), there was a clear difference of judicial opinion as to whether section 46(5) entitles the tribunal in question (i.e. the court or the Trade Marks Registry) to "rewrite" the specification or merely delete from the specification those goods or services for which the mark has not been used.

As will be seen below, it is now settled that the tribunal may rewrite the specification of goods and services. The tribunal will strive to reach a fair description which would be used by the average consumer for the products or services in question. The leading cases are examined below.

1. TYPHOO

The first reported decision of the UK High Court in which section 46(5) of the TMA 1994 was considered was the TYPHOO case³. In that case, the claimant's TYPHOO mark was registered for, among other things, "Domestic utensils and containers... combs, brushes... sponges and instruments (non-electric) and materials for cleaning; and glassware, porcelain and earthenware...". The mark had been used for tea canisters, tea pots, mugs and biscuit barrels most of which were either given away for promotional purposes (to promote the claimant's brand of tea) or sold on a "special offer" basis.

The Judge ordered partial revocation of the mark but allowed it to remain registered in respect of "domestic utensils and containers" as well as "glassware, porcelain and earthenware" on the basis that the claimant had shown some use in respect of goods falling within those descriptions. The Judge's reasoning was as follows:

*"It appears to me that one simply looks at the list of items on the register and asks oneself, in relation to each item, whether or not the mark has been used "in relation to" or "in connection with" that item during the last five years. If the answer is in the affirmative, then the mark can remain registered in respect of that item... One does not dig deeper and, as it were, narrow a particular category of item to reflect the extent of the goods to which the mark has been used"*⁴.

2. MINERVA

In the MINERVA case⁵, the Judge, Jacob J, disagreed with the reasoning of the Judge in the TYPHOO case. In MINERVA, the mark was registered for a specification of goods including "paper and paper articles; cardboard and cardboard articles; printed matter; stationery...". The

³ *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767

⁴ *page 808*

⁵ *MINERVA TM* [2000] FSR 734

proprietor demonstrated use on printed forms but there was no evidence of use in relation to books (the goods of interest to the applicant for revocation).

The Judge decided that the term "printed matter" was very broad and that it should be revoked for printed matter other than stationery, holding that in some cases it would inevitably be necessary to "dig deeper". He explained his reasoning in more detail:

"The problem is that some of the language for specifications of goods is apt to be extremely wide... Wide words can cover what are commercially quite different sorts of articles. So if one were to show use for just one of that sort, it would be commercial nonsense to maintain the registration for all goods covered by the wide words".

3. Decon

In the Decon case⁶, the marks in question were registered for "cleaning and decontaminating substances and preparations" and "sanitary substances; disinfectants; sterilising substances and preparations". The claimant had used the mark for a range of cleaning products predominantly for use in laboratories.

The Judge, Pumfrey J, agreed with the approach taken by Jacob J in the MINERVA case that at times it was "inevitable that one is obliged to dig deeper". In deciding that the marks should be limited by the addition of the words "all for non-domestic use", the Judge explained his reasoning:

The problem which is raised in an acute form in this case is how much deeper it is right to dig. It is not possible to draw a list of goods in respect of which the mark has not been used, and it seems to me that the question is the more general one: how should the specification of goods be narrowed to reflect the non-use? In my judgment, the task is best performed by asking what would be a fair specification of goods having regard to the use that the proprietor has in fact made of the mark and assuming that he will continue that use..."

4. MERC

In the MERC case⁷ the registrations in question covered clothing. The proprietor had used the mark for particular types of clothing. Pumfrey J decided that the registration should be revoked for all clothing except the types of clothing for which use had been proved.

5. FREESTYLE

⁶ *Decon Laboratories Ltd v Fred Baker Scientific* [2001] R.P.C. 17

⁷ *DaimlerChrysler AG v Alavi (t/a MERC)* [2001] R.P.C. 42

In the FREESTYLE case⁸ the parties were both in the holiday and travel business, the claimant providing package holidays and the defendant cruise holidays. One of the issues in the case related to partial revocation of the claimant's marks. Following the reasoning in the TYPHOO case, the claimant's registrations were limited, in effect, to package holiday services. The Court of Appeal held that, in order to decide the fairest way to describe the use the proprietor had made of its mark, the court should adopt the mantle of the notional, reasonably well-informed consumer of the relevant products.

6. ESB

In the ESB case⁹ the court held that a registration for "beers" should be restricted to "bitter", (an English-style beer) which the court held was a commercially different product to lager. This seems a surprisingly harsh result given the nature of the products and the likelihood of them being encountered side by side in the same outlets. In the Court of Appeal, the Judge, Pumfrey J, elaborated on the factors to be taken into account. These, he said, included:

"...the intended use of the proprietor's goods, the channels of trade through which they [are] sold and the likely purchasers of the goods..."

7. ANIMAL

In the ANIMAL case¹⁰ the registration in question covered among other things "clothing, footwear, headgear, baseball caps, sweatshirts, and T-shirts...". The proprietor used its mark for a number of different items of surfer style clothing. The defendant sought to limit the mark to "casual surf type wear". The Judge, Jacob J, limited "footwear" to "casual footwear" and limited "headgear" to the particular items for which use had been proved. However, the Judge allowed the proprietor to retain the registration for "clothing". Jacob J provided further guidance on the factors relevant in reaching a fair description of the proprietor's goods:

A lot depends on the nature of the goods - are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made".

In a number of other cases, the tribunals in the UK have given guidance on the correct approach to be taken in relation to particular types of goods and services. For example, in the MERCURY

⁸ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 586

⁹ *West v Fuller, Smith & Turner plc* [2003] FSR 44

¹⁰ *ANIMAL T.M.* [2004] FSR 19

case¹¹ the Judge, Laddie J, held that specifications covering "computer software" will normally be too broad, because computer software is defined by its function rather than just the medium on which it is recorded. Although MERCURY was a case under the previous law¹², it has been cited with approval in a number of subsequent cases, including the MINERVA, Decon, MERC and FREESTYLE cases.

A similar approach has been taken in subsequent decisions in relation to similarly broad collective terms. In the recent WISI case¹³, for example, the term "electrical and electronic apparatus" was held too broad.

III. Conclusion and Comments

In the light of these cases, it is clear that, in the UK, broad terms in trademark specifications such as "printed matter", "electronic apparatus" and "computer software" will generally be regarded as too wide and will be cut back to a fair description of the proprietor's goods. The same approach is likely to be taken in respect of similarly broad terms such as "pharmaceutical preparations" and "financial services". Permitting the tribunal to rewrite specifications, rather than allow merely the deletion of goods or services which have not been used, may help discourage the use of overly-broad, general descriptive terms in specifications of goods and services.

The principles which have been laid down by the courts in rewriting such overly-broad specifications provide useful guidance and in most cases are likely to be sufficient. It is likely, however, that difficult cases will continue to arise. This issue has yet to be considered by the ECJ and, as some UK judges have noted¹⁴, it is likely that at some stage a reference to the ECJ will be necessary to clarify the criteria to be applied in restricting a trademark specification for non-use.

¹¹ *Mercury Communications Limited v Mercury Interactive UK Limited* [1995] FSR 850

¹² Trade Marks Act 1938

¹³ WISI Trade Mark [2006] R.P.C. 22

¹⁴ e.g. Pumfrey J in the MERC case